

**DECISION
of the First Board of Appeal
of 14 September 2022**

In case R 463/2022-1

Mirza International Limited

14/6 Civil Lines

208 001 Kanpur

India

Opponent / Appellant

represented by MARCHI & PARTNERS S.R.L., Via Vittor Pisani, 13, 20124 Milano (MI), Italy

v

Shenzhen Bluelans Network Technology Co., Ltd.

2F&3F, Plant 2, Zone 1,

Guangyayuan Ind Park, Wuhe Comm,

Bantian St

Shenzhen

People's Republic of China

Applicant / Defendant

represented by ASTERNERY S.L, CALLE NUÑEZ MORGADO 5, 28036 MADRID, Spain

APPEAL relating to Opposition Proceedings No B 3 139 170 (European Union trade mark application No 18 321 733)

THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), M. Bra (Rapporteur) and E. Fink (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 15 October 2020, Shenzhen Bluelans Network Technology Co., Ltd. ('the applicant') sought to register the word mark

red temp

for the following list of goods:

Class 25 - Long sleeved vests; Jackets; Gowns; Snow suits; Trousers; Turtleneck pullovers; Waterproof pants; Blouses; Fleece shorts; Formalwear; Jeans; Bras; Baseball uniforms; Training suits; Lingerie; Down suits; Sports vests; Sleepwear; Women's suits; Bloomers.

- 2 The application was published on 23 October 2020.
- 3 On 18 January 2021, Mirza International Limited ('the opponent') filed an opposition against the registration of the published trade mark application for all the goods.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR.
- 5 The opposition was based on EUTM registration No 461 210 '**RED TAPE**' filed on 10 February 1997 and registered on 22 April 1999 for the following goods:

Class 25 - Clothing, footwear, headgear.

- 6 By decision of 28 January 2022 ('the contested decision'), the Opposition Division rejected the opposition for all the contested goods on the grounds that there was no likelihood of confusion. It gave, in particular, the following grounds for its decision.

The goods

- The contested 'long sleeved vests; jackets; gowns; snow suits; trousers; turtleneck pullovers; waterproof pants; blouses; fleece shorts; formalwear; jeans; bras; baseball uniforms; training suits; lingerie; down suits; sports vests; sleepwear; women's suits; bloomers' are included in the opponent's broad category of 'clothing'. Therefore, they are identical.

Relevant public – degree of attention

- The goods at issue are directed at the public at large. The degree of attention is considered to be average.

The signs

- Both signs are word marks containing the component ‘RED’, which is a very basic English word and is a basic colour, along with ‘blue’, ‘green’, ‘yellow’ and ‘black’ (13/10/2009, T-146/08, Redrock, EU:T:2009:398, § 78; 28/09/2011, T-356/10, Victory Red, EU:T:2011:543). Since this coinciding term in both marks is followed by a noun, it will be interpreted by the public as a particular characteristic attributed to those nouns and will, for this reason, have a limited impact. In addition, taking into consideration that the goods are clothing items, the relevant public will perceive this component as having a limited distinctiveness.
- It is appropriate to first examine the opposition in relation to the part of the public in the relevant territory for which the verbal components ‘TAPE’ and ‘TEMP’, respectively, are fanciful words and have no meaning, such as the Portuguese- or Spanish-speaking parts of the public.
- The most distinctive components of the signs, ‘TAPE’ and ‘temp’ respectively, are rather short words, and small differences are more noticeable in short words than in longer words.
- Overall, the signs are visually, aurally and conceptually similar to a low degree.

Global assessment

- The differences in the distinctive elements ‘TAPE’ and ‘temp’, respectively, are clear enough to attract the relevant consumers’ attention and outweigh the coincidence in the component ‘RED’, which has a limited impact.
- In the present case, the fact that the goods are identical and the distinctiveness of the earlier mark is normal cannot compensate for the differences between the signs, which are visually and aurally clear in their most distinctive components.
- Considering all the above, the Opposition Division finds that there is no likelihood of confusion on the part of the public in the relevant territory under assessment, that is to say, the Portuguese- and Spanish-speaking part of the public, who will not discern any meaning in the components ‘TAPE’ and ‘temp’ respectively. This is the best-case scenario for the opponent, as another part of the public, such as the English- or German-speaking part, may perceive either one, or both, of the marks as conveying a concept. Therefore, irrespective of their degree of distinctiveness, the signs would be perceived as conceptually not similar and would be even more distinguishable by those consumers. For these reasons, it is not necessary to examine this part of the public, as the outcome will not be any different.
- Considering all the above, there is no likelihood of confusion on the public’s part. Therefore, the opposition must be rejected.

- 7 On 23 March 2022, the opponent filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 26 May 2022.
- 8 No response was filed.

Submissions and arguments of the opponent

- 9 The arguments raised in the statement of grounds may be summarised as follows.
 - The marks are similar to a high degree on account of the coinciding distinctive initial term ‘RED’.
 - The contested decision did not take into account all relevant factors in the overall assessment.
 - The earlier mark is reputed throughout the EU (Annexes 1-4).
 - There is a likelihood of confusion and as such the appeal should be allowed and the applicant’s mark should not be allowed to proceed to registration.

Reasons

- 10 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Article 8(1)(b) EUTMR

- 12 In accordance with Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its similarity to the earlier trade mark and the identity or similarity of the goods 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.
- 13 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from undertakings economically linked, constitutes a likelihood of confusion within the meaning of that Article (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 16, 18; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 30). It is clear from that provision that a likelihood of confusion presupposes both that the mark applied for, and the earlier mark are identical or similar, and that the goods covered by the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (12/10/2004, C-106/03, Hubert, EU:C:2004:611, § 51).

- 14 Likelihood of confusion must be assessed globally, taking into account all factors relevant to the circumstances of the case (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 16; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18).

Relevant public and its level of attention

- 15 In the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods and services concerned. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17-26). It should, however, be recalled that the average consumer's level of attention is likely to vary according to the category of goods or services in question (20/10/2011, T-189/09, P, EU:T:2011:611, § 26; 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 42).
- 16 In the present case, the Board endorses the contested decision's undisputed finding that the goods at issue are directed at the public at large whose level of attention is average.
- 17 Finally, since the earlier mark is a European Union trade mark, the relevant territory for the assessment of the likelihood of confusion is the European Union.
- 18 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.
- 19 This being said, the contested decision found it appropriate to focus the analysis on the Spanish- and Portuguese-speaking public who on the one hand will understand the coinciding term 'RED' and, on the other, for whom neither 'TAPE' nor 'TEMP' will have a meaning. Accordingly, the Board will follow this undisputed approach taking into account the applicant's arguments regarding the distinctiveness of these elements.

Comparison of the marks

- 20 With respect to the comparison of the signs, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarities between the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25).
- 21 According to settled case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more

relevant aspects, namely the visual, aural and conceptual aspects (23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 30; 28/04/2004, C-3/03 P, Matratzen, EU:C:2004:233; 12/07/2006, T-97/05, Marcorossi, EU:T:2006:203, § 39; 22/06/2005, T-34/04, Turkish Power, EU:T:2005:248, § 43; 01/06/2006, C-324/05 P, Turkish Power, EU:C:2006:368).

- 22 The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. The average consumer normally perceives a mark as a whole and does not, in general, engage in a specific analysis of its various details (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 35 and the case-law cited).
- 23 The signs to be compared are:

RED TAPE	red temp
<i>Earlier mark</i>	<i>Contested sign</i>

- 24 The signs under comparison are word marks. Thus, these words are protected as such and not their written form. It is therefore irrelevant that the contested sign is represented in title-case or the earlier mark in a combination of upper and lower-case letters (27/01/2010, T-331/08, Solfrutta, EU:T:2010:23, § 16).
- 25 As correctly held in the contested decision and not disputed by the parties, the coinciding initial term ‘RED’ will be understood by the relevant public throughout the European Union as the colour ‘red’, considered both as a very basic English word and colour (13/10/2009, T-146/08, Redrock, EU:T:2009:398, § 78; 28/09/2011, T-356/10, Victory Red, EU:T:2011:543).
- 26 This being said, the contested decision found that this term is of limited distinctiveness with respect to the goods at issue which are clothing items since it is likely that the goods could contain or be in that colour, even if it is not the sole or predominant colour for all the goods in question.
- 27 The Board cannot follow this approach for the following reasons.
- 28 Firstly, the Board acknowledges that indeed the Court case-law has not excluded that the colour of the goods in question may be regarded as one of the ‘other characteristics’ of those goods, within the meaning of Article 7(1)(c) EUTMR (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293, §43, and the case-law cited therein). However, for this to be the case, the mark as a whole must refer to a characteristic which is objective and inherent to the nature of that product and intrinsic and permanent with regard to that product (07/05/2019, T-423/18, vita, EU:T:2019:291, § 44; 23/10/2015, T-822/14, Cottonfeel, EU:T:2015:797, § 32; 05/07/2016, T-167/15, NEUSCHWANSTEIN, EU:T:2016:391, § 30; 11/10/2018, T-120/17, FLUO. (fig.), EU:T:2018:672, § 40).

- 29 In this regard, the Board notes that even though the contested decision acknowledged that the colour red does not have an immediate link with the nature of the goods at issue, it subsequently incorrectly concluded that the possibility that those goods could contain this colour is sufficient to consider it of limited distinctiveness. Therefore, not only did the contested decision improperly apply the OFF-WHITE test, bearing in mind the criteria set by the said case-law, but it was also incoherent in its reasoning, the latter vitiated by an error.
- 30 According to that case-law (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293, § 45), the mere fact that the colour name corresponds to one of the possible colour variations which the goods at issue may have, it does not, however, constitute the sole or even predominant colour. That colour is only presented as a purely random and incidental aspect, which only some of those goods may have and which does not, in any event, have any direct and immediate link with their nature. Thus, the mere fact that the goods in question are more or less usually available in a colour or colour shade, among other colours, is irrelevant, since it is not ‘reasonable’ to believe that, for that reason alone, that colour will actually be recognised by the relevant public as a description of an intrinsic characteristic, which is inherent to the nature of those goods (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293, §45; 07/05/2019, T-423/18, *vita*, EU:T:2019:291, § 45-46).
- 31 Therefore, in line with the case-law, these mere findings should have led to the conclusion that the colour ‘red’ does not constitute an ‘intrinsic’ characteristic which is ‘inherent to the nature’ of the goods concerned (clothing), but a purely random and incidental aspect which only some of them may have and which does not, in any event, have any direct and immediate link with their nature, since such goods are available in a multitude of colours, among them the colour red, which is not more prevalent than the others (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293, § 43, 45; 07/05/2019, T-423/18, *vita*, EU:T:2019:291, § 45-46).
- 32 Consequently, the mere fact that the goods concerned ‘*could be*’, as found in the contested decision, or even are, more or less usually available in red, among other colours, and that such colour might even be aesthetically appealing to some consumers, is irrelevant, since it is not ‘reasonable’ to believe that for that reason alone the colour red will actually be recognised by the relevant public as a description of a characteristic which is objective and inherent to the nature of the goods in question, as well as intrinsic and permanent for those goods, as required by the case-law (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293, § 45; 07/05/2019, T-423/18, *vita*, EU:T:2019:291, § 45-46; 09/06/2021, R 2154/2020-1, *Blue black threads*, § 48).
- 33 In light of the above, the Board concurs with the applicant that the coinciding term ‘RED’ is normally distinctive with respect to the goods at issue.
- 34 The additional differentiating elements of the marks, namely ‘TAPE’ in the earlier mark and ‘TEMP’ in the contested sign, as found by the contested decision and not disputed by the parties, will be considered as meaningless by a vast majority of the Spanish- and Portuguese-public.

- 35 However, for the sake of completeness, the Board notes that the term ‘TAPE’ in the earlier mark as such is not necessarily meaningless for Spanish speakers since it is the third person singular of the present tense subjunctive form of the verb ‘tapar’ (to cover), i.e. to cover oneself in the context of clothing is meaningful ‘que se tape!’. This being said, since ‘TAPE’ is preceded by the English word ‘RED’, which will be understood as such by the Spanish-speaking public, there is no reason to believe that the relevant public will associate it with the Spanish meaning. This is all the more true given that ‘TAPE’ exists as such in English and independently if understood or not, it is easily readable following English pronunciation rules of the preceded word.
- 36 Consequently, since neither ‘TAPE’ nor ‘TEMP’ are basic English words, nor it has been proven that the relevant Spanish- and / or Portuguese-part of the public will associate them with their respective meanings, the Board will follow the contested decision’s undisputed approach that both terms will be perceived as meaningless.
- 37 As to the visual comparison of two-word marks, although there is a risk in relying too much on a mechanical quantitative evaluation, counting the total number of letters, identifying the number of identical letters and comparing their order in the respective marks, this can provide certain guidance. Furthermore, the Court has confirmed that what matters in the assessment of the visual similarity between two-word marks is, rather, the presence, in each of them, of several letters in the same order (25/03/2009, T-402/07, Arcol II, EU:T:2009:85, § 83; 21/01/2015, T-685/13, Blueco, EU:T:2015:38, § 33).
- 38 Visually, the signs display immediately a noticeable coincidence in the initial distinctive term ‘RED’ where customers tend to focus (17/03/2004, T-183/02 and T-184/02, Mundicor, EU:T:2004:79, § 81; 16/03/2005, T-112/03, Flexi Air, EU:T:2005:102, § 64-65). In addition, the marks share the first letter ‘T’ of the second 4 letter-terms ‘TAPE’ vs. ‘TEMP’, respectively, and coincide in the letters ‘P’ and ‘E’, though placed in different positions. Moreover, they have the same structure as both are two-word marks which share the same amount of letters.
- 39 Therefore, the marks are similar to an average degree.
- 40 Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the signs coincides in the initial sound of the word ‘RED’ and the first letter ‘T’ of the second word, namely ‘TAPE’ vs. ‘TEMP’, respectively. Since the remaining coinciding letters, namely ‘P’ and ‘E’ are placed in different positions, they do not add to an aural similarity arising solely from the initial term ‘RED’ and the first letter ‘T’ mentioned above.
- 41 Consequently, the marks are aurally similar to an average degree.
- 42 Conceptually, given the distinctive notion of the term ‘RED’ with respect to the goods at issue and the lack of meaning of the remaining elements for the vast majority of the relevant public under focus, the marks are identical from the semantic perspective for this part of the public.

- 43 Overall, the marks are visually and aurally similar to an average degree whereas conceptually, the marks are identical.

Comparison of the goods

- 44 The Board endorses the contested decision's undisputed finding that the goods under comparison are identical since the contested goods which are different items of clothing are included in the opponent's broad category of 'clothing'.

Overall assessment of the likelihood of confusion

- 45 According to established case-law, the likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 16; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18).
- 46 Such a 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 (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).
- 47 In addition, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his or her trust in the imperfect picture of them that he or she has kept in his or her mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).
- 48 In the present case, the goods are considered identical. The signs are visually and aurally similar to an average whereas from the semantic perspective, the marks are identical. Finally, the distinctiveness of the earlier trade mark is normal.
- 49 In light of the foregoing considerations and taking into account the notion of imperfect recollection and the interdependence of the various factors, there exists a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR on at least part of the relevant Spanish- and Portuguese-speaking public.
- 50 Therefore, there is a reason to assume that a significant part of the relevant public may be misled into thinking that the goods bearing the signs in dispute would come from the same 'RED' undertaking or, as the case may be, from undertakings that are economically linked.
- 51 It follows that the opposition must be upheld in its entirety.
- 52 Accordingly, the contested decision is annulled.

Costs

- 53 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent's costs of the opposition and appeal proceedings.
- 54 As to the appeal proceedings, these consist of the appeal fee of EUR 720 and the opponent's costs of professional representation of EUR 550.
- 55 As to the opposition proceedings, the applicant must reimburse the opposition fee of EUR 320 and the opponent's costs of representation of EUR 300. The total amount is fixed at EUR 1 890.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Upholds the opposition in its entirety and rejects the application in respect to all the contested goods;**
- 3. Orders the applicant to bear the opponent's costs incurred in the appeal and opposition proceedings in the amount of EUR 1 890.**

Signed

G. Humphreys

Signed

M. Bra

Signed

E. Fink

Registrar:

Signed

H.Dijkema

