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The eye has a tendency to see what it expects to see, but ZARA and ZANA are not confusingly similar

Julius Stobbs, Monica Ézsiás (Stobbs IP) · Wednesday, August 31st, 2022

Summary

The owner of a boutique store, Ms. Kotri (Applicant), successfully defended her trade mark application before the UKIPO for HOUSE OF ZANA, covering “clothing” in class 25, against apparel retailer, Inditex (Opponent). The Opponent sought to prevent registration on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 and relied on several registrations for the wordmark ZARA covering class 25 clothing.

Section 5(2)(b)

On a visual comparison, the Registrar considered the stylisation of the contested mark as contributing to the overall impression, yet being secondary to the words. Though the average consumer does not analyse a mark’s various details, “HOUSE OF” is common parlance in the fashion industry and therefore of low-level distinctiveness, making “ZANA” the dominant element.

Aurally, “House of Zar-nuh” consists of four syllables, whereas “Za-ruh” consists of two syllables.

The Registrar referenced a High Court judgment: “The human eye has a well-known tendency to see what it expects to see and the human ear to what it expects to hear. Thus it is likely that some consumers would misread or mishear UVEDA as AVEDA”.^[1]

However, the marks here were considered visually and aurally similar to a low-medium degree.

Most interesting is the Registrar’s analysis on conceptualism. The Applicant emphasised her heritage and rationale for choosing the name: Zana is a type of fairy in Albanian folklore thereby alluding to her items of clothing as being manufactured with magical delicacy. The Opponent contested that both Zana and Zara are female forenames of Hebrew origin. The Registrar found that the average consumer would be unaware of the etymology. Even if Zana was viewed as a female name, the shared concept in and of itself is neutral. There must be more of a connection between the names. They were therefore considered conceptually different.

Taking all relevant factors into account, a likelihood of confusion was not found.

Section 5(3)

In assessing parasitism, the Registrar found no cynical motive in the Applicant's use of the name Zana, but equally noted that subjective intention cannot override an objective transfer of image and free-riding on the power of attraction.

While HOUSE OF ZANA may call to mind ZARA, it is not enough for a finding that consumers will link the two as deriving from one commercial source. It was "not satisfied that the mental link would be more than fleeting".

Reputation alone does not make it more likely that a consumer would purchase the Applicant's goods: "The similarity from the overall impressions are not so strong as to provoke such an unthinking Pavlovian response".

The Opponent's arguments for a hypothetical circumstance of the Applicant's goods being of inferior quality were insufficient to find a serious risk of injury to the Opponent.

The Opposition failed on all accounts under s.5(3).

Comment

Perhaps if the marks were simple wordmarks ZANA and ZARA would consumers not immediately notice the difference between the letter 'n' from 'r', especially considering their imperfect recollection.

Though not considered, it is noteworthy that, for a finding of indirect confusion, it is irrelevant whether consumers believe clothing from HOUSE OF ZANA derive from Zara of Inditex – even if, perhaps, it may be more likely that Inditex, with its portfolio of retail brands, could sell clothing under HOUSE OF ZANA.

Only once in a blue moon will an Opponent win on s.5(3) where it fails on s.5(2)(b). *Red Bull v Monster*^[2] demonstrated recently it is possible – however, if the later mark is not confusingly similar to the earlier mark, and the Opponent cannot prove that the Applicant intended to ride on its coat-tails, then the change in economic behaviour will depend on an actual image transfer (from RED DAWG to RED BULL, or HOUSE OF ZANA to ZARA). Zara's reputation is undeniable, but alone not enough to cross the line – this is so even where the goods are identical. Perhaps an opponent has a greater chance of success on s.5(3) where its industry is niche, such as for energy drinks, contrary to the saturated clothing sphere.

[1] *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589

[2] *Monster Energy Company v Red Bull GmbH* [2022] EWHC 2155 (Ch)

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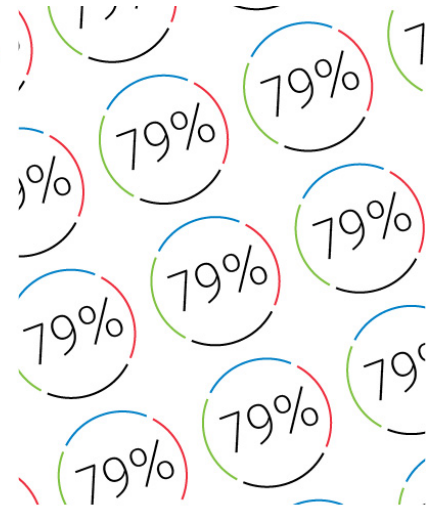
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