

O/138/21

TRADEMARKS ACT 1994

IN THE MATTER OF TRADEMARK APPLICATION 3466126

BY

SERENE UNDERWEAR LTD

TO REGISTER THE FOLLOWING TRADEMARKS IN CLASSES 24 & 25



AND THE OPPOSITION UNDER NO. 420042 THERETO

BY

CREACIONES SELENE, S.L

## Background and pleadings

1. Serene Underwear Ltd (“the applicant”) applied to register the trade marks displayed on the cover page in the UK on 12 February 2020. They were accepted and published in the Trade Marks Journal on 28 February 2020 in respect of the following goods:

**Class 24:** Knitted elastic fabrics for ladies underwear.

**Class 25:** Underwear; Anti-sweat underwear; Babies' pants [underwear]; Boy shorts [underwear]; Briefs [underwear]; Disposable underwear; Functional underwear; Gussets for underwear [parts of clothing]; Jockstraps [underwear]; Knitted underwear; Ladies' underwear; Long underwear; Maternity underwear; Men's underwear; Sweat-absorbent underclothing [underwear]; Sweat-absorbent underwear; Thermal underwear; Trunks [underwear]; Women's underwear; Underwear; Anti-sweat underwear; Babies' pants [underwear]; Boy shorts [underwear]; Briefs [underwear]; Disposable underwear; Functional underwear; Gussets for underwear [parts of clothing]; Jockstraps [underwear]; Knitted underwear; Ladies' underwear; Long underwear; Maternity underwear; Men's underwear; Sweat-absorbent underclothing [underwear]; Sweat-absorbent underwear; Thermal underwear; Trunks [underwear]; Women's underwear; Bralettes; Socks; Socks and stockings; Socks for infants and toddlers; Socks for men; American football socks; Ankle socks; Anklets [socks]; Anti-perspirant socks; Bed socks; Footless socks; Inner socks for footwear; Japanese style socks (tabi covers); Japanese style socks (tabi); Men's dress socks; Men's socks; Non-slip socks; Pop socks; Sports socks; Sweat-absorbent socks; Tennis socks; Thermal socks; Toe socks; Trouser socks; Water socks; Woollen socks; Yoga socks.

2. CREACIONES SELENE, S.L (“the opponent”) opposes the trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of three earlier European Union Trade Marks (EUTMs), namely:

a) **EUTM No: 15485972**, which was filed on 27 May 2016 and registered on 13 October 2016 for the following mark:

for the following goods and services:

**Class 16:** Photographs; Printers' type; Adhesives for stationery or household purposes; Artists' materials; Typewriters and office requisites (except furniture); Printing blocks; Stationery; Paper, cardboard; Instructional and teaching material (except apparatus); Paint brushes; Printed publications, books, magazines; Printed matter; Plastic materials for packaging (not included in other classes); Catalogues of lingerie, corsetry and underwear; Bookbinding material.

**Class 25:** Underwear; Foundation garments; Underwear; Ready-made clothing, footwear (included in this class), headgear.

**Class 35:** Recycling of waste and refuse materials; Recycling of valuable materials and plastic; Cutting services; Organisation of exhibitions for commercial or advertising purposes, wholesaling and/or retailing and/or sale via global computer networks of underwear, lingerie and corsetry, ready-made clothing, footwear (included in this class), headgear; Waste management services; Advertising; Metal plating; Organisation of fashion shows for commercial and promotional purposes, business management; Business administration; Office functions.

**Class 40:** Recycling of valuable materials and plastic; Recycling of waste and refuse materials; Needlework and dressmaking; Services for metal coatings; Treatment of materials that are present during the production of any substance or object other than a building; cutting services; Cloth cutting; Moulding of concrete; Waste management services; Dyeing; Polishing by abrasion.

**Class 42:** Industrial analysis and research services; Scientific and technological services and research and design relating thereto; Dress designing.

- b) **EUTM No: 11544772**, which was filed on 05 February 2013 and registered on 23 May 2013 for the following mark:

**CREACIONES SELENE**

for the following goods:

**Class 25:** Ladies Underwear.

- c) **EUTM No. 15485808**, which was filed on 27 May 2016 and registered on 27 September 2016 for the following mark:

**CREACIONES SELENE**

for the following goods and services:

**Class 16:** Catalogues of lingerie, corsetry and underwear; Printed publications, books, magazines; Paper, cardboard; Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging (not included in other classes); Printers' type; Printing blocks.

**Class 25:** Underwear; Underwear; Foundation garments; Ready-made clothing, footwear (included in this class), headgear.

**Class 35:** Advertising; Business management; Business administration; Office function services; Organisation of exhibitions for commercial or advertising purposes, wholesaling and/or retailing and/or sale via global computer networks of underwear, lingerie and corsetry, ready-made clothing, footwear (included in this class), headgear; Organisation of fashion shows for commercial and advertising purposes.

**Class 40:** Cloth cutting; Needlework and dressmaking; Recycling of waste and refuse materials; Recycling of valuable materials and plastic; Waste

management services; Moulding of concrete; Treatment of materials that are present during the production of any substance or object other than a building; cutting services; Polishing by abrasion; Services for metal coatings; Dyeing.

**Class 42:** Dress designing; Scientific and technological services and research and design relating thereto; Industrial analysis and research services.

3. The opponent relies on all of the goods and services covered under each of its earlier marks.
4. The opponent argues that the respective goods and services are identical and highly similar in respect of the class 25 goods at issue, and similar or complementary in respect of the remaining goods and services at issue. It claims that the marks are similar. It states that the applicant's mark is visually, phonetically and conceptually highly similar to its earlier marks. It adds that the dominant element in each of the earlier marks is the word 'SELENE'. It claims that the lines and coloured background do not detract from the word 'SERENE' in the contested mark and that the word elements at issue differ only by one letter.
5. The opponent also claims that the word 'CREACIONES' in the earlier EUTMs 11544772 and 15485808 means 'creations' in English and this meaning will be appreciated by the average consumer as the words are so similar. Therefore, it argues that the element 'SELENE' is the identifying element of those marks.
6. The applicant filed a counterstatement denying the claims made and stating that its mark is an English word not Spanish, that it would be inaccurate to say they are pronounced the same, and that they had no existing knowledge of the earlier 'SELENE' marks. The applicant added that the clothing goods at issue in class 25 are in different markets and will not be confused. It states that whilst the word 'SELENE' is a dominant element of the earlier marks, it will be pronounced differently to the English word 'SERENE'. Furthermore, it states that the parallel lines bordering the word 'SERENE' in the contested mark "serve as a huge distinctive factor when comparing both logos".

7. The applicant claims that the word 'SELENE' has a meaning, being defined as a moon goddess, whilst the word 'SERENE' means calm and tranquillity. It suggests that these differences will not go unnoticed.
8. Neither side has filed evidence or provided written submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. The applicant is unrepresented. The opponent is represented by Mathys & Squire LLP.

## **DECISION**

### **Section 5(2)(b)**

10. Section 5(2)(b) of the Act is 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”.

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which states:

“6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

12. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2, above, which qualify as earlier trade marks under the above provisions. EUTMs 15485972 and 15485808 had not completed the registration process more than 5 years before the filing date of the application in suit, and so are not subject to proof of use, as per section 6A of the Act. EUTM 11544772 did complete the registration process more than 5 years before the filing date of the application in suit, however the applicant did not put the opponent to proof of use. The opponent can, as a consequence, rely upon all of the goods and services covered under its earlier marks.

### **The Principles**

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 great 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 the earlier mark to mind, 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**

14. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*, Case T-133/05, the General Court ("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 für 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".

17. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

18. For the purposes of procedural economy, I will begin my comparison with an assessment of the opponent's earlier EUTM 1548972, as this earlier right has the broadest list of goods and services of the three rights relied on. I will consider the remaining earlier rights later in my decision.

19. The parties' respective specifications are:

Earlier EUTM No: 15485972	Contested Application
<p><b>Class 16:</b> Photographs; Printers' type; Adhesives for stationery or household purposes; Artists' materials; Typewriters and office requisites (except furniture); Printing blocks; Stationery; Paper, cardboard; Instructional and teaching material (except apparatus); Paint brushes; Printed publications, books,</p>	<p><b>Class 24:</b> Knitted elastic fabrics for ladies underwear. <b>Class 25:</b> Underwear; Anti-sweat underwear; Babies' pants [underwear]; Boy shorts [underwear]; Briefs [underwear]; Disposable underwear; Functional underwear; Gussets for underwear [parts of clothing]; Jockstraps [underwear];</p>

<p>magazines; Printed matter; Plastic materials for packaging (not included in other classes); Catalogues of lingerie, corsetry and underwear; Bookbinding material.</p> <p><b>Class 25:</b> Underwear; Foundation garments; Underwear; Ready-made clothing, footwear (included in this class), headgear.</p> <p><b>Class 35:</b> Recycling of waste and refuse materials; Recycling of valuable materials and plastic; Cutting services; Organisation of exhibitions for commercial or advertising purposes, wholesaling and/or retailing and/or sale via global computer networks of underwear, lingerie and corsetry, ready-made clothing, footwear (included in this class), headgear; Waste management services; Advertising; Metal plating; Organisation of fashion shows for commercial and promotional purposes, business management; Business administration; Office functions.</p> <p><b>Class 40:</b> Recycling of valuable materials and plastic; Recycling of waste and refuse materials; Needlework and dressmaking; Services for metal coatings; Treatment of materials that are</p>	<p>Knitted underwear; Ladies' underwear; Long underwear; Maternity underwear; Men's underwear; Sweat-absorbent underclothing [underwear]; Sweat-absorbent underwear; Thermal underwear; Trunks [underwear]; Women's underwear; Underwear; Anti-sweat underwear; Babies' pants [underwear]; Boy shorts [underwear]; Briefs [underwear]; Disposable underwear; Functional underwear; Gussets for underwear [parts of clothing]; Jockstraps [underwear]; Knitted underwear; Ladies' underwear; Long underwear; Maternity underwear; Men's underwear; Sweat-absorbent underclothing [underwear]; Sweat-absorbent underwear; Thermal underwear; Trunks [underwear]; Women's underwear; Bralettes; Socks; Socks and stockings; Socks for infants and toddlers; Socks for men; American football socks; Ankle socks; Anklets [socks]; Anti-perspirant socks; Bed socks; Footless socks; Inner socks for footwear; Japanese style socks (tabi covers); Japanese style socks (tabi); Men's dress socks; Men's socks; Non-slip socks; Pop socks; Sports socks; Sweat-absorbent socks; Tennis</p>
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<p>present during the production of any substance or object other than a building; cutting services; Cloth cutting; Moulding of concrete; Waste management services; Dyeing; Polishing by abrasion.</p> <p><b>Class 42:</b> Industrial analysis and research services; Scientific and technological services and research and design relating thereto; Dress designing.</p>	<p>socks; Thermal socks; Toe socks; Trouser socks; Water socks; Woollen socks; Yoga socks.</p>
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20. Applying the principle established in *Meric*, the opponent's earlier general categories of 'Underwear' and 'Ready-made clothing' entirely encompass all of the contested goods in class 25, these goods are therefore identical.

21. The contested goods 'Knitted elastic fabrics for ladies underwear' in class 24, are fabric materials intended to be finished and manufactured as ladies underwear or as an integral part of ladies underwear. These goods are piece materials rather than the finished article.

22. The earlier good 'Underwear' comprises a finished article of clothing that will be constructed using the contested goods in class 24. These goods are intended for sale to the general public or as wholesale. The earlier services 'Needlework; Dressmaking; Dyeing and Cloth cutting' form part of the process in the production of clothing and other textile items and may therefore require the contested class 24 goods, in order to complete an article.

23. The opponent states that the contested goods in class 24 are fabrics from which some of the its registered goods may be made and as such these goods are highly complementary. I am reminded of the case of *Les Éditions Albert René v OHIM*, Case T-336/03, where the GC found that:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished

goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

24. Although the knitted elastic fabric might be used in the production of the final underwear garment, I do not find them similar as the respective uses, user and physical nature of the two items would be very different. The trade channels would also differ. The elastic products are far more likely to be purchased wholesale to be used in the production of a finished article, which would then be on sale to the general public. I would also say this reasoning applies equally to the following services that are protected under the opponent’s mark: Needlework and dressmaking; Cloth cutting; Dyeing. These contested goods are dissimilar to the opponent’s goods and services.

25. In conclusion, I have found all of the contested class 25 goods to be identical to the class 25 goods of earlier EUTM 15485972. I have found the contested class 24 goods to be dissimilar to all of the earlier goods and services of the opponent. The opposition is dismissed insofar as it pertains to the class 24 element of contested application. This decision will therefore continue on the basis of the contested class 25 goods only.

#### **Average consumer and the purchasing act**

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

27. 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.”

28. The average consumer of underwear and socks will predominantly be the general public but may also be a professional public buying on behalf of others.

29. The selection of such goods is largely a visual process, as the average consumer (general public) will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact.

30. A professional consumer will likely take more care over the visual appraisal of these goods as they will often be buying in much larger quantities and will need to assess the quality, sizing, construction etc to a higher degree. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in those circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping<sup>1</sup>. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer’s mind.

31. The average consumer will therefore pay a higher degree of attention in its visual assessment, during the purchase of clothing, footwear or headgear, however they will not necessarily be paying the highest level of attention.

### **Comparison of marks**

32. 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

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<sup>1</sup> *Quelle AG v OHIM*, Case T-88/05, paragraph 69

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.”

33. 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.

34. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade marks

35. The earlier mark is comprised of two words, ‘CREACIONES’ and ‘SELENE’ presented in a somewhat stylised script and design. The opponent claims that the distinctive, identifying element of this earlier mark is the word ‘SELENE’, with the accompanying word ‘CREACIONES’ likely to be perceived as

descriptive. Objectively speaking, neither of the words appear to be from the English language. The words are placed closely together with the word 'CREACIONES' on top of the element 'SELENE' and presented in a much smaller typeface. I therefore agree with the opponent's statement that the element 'SELENE' can be said to be the more dominant element in the mark, playing a greater role than the element 'CREACIONES' due to the significant difference in sizes of those two elements. I note that the applicant also admits, in paragraph one of its counterstatement, that it is the word 'SELENE' that is dominant in the earlier mark. The overall impression in the earlier mark therefore can be said to lie in the word 'SELENE'.

36. The contested marks both comprise of the single word 'SERENE' which will be perceived as a normal dictionary word. There are some simple figurative elements in the marks, including the use of colour, that must also be considered, but the dominant and distinctive element in both marks is the word 'SERENE' itself.
37. Comparing the marks visually, the opponent claims that the marks are highly similar as the material particulars of the respective marks differ only by a single letter. It is correct that the two words 'SELENE' and 'SERENE' are similar in the prescribed manner however, I must consider the marks as a whole.
38. The earlier mark uses a stylised font with the letters 'S' and 'L' larger than the other letters in the word 'SELENE'. The word 'CREACIONES' is presented in much smaller, fairly standard typeface and placed on top of the second half of the word 'SELENE'. The top of the letter 'S' in 'SELENE' is noticeably shortened from where it might expect to be. The word 'SELENE' is also a mix of upper, and lower case, lettering.
39. The word 'SERENE' in the applicant's marks is presented all in upper-case lettering with a bold, thick font. There are horizontal black lines placed directly above and below the word. These elements are not negligible and frame the word within the mark, however they cannot be said to be highly innovative or distinctive.
40. Considering the above, I find that the marks are visually similar to a high degree.



41. Turning to the aural similarities between the marks, I would consider that most UK consumers will not be particularly well-versed in the Spanish language and would not necessarily sound out the word 'CREACIONES' in the correct manner. The word 'CREACIONES' would likely be pronounced *kree/ah/she/own/ez*. The word 'SELENE' is likely to be pronounced *suh/leen* by a UK consumer.
42. The contested marks will be pronounced *suh/reen*. The words 'SERENE' and 'SELENE' therefore share identically an initial sound at the beginning of each word, and quite similar second syllables.
43. Due to the size of the word 'CREACIONES' in the earlier mark, and the dominance of the word 'SELENE', combined with the fact that as a Spanish word, 'CREACIONES' is likely to be difficult for the average UK member of the public to articulate, I believe that many consumers will simply verbalise the 'SELENE' element of the earlier mark. For that part of the relevant public, these marks can be said to be aurally similar to a high degree. There will, however, be a part of the relevant public which does articulate the word 'CREACIONES' in one way or another, and for that consumer, there can be said to be significant differences in the phonetic impact of these marks, albeit the case that the word 'SELENE' is likely to be the first element enunciated due to its prominence in the mark. For that part of the relevant public, these marks can be said to be aurally similar to a medium degree.
44. Conceptually, the earlier mark would appear to have no specific meaning to the average UK consumer who would be likely to perceive them to be Spanish words. The word 'SELENE' may be perceived to be a female forename. The average consumer might consider that 'CREACIONES' means 'creations' in English, as the opponent has claimed however, although the opponent states that this is a solely descriptive term, I disagree. The word 'creations' does not give any indication as to what the goods are. It merely suggests that they have been made (in other words 'created') by a person or undertaking. The words 'CREACIONES SELENE' do not appear to be suggestive or descriptive of the goods or services the earlier mark is registered for and so may be said to be fanciful. If the average consumer perceives the word 'SELENE' to be a female

forename the earlier mark may convey the concept of something created by a person called Selene, as it is not uncommon for clothing goods to be marked or branded with the name of a designer. For at least a part of the relevant public the earlier mark will convey no message at all.

45. The verbal element 'SERENE' in the contested marks is a standard dictionary word meaning peaceful, tranquil or calm.<sup>2</sup> This is not suggestive or allusive of the goods applied for. Based on my assessment above, the earlier mark may or may not convey a conceptual message and the contested marks have a clear meaning which is very different to the possible interpretation of the earlier mark, therefore I conclude that the marks at issue are conceptually dissimilar.

### **Distinctive character of the earlier trade mark**

46. 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-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

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<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/serene>

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).”

47. The opponent has not provided any evidence that the earlier mark has acquired an enhanced degree of distinctive character and no claim was made to that effect. I must therefore assess the mark purely on its inherent distinctive character.

48. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed 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.”

49. 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 them: see *Matratzen Concord AG v OHIM*, Case T-6/01.

50. The earlier mark is comprised of one foreign word ‘CREACIONES’ and another word ‘SELENE’ which may be perceived to be a female forename. The mark is

not descriptive of the opponent's goods or services. The average consumer in the UK is unlikely to automatically translate the word 'CREACIONES' into its English equivalent 'creations' as the opponent has claimed. However, the words are not invented which would usually provide the highest degree of distinctive character. I would therefore say that the earlier mark, when taken as a whole, has at least a medium degree of inherent distinctive character.

### **Likelihood of Confusion**

51. There are two types of confusion that I must consider. Firstly, direct confusion i.e. one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

52. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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.”

53. I have previously found that the contested goods in class 25 are identical to the opponent's earlier class 25 goods. I have found the marks to be visually similar to a high degree, aurally similar to either a medium or a high degree and

conceptually dissimilar. The earlier mark is inherently distinctive to at least a medium degree, and the average general public consumer would be paying a medium degree of attention, with a professional consumer paying a slightly higher level of attention when selecting the goods at issue. Given the levels of similarity, particularly in respect of the visual and aural similarities, and the identity between the goods, I find that there is a direct likelihood of confusion between these marks.

54. In making my assessment, I have kept in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. I have also taken into account the issue of interdependency, where a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

55. The opposition has been successful in respect of the class 25 goods. The opponent's remaining earlier marks, namely EUTM 11544772 and EUTM 15485808 are registered for the same or lesser goods and services and therefore my finding regarding the dissimilarity of the contested goods in class 24 will be the same. The marks the subject of the remaining earlier EUTM's, are no closer to the contested application than the EUTM which has been the subject of my assessment and therefore do not provide the opponent with any stronger case. Therefore, I find no reason to consider these marks further.

## **Conclusion**

56. The opposition has succeeded in respect of the contested goods in class 25. Subject to appeal, the application will be refused in respect of the entire class 25 list of goods.

57. The opposition has failed in respect of the contested goods in class 24. The application may proceed to registration for all of the class 24 list of goods.

## **Costs**

58. The opponent has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice (TPN) 2/2016. The award of costs is calculated as follows:

Official fee	£100
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Preparing the Notice of Opposition and considering the Counter Statement	£450
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<b>Total</b>	<b>£550</b>
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59. I therefore order Serene Underwear Ltd to pay CREACIONES SELENE, S.L the sum of £550. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 4th day of March 2021**

**L Nicholas**

**For the Registrar**