

OPPOSITION No B 3 138 445

Celine, 16 rue Vivienne, 75002 Paris, France (opponent), represented by **Novagraaf France**, Bâtiment O2 - 2, rue Sarah Bernhardt CS 90017, 92665 Asnières-sur -Seine, France (professional representative)

a g a i n s t

CO.R.D. GmbH & Co. Kg, Industriestr. 2 A, 93192 Wald, Germany (holder), represented by **Weickmann & Weickmann Patent- und Rechtsanwälte PartmbB**, Richard-strauss-str. 80, 81679 München, Germany (professional representative).

On 15/03/2022, the Opposition Division takes the following

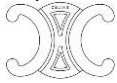
DECISION:

1. Opposition No B 3 138 445 is upheld for all the contested goods.
2. International registration No 1 547 490 is entirely refused protection in respect of the European Union.
3. The holder bears the costs, fixed at EUR 620.

REASONS

On 04/01/2021, the opponent filed an opposition against all the goods of international

registration designating the European Union No 1 547 490  (figurative mark). The

opposition is based on European Union trade mark registration No 17 963 017  (figurative sign). The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods

The goods on which the opposition is based are the following:

Class 18: *Leather and imitation leather; Leather, unworked or semi-worked; Imitation leather; Imitation leather; Fur; Fur; Travelling bags, Travel cases, Traveling trunks, trunks and suitcases, garment bags for travel purposes, Vanity cases, not fitted, Boxes of leather or leatherboard; Bags, rucksacks, shoulder bags, handbags, bags for sports, valises, attaché cases, document holders and briefcases of leather; Luggage tags, Whips, Leather leashes, Saddlery; Walking sticks; Pocket wallets, purses, Business card cases; Credit card cases [wallets]; Card cases, key cases and notecases; Umbrellas; Parasols; Parasols.*

Class 25: *Clothing and underclothing, sweaters, shirts, T-shirts, lingerie, belts (clothing), scarves, neckties, shawls, waistcoats, jerseys (clothing), skirts, waterproof clothing, coats, topcoats, suspenders, trousers, denim trousers, pullovers, dresses, jackets (clothing), sashes for wear, gloves (clothing), tights, socks, swimsuits, bath robes, pyjamas, nightgowns, shorts, pocket squares; Shoes, Fittings of metal for footwear; Boots, half-boots; Footwear soles; Slippers; Headgear; Cuffs; Clothing and boots for sports and skiing.*

The contested goods are the following:

Class 18: *Bags.*

Class 25: *Clothing; footwear; headgear; belts.*

Contested goods in Class 18

Bags are identically contained in both lists of goods.

Contested goods in Class 25

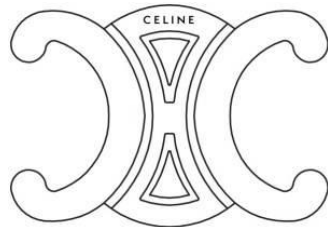
Clothing; headgear; belts are identically contained in both lists of goods.

The contested *footwear* include, as broader category the opponent's *shoes*. Since the Opposition Division cannot dissect *ex officio* the broad category of the contested goods, they are considered identical to the opponent's goods.

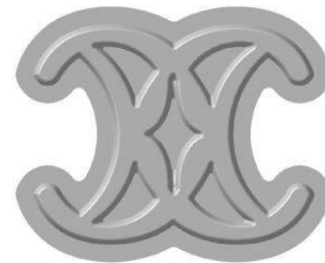
b) Relevant public — degree of attention

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, and contrary to the applicant's submissions, the goods found to be identical are directed at the public at large and the degree of attention is considered to be average.

c) The signs

Earlier trade mark



Contested sign

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 earlier trade mark's figurative element will be perceived, by at least part of the public, as two stylized letters 'C' that are displayed in opposite position and with their respective open portion placed outwards. Among these, is portrayed an element with a hollow shape that is embellished with contour lines and includes in its lower and upper part two triangular figures, pointing versus the center.

However, although it is necessary to take into consideration the average consumer's perception in the assessment of the similarity of signs, this does not exclude the possibility, in the case of signs which allow multiple interpretations, that the perception of signs may not be identical for all consumers (13/09/2017, T-104/17, apo (fig.) / DEVICE OF AN APPLE WITH A BITE (fig.) et al., EU:T:2018:536, § 30).

In light of this principle and taking into account the stylization of the earlier mark, it cannot be excluded either that another part of the relevant public might perceive its figurative element as a fanciful arrangement of different stylized components. In specific, it cannot be excluded that the two letters 'C' displayed in a mirrored position may be perceived by another part of the public just as two arch-shaped stylized component, rather than letters.

Furthermore, this figurative component displays on its top the verbal element 'CELINE'. Part of the relevant consumers, such as, for instance the French-speaking public will perceive this verbal element as a reference to 'Céline', a feminine name of French-origin. However, it cannot be excluded either that another part of the public, such as a substantial part of the Italian-speaking consumers, will perceive such component as a coined word. Indeed, the name 'Céline' is rather rare in Italy. Furthermore, its Italian correspondent is somehow different, being 'Celina'.

Bearing this in mind, the Opposition Division finds it appropriate to focus the comparison on this substantial part of the Italian-speaking part of the public, for which the element 'CELINE' is meaningless and therefore distinctive to an average degree. This takes into account that 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). This applies by analogy to international registrations designating the European Union. Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

In its observations, the holder asserts that the earlier sign's figurative element retains a rather low degree of distinctiveness as such element seems to derive from the design of chain links in front of the 'Arc de Triomphe' (as showed in its Annex 1) being used as a decoration for centuries. In addition, the holder argues that the earlier trade mark's figurative element has a low distinctive character given that many trade marks in the fashion sector include a 'double C' design. In support of its argument the holder refers (in Annex 2) to a search in the register of the German Patent and Trademark Office showing that 19180 trademarks applications in Classes 18 and 25 contains 'letters in special font' as classified under code 27.5.1 of the Vienna Agreement. Finally, the holder provided examples of some trademarks registered in Classes 18 and 25 and containing stylized 'C' and others stylized letters.

The Opposition Division cannot concur with the holder's statement. Firstly, and as the opponent asserts, the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of register data only, it cannot be assumed that all such trade marks have been effectively used. It follows that the evidence filed does not demonstrate that consumers have been exposed to widespread use of, and have become accustomed to, trade marks that include stylized 'C' shapes. In addition, it is noted that the holder provided in 'Annex 3' only very few trademarks and with stylizations that are completely different from the earlier sign. Besides, the evidence in 'Annex 2' are not particularly conclusive as they make generic reference to 'letters in special font' and not to the opponent's trade mark. Finally, there is no reasons why the fact that the opponent's figurative element derives from a decoration of the chain's links of the 'Arc de Triomphe' should be considered a factor that might reduce its degree of distinctiveness. Under these circumstances, the holder claims must be set aside.

On the contrary, the Opposition Division concludes that – independently from how the relevant public will perceive the earlier mark's figurative element, as outlined above – it retains an average degree of inherent distinctiveness being a highly stylized and complex device that is not directly related to the relevant goods in a way that could impair its distinctiveness.

Furthermore, it must be stressed that when signs consist of both verbal and figurative components – as it is for the earlier mark – the verbal element of a sign does not automatically have a stronger impact (31/01/2013, T-54/12, Sport, EU:T:2013:50, § 40). In the instant case, and taking into account of its position, size and dimension, it must be concluded that the earlier marks figurative element is clearly dominant (visually outstanding) over the verbal component 'CELINE', which occupies an extremely limited proportion of the earlier mark.

As regards the contested application, part of the relevant public will perceive it as also consisting of two stylized letters 'C' that are displayed in opposite position and with their respective open portion placed outwards. Such letters appear to meld in the center where it

is present an element with an hallow shape that contains in its center a rhombus shape and also four triangular figures.

Also in this circumstance, it cannot be excluded either that another part of the relevant consumers will perceive the signs as a purely figurative combination of different stylized elements, without necessarily identifying two letters 'C'.

In any event, and independently from the above outlined consumer's perception, the degree of distinctiveness of the contested application's elements is average being a stylized and complex device that is not directly related to the relevant goods in a way that could impair its distinctiveness.

Finally, it must be concluded that the contested sign has no elements that can be considered clearly more dominant (visually outstanding) than other elements.

Visually, the signs retain substantial similarities. In specific, both trademarks share their general structure consisting of two letters 'C' (or, for part of the public, two arch-shaped figurative elements) that are displayed in opposite position and with their respective open portion placed outwards. In addition, in the central area of both signs is present an element with an hallow shape that contains, among others, some triangles. The differences between the signs are limited to factors like the way on how the letters 'C' (or the two arch-shaped figurative elements) are stylized (as in the earlier mark are separated whereas in the contested application seems to meld); the way on how the hallow shape is placed (as in the earlier mark is outside the letter 'C' or arch-shapes) whereas in the contested application is displayed internally and more expanded); the presence of two additional triangle and one rhombus in the contested application and the way on how these elements are arranged. The signs also differ in the earlier mark's secondary verbal element 'CELINE' and in some of their decorative details such as lines and contour.

Despite these differences, and taking into account the above principles and assessment on the degree of distinctiveness and relevance of the sign's elements, it is concluded that their overall stylization and structure render them visually similar to an average degree overall.

Aurally, for part of the public the signs coincide in the sound of the two letters 'C' whereas they differ in that of the earlier mark's verbal element 'CELINE'. In this scenario, the signs are aurally similar to a lower than average degree.

For the part of the public that will perceive the contested sign as purely figurative, the signs are not subject to a phonetic assessment and it is not possible to compare them aurally.

Conceptually, neither of the signs has a meaning for the public under assessment as the earlier mark's element 'CELINE' and the letters 'CC' do not convey any clear meaning in relation to the relevant goods. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence

filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

The appreciation of likelihood of confusion on the part of the public depends, inter alia, on the recognition of the earlier mark on the market, the association which can be made with the registered mark, the degree of similarity between the marks and between the goods or services identified. It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. However, likelihood of confusion covers situations where the consumer directly confuses the trade marks 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.

In the present case the goods have been found identical. They target the general consumers that will pay an average degree of attention. The degree of distinctiveness of the earlier mark is average.

The signs have been found visually similar to an average degree and aurally similar to a lower than average degree (for part of the public) whereas for another it is not possible to compare the signs aurally. The conceptual aspects remain neutral.

In particular, the earlier mark's distinctive and dominant component shares substantial similarities with the contested sign. Indeed, their similar structure and stylisation contributes to create a very similar overall impression.

Although the signs retain some differences, it must be stressed that they are focused on secondary elements such as the earlier mark's component 'CELINE' or are limited to aspects such as the some stylisations and the presence of additional geometrical shapes that still will not be capable to outweigh the assessed similarities between them.

Indeed, although the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind (judgment of 22/06/1999, C-342/97, 'Lloyd Schuhfabrik Meyer', para. 26).

Furthermore, it must be recalled that 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 and bags 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 (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50). Therefore, in the

instant case, the considerable visual similarities between the signs are particularly relevant when assessing the likelihood of confusion.

In light of all the above, and also taking into account the identity of the relevant goods and the average degree of attentiveness paid, the relevant consumers are likely to confuse the signs.

Considering all the above, there is a likelihood of confusion on the part of the Italian-speaking part of the public. As stated above in section c) of this decision, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

Therefore, the opposition is well founded on the basis of the opponent's European Union trade mark registration No 17 963 017. It follows that the contested trade mark must be rejected for all the contested goods.

Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the opposing mark due to its reputation as claimed by the opponent. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

Since the opposition is fully successful on the basis of the ground of Article 8(1)(b) EUTMR, there is no need to further examine the other ground of the opposition, namely Article 8(5) EUTMR.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the holder is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Monika CISZEWSKA

Aldo BLASI

Agnieszka PRZYGODA

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be

filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.