

TRADE MARKS ACT 1994

**In the matter of application number 2379969
by Topy Trademarks Limited
to register the trade mark Jessica (and device)**

**and in the matter of opposition number 93471
by Cofra Holding AG**

**Appeal of the Applicant from the decision of
Mrs. Judi Pike dated 3 June 2010**

DECISION

1. This is an appeal against a decision of Mrs Judi Pike, the Hearing Officer for the Registrar, dated 3 June 2010, BL O-181-10, in which she rejected an opposition to the registration of the mark shown below for goods in Class 25. The applicant was Topy Trademarks Limited, ("Topy") and the opponent was Cofra Holding AG ("Cofra").
2. Topy applied on 8 December 2004 to register the mark shown below for clothing, footwear and headgear in class 25. The mark consists of the name "Jessica" together with a large "j" device:



3. Notice of opposition was filed on 8 June 2005, the original opponent later being substituted by the current opponent, Cofra. The opposition is based on section 5(2)(b). Cofra initially relied upon three earlier Community trade marks. Two of those had lapsed by the date of the hearing in front of Mrs Pike. The third mark was CTM number 409673 for the word mark "Yessica" registered with an application date of 28 October 2004 for

"textiles and textile goods, not included in other classes; bed and table covers" in Class 24, and retailing services in Class 35.

4. Neither side filed any evidence, and only Cofra filed written submissions. Neither side requested a hearing, so that Mrs Pike reached her decision on the basis of the papers only.
5. She decided, in brief, that:
 - a. The CTMs which had lapsed after the date the opposition was lodged (there being no evidence that they had been used) could not be taken into account for the purposes of the opposition. Therefore, only the third mark, CTM number 409673, was relevant for the purposes of section 5(2)(b). This part of the decision was not appealed.
 - b. Although there was a high level of similarity between the retailing services in Cofra's specification and the goods in Toppo's specification, overall there was no likelihood of confusion.

The opposition therefore failed.

6. An appeal was lodged by Cofra and its TM55 was dated 1 July 2010. The Grounds of Appeal are lengthy and refer to a number of factual matters as well as a number of parts of the Hearing Officer's decision. It is said, in brief, that the Hearing Officer erred because she conducted a flawed comparison of the marks. In particular, she (a) was wrong to hold that the initial letters J and Y are different and are pronounced differently, and that the marks were conceptually dissimilar, and (b) erred in ignoring her own finding as to the high distinctive character of Cofra's mark and as to the principles of interdependency for the assessment of the likelihood of confusion.
7. On the last page of the Grounds of Appeal is a paragraph under the heading "Additional Evidence", which states:

"The Opponent intends to file further evidence in support of the grounds set out above. The Opponent hereby requests leave to submit such evidence before the Appointed Person together with its skeleton arguments at such time when a hearing date is set."

8. By a letter of 14 October 2010, Toppo's trade mark attorneys indicated that it would not be represented on the appeal, but would rely on the reasoning set out in its notice of defence and counterstatement and the decision of 3 June. The hearing of the appeal was fixed for 5 November 2010. On 3 November 2010, Cofra's solicitors submitted a skeleton argument together with four witness statements, all of which are dated 2 November 2010. By a covering letter Cofra indicated that it no longer wished to attend the oral hearing but asked that the case be decided on the basis of the written submissions and fresh evidence.
9. It appeared to me that there were two problems with that course. First, it was not clear to me whether the appellant's solicitors, Messrs. Taylor Wessing, had served the skeleton argument and evidence upon Toppo's attorneys (in fact they had not done so, but served them on 5 November). Secondly, nothing in the skeleton argument or the evidence provided to me on 3 November explained the basis upon which Cofra sought to adduce evidence for the first time on the appeal. I was concerned that I should not proceed to deal with the substantive elements of the appeal before I had dealt with the issue (which Cofra needed to address) of whether the fresh evidence should be admitted. I asked the Treasury Solicitors to inform the parties of those concerns. On 5 November, I ordered Cofra (if it wished to pursue its application to adduce its fresh evidence) to file evidence in support of that application and I gave directions for evidence in answer and in reply.
10. I did not, in the event, receive any further evidence from either party. Instead, both parties filed written submissions addressing the points I had raised. It does not seem to me that the provision of written submissions is a proper substitute for a witness statement explaining why the evidence is only filed at this stage and the significance of that evidence. However, rather than cause further delay and put the parties to further expense, I decided to deal with the point on the basis of those written submissions, and I do so below. Both parties indicated their willingness for me to deal with the matter on paper.

The decision of the Hearing Officer

11. The Hearing Officer's consideration of the section 5(2)(b) grounds commenced with citation of the usual authorities. She then considered the issue of the average consumer and the purchasing process, finding that because the retail services are not particularised there could be a wide range of "average" customers. Next she compared the goods. She found at paragraph 16 that the retail services in Cofra's specification covered retailing of clothing, footwear and headgear, so there was a high level of similarity between the "retailing services" of Cofra's earlier mark and "clothing, footwear and headgear" of Toppo's application. At paragraph 17 she found no similarity between textile goods and clothing, footwear and headgear. No appeal arises on any of those points.

12. The crux of the appeal relates to the Hearing Officer's comparison of the parties' marks and the conclusions she drew as a result. She said (I have removed her footnote references, for brevity):

"18. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

19. ...

20. As [Cofra's] mark is for a word only, the only possible point of convergence between the marks is the word element. Both words consist of seven letters, of which the first letter is different and the remaining letters ('essica') are identical. The first letters, Y and J, look very different. Proportionally, the JESSICA element in TTL's mark is as prominent as the device element, it plays an equally dominant and distinctive rôle to the device. YESSICA does not readily divide into separate elements; there is no separate dominant and distinctive element. The device and word are separate elements in TTL's mark so that the device forms no part of JESSICA which may have put a visual difference between the marks. Owing to the similarity in both structure and composition of the -ESSICA elements of both marks, there is a good deal of visual similarity between the marks, notwithstanding the different first letters. Factoring in the distinctive, prominent device, which is separate to and positioned above the word element, there is a reasonable degree of similarity between the marks.

21. [Cofra] submits that the marks are clearly similar aurally because it claims the syllabic structure is identical (-ESSICA). [It] further submits:

"Furthermore, in many countries in Europe, the letter "J" is pronounced similarly to the letter "Y", for example, JESSICA would be pronounced YESSICA. This makes the marks identical from an aural comparison."

The aural assessment must be from the standpoint of the average consumer in the UK. In the UK, the letter J is pronounced as a J, not a Y. J has a harder sound than Y; it is different aurally (it is not comparable to c/k/x/q, for example).

22. [Cofra] goes on to say:

“For many consumers in the UK it is submitted that the element JESSICA could be pronounced as “YESSICA”, given that consumers are used to the pronunciation of fashion brands being different to the English pronunciation. This is especially so in relation to clothing and fashion brands generally. For example, GUCCI is pronounced in the Italian style. Accepted English pronunciation of this name would be as GUCKI or GUSI.”

I will come onto conceptual identity, but JESSICA is a very common forename in the UK which would be pronounced with a J, not with a Y instead of the J. Because it is so well known, it would not be perceived as a foreign name and so there appears to be no reason why the UK average consumer would give it a foreign pronunciation. Average consumers in the UK do not assume that all fashion brands are foreign and deserve a foreign pronunciation, especially when the brand consists of a well-known English word. I am not persuaded that the average UK consumer would turn the J into a Y. The marks are not aurally identical but the rhythmic pattern of the remaining syllables and letters does make for a good deal of similarity.

23. [Cofra] submits that conceptually, “the marks are identical consisting of a first or christian name”. I find this submission difficult to understand because YESSICA is not a name in the UK, at least not to my knowledge and there is no evidence otherwise. I agree that JESSICA is a forename. Its conceptual significance is solely that it is a forename; i.e. it is not a word which could be a surname or a word with another meaning. YESSICA is an invented word; the respective marks are, therefore, conceptually dissimilar, although as the application is for an invented word, there is not conceptual dissonance.”

Likelihood of confusion

24. It is necessary to consider the distinctive character of the earlier trade mark; ... Invented words have high inherent distinctive character; YESSICA is an invented word and therefore has a high degree of inherent distinctive character. There is a high level of similarity between [Toppo's] clothing, footwear and headgear and [Cofra's] retailing services, and a low level of similarity between [Cofra's] textiles and [Toppo's] clothing and headgear. There is no similarity between the application and [Cofra's] textile goods, bed and table covers. I have found the marks to be dissimilar conceptually but that there is a good deal of similarity visually and more so aurally.”

13. At paragraph 25, the Hearing Officer cited paragraphs 68-9 of the General Court's decision in Case T-88/05, *Quelle AG v OHIM* and continued:

“Clothing is a visual purchase so the visual aspect of the similarity carries more weight in my comparison than the aural similarity. Visual perception of the mark includes TTL's device element which forms part of the overall perception of the application, as per *Shaker*. The visual perception also includes differing first letters of the respective word elements; consumers normally attach more importance to the first part of words. However, what is more significant than the

differing first letters per se is the effect of them on the meaning or concept of the words: the differing first letters mean that one is an invented word with no concept and the other is a very well-known female forename. Visual and aural similarity can be offset by a lack of conceptual similarity, as found by the GC in *Phillips-Van Heusen Corp v OHIM* [2004] ETMR 60

“54 Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning – to counteract to a large extent the visual and aural similarities between the two marks.”

26. Although I bear in mind that the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind, the conceptual dissimilarity of the marks is an important factor reducing the likelihood of imperfect recollection. In considering the interdependency principle (*Canon*), whereby a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services, and vice versa, the position here is of a substantial degree of similarity between goods and services and between the marks aurally and visually, but that the latter is offset to a very great extent by the conceptual dissimilarity. Taking all the factors into account, I consider that there is no likelihood of confusion.”

14. The Hearing Officer therefore rejected the opposition with costs.

The Grounds of Appeal

15. The lengthy Grounds of Appeal complain that the Hearing Officer:

- 1.1 should have assessed the visual similarities between the marks in lower-case, handwritten style, not just in standard typeface;
- 1.2 failed to take into proper account the mix of ethnicities in the UK, when assessing aural similarity;

- 1.3 erred in assessing conceptual similarity, because the average consumer would see “Yessica” as a variation of “Jessica”; and
2. misapplied the principles of a global appreciation of likelihood of confusion, and in particular the interdependency principle, in a number of ways discussed below.

The standard of review

16. The standard of review for this appeal is helpfully set out at paragraphs 5-6 of the decision of Daniel Alexander QC in *Digipos Store Solutions Group Limited v. Digi International Inc* [2008] RPC 24:

“5... It is clear from *Reef Trade Mark* [2003] RPC 5 (“*Reef*”) and *BUD Trade Mark* [2003] RPC 25 (“*BUD*”) that neither surprise at a Hearing Officer’s conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef*, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer’s decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge’s evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.”

The decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind mentioned above.

The application to adduce evidence

17. Cofra wishes to adduce evidence on the appeal, having failed to adduce any evidence before the Registrar, in the circumstances which I have set out above. The evidence consists of five short witness statements, one of which (Miss Gray’s) exhibits a number of documents, such as extracts from the OED and downloaded pages from websites. I

note that all of the exhibits related to the position in November 2010, years after the relevant date in this opposition. Whether the dates of the documents are of significance I do not know; that is not a matter addressed by the evidence. The evidence alleges that (a) some foreign words spelled with a J are properly pronounced (in the UK) as a Y, e.g. Janacek; (b) people whose mother tongue is German, Polish or Swedish would pronounce "Jessica" as "Yessica" and that there are several hundred thousand Germans and Poles living in the UK and (c) that Yessica is a girl's name in e.g. Germany.

18. I note that the points covered by the evidence which Cofra now wishes to adduce were broadly raised in its written submissions to the Hearing Officer, with reference to the pronunciation of "Jessica" by other Europeans and by "many consumers in the UK."
19. Applications to adduce evidence for the first time on appeal must be scrutinised with some care in the light of the principles considered by the Court of Appeal in *DU PONT Trade Mark* [2003] EWCA Civ 1368, [2004] FSR 15. In summary, these are as follows: (1) the factors set out in *Ladd v Marshall* [1954] 1 WLR 1489 remain basic to the exercise of the discretion; (2) *Ladd v Marshall* is no longer a straitjacket, on the contrary the matter is to be looked at in the round to see that the overriding objective is furthered; and (3) in the particular context of trade mark appeals the additional factors set out in *Hunt-Wesson Inc's Trade Mark Application* [1996] RPC 1489 may be relevant.
20. The first *Ladd v Marshall* requirement is that the new evidence could not have been obtained with reasonable diligence for use at the first instance hearing. Plainly that is not the case in relation to this evidence, which would of course have been available at the time evidence was due to be filed in the opposition; moreover, it is clear that the trade mark attorneys acting for Cofra at that time had the essential points raised by the evidence clearly in mind when making their written submissions to the Hearing Officer.
21. The second *Ladd v Marshall* requirement is that the new evidence would probably have an important influence on the result of the case. I discuss this point below.
22. The third requirement is that the new evidence is credible. I have no reason to doubt that this requirement is satisfied in this case, subject to the date issue mentioned above.

23. As for the additional factors in *Hunt-Wesson*, the first is the undesirability of allowing a trade mark on to the Register which may be invalid. In the circumstances of the present case it seems to me that this will turn on the question of whether the evidence is likely to be of significance to the decision. The second is the undesirability of a multiplicity of proceedings. This is a factor in favour of the admission of the new evidence, but in my view not a strong one.
24. The essential point, it seems to me, is whether the evidence which Cofra wishes to file at this stage would have a significant impact upon the merits of the opposition. The evidence goes to two points. First, that the average consumer in the UK is aware that some *foreign* words written with a J are pronounced as if written with a Y. It seems to me that this point is of no significance whatsoever to the assessment of the similarity of these marks. The Hearing Officer picked up this point in paragraph 22 of her decision when she said at paragraph 22 "Jessica is a very common forename in the UK which would be pronounced with a J, not with a Y instead of the J. Because it is so well known, it would not be perceived as a foreign name and so there appears to be no reason why the UK average consumer would give it a foreign pronunciation." I agree. I see no reason why the average consumer in the UK (even if such average consumers included those whose mother tongue is not English) seeing Toppo's sign would think that it was a foreign name which ought to be pronounced as such.
25. Secondly, the evidence goes to the question of how Toppo's sign might be pronounced by Germans, Poles, etc resident in the UK and whether Yessica would be recognised as a name. However, again, it does not seem to me that this would have been a relevant point for the Hearing Officer to consider. What the Hearing Officer had to consider was how the mark would be perceived by the *average* UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word.
26. The position seems to me to be analogous to that considered by the European Court of Justice in Case C-421/04, *Matratzen Concord AG v Hukla Germany SA*, Case, [2006] E.C.R.

I-2303; [2006] E.T.M.R. 48 in relation to marks consisting of descriptive terms in a foreign language. In that case, the question was whether a mark registered in Spain for a variety of bedding goods including mattresses was invalid because it consisted of the German word “Matratzen,” which means mattress. The position under Spanish law is (or was) that names borrowed from foreign languages are seen as fanciful, unless they resemble a Spanish word, so that the average consumer would understand their meaning, or the mark had acquired a genuine meaning on the national market. The ECJ essentially approved that position. The UKIPO’s position, as set out in Practice Amendment Notice 12/06 after *Matratzen*, is that marks consisting of a descriptive word in another European language will be refused registration only if the average UK consumer is likely to recognise them as such:

“In general, the most widely understood European languages in the UK are French, Spanish, Italian and German. The majority of UK consumers cannot be assumed to be fluent in any of these languages, but most of them will have an appreciation of some of the more common words from these languages, particularly common French words. So it may be assumed that the meaning of ‘Biscuit pour Chien’ (dog biscuits) will be known to the average UK customer for dog biscuits. Similarly, it may be assumed that traders in and/or average UK consumers of cosmetics (who will be accustomed to seeing French descriptions on the packaging of cosmetics) will know the meaning of ‘lait’ (milk) and will be able to decipher the meaning of ‘Lait hydratant’ as being moisturising milk (or similar).”

27. Hence, following *Matratzen*, marks consisting of foreign words may be registered if they are not likely to be recognised as descriptive. In BL O/25/05, *Acqua di Gio*, Mr Geoffrey Hobbs QC sitting as the Appointed Person said at paragraph 29 “the impact of a word mark on speakers of English should be used to determine whether it is acceptable for registration in the United Kingdom on absolute and relative grounds” and at paragraph 41 he said “it is impermissible for the English equivalents of foreign words to be used for the purpose of testing issues relating to the distinctiveness, descriptiveness or deceptiveness of such words in the United Kingdom in the absence of good reason for thinking that a significant proportion of the predominantly anglophone public in the United Kingdom would understand the meaning of the word(s) in question.” In my judgment, the position is that even though many people live in the UK whose native tongue is not English, that does not mean that such individuals are to be treated as the relevant “average” consumers for the purpose of deciding what a word means, or how a

word would be pronounced, in the United Kingdom. In the absence of special circumstances, the average public is the “predominantly anglophone public.”

28. Furthermore, Cofra’s proposed evidence that Yessica is a German name is not sufficient, in my view, to overcome the difficulty identified above; the evidence would have had to go further and show that it would be recognised as such in the UK. Cofra argued that Hansel and Gretel might be recognised as foreign names by the average consumer in the UK by virtue of the fairy story, but this does not prove that the same would apply to “Yessica”. As with the examples given in PAN 12/06, recognition will depend upon the facts of each case.

29. It seems to me that the similarity of marks, just as much as descriptiveness, must be assessed from the standpoint of the average consumer in the UK. The Hearing Officer said this at paragraph 21 of her decision. In my judgment her approach was correct. The question was not whether some people living in the United Kingdom might pronounce the J of Jessica as a Y, but how an average member of the relevant public in the United Kingdom would pronounce the word. In my judgment, therefore, the evidence now produced as to how Germans, Poles, etc might pronounce the word was irrelevant to the assessment which the Hearing Officer had to carry out.

30. Equally, it does not seem to me that evidence that Yessica is a name, in, say, Germany would be of help in assessing its meaning to an average UK consumer. The fact that a number of people in the UK might speak German and might know that in the German language a J is pronounced as a Y, would be irrelevant unless the word in question was obviously a German word. The name Jessica is not such a word. Cofra referred me to a passage in BL O/337/09, *Tucci/Tuzzi*, where the Hearing Officer took into account the multi-cultural nature of the population of the UK. However, the facts of that case were significantly different from the facts before me because the relevant consumer would see the Italianate words which it was considering as words from a non-English language, and most probably as invented words. Whilst that might be the case for “Yessica,” it is certainly not the case for the well-known English forename “Jessica.”

31. For these reasons also, it seems to me that the evidence now put forward on Cofra's behalf is not of significance to the appeal. Bearing in mind the overriding objective, it seems to me unnecessary and inappropriate to permit Cofra to adduce this evidence now.
32. A further factor which I would, if necessary, have taken into account was the likely impact upon Toppo of permitting Cofra to adduce evidence at this stage. However, I do not need to consider that point or Toppo's submissions as to prejudice, because, for the reasons set out above, I refuse the application to adduce the further evidence.

Substance of the appeal

33. I move on to the other factors raised by the Grounds of Appeal. I note that the skeleton argument submitted on behalf of Cofra said that the appeal related to two of Mrs Pike's findings: (1) the lack of overall similarity between the marks and (2) the finding of no likelihood of confusion. I do not read the decision under appeal as having found that there was no overall similarity between the parties' respective marks. It seems to me that the Hearing Officer found that there were both visual and aural similarities between them (see paragraphs 20 and 22 respectively and also paragraph 25). The considerations set out in paragraph 25 did not, in my view, lead her to say that there was *no* overall similarity between marks, although she found them on balance less similar than would have been the case had she found conceptual similarity too.
34. The essence of the appeal is, therefore, whether the Hearing Officer erred in her assessment of the likelihood of confusion. This was broken down into a large number of smaller points both in the Grounds of Appeal and in the skeleton argument provided to me, although I have of course had to take into account the fact that many of the points raised in the skeleton relied upon the evidence which I have refused to permit Cofra to adduce.
35. First, as to the assessment of the visual similarity of the marks, Cofra said that the Hearing Officer did not take into account the similarities of a lower-case, handwritten or stylised "y" and "j". It is not clear from paragraph 20 of the decision whether that is a fair criticism of her analysis, nor was this point raised in the written submissions to the

Hearing Officer. However, it seems to me that even if this criticism of her analysis were justified, it takes the appellant nowhere, because the Hearing Officer found in any event, that there was "a good deal of visual similarity between the marks, notwithstanding the different first letters." It does not seem to me that her view would have been any more favourable to Cofra had she considered the point that it now makes. Her view as to the visual similarity of the words alone was plainly tempered by her consideration of the impact of the additional device element in Toppo's mark, which she found to have equal visual prominence to the word element. In the skeleton argument, but not in the Grounds of Appeal, Cofra sought to argue that the device had little impact because the word element of Toppo's mark was more dominant. That is not a matter which it would be appropriate to me to revisit on appeal, given that the Hearing Officer plainly did consider the impact of the device when looking at the visual similarity of the marks.

36. The next point raised by the Grounds of Appeal relates to the assessment of the aural similarities of the marks. The arguments are based upon the point already discussed of the identity of the "average UK consumer" and the likelihood that they would pronounce a word beginning with J as a Y. For the reasons given above, it does not seem to me that these points demonstrate any error on the part of the Hearing Officer in this part of her decision.
37. The next point relates to the Hearing Officer's assessment of the conceptual similarities of the marks. This is put in a number of ways. First, it is said that the average UK consumer "as correctly interpreted" would see "Yessica" as a spelling variation of the well-known name "Jessica". It seems to me that this argument suffers from the problem as to the perception of the two words by the average consumer already discussed: unless the average consumer was familiar with "Yessica" as the equivalent of "Jessica," no conceptual similarity would be found. I reject Cofra's additional argument that even without knowing that Yessica is a girl's name, an average UK consumer would make a connection with Jessica, because it is a well-known name. On this point, I see no basis upon which it would be proper for me to interfere with the Hearing Officer's view.
38. Secondly, Cofra says that the Hearing Officer failed to take account of consumer familiarity with variations in the spelling of girls' names, giving the example of "Jasmin"

being alternatively spelled as “Yasmin”. Again, this is not a point that was raised in the submissions below, nor am I convinced that because an average consumer may know that “Jasmin”/“Jasmine” may be spelled with either a J or a Y, he would assume that the word “Yessica” must be an alternative spelling of “Jessica.” Such an assumption would be even less likely to be made as the mark must be considered in notional use in relation to the goods or services, not as a forename. The Hearing Officer found that Yessica is not known as a name in the UK, and so would be perceived as an invented word. It does not seem to me that there is any fault in that analysis entitling me to interfere with the finding on appeal.

39. Next, the appellant alleged that the Hearing Officer misapplied the principles of the global appreciation of likelihood of confusion, and in particular the interdependency principle. It set out a large number of points under this head in the Grounds of Appeal, some of which seem to me to overlap, and I shall deal with them accordingly.

37. The Hearing Officer accepted at paragraph 25 of her decision that the visual impact of marks used on clothing is significant as clothing is “a visual purchase”. Cofra submitted that she failed to give effect to that (correct) finding, because of her finding that it was outweighed by the lack of conceptual similarity between the marks. Cofra also relied on my decision in BL O/131/09 where I referred to the public being accustomed to seeing marks used in different configurations, especially as sub-brands. Nevertheless, it does not seem to me that the Hearing Officer can be said to have committed an error of principle in her assessment of the relative importance of the visual similarities of the marks as opposed to their conceptual differences.

38. Cofra also suggested that the Hearing Officer placed too much emphasis on the first letters of the two marks, and so failed to consider the marks as a whole. I do not consider that she did make such an error. It seems to me that the submission wrongly ignores the impact of the device element of Toppo’s mark (not an error made by the Hearing Officer) and the impact of the conceptual difference found by the Hearing Officer based on Jessica being recognised by the relevant consumers as a name, whilst Yessica would be seen (and have added distinctiveness) as an invented word. Equally, in

my judgment, the Hearing Officer gave weight to the distinctive character of “Yessica” as a mark and cannot be said to have erred in principle in this regard.

39. Similarly, Cofra complained that the Hearing Officer gave too much importance to her finding of conceptual dissimilarity and wrongly applied the principles which she had cited from the *Bass/Pash* case (Case T-292/01 *Phillips-Van Heusen Corp v OHIM*). Cofra sought to distinguish that case on its facts, but it seems to me that regardless of its particular facts, that case sets out the principal that conceptual differences may to a large extent counteract visual and aural similarities between the marks, especially where one of the marks has a clear meaning which the public would immediately grasp, and the other does not. In my judgment, the Hearing Officer did not make any error in that respect.
40. The complaints made about paragraph 26 of the decision seemed to me to have rather more substance to them. They are twofold: first, the Hearing Officer noted that the average consumer would rarely have the chance to see the two marks side by side and said “the conceptual dissimilarity of the marks is an important factor reducing the likelihood of imperfect recollection.” Cofra justifiably complained that “a likelihood of imperfect recollection” is not a legal test, but I am not sure what that is what the Hearing Officer was saying. Her point could certainly have been more clearly explained, but in my view what she was saying was that where imperfect recollection of one mark may lead to confusion with the other, the risk of such confusion may be reduced where the marks are conceptually dissimilar. In other words, when the mark is not perfectly recollected, the lack of similarity of the concept of the mark may prevent confusion between them. Put in that way, this slightly odd comment in the decision does not seem to me to reflect a distinct error of principle in the Hearing Officer's analysis.
41. The second point about paragraph 26 arises out of the Hearing Officer's comment that “In considering the interdependency principle (*Canon*), whereby a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services, and vice versa, the position here is of a substantial degree of similarity between goods and services and between the marks aurally and visually, but that the latter is offset to a very great extent by the conceptual dissimilarity.” Cofra's complaint is that the interdependency principle requires the Hearing Officer to offset the

similarity between goods/services on the one hand against the similarity between the marks on the other, yet the last phrase of the sentence just quoted suggests that the Hearing Officer was offsetting the visual and aural similarities of the marks against their conceptual dissimilarity. That argument is understandable given the wording of that sentence in paragraph 26. However, the Hearing Officer did set out the correct test in the first part of her sentence, so it seems highly unlikely that she was not seeking to carry out the appropriate test for assessing the likelihood of confusion. Putting that last phrase into context, and looking at the whole of her decision, it is clear that the Hearing Officer felt that the visual and aural similarities of the marks were outweighed by their conceptual dissimilarity, hence in particular her reference in paragraph 25 to *Bass/Pash*. In my judgment, what she was doing in the sentence criticised by Cofra was to seek to explain why, despite the substantial similarity of the goods/services, and the aural/visual similarity of the marks, she found no likelihood of confusion: the substantial similarity between the goods and services was outweighed by the reduced level of similarity between the marks. In the circumstances, it does not seem to me that paragraph 26 discloses a material error of principle justifying my interference on appeal.

42. For all these reasons, the appeal is refused.

43. As I have said, there was no hearing of the appeal, and Topy made no submissions on the substance of the appeal. However, following the Order which I made in relation to the application to adduce evidence on the appeal, Messrs Marks & Clerk LLP submitted written submissions on Topy's behalf on that point. It seems to me that Cofra ought to make a contribution towards Topy's costs of considering the evidence field by Cofra, considering its submissions as to why it should be allowed to adduce the evidence on appeal, and responding to them. I will therefore order Cofra to pay Topy the sum of £300 within 14 days of the date of this decision.

Amanda Michaels
2 March 2011