

**O-0046-23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION UK00003658177 BY WANG XUEZHOU TO  
REGISTER:**

**SILKY MIRACLE**

**AS A TRADE MARK IN CLASSES 24 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 430506  
BY SILKYMIRACLE LTD**

## Background & Pleadings

1. On 21 June 2021, Wang Xuezhou (“the applicant”) applied to register the above trade mark in the United Kingdom in respect of the following goods:

*Class 24: Bed sheets; Bed linen; Bed blankets; Bed covers; Towels; Household linens; Ticks [mattress covers]; Pillowcases; Sleeping bags; Quilt covers.*

*Class 25: Pajamas; Pants; Overalls; Children’s clothing; Pullovers; Shirts; Suits; Coats; Overcoats; Clothing*

The application was published for opposition purposes on 22 October 2021.

2. On 24 January 2022, Silkymiracle Ltd (“the opponent”) opposed the application, in its entirety, under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. The opponent relies upon the following trade marks. For the purpose of its claim under section 5(1), the opponent relies upon *textiles* and *substitutes for textiles* and household linen (respectively) in class 24 and, for the purpose of its claim under section 5(2)(a), it relies upon all goods for which the earlier marks are registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 3242826

## SILKY MIRACLE

Filing date: 11 July 2017

Registration date: 13 September 2019

*Class 24: Textiles and substitutes for textiles*

*Class 25: Footwear; headgear*

---

<sup>1</sup> The opposition was originally pleaded under Sections 5(1)/(2), 5(3) and 5(4) but Sections 5(3) and 5(4) were later withdrawn by the opponent.

## SILKY MIRACLE

Filing date: 11 July 2017

Registration date: 26 October 2018

*Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated soaps; perfumery, essential oils.*

*Class 20: Furniture, mirrors, picture frames; containers, not of metal, for storage or transport; unworked or semi-worked bone, horn, whalebone or mother-of pearl; shells; meerschaum; yellow amber.*

*Class 24: Household linen; curtains of textile or plastic.*

*Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).*

3. The opponent contends that, in light of the identity between the marks and the similarity and/or identity between the parties' goods, there exists a likelihood of confusion, including a likelihood of association, on the part of the public.

4. In its counterstatement, the applicant denies that the parties' marks are identical or similar and that the respective goods are identical or similar, and effectively denies that there exists any likelihood of confusion.

5. The applicant is represented by London IP Ltd and the opponent by Taylor Wessing LLP. Both parties filed written submissions during the evidential rounds. Neither party elected to request a hearing and only the opponent filed submissions in lieu. Whilst I do not propose to summarise those submissions here, I will keep them in mind throughout and intend to refer to them only where necessary.

6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why my decision will continue to make reference to the trade mark case law of EU courts.

## **Decision**

7. Section 5(1) of the Act reads as follows:

“5 (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

8. Section 5(2)(a) reads:

“A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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. Section 5A reads:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. The trade marks relied upon by the opponent clearly qualify as earlier marks under the provisions set out in section 6 of the Act. In accordance with section 6A of the Act, as neither had completed its registration procedure more than five years prior to the

filing date of the applicant's mark, neither is subject to the proof of use requirements. Consequently, the opponent can rely upon its marks and all goods for which they are registered without providing evidence of use.

### **Section 5(2)(b) - Case law**

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 greater 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**

12. The goods to be compared are set out at paragraphs 1 and 2 to this decision. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so<sup>2</sup>.

---

<sup>2</sup> *Separode Trade Mark* decision, BL O-399-10 (AP)

13. *Household linens/linen* in class 24 is present in both the applicant's specification and the opponent's UKTM ending '517. These goods are self-evidently identical.

14. The General Court ("GC") set out a further provision as to when goods can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05. It stated:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

15. If it would be wrong to conclude that all of the goods for which the applicant seeks registration in class 24 are encompassed by, and therefore identical to, the opponent's *textiles* (for which its UKTM ending '826 is registered), I find the goods' similarity is, at least, fairly high. With *textiles* being a rather broad term, there could be some similarity in the use of the goods and in the respective users. With the applicant's goods all being textile-based it seems highly likely that there will be some opportunity for correlation in the goods' physical nature. The goods may reach the market via the same channels of trade, they could be sold in proximity and there could arise an opportunity for the goods to occupy competitive roles<sup>3</sup>. Finally, it would not seem unusual for a single entity to produce both parties' class 24 goods.

16. In the alternative, I consider the applicant's class 24 goods against the opponent's *household linen*, for which its mark ending '517 is registered. A number of the terms in the applicant's specification may, in my view, be directly encompassed by *household linen* (*bedsheets* and *bed linen*, for example). Still, if that approach is considered incorrect, I find the goods' similarity of at least a fairly high degree. There is some opportunity for similarity in the goods' use, though I accept these are variable amongst the terms, and the users are likely to be the same. The goods will also likely

---

<sup>3</sup> *Treat*, [1996] R.P.C. 281

share some physical characteristics and move through the same or similar trade channels. It would not seem unreasonable for the consumer to expect a single entity to offer both *household linen* and the class 24 goods cited in the applicant's specification. Additionally, there could be some circumstances whereby the goods are competitive, and may be used alongside one another.

17. The applicant also seeks registration for *pajamas; pants; overalls; children's clothing; pullovers; shirts; suits; coats; overcoats* and *clothing* in class 25. The opponent's UKTM ending '826 is registered for *footwear* and *headgear*, in the same class. The goods are used for a highly similar purpose; to cover a particular area of the body for protective or aesthetic reasons. The users of the respective goods are likely to be shared and, in my experience, the goods generally reach the market via the same trade channels. The goods are often sold in the same retail establishments, in fairly close proximity and it is not unusual for a single entity to offer both parties' respective goods. The goods may not be competitive; the consumer will typically know which it requires and the goods are not interchangeable, and whilst they may not be indispensable for one another, they are often used alongside one another. I find a high degree of similarity.

### **The average consumer and the nature of the purchasing act**

18. 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. 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.”

19. The average consumer of the goods and services at issue is likely to be a member of the general public. All of the goods at hand are likely to be self-selected by the average consumer from a traditional retail establishment, such as a department store or clothing store, or an online equivalent. The marks’ visual impact is likely to play the greater role in the selection process, though I do not overlook the marks’ aural impression as guidance could be sought from retail assistants, for example. The goods are, in my experience, purchased fairly frequently and are not typically sold at a particularly high cost, though I accept these are variable, particularly in the clothing sector. For both the class 24 and 25 goods, the consumer will likely be alive to considerations such as quality, sustainability and compatibility. Weighing those considerations, I find it likely that the average consumer will apply a medium degree of attention to its purchase of the relevant goods.

### **Comparison of trade marks**

20. Both the applicant’s trade mark and those relied upon by the opponent are solely comprised of two words; SILKY MIRACLE. I find the marks are identical.

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

21. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. 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).”

22. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

23. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence showing the use made of the earlier mark(s), I have only its inherent distinctiveness to consider. Conceptually, the meaning of the mark’s words will be readily identified; SILKY as an adjective used to describe something which is soft or smooth and MIRACLE used to describe something which is extraordinary in some way. Together, the words create an impression of something which is exceptionally (or ‘miraculously’) soft or smooth. When considered against the goods relied upon for the purpose of the opposition, such an impression could be seen to play an allusive role concerning a quality of the goods themselves, specifically their

texture. That being said, the mark does not refer specifically to the goods and 'SILKY MIRACLE' is not, to my knowledge, a common term in the relevant field. On balance, I find the earlier mark(s) inherently distinctive to a medium degree.

### **Likelihood of confusion**

24. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

25. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

26. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element

in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.””

27. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

28. I will begin by considering a likelihood of direct confusion. As the case law explains, this involves the average consumer simply mistaking one trade mark for the other. I have found that the average consumer will apply a medium degree of attention to its selection of the goods and that the parties’ goods are either identical or similar to a fairly high or high degree. Such factors, coupled with the identity between the parties’ respective trade marks, would likely result in direct confusion on the part of the average consumer, whereby it mistakes one mark for the other. There is nothing between the parties’ marks to enable the consumer to make a distinction between them and, consequently, even if the goods’ similarity were to be of only a low degree, the outcome would likely remain the same.

29. Having found a likelihood of direct confusion, I need not consider the likelihood of indirect confusion.

## **Conclusion**

**30. The opposition has been wholly successful and, subject to any successful appeal, the application will be refused.**

## **Costs**

31. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In the circumstances, in accordance with that TPN, I award the opponent the sum of **£600** as a contribution towards the cost of the proceedings, calculated as follows:

Filing a Notice of Opposition (official fee): £100<sup>4</sup>

Preparing written submissions: £250

Considering the other side's submissions and  
preparing written submissions in lieu of a hearing: £250

32. I order Wang Xuezhou to pay Silkymiracle Ltd the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of January 2023**

**Laura Stephens**  
**For the Registrar**

---

<sup>4</sup> Reduced to reflect the withdrawal of initially pleaded grounds