

**Notification of provisional refusal of protection based on an opposition  
(Article 5 of the Madrid Protocol and Rule 17(1) and (2) of the Common Regulations  
under the Madrid Agreement and Protocol and Article 78 EUTMDR)**

Alicante, 13/07/2018

*International registration No:* **1387991**  
*Date of notification to EUIPO:* **08-02-2018**  
*Trade mark:* **LUX**  
*Holder:* **GUANGZHOU DARING INTERNATIONAL  
FORWARDING CO., LTD.  
Rm. 719,  
No. 799, Sanyuanli Avenue,  
Baiyun Dist.  
Guangzhou**  
*Opposition number:* **B3051960**

Protection of the abovementioned mark is provisionally refused for the European Union.

The provisional refusal is based on the fact that an opposition has been filed against the international registration.

I. The grounds for opposition are as follows.

Conflict with an earlier mark because of likelihood of confusion (Article 8(1)(b) EUTMR);

II. Name and address of the opposing party:

**LUX INDUSTRIES LIMITED  
39 Kali Krishna Tagore Street  
WEST BENGAL, CALCUTTA 700007  
LA INDIA**

III. The opposition is based on a mark which was the subject of an application or registration.

- type of mark : **EUTM**
- filing date, registration date and, if applicable, priority date:

Filing date: **01/08/2012**

Registration date: **12/12/2012**

- filing number and, if different, registration number:

Filing number: 011087178

Registration number: 011087178

- reproduction of the mark: (see annex)
- list of goods and services on which the opposition is based: (see annex)

IV. The provisional refusal relates to,

all the goods and services covered by the designation of the European Union.

The Office will notify the opposition separately to the holder of the international registration, including all evidence on which it is based, pursuant to Article 6(1) EUTMDR. The Office will set time limits for the holder. The notification will open an (extendable) cooling-off period of two months and a further period of two months for the opponent to substantiate the opposition. The notification will set a time limit of, in principle, six months for the holder of the international registration to submit observations.

The Office will also set a time limit of two months for the holder to appoint a representative within the meaning of Article 120(1) EUTMR. Protection of the international registration for the European Union will be refused in whole if the holder fails to appoint a representative within the time limit.



**Jesús MARTINEZ MARTINEZ**

Enclosures (excluding the cover letter): 21 pages.

## **OPPOSITION TO INTERNATIONAL TRADEMARK DESIGNATING THE EUROPEAN UNION Nº 1387991**

### **EXPLANATION OF GROUNDS**

Taking into account the definition established in Article 8.2.a (ii) of the Council Regulation (EC) 2017/1001 of 14 June 2017, whereby it is established that “earlier trade mark” is understood as:

- (i) **EU trade marks;**
- (ii) **trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;**

We hereby file the present opposition based on the fact that the **International Registration designating the European Union no. 1387991 “LUX” (and device) in class 25 int.**, falls within the prohibition established in Article 8.1. b) of the above-mentioned Regulation, which in connection with the above matter provides:

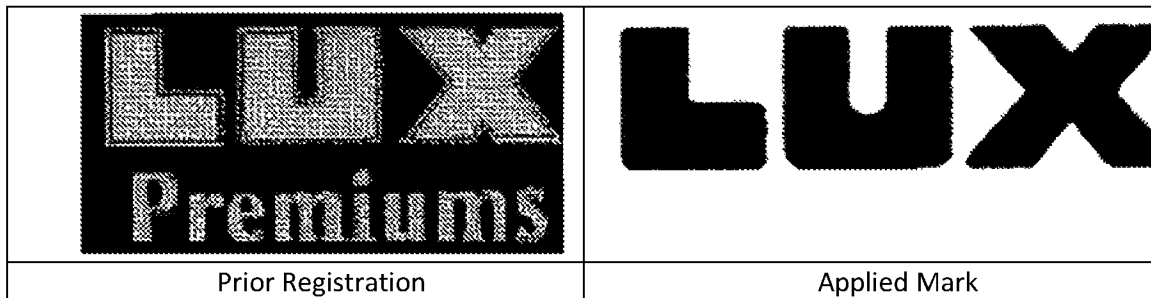
**8.1.b) “if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark....”**

And by reason of the following:

#### **1. IDENTITY/SIMILARITY OF SIGNS:**

##### ***Comparison of the signs***

The **International Registration designating the European Union no. 1387991 “LUX” (and device)** is confusingly SIMILAR to LUX INDUSTRIES, LTD.’s existing prior EU Registration nº 011087178 “LUX PREMIUMS” as it can be clearly seen from the following comparison:



**The relevant territory is the European Union.**

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57).

Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

In the present case, the **dominant element** of both marks is the word “LUX”. This is because it is the only word element of the opposed mark, and the most eye-catching element of the prior mark, as the term “premiums” is descriptive and lack of distinctive character, as we will explain below.

This word element “LUX”, which the signs have in common, will not be associated with any meaning. In this sense, the abbreviation ‘LUX’ will not allude to the word ‘luxury’ as, for instance, this latest term would be ‘πολυτέλεια’ (the transliteration in the Latin alphabet is ‘polyteleia’) in Greek, ‘lusso’ in Italian or ‘prabanga’ in Lithuanian or ‘lujo’ in Spanish.

The earlier sign is composed of a figurative element depicting the terms LUX PREMIUMS in a rectangular background, being the word elements written in grey letters at the middle of the rectangle. The term ‘LUX’ depicted horizontally in a higher size which represents more than 60% of the mark. The verbal element ‘PREMIUMS’ is less important (it is not visually eye-catching) due to its size and position in the mark.

The word element 'LUX' of the earlier mark, by virtue of its dominant position and size, overshadows the remaining elements of the mark. It is the visually dominant element of the earlier mark.

The contested sign is a figurative mark, which consists of the verbal element 'LUX', which is depicted in black letters. The contested sign has no elements that could be considered clearly more dominant (visually eye-catching) than other elements.

The element that the signs have in common, namely 'LUX', will be understood, at least by a part of the Greek-, Italian-, Spanish- Portuguese- and Lithuanian-speaking public, among others, as the Latin word for light, which is used to designate 'a unit of illuminance and luminous emittance, measuring luminous flux per unit area'.

Taking into account the abovementioned meaning of the word 'LUX' and, particularly, the fact that there is no connection with 'a unit of illuminance and luminous emittance, measuring luminous flux per unit area' with respect to the goods in Class 25, it is considered that the word 'LUX' has an average degree of distinctiveness.

Furthermore, at least for a part of the Greek-, Italian-, Spanish- and Lithuanian-speaking public, among others, the word 'LUX' is meaningless and therefore also distinctive.

The element 'PREMIUMS' of the contested sign is an English word that, when used as a modifier, relates to or denotes a commodity of superior quality and therefore a higher price.

The General Court has held that this word confers a certain prestige and a connotation of excellence on its object and that it will be easily understood by the average consumer of the European Union because of its frequent use in the field of trade in goods (22/05/2012, T-60/11, Suisse Premium, EU:T:2012:252, §§ 40 and 46; 12/01/2005, T-334/03, Europremium, EU:T:2005:4, § 43).

Therefore, this element is considered laudatory for the relevant public, who will not pay attention to this weak element and will focus their attention on the other more distinctive elements of the mark. Therefore, the word element 'LUX' is the most distinctive and dominant element of both marks.

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37).

**Visually**, the signs are similar to the extent that they both contain the distinctive and independent verbal element 'LUX'. Both are depicted in the same typeface, capital bold letters. As previously mentioned, the figurative elements and the word "PREMIUMS" have less impact on consumers than the verbal elements "LUX".

Furthermore, the coinciding verbal element "LUX" is the dominant element in both marks, as the word 'LUX' constitutes the entire contested mark and the first element of the earlier sign.

The relevant public generally tends to focus on the first part of a sign when being confronted with a trade mark. This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader.

Consequently, the fact that the contested mark is totally incorporated in the earlier sign at its beginning has to be taken into account when assessing the likelihood of confusion between the marks.

Therefore, the marks are visually similar to a high degree.

**Aurally**, the earlier mark will be pronounced as 'LUX', the descriptive term "premiums" would be simply ignored by consumers and not even pronounced, as it is descriptive and laudatory. Consequently, the pronunciation of the marks coincides in the sound of the letters 'LUX', present identically in both signs.

Considering that the contested mark is aurally fully included in the earlier mark, as its first element, it is concluded that the marks are aurally similar to a higher than average degree.

**Conceptually**, reference is made to the previous assertions concerning the semantic content conveyed by the marks. However, for a part of the Greek-, Italian- and Lithuanian-speaking public, the word 'LUX' will be associated with light, a concept that is not related to the goods at issue; for this part of the relevant public, the marks are conceptually highly similar.

#### ***Relevant public – level of attention***

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of

attention is likely to vary according to the category of goods or services in question. In the present case, the goods found to be identical or similar are directed at the public at large. The degree of attention is considered average.

## **2. IDENTITY/SIMILARITY OF PRODUCTS:**

The above stated is all the more true if we take into account the services respectively covered by each mark under study.

The prior marks claim protection, for ***Garments and undergarments***, in class 25.

The applied mark claims protection for: ***Tee-shirts; smocks; clothing; sports jerseys; knitwear [clothing]; shoes; hats; hosiery; scarves; leather belts [clothing]***, in class 25.

Garments is a synonymous of ***clothing***, so this product claimed by the prior mark includes, as it is a broader category, the contested “tee-shirts, smocks, clothing, sports jerseys, knitwear (clothing), hosiery, scarves, leather belts (clothing)”. These products have, with the earlier mark’s “garments” or “clothing” products, a relationship of identity.

The contested “***shoes***” and “***hats***” are similar to the opponent’s ***garments/clothing***. These goods have the same purpose, since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion that target the same relevant public and are often found in the same retail outlets. Moreover, many manufacturers and designers produce these goods.

It is obvious that the products protected by the prior Trademarks could be confused and related with those now applied for, taking into account that these goods claimed by the contested mark, are identical and similar, share the same distribution channels, have all the same nature and for this reason, a well-informed consumer would confuse them.

As stated in Judgement of the Court of Justice, Case C-39/97, *Canon Kabushiki Kaisha v Metro Goldwin Meyer Inc. (1998) OJ OHIM 12/98, paragraph 23*, “in assessing the similarity of the goods / services concerned, all the relevant factors relating to these goods/services should be taken into account. These factors include, inter alia, their nature, their purpose of use and their method of use and whether they are in competition with each other or are complementary.

Further factors include the purpose of the goods and services, whether or not they may be expected to be manufactured, marketed or provided by the same undertaking, or by economically linked undertakings, as well as their distribution channels and sales outlets.

It is important to note that there is some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered.

Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. This, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

### **3. GLOBAL ASSESSMENT OF THE LIKELIHOOD OF CONFUSION**

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services.

Therefore, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

The goods are identical or similar.

The relevant public is the public at large, the degree of attention is considered average and the earlier mark has a normal degree of distinctiveness.

The relevant goods are included within class 25.

According to the principle of imperfect recollection, average consumers rarely have the chance to make a direct comparison between different marks, but must trust in their imperfect recollection of them. Consumers will also be more likely to remember the similarities than the dissimilarities between the signs, especially taking into account that, in the present case, the similarities are at the beginnings of the marks, where they will catch the primary attention of the consumer.



The comparison of the signs has shown a high degree of similarity from the visual, conceptual and aural perspective. These degrees of aural, visual and conceptual similarity, combined with the consumers' imperfect recollection and considering the interdependence principle for the goods that are identical or similar, result in a likelihood of confusion between the signs. The relevant consumer will confuse the marks or alternatively perceive the contested mark as a sub-brand or variation of the earlier mark (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49)

Regarding the differing figurative elements, when signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4, Best Tone, § 24; 13/12/2011, R 53/2011-5, Jumbo, § 59).

The signs also differ in the additional word, 'PREMIUMS', of the prior mark, which, however, is laudatory and, therefore, the relevant public will not pay attention to this weak element.

Consequently, the fact that the prior mark has an additional laudatory word and cosmetic figurative elements will not prevent consumers from believing that the goods offered under the marks come from the same undertaking or economically linked undertakings. In both marks, the element 'LUX' can be clearly identified, and it has an independent role in each of the marks; in addition, it is the first verbal element of the prior mark and the sole element in the contested sign.

Furthermore, consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader. Consequently, the identity between the first verbal element of the prior mark and the sole element of the applied sign has to be taken into account when assessing the likelihood of confusion between the marks.

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings. Indeed, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand, a variation of the

earlier mark, configured in a different way according to the type of goods or services that it designates (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49).

It is a result of the unitary character of the EU trade mark, that an earlier EU trade mark has identical protection in all Member States. Earlier EU trade marks may therefore be relied upon to challenge any subsequent application for a trade mark which would prejudice their protection, even if this is only in relation to the perception of consumers in part of the European Union.

Finally, the global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods may be offset by a lower degree of similarity between the marks, **and vice versa** (see judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 20).

In this sense, and noting that the goods at issue are identical or highly similar, the risk of confusion would be higher.

#### **4. FORMS OF ORDER SOUGHT**

Based on the above arguments, and such others as may be adduced in the course of proceedings, we hereby respectfully request the Office to reject International Trademark designating the European Union no. 1387991 based on article 8.1. b) of the Regulation. We also respectfully request the Office to grant our client an award of costs as defined under article 109 of the Regulation and 6 (4) of the delegated Regulation, if the opposition proceedings are deemed to commence and our request of rejection is accepted. This party reserves the right to respond to the arguments to be brought forward by the Applicant, and to submit further arguments or evidence if necessary or desirable.



Franco de Barba  
Trademark Attorney  
MERX PATENTES Y MARCAS, S.L.P.  
Representative id nº 75912  
fdebarba@merx-ip.com

Alicante, 11/05/2018

MERX PATENTES Y MARCAS, S.L.P.  
Calle Pinar, 5  
28006 Madrid  
Spain

**Receipt of notice of opposition**

<i>Number of the opposition:</i>	003051960
<i>Your reference:</i>	201800174/EM/FB
<i>Trade mark:</i>	W01387991
<i>Opponent:</i>	LUX INDUSTRIES LIMITED 39 Kali Krishna Tagore Street 700007 WEST BENGAL, CALCUTTA India

Your notice of opposition, directed against the abovementioned trade mark, was received by the Office on **11/05/2018 at 19:06:40**.

It was given the above opposition number.

**Please quote this number in all future communications regarding the opposition.**

Please note that EUIPO will not send an invoice.

**Operations Department**

**Thank you for filing online**

Our online services make it easier for you to file your notice of opposition, send attachments and spot any mistakes. Filing online is also quicker and safer than using fax or post, as you can be sure your notice of opposition reaches EUIPO instantly via our secure servers.

Date of receipt (DD/MM/YYYY) 11/05/2018	Number of pages (including this one) 4
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### Acknowledgement of receipt of a Notice of opposition

Your notice of opposition has been submitted successfully.  
We thank you for choosing to use the online OPPOSITION form.

Opposition number:	003051960
Date of submission:	11/05/2018
Time of submission:	19:06
Number of attached files:	1
Payment method:	Current account with EUIPO
Payment ID number:	184XDRP6
Account No:	0000002493

Please indicate the opposition number in any further communication with the EUIPO.

## NOTICE OF OPPOSITION

Your reference: 201800174/EM/FB

### Opponent(s)

Opponent EUIPO ID: 527040

Name of legal entity or first name and surname: LUX INDUSTRIES LIMITED  
 Legal form: Limited Company  
 Type: Legal Entity  
 Street address: 39 Kali Krishna Tagore Street  
 City: WEST BENGAL, CALCUTTA  
 Postal Code: 700007  
 Country: India  
 Postal address (if different):  
 Telephone number:  
 Fax number:  
 E-mail address:  
 Website:

### Representative(s)

EUIPO representative ID: 75912

Name or legal name: MERX PATENTES Y MARCAS, S.L.P.  
 Type: Association  
 Street address: Calle Pinar, 5  
 City: Madrid  
 Postal Code: 28006  
 Country: Spain  
 Postal address (if different):  
 Telephone number: 0034-912195497  
 Fax number: 0034-911436637  
 E-mail address: info@merx-ip.com  
 Website: http://www.merx-ip.com

### Challenged entity

Challenged registration ID: W01387991

Type of entity: IR  
 Name of the owner/holder: GUANGZHOU DARING INTERNATIONAL FORWARDING CO., LTD.  
 Designation date: 11/12/2017  
 Representation of the trade mark: LUX  
 Trade mark type: Figurative

Representation of mark



### Language of proceedings

☒ First language: EN (English) ☐ Second language: FR (French)

### Extent of the application

☒ Against all the goods and services  
☐ Against some of the goods and services

## NOTICE OF OPPOSITION

<b>Class</b>	<b>Goods and services</b>
25 (EN)	Tee-shirts; smocks; clothing; sports jerseys; knitwear [clothing]; shoes; hats; hosiery; scarves; leather belts [clothing].


  

**Grounds for opposition**

**Selected ground number 1**

Article 8(1)(b) EUTMR - There exists a likelihood of confusion on the part of the public

**Basis of opposition**

Type of basis	EUTM/A
Name of the owner/applicant	LUX INDUSTRIES LIMITED
Application date	01/08/2012
Filing number	011087178
Registration number	011087178
Registration date	12/12/2012
Expiry date	01/08/2022
Trade mark type	Figurative
Representation of the earlier right	 <input type="checkbox"/> Colour(s) claimed
Verbal elements	LUX PREMIUMS

☒ The opposing party accepts that the necessary information for this trade mark is imported from the relevant online official database, accessible through TMVIEW, and that this source is used for substantiation purposes without prejudice to its right or obligation to provide any additional information that may be necessary to comply with the substantiation requirements of Article 7(2) and (4) EUTMDR

**Goods and services used as basis**

☒ Based on all the goods and services  
☐ Based on part of the goods and services, namely:

<b>Class</b>	<b>Goods and services</b>
25 (EN)	Garments and undergarments.

**Entitlement**

☒ Owner/Co-owner ☐ Authorised licensee  
☐ Person authorised under the applicable law

**Statement of grounds**

**Uploaded File(s)**

<b>Title</b>	<b>Confidential</b>
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## NOTICE OF OPPOSITION

GROUNDS 1387991 (1).pdf			<input checked="" type="checkbox"/>
<b>File(s) linked from other proceedings</b>			
<b>Procedure</b>	<b>Filing number</b>	<b>Subject</b>	<b>Date</b>
<b>Fees</b>			
Payment method		Current account	
Opposition of EUTM fee		320.00 €	
Total amount		320.00 €	
Current account with EUIPO			
Account N°		0000002493	
<b>Signature</b>			
First name and Surname			Capacity of the signatory
FRANCO NOE DE BARBA			Legal practitioner

### Annexes:

GROUNDS 1387991 (1).pdf

## **OPPOSITION TO INTERNATIONAL TRADEMARK DESIGNATING THE EUROPEAN UNION Nº 1387991**

### **EXPLANATION OF GROUNDS**

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**8.1.b) “if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark....”**

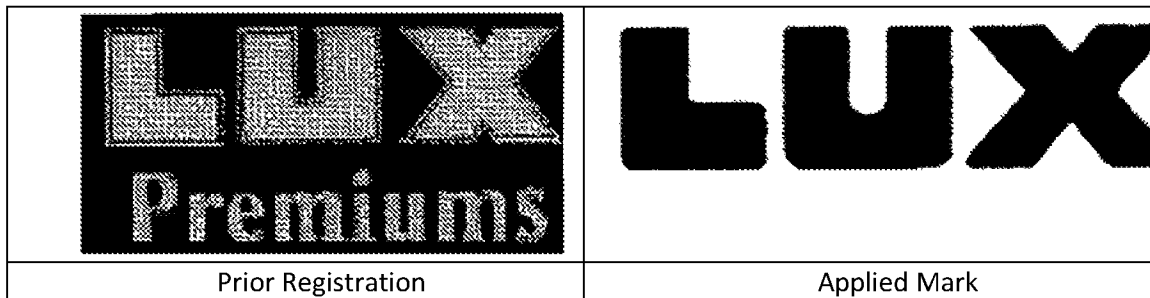
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Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

In the present case, the **dominant element** of both marks is the word “LUX”. This is because it is the only word element of the opposed mark, and the most eye-catching element of the prior mark, as the term “premiums” is descriptive and lack of distinctive character, as we will explain below.

This word element “LUX”, which the signs have in common, will not be associated with any meaning. In this sense, the abbreviation ‘LUX’ will not allude to the word ‘luxury’ as, for instance, this latest term would be ‘πολυτέλεια’ (the transliteration in the Latin alphabet is ‘polyteleia’) in Greek, ‘lusso’ in Italian or ‘prabanga’ in Lithuanian or ‘lujo’ in Spanish.

The earlier sign is composed of a figurative element depicting the terms LUX PREMIUMS in a rectangular background, being the word elements written in grey letters at the middle of the rectangle. The term ‘LUX’ depicted horizontally in a higher size which represents more than 60% of the mark. The verbal element ‘PREMIUMS’ is less important (it is not visually eye-catching) due to its size and position in the mark.

The word element 'LUX' of the earlier mark, by virtue of its dominant position and size, overshadows the remaining elements of the mark. It is the visually dominant element of the earlier mark.

The contested sign is a figurative mark, which consists of the verbal element 'LUX', which is depicted in black letters. The contested sign has no elements that could be considered clearly more dominant (visually eye-catching) than other elements.

The element that the signs have in common, namely 'LUX', will be understood, at least by a part of the Greek-, Italian-, Spanish- Portuguese- and Lithuanian-speaking public, among others, as the Latin word for light, which is used to designate 'a unit of illuminance and luminous emittance, measuring luminous flux per unit area'.

Taking into account the abovementioned meaning of the word 'LUX' and, particularly, the fact that there is no connection with 'a unit of illuminance and luminous emittance, measuring luminous flux per unit area' with respect to the goods in Class 25, it is considered that the word 'LUX' has an average degree of distinctiveness.

Furthermore, at least for a part of the Greek-, Italian-, Spanish- and Lithuanian-speaking public, among others, the word 'LUX' is meaningless and therefore also distinctive.

The element 'PREMIUMS' of the contested sign is an English word that, when used as a modifier, relates to or denotes a commodity of superior quality and therefore a higher price.

The General Court has held that this word confers a certain prestige and a connotation of excellence on its object and that it will be easily understood by the average consumer of the European Union because of its frequent use in the field of trade in goods (22/05/2012, T-60/11, Suisse Premium, EU:T:2012:252, §§ 40 and 46; 12/01/2005, T-334/03, Europremium, EU:T:2005:4, § 43).

Therefore, this element is considered laudatory for the relevant public, who will not pay attention to this weak element and will focus their attention on the other more distinctive elements of the mark. Therefore, the word element 'LUX' is the most distinctive and dominant element of both marks.

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37).

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**Aurally**, the earlier mark will be pronounced as 'LUX', the descriptive term "premiums" would be simply ignored by consumers and not even pronounced, as it is descriptive and laudatory. Consequently, the pronunciation of the marks coincides in the sound of the letters 'LUX', present identically in both signs.

Considering that the contested mark is aurally fully included in the earlier mark, as its first element, it is concluded that the marks are aurally similar to a higher than average degree.

**Conceptually**, reference is made to the previous assertions concerning the semantic content conveyed by the marks. However, for a part of the Greek-, Italian- and Lithuanian-speaking public, the word 'LUX' will be associated with light, a concept that is not related to the goods at issue; for this part of the relevant public, the marks are conceptually highly similar.

#### ***Relevant public – level of attention***

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of

attention is likely to vary according to the category of goods or services in question. In the present case, the goods found to be identical or similar are directed at the public at large. The degree of attention is considered average.

## **2. IDENTITY/SIMILARITY OF PRODUCTS:**

The above stated is all the more true if we take into account the services respectively covered by each mark under study.

The prior marks claim protection, for ***Garments and undergarments***, in class 25.

The applied mark claims protection for: ***Tee-shirts; smocks; clothing; sports jerseys; knitwear [clothing]; shoes; hats; hosiery; scarves; leather belts [clothing]***, in class 25.

Garments is a synonymous of ***clothing***, so this product claimed by the prior mark includes, as it is a broader category, the contested “tee-shirts, smocks, clothing, sports jerseys, knitwear (clothing), hosiery, scarves, leather belts (clothing)”. These products have, with the earlier mark’s “garments” or “clothing” products, a relationship of identity.

The contested “***shoes***” and “***hats***” are similar to the opponent’s ***garments/clothing***. These goods have the same purpose, since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion that target the same relevant public and are often found in the same retail outlets. Moreover, many manufacturers and designers produce these goods.

It is obvious that the products protected by the prior Trademarks could be confused and related with those now applied for, taking into account that these goods claimed by the contested mark, are identical and similar, share the same distribution channels, have all the same nature and for this reason, a well-informed consumer would confuse them.

As stated in Judgement of the Court of Justice, Case C-39/97, *Canon Kabushiki Kaisha v Metro Goldwin Meyer Inc. (1998) OJ OHIM 12/98, paragraph 23*, “in assessing the similarity of the goods / services concerned, all the relevant factors relating to these goods/services should be taken into account. These factors include, inter alia, their nature, their purpose of use and their method of use and whether they are in competition with each other or are complementary.

Further factors include the purpose of the goods and services, whether or not they may be expected to be manufactured, marketed or provided by the same undertaking, or by economically linked undertakings, as well as their distribution channels and sales outlets.

It is important to note that there is some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered.

Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. This, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

### **3. GLOBAL ASSESSMENT OF THE LIKELIHOOD OF CONFUSION**

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services.

Therefore, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

The goods are identical or similar.

The relevant public is the public at large, the degree of attention is considered average and the earlier mark has a normal degree of distinctiveness.

The relevant goods are included within class 25.

According to the principle of imperfect recollection, average consumers rarely have the chance to make a direct comparison between different marks, but must trust in their imperfect recollection of them. Consumers will also be more likely to remember the similarities than the dissimilarities between the signs, especially taking into account that, in the present case, the similarities are at the beginnings of the marks, where they will catch the primary attention of the consumer.

The comparison of the signs has shown a high degree of similarity from the visual, conceptual and aural perspective. These degrees of aural, visual and conceptual similarity, combined with the consumers' imperfect recollection and considering the interdependence principle for the goods that are identical or similar, result in a likelihood of confusion between the signs. The relevant consumer will confuse the marks or alternatively perceive the contested mark as a sub-brand or variation of the earlier mark (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49)

Regarding the differing figurative elements, when signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4, Best Tone, § 24; 13/12/2011, R 53/2011-5, Jumbo, § 59).

The signs also differ in the additional word, 'PREMIUMS', of the prior mark, which, however, is laudatory and, therefore, the relevant public will not pay attention to this weak element.

Consequently, the fact that the prior mark has an additional laudatory word and cosmetic figurative elements will not prevent consumers from believing that the goods offered under the marks come from the same undertaking or economically linked undertakings. In both marks, the element 'LUX' can be clearly identified, and it has an independent role in each of the marks; in addition, it is the first verbal element of the prior mark and the sole element in the contested sign.

Furthermore, consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader. Consequently, the identity between the first verbal element of the prior mark and the sole element of the applied sign has to be taken into account when assessing the likelihood of confusion between the marks.

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings. Indeed, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand, a variation of the

earlier mark, configured in a different way according to the type of goods or services that it designates (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49).

It is a result of the unitary character of the EU trade mark, that an earlier EU trade mark has identical protection in all Member States. Earlier EU trade marks may therefore be relied upon to challenge any subsequent application for a trade mark which would prejudice their protection, even if this is only in relation to the perception of consumers in part of the European Union.

Finally, the global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods may be offset by a lower degree of similarity between the marks, **and vice versa** (see judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 20).

In this sense, and noting that the goods at issue are identical or highly similar, the risk of confusion would be higher.

#### **4. FORMS OF ORDER SOUGHT**

Based on the above arguments, and such others as may be adduced in the course of proceedings, we hereby respectfully request the Office to reject International Trademark designating the European Union no. 1387991 based on article 8.1. b) of the Regulation. We also respectfully request the Office to grant our client an award of costs as defined under article 109 of the Regulation and 6 (4) of the delegated Regulation, if the opposition proceedings are deemed to commence and our request of rejection is accepted. This party reserves the right to respond to the arguments to be brought forward by the Applicant, and to submit further arguments or evidence if necessary or desirable.

A handwritten signature in black ink, appearing to read 'Franco de Barba', with a stylized flourish at the end.

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