

O-417-13

TRADE MARKS ACT 1994


IN THE MATTER OF TRADE MARK APPLICATION NO 2 550 256  
IN THE NAME OF ELISABETH ANNE JONES  
TO REGISTER IN CLASSES 18 AND 25 THE TRADE MARK:

*Mimii*  
*www.mimii.co.uk*

AND

OPPOSITION THERETO UNDER NO 101 105  
BY PRADA S.A

**The Background and Pleadings**

1. Elisabeth Anne Jones (EAJ) applied to register the trade mark  [www.mimn.co.uk](http://www.mimn.co.uk) on 11 June 2010. The application was published in the Trade Marks Journal on 23 July 2010 in respect of the following goods:


Class 18:

Leather and animal skin bags and accessories, trunks and travelling bags, handbags, rucksacks, purses, umbrellas and parasols.

Class 25:

Clothing and accessories, scarves, shawls, belts and accessories, footwear, headgear (hats etc).

2. Prada S.A oppose the registration on the basis of Section 5(2)(b) and 5(3) of the Trade Marks Act 1994 based upon the following earlier trade marks:

Earlier trade mark	Filing date	Date of registration	Goods relied upon
2138216A MIU MIU	5 July 1997	2 October 1998	<b>Class 18</b> Handbags, wallets, , shoulder bags keycases, <b>Class 25</b> Clothing for women, coats, raincoats, belts, waistcoats, blouses, pullovers, jackets, trousers, skirts, dresses, suits, shirts, sweaters, gloves, boots, shoes.
2138216B 	5 July 1997	2 October 1998	<b>Class 18</b> Handbags, wallets, , shoulder bags keycases, <b>Class 25</b> Clothing for women, coats, raincoats, belts, waistcoats, blouses, pullovers, jackets, trousers, skirts, dresses, suits, shirts, sweaters, gloves, boots, shoes.

CTM 4253191 MIU MIU	25 January 2005	16 February 2006	Class 18 Leather and imitations of leather and goods made of these materials not included in other classes Class 25 Clothing, shoes, headgear
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3. Prada also oppose on the basis of its common law rights in MIU MIU. It claims this sign has been used in the UK since 1992 in respect of “handbags, wallets, luggage, tote bags, clutch bags, all purpose sports bags, carry-on bags, shoulder bags, clothing for women including: coats, raincoats, belts, waistcoats, blouses, pullovers, jackets, trousers, skirts, dresses suits, shirts, chemises, t-shirts, sweaters, underwear, hosiery, gloves, ties, scarves, hats, caps, boots and shoes, eyewear, keyrings and jewellery”.
4. Under Section 5(2)(b) of the Act, Prada claims that the goods are identical and/or similar and the respective trade marks are similar. As such, there is a likelihood of confusion. Under Section 5(3), Prada claims that use of the contested trade mark would lead to unfair advantage because it would benefit from its earlier marks’ goodwill and reputation. There will also be detriment to the reputation and distinctive character since the applicant’s goods do not reflect the same high end environment used by the opponent when selling its luxury goods. Under Section 5(4)(a), Prada claims that it has acquired goodwill in MIU MIU and use of the contested trade mark would constitute a misrepresentation.
5. EAJ filed a counterstatement denying the grounds of opposition.
6. Neither side requested a hearing and both sides filed evidence. This decision is therefore taken following a thorough perusal of the papers.

### **The Opponent’s Evidence**

7. This is a witness statement from Murielle Vincenti, the Intellectual Property Director of the opponent’s. The following relevant information is contained therein:
  - Miu Miu is the personal nickname of Ms Miuccia Prada. It was created in 1992 as a fashion label with an autonomous identity from its parent company Prada and has since evolved into one of the world’s leading fashion brands.
  - It is pronounced “mewmew” as if it were a single word without a break in the middle. The following goods are relied upon for this opposition as these have been used under the Miu Miu trade mark: “handbags, wallets, luggage, tote bags, clutch bags, all purpose sports bags, carry-on bags, shoulder bags, clothing for women including: coats, raincoats, belts, waistcoats, blouses, pullovers, jackets, trousers, skirts, dresses suits, shirts, chemises, t-shirts, sweaters, underwear, hosiery, gloves, ties, scarves, hats, caps, boots and shoes, eyewear, keyrings and jewellery”.
  - The first Miu Miu store opened in the UK in London in 1998 and there are now 7 Miu Miu stores in the UK (6 in London, including Selfridges and Harrods and 1 in Glasgow) and over 55 stores in 19 countries worldwide, including in France,

Germany, Italy, and Spain. Goods are also sold via its international website [www.miumiu.com](http://www.miumiu.com).

- Ms Prada and Miu Miu have been the recipients of numerous international awards, including various Designer of the Year awards for Ms Prada, an honorary PhD from the London Royal Academy of Arts in 2000, a nomination for Ms Prada from Time Magazine as one of 2005's Top 100 most influential people in the world and Ms Prada being crowned one of the "Magnificent Seven" by Vogue Magazine in 2005.
- Worldwide sales have been extensive. Exhibit MM02 is an article, dated 27 April 2007 from Fashion Wire Weekly, a leading newswire service dedicated to fashion. This reports the profit increase of Prada with specific information regarding the performance of Miu Miu. It is noted that this is referred to as a "healthy business" which had achieved a 22% increase in sales in 2006 achieving a total revenue of 154 million Euros, with sales in Europe accounting for 27% of this figure. The same information is corroborated by a second article exhibited at MM03. This is from Vogue UK online and is dated 30 April 2007.
- Sales figures for the UK are provided. These are around £3 million in 2004, increasing each year to around £7.5 million in 2011.
- Advertising expenditure in the UK (provided in Euros) was around 0.5 million in 2004, remained at around 0.3-0.4 million (with slight variation) until 2010 when it increased to around 0.7 million for the years 2010 and 2011.
- Exhibit MM04 are copies of newspaper clippings, magazine extracts and articles from the UK featuring Miu Miu goods from 2009 to 2011. It is noted that these include titles such as Glamour magazine, Grazia UK, Lula, In Style UK, Marie Claire UK, Red. It is also noted that the exhibit includes an article in "In Style UK" dated 1 December 2010. Although after the relevant date, the content of the article is relevant as it provides an extremely positive history of the Miu Miu brand, with women's clothing, bags and shoes specifically mentioned. Also included in the article are numerous celebrities wearing Miu Miu goods. Further, included in the exhibit is an article from the Daily Telegraph dated July 2010, which again although dated after the relevant date, describes how Miu Miu achieved a notable hat trick having appeared on the covers of Elle, W Magazine and Vogue that very month. There is another article in the Daily Telegraph, dated October 2009, describing Miu Miu's collection at Paris Fashion week. A further article appeared in the Independent the same month.
- Exhibit MM05 contains a number of articles featuring celebrities wearing Miu Miu. A handful of articles are dated prior or around the relevant date.

The remainder of the witness statement contains submissions which will not be referred to here but will be referred to where appropriate during this decision.

### **The Applicant's evidence**

8. This is a witness statement from Elisabeth Anne Jones of the Applicant. The following points are contained therein:
  - Goods sold under the MIMU trade mark include bags, purses, belts, clothing, scarves, hats and accessories. These are sold via the applicant's website at [www.mimu.co.uk](http://www.mimu.co.uk) and other, third party websites, including [www.amazon.co.uk](http://www.amazon.co.uk), [www.thetravellingsouk.com](http://www.thetravellingsouk.com) and [www.spirit-boutique.com](http://www.spirit-boutique.com). Exhibit EAJ1 is a copy of a page from amazon which shows the number of items currently sold on amazon, EAJ2 is a copy of a page from [www.thetravellingsouk.com](http://www.thetravellingsouk.com) and shows the variety of bags sold under the MIMU name and EAJ3 is a copy of a page from [www.spirit-boutique.com](http://www.spirit-boutique.com)

which shows a number of items sold under the MIMU mark. Further, MIMU items are sold by Galletly and Tubbs in Glasgow, Sara MacLeod Boutique in Newcastle Upon Tyne and Zapita in Farnham.

- The name MIMU was created in 2006.
- At the time of the trade mark application, Ms Jones was unaware of the earlier trade mark and did not decide to use her mark with the earlier trade marks in mind. Ms Jones goes on to make some submissions which will not be summarised here but will be referred to where appropriate during this decision.
- Approximate turnover figures range from £65,000 in 2006/2007, increasing steadily each year to £330,000 in 2011/2012. No advertising spend is provided, but Ms Jones describes her advertising activities.
- Exhibit EAJ4 contains copies of letters received from a number of Ms Jones's customers. These state that the MIMU mark is recognised as being that of Ms Jones and that none of them have ever been confused with MIMU and the earlier trade mark. These letters are to be treated as hearsay evidence, a point which will be returned to further below. Ms Jones follows up these letters by stating that her products are sold at different outlets to those of the opponent.
- Exhibit EAJ5 contains letters from a number of charities which appear to confirm the attendance of Ms Jones at various events.
- Exhibit EAJ6 contains copies of flyers and website pages that relate to various events Ms Jones has either already attended or will attend in future. Exhibit EAJ7 refers to a list of events from 2009 that Ms Jones attended and Exhibit EAJ8 is a similar list from 2012.
- Exhibit EAJ9 is a copy of a swing tag attached to items sold under the MIMU trade mark. Exhibit EAJ10 shows further swing tag copies. Exhibit EAJ11 is a flyer relating to the business.
- Ms Jones disputes the pronunciation of the earlier trade marks as provided in its evidence and suggests there are alternative ways in which it could be articulated. Further, she says that her own mark will be pronounced as "memo". She further notes the space between the words MIU MIU.
- Ms Jones states that she is not aware of any instances of confusion. Further, Exhibit EAJ12 contains the results of an internet search on both the search engine google and the amazon retail website for MIMU. The opponent's trade mark does not show up on either search.

Ms Jones concludes her witness statement by making a number of submissions. These will not be summarised here. Rather, they will be referred to where appropriate during this decision.

### **The Opponent's evidence in reply**

9. This is a witness statement from Murielle Vincetti. The following points are contained therein:
  - Though Ms Jones says that she created the name MIMU in 2006, she does not state whether or not she carried out a trade mark searching prior to adopting the mark or filing her trade mark application.

## O-417-13

- In response to Ms Jones's claim that she was unaware of the earlier trade marks, Ms Vincetti directs attention to the evidence of Miu Miu's trade and reputation as supported by its evidence.
- Ms Vincetti comments on the evidence filed by Ms Jones and notes that some of the items sold under the MIMU trade mark are being marketed as "designer" and so are, according to Ms Vincetti, targeted at the same consumer. Further, the price range of the items and the turnover figures given do not suggest that a large number of items have been sold.
- As the relevant date is 11 June 2010 the turnover figures for 2011/2012 are not relevant.
- In respect of the customer letters filed, Ms Vincetti comments on their identical and presumably pre-prepared wording. Further, some refer to purchases that occurred after the relevant date. The evidential value of these letters is therefore questioned.
- In respect of letters from charitable organisations, it is noted that one refers to advertising of MIMU in its members' magazine though no circulation figures are provided. In response to another, Ms Vincetti exhibits at MM06 an extract from the relevant charity's website. Ms Vincetti suggests that the website content shows that Ms Jones attended only two events and further that these were at a local rather than national level. Finally, in respect of the Country Living fairs attended, these are invariably in London with other locations only added following the relevant date in these proceedings.
- Some of the evidence filed is only a list of exhibitors. No other context is provided. As to the events allegedly attended by Ms Jones in 2009, no other context is provided (sales, number of attendees etc). The list relating to 2012 is after the relevant date. Ms Vincetti therefore concludes that MIMU cannot be known to a large and varied proportion of the UK.
- In response to Ms Jones's assertion that there is a space between MIU MIU, exhibit MM09 is a page downloaded from the opponent's website showing that the spaces between the words is not pronounced.
- Ms Vincetti disagrees with Ms Jones's alternative pronunciations of MIU MIU. As MIU MIU is the personal nickname of Ms Miuccia Prada, the pronunciation provided is correct.
- As regards the absence of instances of confusion, Ms Vincetti points out that this does not mean that there is not a likelihood of confusion.
- In respect of the google and amazon search results, Ms Vincetti says that they are reliant on algorithms and so it is not relevant that MIU MIU failed to appear when searching MIMU.

The remainder of this witness statement is comprised of submissions. As before, they will not be summarised here but will be taken into account when appropriate and referred to during this decision.

### **Preliminary remarks on the applicant's evidence**

10. Two points are noted from the applicant's evidence. Firstly, that much has been made of the use made of the contested trade mark to date, presumably the applicant considers this to be parallel trade. In this regard, evidence of parallel trading is a factor which could, potentially, assist in deciding whether there exists a likelihood of confusion. This is because if the evidence establishes that the respective marks have actually been put to use in the same market without the consumer being confused regarding economic origin, then this can inform the tribunal's decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace. However, this approach

must also take in account the decisions which advise caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u.co.uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45). In the first of these cases, Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

11. Some evidence of use has been provided to this tribunal, which has already been summarised. Bearing in mind the case-law referred to above, for concurrent trading to play a meaningful role in the assessment of the likelihood of confusion the Tribunal must be satisfied that the parties have traded in circumstances that provide consumers the opportunity for exposure to both marks and, further that they have been able to differentiate between them without confusion as to trade origin. There has been no evidence to this effect here. Indeed, the applicant has been at pains to stress that the parties operate out of different outlets. As a result, this factor can be given no weight in determining whether or not there is a likelihood of confusion.
12. Secondly, the applicant’s evidence contains a number of copies of correspondence from customers which appear to suggest the trade marks are not confusingly similar and that the contested trade mark is associated with the applicant alone. In this regard, the contents of the decision in *esure Insurance Ltd v Direct Line Insurance Plc* [2008] RPC 34 is noted where Arden LJ stated:

“56 In my judgment, Mr Hobbs is correct on this point. What the hearing officer had to determine was what the average consumer would have thought of the two marks and whether they would have confused him. The services sold by the parties were identical and were of a kind familiar to members of the public. In those circumstances, I see no reason why the hearing officer should not have decided the issue of similarity on his own in the absence of evidence apart from the marks themselves and evidence as to the goods or services to which they were, or, in the case of esure’s mark, were to be applied. As Lord Diplock held in *Re GE Trade Mark* at 321:

“My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused ... But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced, but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

## O-417-13

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods.”

13. Issues of confusion are therefore a jury question and for the Tribunal (the decision maker) to decide, there being nothing esoteric in the nature of the goods in question here.
14. In respect of the content of the letters, it is noted that these customers are unequivocal that they associate the contested trade mark with the applicant alone. Presumably the applicant considers that this evidence demonstrates that there is no actual confusion. However, in reaching a decision as to the likelihood of confusion, the position must be considered objectively, from the viewpoint of the relevant consumer in respect of these goods; who, in this case, will be the public at large. Consequently, an absence of examples of confusion is not determinative.
15. Finally, the opponent's observations as regards the wording of these letters (they essentially contain the same content) is also noted. The following is observed: *Re Christiansen's TM* [1885] 3 RPC 54 at 60 where Lord Esher MR stated:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

### **Conclusions on the Opponents evidence**

16. The earlier trade marks have, according to the opponent, been used in respect of the following goods: : “handbags, wallets, luggage, tote bags, clutch bags, all purpose sports bags, carry-on bags, shoulder bags, clothing for women including: coats, raincoats, belts, waistcoats, blouses, pullovers, jackets, trousers, skirts, dresses suits, shirts, chemises, t-shirts, sweaters, underwear, hosiery, gloves, ties, scarves, hats, caps, boots and shoes, eyewear, keyrings and jewellery”. Further, the Opponent claims that it has a reputation in respect of these goods.
17. It is clear from the evidence that MIU MIU has been subject to long standing use. However, the turnover figures are not particularly large for the clothing industry. Further the outlets where the products have been sold are very limited. It is true that there is evidence of press articles etc detailing a number of celebrities wearing MIU MIU products. However, for evidence to demonstrate that a trade mark has acquired a reputation, it is necessary for it to show that it is known to a significant part of the public concerned who in the case of these goods, is the public at large. Though it is accepted that MIU MIU will be known, for example, to fashionistas, the evidence is considered to be unpersuasive as regards MIU MIU being known by a significant part of the public at large.



**DECISION – LIKELIHOOD OF CONFUSION**

18. The relevant parts of section 5 of the Act read as follows:

(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.

19. The leading authorities which guide me in this ground are from the CJEU: *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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C- 334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

20. For reasons of procedural economy, it is considered that the opponent's strongest case is in respect of its earlier CTM registration 4253191 for MIU MIU (word only) as this trade mark is not subject to the proof of use provisions and so contains the broadest specification of goods available to the opponent. This earlier trade mark will therefore be focussed upon during this decision. If the opponent cannot succeed here, it is highly unlikely to succeed in respect of its earlier rights in a stylised version of MIU MIU (with a narrower specification).

### **The average consumer**

21. The case-law informs that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).
22. In relation to general items of clothing, the case law<sup>1</sup> informs me that it is the visual impression of the marks that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web site rather than by oral request. The average consumer will be the public at large, who in my view will display a medium degree of attention during the purchasing process and is said to be reasonably well informed and reasonably observant and circumspect. Likewise the position is expected to be the same in respect of leather goods such as bags and shoes.

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<sup>1</sup> See, for example, *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T57/03 and *React Trade Mark* [2000] RPC 285.

**Comparison of goods.**

23. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

24. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

25. The definition of complementary is also borne in mind. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 GC* explained when goods are complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

## O-417-13

The earlier goods are:

Class 18:

Leather and imitations of leather and goods made of these materials not included in other classes

Class 25:

Clothing, shoes, headgear

The contested goods are:

Class 18:

Leather and animal skin bags and accessories, trunks and travelling bags, handbags, rucksacks, purses, umbrellas and parasols.

Class 25:

Clothing and accessories, scarves, shawls, belts and accessories, footwear, headgear (hats etc).

### **Comparison of goods in class 18:**

26. The earlier goods are a broad term which can include any bags or other items made from leather and imitations of leather. The following contested goods are clearly included within this term: leather bags and accessories, trunks and travelling bags, handbags, rucksacks, purses. The contested term animal skin bags and accessories are clearly highly similar, The remaining contested terms are umbrellas and parasols. In respect of the latter contested goods, umbrellas and parasols have a specific function, namely to protect from the elements, most likely rain and sunshine. They are also entirely different in nature from any of the earlier goods. However, they may coincide in respect of trade channels as umbrellas and parasols can be sold alongside bags. They are therefore similar, though only to a very low degree.

### **Comparison of goods in class 25:**

27. The earlier term is broad and will include the complete range of clothing and accessory items. The following contested terms are clearly identical to the earlier term: clothing and accessories, scarves, shawls, belts and accessories. The term headgear appears in each specification is so is obviously identical. The remaining contested term is footwear which is clearly identical to the earlier shoes. It is true that footwear is a broad term and so will include items that are not identical to shoes, for example boots. However nothing turns on this point as these goods are, in any case, clearly highly similar, as will be the case in respect of any other type of generic footwear.

28. The upshot of this is that all of the contested goods are either identical or similar (at least to some degree) to those of the earlier trade marks.

**Comparison of marks**

29. 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

30. The respective trade marks are shown below:

MIU MIU	
Earlier trade mark	Contested trade mark

31. The earlier trade mark is word only whereas the contested trade mark is presented in a stylised script. Despite the stylisation, the individual words MIMU and www.mimu.co.uk can clearly be read. Visually, it is noted that each of the trade marks contain the letters MIU (presented twice in the earlier trade mark). The contested trade mark contains an additional letter M and www.mimu.co.uk, neither of which have counterparts in the earlier trade mark. Further there is a gap between each element of the earlier trade mark. They are visually similar only to a low degree.

32. Aurally, the parties have offered up alternative pronunciations, in a way in which each feels best supports their respective positions. The Tribunal must decide the matter objectively, based upon any potential articulation, but which is also reasonably realistic. Bearing this in mind, it is considered that it is reasonable to consider that the earlier trade mark will be pronounced as “mee-u mee-u”, with the contested trade mark as “mee-mu”. The web address in the contested trade mark is unlikely to be pronounced, though this is not impossible. Proceeding on the basis of what is considered to be a realistic scenario, it is considered that there is aural similarity between the trade marks, to a moderate degree. In the event that the web address in the contested trade mark is articulated, the degree of similarity nevertheless remains moderate.

33. Conceptually, it is noted that the earlier trade mark is, according to the evidence of the opponent, the nickname of its founder, Ms Prada, which no doubt, some of the general public of the United Kingdom will be aware. However, for much of this public, the earlier trade mark has no meaning at all and has the look and feel of an invented term. The contested trade mark has no meaning. Whether or not the earlier trade mark is understood as a nickname, the marks therefore have no concept in common.

#### **Distinctive and dominant components**

34. It is considered that the earlier trade mark does not have a stand-alone distinctive and dominant component. Rather, it will be appreciated instantly as a whole. In respect of the contested trade mark, the elements www.co.uk are clearly recognisable as a web address and so are non distinctive. The element MIMU is meaningless and has the look and feel of an invented term. It is considered that the distinctive character of the contested trade mark lies within this element. The same element appears in larger typeface above the web address in the contested mark. Its size ensures its visual dominance within the mark as a whole. Bearing in mind all of the aforesaid, it is considered that the distinctive and dominant element of the contested trade mark is the larger MIMU.
35. Bearing in mind all of the aforesaid, it is considered that the respective trade marks are similar, to a low to moderate degree.

#### **Distinctiveness of the earlier trade mark**

36. The degree of distinctiveness to be accorded to the earlier trade mark is important because the more distinctive the earlier marks (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).
37. The distinctiveness of a trade mark is to be assessed on the basis of the goods and services to which it is applied, from the perspective of the consumers of those goods and services. As already stated, the earlier trade mark was chosen as it is the personal nickname of Ms Prada, which will be known to at least some of the relevant consumer base. It also has the look and feel of an invented term. In any case, it has no meaning in respect of the goods of interest here. It is considered that the earlier trade mark is highly distinctive per se, whether it is viewed as an invented term or known to be a nickname

#### **Global Assessment – conclusion on likelihood of confusion**

38. In considering the likelihood of confusion therefore, it is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
39. The marks have been found to be similar, to a low to moderate degree. Many of the goods are identical or highly similar. In respect of these goods, which include

clothing, it is noted that visual impressions can be the most important. However, this does not mean that aural similarity can be ignored. In respect of these trade marks, the degree of aural similarity is at least moderate. It is true that the trade marks have no concept in common. However, this also means that there is no difference in concept which would have the effect of creating a gap between them which counteracts the degree of aural similarity. Further, many of the goods are either identical or highly similar which can counteract a lower degree of similarity between the marks so the interdependency principle is in full operation here. Further, it is also borne in mind that although the relevant public will display a reasonable degree of attention during the purchasing process, it rarely has the chance to view trade marks side by side and so must rely upon an imperfect picture of them. It is considered that the differences between the trade marks is outweighed by the similarities, with the effect being that the relevant public displaying a reasonable degree of attention is likely to be unable to accurately distinguish between them. Therefore, in respect of the identical and highly similar goods, there is a likelihood of confusion.

40. In respect of the contested *umbrellas and parasols* which have been found to be similar to a very low degree, it is noted that the marks are not identical as there are important visual differences. For the very low degree of similarity of goods to be effectively counteracted and for confusion to then be likely, the marks would need to be identical or so highly similar as to be almost identical. Further, though a reputation can assist where there is a distance between the goods, this has not been shown here. The absence of either of these factors weighs against there being a likelihood of confusion. The opposition under Section 5(2)(b) therefore fails in this regard.
41. As the opponent has not been wholly successful under Section 5(2)(b), the remaining grounds of opposition will also be considered, though in respect of umbrellas and parasols only.

### Section 5(3) – Reputation

42. Section 5(3)<sup>2</sup> of the Act reads:

“5-(3) A trade mark which-

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

43. In order to succeed under this ground the earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU stated:

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<sup>2</sup> Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01).

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

44. As already indicated, the opponent has failed to demonstrate that MIU MIU is known by a significant part of the relevant public, who in this case is the public at large. As proof of reputation is a requirement of Section 5(3), this ground of opposition fails.

#### **Section 5(4)(a) – Passing Off**

45. The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position thus:

“The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff... Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

46. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.”

47. To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature<sup>3</sup>. However, being a small player does not prevent the law of passing-off from being relied upon<sup>4</sup>.

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<sup>3</sup> *Hart v Relentless Records* [2002] E.W.H.C. 1984

<sup>4</sup> See, for instance, *Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002] R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).



**The relevant date**

48. The matter must be judged at a particular point(s) in time. In *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 the General Court stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

49. The relevant date at which the opponent must establish its goodwill is, consequently, 22 June 2010.

50. The opponent claims that it has used MIU MIU in respect of the following: “handbags, wallets, luggage, tote bags, clutch bags, all purpose sports bags, carry-on bags, shoulder bags, clothing for women including: coats, raincoats, belts, waistcoats, blouses, pullovers, jackets, trousers, skirts, dresses suits, shirts, chemises, t-shirts, sweaters, underwear, hosiery, gloves, ties, scarves, hats, caps, boots and shoes, eyewear, keyrings and jewellery”. The evidence clearly shows use in respect of a wide variety of clothing for women, shoes for women and handbags, clutchbags and shoulder bags. The evidence is either scarce or nonexistent in respect of the remaining items claimed.

**Misrepresentation and damage**

51. Having decided that goodwill has been established, the next step is to consider whether or not there has been a misrepresentation. In this respect, the guidance provided by Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 is helpful when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent’s customers or potential customers would be misled into purchasing the applicant’s products in the belief that it was the opponent’s. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that “he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill”.

52. The tribunal must be satisfied that the goods offered under the applicant’s mark would be taken (or likely to be taken) by the relevant public to actually be the responsibility of the opponent. In terms of the “public”, this means a substantial number of the opponent’s customers or potential customers. Although an intention to misrepresent would be a highly relevant factor, it is not a prerequisite. Misrepresentation can be found in innocent circumstances. As regards the particular

## O-417-13

signs, these have already been objectively analysed and found to have some similarities. However, the goods must also be considered.

53. Whilst there is no requirement for there to be a common field of activity of the respective parties, see *Lego Systems A/S v Lego M Lemelstrich Ltd* [1983] FSR 155, the level of similarity of the respective goods and services is, nonetheless, a relevant factor as demonstrated in *Harrods Ltd v Harrodian School* [1996] RPC 697, where Millett LJ stated:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

and

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

and

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

54. In these proceedings, although it is possible for the trade channels to coincide, this does not equate to there being a common field of activity in respect of clothing, shoes and bags on the one hand and umbrellas and parasols on the other. There is a distance between these goods in this regard. Further, the respective signs contain enough differences to ensure that the public will not consider the responsibility for umbrellas and parasols sold under the sign MIMU [www.mimu.co.uk](http://www.mimu.co.uk) to lie with the opponent. This ground of opposition therefore fails.

55. The sum of all this is that the opposition succeeds for the most part and in respect of the following goods:

Class 18:

Leather and animal skin bags and accessories, trunks and travelling bags, handbags, rucksacks, purses.

Class 25:

Clothing and accessories, scarves, shawls, belts and accessories, footwear, headgear (hats etc).

56. The remaining goods, namely umbrellas and parasols, can proceed to registration.

**COSTS**

57. The opponent has been, for the most part, successful and so is entitled to a contribution towards its costs. It is, therefore, awarded the sum of £1200, which is made up as follows:

Statutory fee for filing opposition - £200  
Filing opposition and considering counterstatement - £300  
Considering evidence - £350  
Preparing and filing evidence - £350

58. I order Elisabeth Anne Jones to pay Prada S.A the sum of £1200. The above sum should 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 22nd day of October 2013**

**Louise White**

**For the Registrar,  
The Comptroller-General**