

O/500/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003484184

BY MARIIA POPOVA

TO REGISTER THE FOLLOWING TRADE MARK

IN CLASS 25:

MASHA POPOVA

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421448 BY ANIMACCORD LTD

BACKGROUND AND PLEADINGS

1. On 25 April 2020, Mariia Popova (“the applicant”) applied to register MASHA POPOVA as a trade mark in the United Kingdom, in respect of the following goods in class 25:

Articles of clothing; Articles of clothing made of leather; Articles of outer clothing; Blue jeans; Boots; Clothes; Clothing; Clothing made of leather; Clothing of imitations of leather; Clothing of leather; Coats; Coats for men; Coats for women; Coats of denim; Cocktail dresses; Embroidered clothing; Evening dresses; Evening gowns; Evening wear; Fashion hats; Footwear; Footwear for men and women; Gloves [clothing]; Headscarfs; Hoodies; Jackets; Jeans; Jerseys [clothing]; Knitted clothing; Knitwear; Lace boots; Ladies’ boots; Ladies’ clothing; Ladies’ dresses; Ladies’ footwear; Ladies’ outerclothing; Ladies’ sandals; Ladies’ suits; Ladies wear; Leather clothing; Leather (Clothing of imitations of -); Leather garments; Men’s and women’s jackets, coats, trousers, vests; Men’s clothing; Menswear; Outerwear; Padded jackets; Pants; Parkas; Platform shoes; Sandals; Scarves; Shirts; Shoes; Shorts; Sneakers; Sneakers [footwear]; Socks; Sweatsuits; Swimming costumers; Tights; Track suits; Trainers [footwear]; Trousers; T-shirts; Underwear; Women’s clothing; Womens’ outerclothing; Women’s shoes; Women’s suits; Womens’ underclothing; Womens’ undergarments; Women’s underwear; Woolen clothing; Denim coats; Denim jackets; Denim jeans; Denim pants; Denims [clothing]; Dresses; Dresses for evening wear.

The application was published for opposition purposes on 29 May 2020.

2. On 28 August 2020, Animaccord Ltd (“the opponent”) opposed the application, in full, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks and the class 25 goods for which they are registered. Those goods are laid out, respectively, below:

European Union Trade Mark (“EUTM”) 15549959¹:

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoys protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings

MASHA AND THE BEAR

Filing date: 16 June 2016; Registration date: 14 October 2016

Clothing; Footwear; Headgear; Bandanas [neckerchiefs]; Body linen [garments]; Underclothing; Half-boots; Neckties; Vests; Waistcoats; Hosiery; Tights; Combinations [clothing]; Suits (Bathing -); Swimsuits; Costumes (Masquerade -); Beach clothes; Jackets; Jackets [clothing]; Ear muffs [clothing]; T-shirts; Socks; Gloves [clothing]; Pyjamas; Scarfs; Braces for clothing [suspenders]; Suspenders; Dresses; Aprons [clothing]; Dressing gowns; Sashes for wear.

EUTM 18113664

MASHA'S SONGS

Filing date: 23 August 2019; Registration date: 28 July 2020

Clothing excluding sleepwear; headgear; footwear; bandanas [neckerchiefs]; body linen [garments]; underclothing; underwear; half-boots; neckties; vests; waistcoats; hosiery; tights; combinations [clothing]; bathing suits; swimsuits; masquerade costumes; beach clothes; jackets [clothing]; ear muffs [clothing]; t-shirts; socks; gloves [clothing]; scarfs; braces for clothing [suspenders]; suspenders; dresses; aprons [clothing]; sashes for wear.

3. In its statement of grounds, the opponent submits that, on account of the similarities between the marks at issue and the identity (or at least high similarity) between the respective goods, the relevant public would be led to conclude that the goods provided under the applicant's MASHA POPOVA mark originate from the same commercial origin as those provided by the opponent, or at least that there is an economic connection between the two. In other words, there exists a likelihood of confusion.

because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

4. In its counterstatement, the applicant accepts the identity and/or similarity between the goods at issue but claims that the average consumer will attribute the marks' shared use of the MASHA element to mere coincidence, rather than falling susceptible to confusion.

5. For the purpose of the opposition, the applicant is represented by Dolleymores and the opponent is represented by Clarion Solicitors Limited. Neither party elected to file evidence nor written submissions. Neither party requested a hearing, nor did they file submissions in lieu. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

DECISION

6. Section 5(2)(b) of the Act reads as follows:

“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.”

7. The trade marks relied upon by the opponent qualify as earlier marks because they were applied for at an earlier date than the application, pursuant to section 6 of the Act. As neither mark had completed its registration procedure more than 5 years before the application date of the contested mark, neither is subject to the proof of use

provisions set out in section 6A of the Act². The opponent can therefore rely upon both marks and all goods it has identified without providing evidence of use.

8. The following principles are gleaned from the decisions of the European Union ("EU") courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

² See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825)

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

9. Although, at the time of issue, the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Comparison of goods

10. The competing goods are laid out in the table below:

The opponent's goods	The applicant's goods
<p>EUTM 15549959:</p> <p>Clothing; Footwear; Headgear; Bandanas [neckerchiefs]; Body linen [garments]; Underclothing; Half-boots; Neckties; Vests; Waistcoats; Hosiery; Tights; Combinations [clothing]; Suits (Bathing -); Swimsuits; Costumes (Masquerade -); Beach clothes; Jackets; Jackets [clothing]; Ear muffs [clothing]; T-shirts; Socks; Gloves [clothing]; Pyjamas; Scarfs; Braces for clothing [suspenders]; Suspenders; Dresses; Aprons [clothing]; Dressing gowns; Sashes for wear.</p> <p>EUTM 18113664:</p> <p>Clothing excluding sleepwear; headgear; footwear; bandanas [neckerchiefs]; body linen [garments]; underclothing; underwear; half-boots; neckties; vests; waistcoats; hosiery; tights; combinations [clothing]; bathing suits; swimsuits; masquerade costumes; beach clothes; jackets [clothing]; ear muffs [clothing]; t-shirts; socks; gloves [clothing]; scarfs; braces for clothing [suspenders]; suspenders; dresses; aprons [clothing]; sashes for wear.</p>	<p>Articles of clothing; Articles of clothing made of leather; Articles of outer clothing; Blue jeans; Boots; Clothes; Clothing; Clothing made of leather; Clothing of imitations of leather; Clothing of leather; Coats; Coats for men; Coats for women; Coats of denim; Cocktail dresses; Embroidered clothing; Evening dresses; Evening gowns; Evening wear; Fashion hats; Footwear; Footwear for men and women; Gloves [clothing]; Headscarfs; Hoodies; Jackets; Jeans; Jerseys [clothing]; Knitted clothing; Knitwear; Lace boots; Ladies' boots; Ladies' clothing; Ladies' dresses; Ladies' footwear; Ladies' outerclothing; Ladies' sandals; Ladies' suits; Ladies wear; Leather clothing; Leather (Clothing of imitations of -); Leather garments; Men's and women's jackets, coats, trousers, vests; Men's clothing; Menswear; Outerwear; Padded jackets; Pants; Parkas; Platform shoes; Sandals; Scarves; Shirts; Shoes; Shorts; Sneakers; Sneakers [footwear]; Socks; Sweatsuits; Swimming costumers; Tights; Track suits; Trainers [footwear]; Trousers; T-shirts; Underwear; Women's clothing; Womens' outerclothing; Women's shoes; Women's suits; Womens' underclothing; Womens' undergarments; Women's underwear; Woolen clothing; Denim coats; Denim</p>

	jackets; Denim jeans; Denim pants; Denims [clothing]; Dresses; Dresses for evening wear.
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11. The following terms are present in both parties' specifications and are, self-evidently, identical:

Clothing; footwear; gloves [clothing]; jackets; scarves (scarfs); socks; tights; t-shirts; underwear³; dresses

12. Where goods are not literally identical, a further provision for identity was set out in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05. The General Court ("GC") stated:

"29. ...the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

13. Applying that principle, the applicant's *articles of clothing; articles of clothing made of leather; articles of outer clothing; blue jeans; clothes; clothing made of leather; clothing of imitations of leather; clothing of leather; coats; coats for men; coats for women; coats of denim; cocktail dresses; embroidered clothing; evening dresses; evening gowns; evening wear; hoodies; jackets; jeans; jerseys [clothing]; knitted clothing; knitwear; ladies' clothing; ladies' dresses; ladies' outerclothing; ladies' suits; ladies wear; leather clothing; leather (clothing of imitations of -); leather garments; men's and women's jackets, coats, trousers, vests; men's clothing; menswear; outerwear; padded jackets; pants; parkas; shirts; shorts; sweatsuits; swimming*

³ EUTM 18113664

costumers; track suits; trousers; women's clothing; womens' outerclothing; women's suits; womens' underclothing; womens' undergarments; women's underwear; woolen clothing; denim coats; denim jackets; denim jeans; denim pants; denims [clothing] and dresses for evening wear are encompassed by the opponent's *clothing* (or *clothing excluding sleepwear*, in the case of EUTM '664). The goods are therefore identical.

14. The applicant's *boots; footwear for men and women; lace boots; ladies' boots; ladies' footwear; ladies' sandals; platform shoes; sandals; shoes; sneakers; sneakers [footwear]; trainers [footwear]* and *women's shoes* are encompassed by the opponent's *footwear*. These goods are identical.

15. The applicant's *fashion hats and headscarfs* are encompassed by the opponent's *headgear*. These goods are also to be considered identical.

Average consumer and the nature of the purchasing act

16. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

17. I take note of the comments of the GC in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)*, Joined cases T117/03 to T-119/03 and T-171/03 (“*New Look*”). In that case, it commented:

"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."

18. With regard to the selection process, I also note the following passage from *New Look*:

"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."

19. As far as the parties are concerned, the opponent suggests that the goods' purchase will not be highly considered and will likely receive a relatively low degree of

attention from the average consumer⁴. The applicant submits that the average consumer would apply a *standard* level of care and consideration⁵.

20. The goods at issue here fall within the broad terms (or are identical to) *clothing, footwear and headgear*. The average consumer of such goods is likely to be a member of the general public. In my experience, the goods are generally self-selected by consumers from traditional high-street retailers or their online equivalents. Consequently, the marks' visual impact is likely to carry the greatest weight throughout the selection process. However, given that it would not be unusual for recommendations to be made orally in this field by peers or salespeople, for example, I do not discount the significance of the marks' aural element. The goods are purchased fairly frequently and the costs are admittedly variable. When approaching the selection process, consumers are likely to be alive to factors such as compatibility, comfort and quality. All things considered, it seems likely that the average consumer will apply a medium degree of attention to the purchase.

Comparison of trade marks

21. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

⁴ See paragraph 10 of the opponent's statement of grounds

⁵ See paragraph 4 of the applicant's counterstatement

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, to artificially dissect the trade marks, 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.

23. The parties’ trade marks appear as follows:

Opponent’s marks	Applicant’s mark
EUTM 15549959: MASHA AND THE BEAR	MASHA POPOVA
EUTM 18113664: MASHA’S SONGS	

24. The opponent’s EUTM ending ‘959 comprises four words of five, three, three and four letters respectively. The words hang together as a unit, with none more notably dominant than the others.

25. The opponent’s EUTM ending ‘664 comprises two words, both of five letters in length. The words hang together, with neither more dominant, though ‘SONGS’ is clearly a possession (of MASHA).

26. The applicant’s mark comprises two words of five and six letters respectively. I do not consider either word to hold a greater weight; each makes a roughly equal contribution to the mark’s overall impression.

The opponent’s ‘MASHA AND THE BEAR’ mark

27. Visually, the marks clearly coincide in their first words, which are identical. I see no tangible visual similarity in the marks' remaining words, of which there are three in the opponent's and one in the applicant's. That said, I bear in mind that, as a general rule of thumb, the beginnings of marks have more of an impact on consumers than their endings. Still, on balance, I find the marks visually similar to a fairly low degree.

28. Aurally, the opponent's mark is likely to be articulated in five syllables; MA-SHA-AND-THE-BARE. The applicant's is also likely to be articulated in five syllables; MA-SHA-POP-OH-VAH. The first two syllables are identical but there is little similarity in the marks' further syllables. I find the aural similarity to be of a medium degree.

29. I note the applicant's submissions regarding the word 'MASHA' which, it explains, is a female forename with Russian and Jewish origins. The applicant further submits that it is identified as such within the UK and will be recognised by the average consumer. Of the marks' conceptual similarity, the applicant states that the marks are conceptually dissimilar on the basis that:

"13. ...The mark in the Application will be seen to refer to a specific person with the full name MASHA POPOVA. The Opponent's trade marks will be seen, respectively, to refer to a person called Masha along with a bear, and songs belonging to a person called Masha."

30. In its pleadings, the opponent submits:

"9. ...As the dominant component of the MASHA Application is the word MASHA, the marks are conceptually identical... the overall impression made by the MASHA Application would be very similar to that made by the each of the MASHA Registrations." (sic)

31. In my experience, MASHA is not a name which would be readily identified as such by the average UK consumer. It seems more likely that it would be considered an invented word. However, in regard to the opponent's mark, whilst I am not convinced

that MASHA will be recognised as a female forename specifically, it seems likely that the average consumer will identify it as a name at least, given that it precedes ‘...AND THE BEAR’; the mark allows MASHA a degree of personification. Consequently, the concept the average consumer is left with is a person (named MASHA) and a bear. In the applicant’s mark, there is little context to offer consumers an indication as to what MASHA means. Neither of the two words it comprises, to my mind, will offer consumers an immediately identifiable concept. It seems likely, instead, that the average consumer will see the mark as a combination of two invented words, both absent of specific meaning. With one mark offering the average consumer a concept, and the other failing to do so, the marks are conceptually dissimilar.

The opponent’s ‘MASHA’S SONGS’ mark

32. Visually, the marks begin identically, both with the first five letters M, A, S, H, A. That said, in the opponent’s mark, MASHA is pluralised, preceding ‘S’, and it is followed by a five-letter word; SONGS. In the applicant’s mark, MASHA precedes the six letter word ‘POPOVA’. Other than both marks’ second word having O as their second letter, the words are not visually similar. On the whole, I find the marks visually similar to no more than a medium degree.

33. In contrast to the applicant’s five syllable mark, aurally, the opponent’s mark is likely to be articulated in only three syllables; MA-SHAS-SONGS. Notwithstanding that the marks’ first syllables are identical and the second highly similar, I find the aural similarity to be of a fairly low degree.

34. Conceptually, the opponent’s mark nods toward a collection of songs belonging to an individual named MASHA. In the applicant’s mark, although it begins with the word ‘MASHA’, as I’ve already stated, it is one of two words which are unlikely to convey any particular meaning to the average consumer; there is nothing contextually to clarify the meaning of MASHA. The marks are conceptually dissimilar.

35. Of course, if I am incorrect in my approach and the average consumer readily understands MASHA to be a female forename, it will do so in each of the marks

consistently. In that event, in the applicant's mark, POPOVA is likely to be identified as the second name (of an individual named MASHA). That individual is the only concept in the applicant's mark. In the opponent's marks, additional conceptual elements are introduced by way of 'A BEAR' or 'SONGS'. If this is how the average consumer interprets the respective marks, the conceptual similarity will be of a medium degree.

Distinctive character of the earlier marks

36. 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-2779, 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)."

37. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought. The same must apply to the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them⁶.

38. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

39. In the absence of evidence of use, and indeed a claim of enhanced distinctiveness, I have only the *inherent* distinctiveness of the earlier marks to consider. Whilst I am willing to accept that 'Masha' is a female forename with Russian and Jewish origin, I must consider whether the average consumer in the UK will identify it as such. Gender aside, I have already concluded that on account of the context in which MASHA is presented within each of the opponent's marks, it seems likely that the average consumer will recognise it as a name, at least. Still, even if it were to be identified as a name, it is not a name with which I would expect the average consumer to be familiar, rather I expect it will be deemed fairly unusual. Furthermore, neither of the marks, in my opinion, can be said to be descriptive nor suggestive of the goods relied upon for the purpose of these proceedings. On balance, I find the earlier marks to possess a fairly high degree of inherent distinctiveness.

Likelihood of confusion

40. To make the assessment as to a likelihood of confusion, I must adopt the global approach advocated by the case law and take account of my earlier conclusions. I keep in mind the average consumer of the goods at issue, the nature of the purchasing

⁶ See *Matratzen Concord AG v OHIM*, Case T-6/01.

process and the fact that the average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in their mind. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as, generally, the more distinctive the mark, the greater the likelihood of confusion.

41. In *Kurt Geiger v A-List Corporate Limited*⁷, Mr Purvis, 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. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the marks, and the goods or services, down to the respective undertakings being the same or related.

43. When approaching my decision, I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*⁸,

⁷ BL O-075-13

⁸ BL O/375/10

though I acknowledge that the examples of indirect confusion he provides are non-exhaustive. Mr Purvis explained that:

“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.””

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.).

(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).”

44. However, in *Duebros Limited v Heirler Cenovis GmbH*⁹, Mr James Mellor Q.C., sitting 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.

45. With regards the relevance of the marks' conceptual positions, in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

46. However, in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

47. I will begin by considering a likelihood of direct confusion. Notwithstanding the identity between the respective goods, I have not found a high degree of visual similarity between either of the opponent's marks and the application and it is the visual considerations which are likely to be predominant during the purchasing process. Whilst it seems likely that consumers paying a medium degree of attention will identify that the marks share a common element in MASHA, the marks' remaining elements

⁹ BL O/547/17

are not sufficiently similar to incite direct confusion; neither of the earlier marks would simply be mistaken for the applied for mark (or vice versa).

48. As the case law indicates, the matter of indirect confusion requires a more multifaceted assessment. Each of the competing marks begins with 'MASHA'. Although the context in the opponent's marks personifies the word 'MASHA', a word with which I suspect the average consumer will generally be unfamiliar, such an insight is absent in the application. Nevertheless, my assessment of the marks, independently, indicated that the average consumer would likely be able to draw a concept from the opponent's marks but that it wouldn't readily attribute a concept to the applicant's mark. On that basis I found the respective marks conceptually dissimilar. That said, I must consider what the thought process of the average consumer would likely be when meeting both parties' marks in the market place; a market place where, in my experience, it is not unusual for traders to adopt multiple brand variations or sub-brands. Based on my earlier findings, consumers who are familiar with either, or both, of the earlier marks would have already concluded that MASHA must be a name and, upon meeting that name in the later mark, being used in respect of identical goods, will likely see it in the same way (with POPOVA assumed to be a surname). Whilst the additional elements in the opponent's marks allows the consumer to distinguish between the marks conceptually, the marks all refer to an individual named 'MASHA'. Particularly in light of the name's unusual nature, in my view, the average consumer will erroneously conclude that the competing marks originate from a single or related undertaking. In other words, indirect confusion would occur.

49. It would put the applicant in no better position were I to consider a likelihood of confusion on the basis that the average consumer readily and immediately identifies MASHA as a female forename (rather than making the inference from the context presented in the opponent's marks); it would be seen as such in each of the marks consistently and consumers will remain of the view that the marks are related, based on the shared element 'MASHA'. Of course I accept that, where MASHA is understood to be a female forename, it holds a lesser degree of inherent distinctiveness (than where it is viewed as an invented word). However, given that the average consumer

is still likely to consider it an uncommon or unusual name which is unlikely to be selected coincidentally by two distinct entities providing the same goods, it would remain inclined to conclude that the goods offered under the respective marks are provided by a single or related undertaking.

Conclusion

50. The opposition has succeeded. Subject to any successful appeal, the application will be refused.

51. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In accordance with that TPN, I award costs as follows:

Official fee:	£100
Preparing a statement and considering the other side’s statement:	£200
Total	£300

52. I order Mariia Popova to pay Animaccord Ltd the sum of £300. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 30th day of June 2021

**Laura Stephens
For the Registrar**