

**O-467-19**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3312870  
BY VIJAY FASHIONS LIMITED  
TO REGISTER**

**ETERNAL**

**AS A TRADE MARK  
IN CLASS 25  
AND OPPOSITION THERETO (UNDER NO. 414180)  
BY  
ETERNA MODE GMBH**

## Background & Pleadings

1. Vijay Fashions Limited ('the applicant') applied to register the mark **ETERNAL** on 23 May 2018. The mark was examined and published in the Trade Mark Journal on 27 July 2018 for the following specification in class 25: *Clothing, footwear and headgear.*

2. ETERNA Mode GmbH ('the opponent') opposes the mark under section 5(2)(b) of the Trade Mark Act 1994 ('the Act') on the basis of its earlier EU marks set out below.

EU No. 658518	EU No. 13284906
<b>eterna</b>  Filing date: 20 October 1997 Registration date: 24 March 1999	<b>ETERNA</b>  Filing Date: 22 September 2014 Registration date: 12 February 2015
<i>Class 25: Men's shirts, women's blouses.</i>	<i>Class 25: Clothing; blouses; shirts; polo shirts; pullovers; blazers; waistcoats; footwear; Headgear; ties; bowties; body shirts; socks and stockings; collar protectors; neckerchiefs; scarves; knitwear [clothing]; pocket squares; quilted jackets [clothing]; padded vests.</i>

3. The opponent's above trade marks both have filing dates that are earlier than the filing date of the application and, therefore, they are both earlier marks, in accordance with Section 6 of the Act. EU TM 13284906 is not subject to proof of use, having not been registered for five years prior to the publication date of the contested application. As the registration procedure for EU TM 658518 was completed more than 5 years prior to the publication date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed a counterstatement in which it denied the marks were similar and put the opponent to proof of use for the earlier mark EU TM 658518.

5. Both parties have been professionally represented throughout. The applicant by Wilson Gunn and the opponent by Brookes IP.

6. Only the opponent filed evidence and written submission in lieu of a hearing. I make this decision based on the consideration of the material before me.

### **Approach**

7. The opponent relies on the two earlier marks set out above. The first of those marks, EU TM 658518 is subject to proof of use, the second mark, EU TM 13284906 is not and has a broader specification. With that in mind I will examine the opposition on the basis of the second mark returning to consider the first mark only if it becomes necessary to do so.

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

8. Section 5(2)(b) of the Act states as follows:

“5(2) A trade mark shall not be registered if because-

(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.

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

### **The principles**

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

## **Comparison of goods**

10. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Meric*'), the General Court held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

11. The opponent's class 25 goods are clearly covered by the broad terms *clothing, footwear and headgear* in the applicant's specification and are therefore considered identical on the *Meric* principle.

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

12. It is necessary to consider the role of the average consumer and how the goods are purchased. 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*.

13. 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.”

14. The guidance given in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 is also appropriate here as the goods in that case were also clothing. The General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between

the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

15. The average consumers for the contested goods are the general public. The goods will be sold in traditional bricks and mortar retail clothing outlets as well as through online websites and mail order catalogues. As set out above in *New Look*, the act of purchasing clothing will be a primarily visual process and factors such as aesthetics, functionality and fit in addition to the cost will come into play. In a retail premises, the average consumer will be viewing and handling items and possibly trying garments on. In an online website or mail order catalogue, a consumer will be viewing images of the goods before selection. Given that clothing prices will vary from garment to garment, I conclude that an average consumer will be paying a normal degree of attention during the purchasing process. Although I have found the purchasing process to be primarily visual, I do not discount any aural consideration such as word of mouth recommendations.

## Comparison of the marks

16. 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 Court of Justice of the European Union 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.”

17. 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.

18. The respective trade marks are shown below:

Opponent's mark	Applicant's mark
<b>ETERNA</b>	<b>ETERNAL</b>

19. Both are word marks and the overall impression of both marks reside solely in these words.

20. In terms of visual similarity the marks share the letters E-T-E-R-N-A. This comprises the whole of the opponent's mark and six of the seven letters in the

applicant's mark. The sole difference is the additional letter L in the applicant's mark. Taking this into account I find there is visual similarity to a high degree.

21. In aural terms, again the marks share six letters which will be pronounced in the usual way. The opponent's mark will be verbalised as EE-TER-NA and the applicant's as EE-TER-NAL so they share the same sound in the first two syllables of the marks. Although the marks differ slightly in the sound of the third syllable, in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends. Overall I find there is aural similarity to a high degree.

22. In conceptual terms, the applicant's mark is an ordinary English word with a known meaning whereas consumers are likely to regard the opponent's mark as an invented word in which case the marks are conceptually dissimilar.

### **Distinctiveness of the earlier mark**

23. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 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).”

24. There is no evidence before me showing use of EU TM No. 13284906 so I am only considering the inherent position. The earlier mark is an invented word which is not descriptive in any way of the goods and as such is considered to be inherently distinctive to a high degree.

### **Likelihood of confusion**

25. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

26. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

27. In this decision I have found that the contested goods are identical. Additionally, I have found that the average consumer will be paying a normal degree of attention in a primarily visually purchasing process. The earlier mark is found to be distinctive to a high degree and the respective marks are visually and aurally highly similar and conceptually dissimilar.

28. Based on the marks and the goods before me and taking into account my assessment above, I find there is a likelihood of direct confusion. There is a single letter difference between the marks and that occurs at the end of a word which could be easily overlooked or misread and lead to one mark being mistaken for another in a predominantly visual purchasing environment as highlighted in the *New Look* case. As stated above in point c of paragraph 25, consumers rarely have the chance to make a comparison between marks side by side but instead rely on an imperfect recollection. I consider that to be the case here.

## **Conclusion**

29. The opposition succeeds under Section 5(2)(b) and subject to any successful appeal against my decision, the application is refused in its entirety. As the earlier EU TM No. 13284906 leads to the opposition being successful, there is no need to consider the remaining trade mark upon which the opposition is based.

## **Costs**

30. The opponent has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£100 Official fee for Notice of Opposition  
£500 Preparation of evidence  
£300 Preparation of submissions  
**£900 Total**

31. I order Vijay Fashions Limited to pay ETERNA Mode GmbH the sum of £900. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12 August 2019**

**June Ralph  
For the Registrar,  
The Comptroller General**