O/1131/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003986654
BY LUCY CROWTHER
TO REGISTER:

MINKA JEWELS

AS A TRADE MARK IN CLASSES 14, 37 AND 42

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446212
BY VALE MILL (ROCHDALE) LIMITED

BACKGROUND AND PLEADINGS

1. On 1 December 2023, Lucy Crowther ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 15 December 2023 in respect of the following goods and services:

> **Class 14:** *Jewellery; Necklaces [jewellery]; Pendants [jewellery]; Bracelets [jewellery]; Brooches [jewellery, jewelry (Am.)]; Amulets being jewellery; Amulets [jewellery]; Pearls [jewellery]; Trinkets [jewellery]; Necklaces [jewellery, jewelry (Am.)]; Jewelry; Gold jewellery; Lockets [jewellery]; Jewelry brooches; Clasps for jewellery; Charms [jewellery]; Charms for jewellery; Jewellery charms; Items of jewellery; Jewellery items; Rings being jewellery; Rings [jewellery]; Trinkets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Bracelets [jewellery, jewelry (Am.)]; Jewellery stones; Rings [jewellery, jewelry (Am.)]; Jewellery products; Precious jewellery; Jewellery chains; Personal jewellery; Jewellery incorporating diamonds; Jewellery for pets; Jewellery incorporating pearls; Diamond jewelry.*
>
> **Class 37:** *Remounting of jewellery; Jewellery remounting.*
>
> **Class 42:** *Designing of jewellery; Design of jewellery.*

2. On 06 March 2024, the application was opposed by Vale Mill (Rochdale) Limited ("the opponent") based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

3. The opponent relies on the following trade mark and some of the goods and services covered by the same, as shown below:

UK00003532416 (series of two) MINKY Minky

Filing date: 11 September 2020

Registration date: 19 February 2021

Class 14: *Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; charm bracelets; charms; jewellery charms; bracelet charms; jewellery chains; tie pins jewellery boxes; jewellery cases; musical jewellery boxes; jewellery caskets; trinkets; key rings and key chains and charms therefor; cuff links; metals badges for wear; pins; ornamental pins; medals; watches; watch straps; parts and fittings for all the aforesaid goods.*

Class 35: *retail services, online retail services, wholesale services, online wholesale services relating to precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments, charm bracelets, charms, jewellery charms, bracelet charms, jewellery chains, tie pins jewellery boxes, jewellery cases, musical jewellery boxes, jewellery caskets, trinkets, key rings and key chains and charms therefor, cuff links, metals badges for wear, pins, ornamental pins, medals, watches, watch straps, parts and fittings for all the aforesaid goods.*

4. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an "earlier mark" in accordance with Section 6 of the Act. As the opponent's earlier mark had not been registered for five years or more at the filing date of the applied-for mark, it is not subject to the use conditions under Section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services it has identified without demonstrating that it has used the mark.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the marks are similar, and the goods and services are identical or similar.

6. The applicant filed a counterstatement, denying the claims made. In particular, the applicant argues that "*the marks, when considered in their entireties, are sufficiently distinct both visually and phonetically"* and that *"the addition of the term "Jewels" provides a clear conceptual distinction, thereby negating any potential confusion or association with the mark "Minky"".* In addition, the applicant contends that the parties

target different segments of the markets, because the opponent is a leading brand in the UK Homecare market, primarily known for laundry, cleaning, and homecare products, not jewellery. The applicant also submits that (a) the typical consumers of the applicant's goods exhibit a high degree of attention due to the bespoke nature of the products and (b) the minimal market presence and the bespoke nature of the applicant's jewellery further diminish any likelihood of confusion. Finally, the applicant requests the opponent to provide evidence of actual confusion and seeks disclosure of the opponent's sales figures related to the sale of jewellery under the earlier mark.

7. The opponent is represented by Roome Associates Limited. The applicant is represented by MOORE LAW. Both parties filed evidence during the evidence rounds. Along with its evidence, the opponent also filed two lots of submissions. Neither party requested a hearing, but they both filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. During the first round of evidence, the opponent did not file any evidence in chief; instead, it filed written submissions dated 22 August 2024.

10. The applicant filed evidence in chief in the form of the witness statement of Scott Appleton, dated 22 October 2024. Mr Appleton is a director and partner at MOORE LAW, the representative of the applicant in these proceedings. His evidence is accompanied by 12 exhibits (SA1-SA12) and relates to various facts, including, among others: how the applicant's goods can be purchased; the etymology of the applicant's

brand; the segments of the market targeted by the parties; and state of the register evidence.

11. In response to the applicant's evidence, the opponent filed evidence in reply in the form of a witness statement of Ann Elizabeth Roome, dated 20 December 2024, along with submissions, also dated 20 December 2024. Ms Roome is a trade mark attorney at Roome Associates Limited, the representative of the opponent in these proceedings. Her evidence is accompanied by 1 exhibit (AER1) and is aimed at showing that the term 'jewels' is descriptive.

DECISION

Section 5(2)(b)

12. 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."

13. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

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

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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."

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM***,** Case T-325/06, the General Court ("GC") stated that "complementary" means:

"[…] 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."

18. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same

undertaking or with economically connected undertakings. As Mr Daniel Alexander QC (as he then was) noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

19. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

20. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

> "29. In addition, 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."

21. The competing goods and services are as follows:

The applicant's goods and services	**The opponent's goods and services**
Class 14: *Jewellery; Necklaces [jewellery]; Pendants [jewellery]; Bracelets [jewellery]; Brooches [jewellery, jewelry (Am.)]; Amulets being jewellery; Amulets [jewellery]; Pearls [jewellery]; Trinkets [jewellery]; Necklaces [jewellery, jewelry (Am.)];*	**Class 14:** *Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; charm bracelets; charms; jewellery charms; bracelet charms; jewellery chains; tie pins jewellery boxes; jewellery cases;*

Jewelry; Gold jewellery; Lockets [jewellery]; Jewelry brooches; Clasps for jewellery; Charms [jewellery]; Charms for jewellery; Jewellery charms; Items of jewellery; Jewellery items; Rings being jewellery; Rings [jewellery]; Trinkets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Bracelets [jewellery, jewelry (Am.)]; Jewellery stones; Rings [jewellery, jewelry (Am.)]; Jewellery products; Precious jewellery; Jewellery chains; Personal jewellery; Jewellery incorporating diamonds; Jewellery for pets; Jewellery incorporating pearls; Diamond jewelry. **Class 37:** *Remounting of jewellery; Jewellery remounting.* **Class 42:** *Designing of jewellery; Design of jewellery.*	*musical jewellery boxes; jewellery caskets; trinkets; key rings and key chains and charms therefor; cuff links; metals badges for wear; pins; ornamental pins; medals; watches; watch straps; parts and fittings for all the aforesaid goods.* **Class 35:** *retail services, online retail services, wholesale services, online wholesale services relating to precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments, charm bracelets, charms, jewellery charms, bracelet charms, jewellery chains, tie pins jewellery boxes, jewellery cases, musical jewellery boxes, jewellery caskets, trinkets, key rings and key chains and charms therefor, cuff links, metals badges for wear, pins, ornamental pins, medals, watches, watch straps, parts and fittings for all the aforesaid goods.*

22. In her counterstatement, the applicant did not deny that the parties' goods and services are identical or similar. Instead, she argued that the parties operate in different markets because the applicant sells jewellery, whereas the opponent primarily sells laundry, cleaning, and homecare products. First, the applicant's argument about the different markets in which the parties have so far chosen to trade is not pertinent. This is because the comparison of the goods and services must be carried out based on the goods and services for which the marks are registered and/or applied-for.

23. Second, in *SKYCLUB* (BL-O/044/21), Professor Phillip Johnson, sitting as the Appointed Person, stated that the principle that where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)) is applicable in trade mark opposition proceedings. Hence, in this case, the applicant's failure to deal with the identity/similarity of the goods and services means that the opponent's claim as to their identity and/or similarity is admitted. Accordingly, I will proceed on the basis that the opponent's claim that the parties' goods in class 14 are identical is admitted – this is also self-evident given that the opponent's specification covers the term *jewellery* and the applicant's goods are all types of jewellery.

24. Having said that, the opponent did not say, for the services which are not identical, to what degree it considers them to be similar. Consequently, I will carry out my assessment bearing in mind that there is an admission of, at least, a low level of similarity.

25. The opponent's specification covers the term *jewellery* in class 14, as well as retail services relating to jewellery. The applied-for services in class 37 cover *Remounting of jewellery; Jewellery remounting*. Remounting of jewellery is a process which involves placing existing gemstones in a brand-new setting, transforming its look. Whilst there is no evidence on the point, from my experience, it is common for jewellery manufacturers and retailers to offer remounting services for jewellery, and the relevant public for these services and the goods to which they relate is the same as well. Accordingly, whilst the goods and services have a different nature and purpose, they target the same users and share the same distribution channels and are therefore similar to a low to medium degree to the opponent's goods in class 14 and services in class 35. The same principles apply to find that the contested *Designing of jewellery; Design of jewellery* are similar to a low to medium degree to the opponent's goods in class 14 and services in class 35.

Average consumer

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average

consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

27. The average consumer for the goods and services at issue is a member of the general public. Both the goods and services are offered through a range of channels, including retail premises such as department stores or via dedicated jewellery shops, as well as online. In retail stores, items of jewellery may be displayed on shelves, where they will be viewed and self-selected by the consumer; alternatively, more expensive items will be stored in a cabinet/behind the counter, where the consumer will need to make a request to view and/or purchase the goods. A similar process will apply to websites, where the consumer will select the goods and services having viewed an image displayed on a webpage. Considered overall, the selection process will be a predominantly visual one, although aural considerations will play their part, particularly when advice is sought from sales representatives.

28. Jewellery may be classed as "costume" jewellery, i.e. jewellery that is decorative but has little intrinsic value, or may be high end which has been crafted from valuable metal such as gold and may be adorned with precious or semi-precious stones. Even in relation to goods at the lower end of the price spectrum, the material of which the goods are made, the function, size, fit and aesthetic considerations are all likely to be relevant factors. In such circumstances, I would expect the consumer to pay an average degree of attention during the selection process. As the cost and importance of such goods increases, so will the degree of attention paid to the selection, with goods at the top end of the price spectrum attracting a high degree of attention.

29. Turning to the services, the remounting and design of jewellery usually encompass a range of bespoke and custom options, allowing clients to create unique pieces that reflect their personal style and story. The services in question are such that, by their own nature, they will attract a slightly above medium (but not high) degree of attention.

30. Whilst the specification of the applied-for mark covers both high and low-end goods (and related services), the assessment of a possible likelihood of confusion must ultimately be based on the actual perception of the average consumer with a lower degree of attention, which, in this case, is medium (for the goods) and slightly above medium (for the services).[1]

Comparison of marks

31. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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 impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

32. 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,

[1] See T-221/09, *ERGO Group,* EU:T:2011:393, § 21

contribute to the overall impressions created by the marks. The respective marks are shown below:

The applied-for mark	**The opponent's mark**
MINKA JEWELS	MINKY Minky

33. Both marks are word-only marks. Although the opponent's mark is a series of two, there is no material difference between them, because word-only marks cover use in all possible fonts and typefaces. Consequently, I will refer to the mark that is presented in capital letters because it is the closer to the applied-for mark.

34. The applied-for mark consists of the words 'MINKA' and 'JEWELS' presented side by side in capital letters. Whilst the applicant argues that the word 'JEWELS' is not descriptive but is a key element of the mark as a whole, it does not provide any reason which would support such an argument. The word 'JEWELS' means "*a precious stone that is used to decorate valuable objects"* and *"decorative objects worn on your clothes or body that are usually made from valuable metals, such as gold and silver, and precious stones"* (Cambridge online dictionary). It is evident, therefore, that the word 'jewels' can refer to either items of jewellery (the word 'jewellery' having the same definition as that of 'jewel', namely "*decorative objects worn on your clothes or body that are usually made from valuable metals, such as gold and silver, and precious stones"*) or precious stones used to decorate items of jewellery; and it is descriptive for the goods and services at issue. Accordingly, I find that the average consumer will recognise the descriptive nature of the word "JEWELS" in relation to the goods at hand, being jewellery; and services, being remounting of jewellery and designing of jewellery. Therefore, it is the word 'MINKA' (which is an invented word and is inherently distinctive) that dominates and will make the greatest contribution to the overall impression.

35. The opponent's mark consists of the single word 'MINKY', presented in a standard typeface in capital letters, without any other elements to contribute to the overall

impression. The overall impression conveyed by the mark therefore rests in the word itself.

Visual similarity

36. In her counterstatement, the applicant states as follows:

> *"Under Section 5(2)(b) of the Trade Marks Act 1994, the defence argues that there is no realistic likelihood of confusion among the relevant public. The marks, when considered in their entireties, are sufficiently distinct both visually and phonetically. The addition of the term "Jewels" provides a clear conceptual distinction, thereby negating any potential confusion or association with the mark "Minky".*

37. Referring to the evidence filed by Mr Appleton, in her written submissions in lieu, the applicant argued that 'MINKA' is a portmanteau of her grandparents' names and reiterated that the word 'jewels' is not descriptive, but is a key element of the mark as a whole which the applicant has used consistently since at least 2016 on her social media accounts and website. In his witness statement, Mr Appleton states that the word 'MINKA' amalgamates the name of the applicant's great-grandmother 'Minnie' and grandmother 'Katrina', whilst the additional word 'Jewels' is based on the fact that the applicant's founder is a gemmologist and specialises in fine jewellery. Mr Appleton also refers to the applicant's mark having been widely documented and recognised by a variety of press outlets, including, but not limited to: Vogue, Vanity Fair, Country Life and other such publications.

38. First, remarkably, the applicant did not deny the opponent's claim that the distinctive parts of the marks, i.e. the words 'MINKA' and 'MINKY', are nearly identical, because they both start with the identical first four letters 'MINK', end with a vowel and are of the same length. The applicant is silent on this point, though she argues that it is the word 'Jewels' that will provide *"a clear conceptual distinction, thereby negating any potential confusion or association"* between the marks. Second, the fact that the applicant might have used 'MINKA JEWELS' as a whole since 2016 or that the mark has received some press attention is wholly irrelevant for the purpose of the

assssment I am required to carry out. This is because, such use cannot have increased the distinctveness of the word 'JEWELS'; but, even if it did, it is not something that is contemplated by the case-law which governs my assessment and which requires me to consider the applied-for mark as it has been filed. Finally, the issue of earlier use has no bearing upon the instant proceedings as set out by Tribunal Practice Notice 4/2009 *"Trade mark opposition and invalidation proceedings – defences",* under the heading "*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark",* which states as follows:

> "4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in Ion Associates Ltd v Philip Stainton and Another, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.
>
> 5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

39. As far as I am aware, at no time did the applicant seek to invalidate the opponent's earlier mark, thus, the existence of a prior right is irrelevant to the issue I have to decide.

40. Bearing in mind that:

A. the words 'MINKA' and 'MINKY', are of the same length, share the same first four letters and differ only in the last vowel (which is an 'A' in the applied-for mark, and a 'Y' in the opponent's mark) and

B. the only difference between ‘MINKA’ and ‘MINKY’ is placed at the end of the signs where the customer’s attention is less focused,

these elements of the marks are similar to a high degree. Although the addition of the word ‘JEWELS’ in the applied-for mark is not completely negligible, it does not introduce a distinctive difference between the marks. Overall, I consider the marks to be visually similar to a high degree.

Aural similarity

41. Aurally, the marks will be pronounced as MIN-KA and MIN-KE. These elements of the marks are similar to a high degree. Though it is possible that the average consumer will verbalise the descriptive element JEWELS, it will attribute it little trade mark significance. Overall, I consider the marks to be aurally similar to a high degree.

Conceptual similarity

42. Conceptually, neither mark has any meaning. Consequently, the conceptual position is neutral. For the sake of completeness, I should say that although the word ‘JEWELS’ in the applied-for mark conveys a concept, it is a descriptive and non-distinctive one, which will not give rise to any distinctive difference between the marks.

Distinctive character of the earlier mark

43. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

44. Registered trade marks possess various 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 made of it.

45. The earlier mark consists of the words 'MINKY'. The word 'MINKY' is an invented word which does not evoke any concept. I consider the mark to be distinctive to a high degree.

Likelihood of confusion

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has

the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

47. Earlier in this decision I found that:

- The marks are visually and aurally similar to a high degree and conceptually neutral.

- The goods are identical, and the services are similar to a low to medium degree.

- The goods and services will be selected visually with an average degree or slightly above average degree attention. However, aural considerations cannot be discounted completely.

- The earlier mark is distinctive to a high degree.

48. I consider that given the identity and similarity of the goods and services and the high distinctive character of the earlier mark, the high degree of visual and aural similarity between the marks is sufficient to cause the average consumer to directly confuse them. In reaching this conclusion, I bear in mind that the elements 'MINKA' and 'MINKY' are of equal length, consisting of five letters, and that the only difference between them is placed at the end of the words, where consumer attention is less focused. Added to this, the absence of any conceptual hook in relation to the earlier mark upon which the memory could hang, one can easily foresee the marks being confused in the imperfect recollection of the average consumer.

49. There is a likelihood of confusion. The opposition succeeds under Section 5(2)(b) in its entirety.

Final remarks

50. As it will be recalled, I have already rejected some of the applicant's arguments including the argument about the applicant enjoying an earlier unregistered right

stemming from her use of the applied-for mark, and that concerning the parties operating in different segments of the market. As I have explained, these arguments are not pertinent.

51. In addition, the applicant contends that the absence of confusion in the marketplace militates against the likelihood of confusion, and that, by not objecting to her use of a sign identical to the applied-for mark, the opponent has lost the right to object to the application. I do not accept these arguments either. First, the opponent's earlier mark is not subject to proof of use, and the opponent has not filed any evidence of use – in the absence of use, it would be simply impossible for the opponent to provide evidence of confusion. In any event, (a) for the opponent to be successful, it does not need to supply evidence of confusion; and (b) for the absence of confusion to be relevant it must derive from the peaceful coexistence of the marks in the marketplace,[2] which is not the case here. Second, for statutory acquiescence to be relevant, it must relate to a registered trade mark. In this connection, the law as it now stands requires the following conditions to be satisfied in order for the five-year period of limitation in consequence of acquiescence to begin:

> 1. The later trade mark must be registered (*Budějovický Budvar, národní podnik, v Anheuser-Busch Inc. ("Budvar"),* case C-482/09);
>
> 2. The application for the later trade mark must have been made in good faith (*Budvar*);
>
> 3. The proprietor of the later mark must use his mark in the UK (*Budvar);*
>
> 4. The proprietor of the earlier trade mark must be aware of the use of the later trade mark for a five-year period that in fact follows the registration of the later trade mark. However, he does not need to be aware of the registration of the later trade mark (*Industrial Cleaning Equipment (Southampton) Ltd v Intelligent Cleaning Equipment Holdings Co Ltd & Anor* [2023] EWCA Civ 1451).

[2] Aceites del Sur-Coosur SA v OHIM, Case C-498/07 P and Budejovicky Budvar NP v Anheuser-Busch Inc, Case C-482/09

52. There is no such a thing as acquiescence to use of an unregistered mark; but in any event, there is no evidence of the opponent being aware of the applicant using the contested mark prior to the application being filed.

53. Lastly, the applicant alleges that the opposition was filed by the opponent in bad faith. It suffices to say, that no such defence is available to the applicant in the absence of a formal challenge to the earlier mark, which is not present in this case.

OUTCOME

54. The opposition is successful, and the application is refused registration.

COSTS

55. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,050 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the
applicant's counterstatement: £250
Filing evidence
and considering the other party's evidence : £400
Submissions in lieu: £300
Official fee: £100
Total: £1,050

56. I, therefore, order Lucy Crowther to pay Vale Mill (Rochdale) Limited the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 2nd day of December 2025

TERESA PINTO

For the Registrar