

BL O/293/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003697460

BY RESPIRE

TO REGISTER THE TRADE MARK:

respire

IN CLASSES 3, 5, 35 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 430942

BY FACCO GIUSEPPE E C. S.P.A.

BACKGROUND AND PLEADINGS

1. On 18 December 2018, RESPIRE (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the European Union. The applicant subsequently applied for the same mark in the UK on 20 September 2021. In accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, by filing an application for the EU mark in the UK within nine months of the end of the transition period, the applicant is entitled to rely on the priority date of the EU mark in UK proceedings. Therefore, the date of the application in these proceedings is considered to be 18 December 2018.

2. Registration is sought for the goods and services in classes 3, 5, 35 and 44 set out in the Annex to this decision.

3. The application was partially opposed by FACCO GIUSEPPE E C. S.p.A. (“the opponent”) on 10 February 2022. The opposition was originally based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, the opponent withdrew the section 5(4)(a) ground in correspondence dated 3 March 2022. The opposition, therefore, proceeds on the basis of section 5(2)(b), and is directed against the following goods and services of the application:

Class 3 Soaps; Perfumery, essential oils, cosmetics, Preparations for the care of the hair, skin and body; Hair lotion; Dentifrices; Antiperspirants [toiletries]; Depilatory preparations; Air fragrancing preparations; All the aforesaid goods being included in this class.

Class 35 The bringing together of a variety of goods (namely beauty products, cosmetics, skin care products, perfumery and air fragrancing preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops; Marketing services, Online retail services relating to cosmetic and beauty preparations, skin care products, Perfumery and Room fragrances; Advertising.

4. Under section 5(2)(b), the opponent relies upon the following trade mark:

The logo for 'ReSpira' is written in a black, elegant cursive script. The letters 'R', 'S', and 'P' are notably large and stylized. Below the word 'ReSpira', there are four small black dots arranged horizontally.

UK registration no. UK00917890080

Filing date 19 April 2018; Registration date 21 September 2018.

Relying upon all of the goods for which the earlier mark is registered, namely:

Class 3 Air fragrancing preparations; Room perfumes in spray form; Essential oils for use in air fresheners.

Class 4 Perfumed candles.

Class 5 Air deodorising preparations; Deodorising room sprays; Air deodoriser gel; Preparations for the neutralising of odours.

5. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent's mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

6. The opponent claims that there is a likelihood of confusion because the marks are visually, aurally and conceptually similar and the goods and services are either identical or highly similar.

7. The applicant filed a counterstatement denying the similarity of the marks, but admitted to the similarity of its "essential oils" and "air fragrancing preparations" in class 3 and "the bringing together of a variety of products (air fragrancing

preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops” and “online retail services relating to room fragrances” in class 35 to the opponent class 3 and 5 goods.

8. The opponent is represented by Stevens Hewlett & Perkins and the applicant is represented by Lewis Silkin LLP. A hearing was neither requested nor considered necessary, however, the applicant filed submissions in lieu. This decision is taken following a careful perusal of the papers.

9. 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 Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

10. Section 5(2)(b) reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. The earlier mark had not completed its registration process more than five years before the relevant date (the priority date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods and services it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

12. The following principles are gleaned from the decisions of the EU courts 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 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:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<u>Class 3</u> Air fragrancing preparations; Room perfumes in spray form; Essential oils for use in air fresheners.	<u>Class 3</u> Soaps; Perfumery, essential oils, cosmetics, Preparations for the care of the hair, skin and body; Hair lotion; Dentifrices; Antiperspirants [toiletries]; Depilatory preparations; Air fragrancing
<u>Class 4</u>	

<p>Perfumed candles.</p> <p><u>Class 5</u></p> <p>Air deodorising preparations; Deodorising room sprays; Air deodoriser gel; Preparations for the neutralising of odours.</p>	<p>preparations; All the aforesaid goods being included in this class.</p> <p><u>Class 35</u></p> <p>The bringing together of a variety of goods (namely beauty products, cosmetics, skin care products, perfumery and air fragrancing preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops; Marketing services, Online retail services relating to cosmetic and beauty preparations, skin care products, Perfumery and Room fragrances; Advertising.</p>
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14. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 for 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.”

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary

and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

20. As highlighted above, in its counterstatement, and in its submissions in lieu, the applicant accepts that its "essential oils" and "air fragrancing preparations" in class 3 and "the bringing together of a variety of products (air fragrancing preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops" and "online retail services relating to room fragrances" in class 35 is "similar" to the opponent class 3 and 5 goods. However, the applicant hasn't specified what degree of similarity those goods share. Therefore, I shall carry out a full comparison of the specifications.

Class 3

21. “Air fragrancing preparations” appears identically in both specifications.

22. I consider that “essential oils for use in air fresheners” in the opponent’s specification falls within the broader category of “essential oils” in the in the applicant’s specification. I consider that the goods are identical on the principle outlined in *Meric*.

23. I consider that “room perfumes in spray form” in the opponent’s specification falls within the broader category of “perfumery” in the applicant’s specification. I consider that the goods are identical on the principle outlined in *Meric*.

24. I consider that “cosmetics”, “preparations for the care of the hair, skin and body” and “hair lotion” in the applicant’s specification are all products which are used for the purpose of personal beautification, and therefore would be produced by cosmetic undertakings. The opponent’s goods are all household fragrance and air deodorising goods, and therefore would be produced by undertakings which specialise in different types of home fragrance. Therefore, the parties’ goods do not overlap in nature, method of use, purpose or trade channels. There may be some overlap in distribution channels as all of the goods may be sold within general retail stores or in supermarkets, but they would not be sold in the same aisle. I do not consider that the goods are in competition nor complementary. Consequently, I consider that the goods are dissimilar.

25. Depilatory preparations are used to remove unwanted hair from the body and therefore can also be considered as products used for the purpose of personal beautification. I therefore consider that the same comparison applies in paragraph 24 above. The goods are dissimilar.

26. I consider that “soaps” in the applicant’s specification are used to clean the users hands or body. I therefore do not consider that soap overlaps in trade channels, nature, method of use and purpose with the opponent’s class 3, 4 and 5 household fragrance and air deodorising goods, which are used to fragrance a person’s home. There may be some overlap in distribution channels as all of the goods may be sold by general

retail stores or in supermarkets, but they would not be sold in the same aisle. The goods are neither in competition nor complementary. Consequently, the goods are dissimilar.

27. I consider that “antiperspirants [toiletries]” in the applicant’s specification are used to reduce the user from sweating. I note that antiperspirants and the opponent’s class 3, 4 and 5 household fragrance and air deodorising goods can all be sold in aerosol cans. However, I also consider that the applicant’s goods can also be sold in a balm form, and the opponent’s goods can be sold in spray form. Therefore, there is limited overlap in nature. However, the goods do not overlap in purpose or method of use as the applicant’s antiperspirants are to be applied to the users armpits to reduce sweating, and the opponent’s goods would be sprayed onto furniture or within the vicinity of the household for fragrance purposes. The goods do not overlap in trade channels, but they may be distributed within the same general retail outlets and supermarkets. However, I note that they would not be sold within the same aisle. The goods are neither competition nor complementary. Therefore, the goods are dissimilar.

28. “Dentifrices” in the applicant’s specification are any substances that can be used to clean teeth. I do not therefore consider that the nature, method of use and purpose of these goods overlaps with any of the opponent’s class 3, 4 and 5 household fragrance and air deodorising goods. I also do not consider that there would be an overlap in trade channels as the opponent’s goods would be produced by home fragrance undertakings and the applicant’s goods would be produced by oral care specialists and sold within dentists. However, there would be an overlap in distribution channels as all of the goods may be sold within general retail stores or in supermarkets, but they would not be sold in the same aisle. The goods are neither in competition nor complementary. Consequently, I consider that they are dissimilar.

Class 35

29. *In Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

30. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He stated (at paragraph 9 of his judgment):

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.

31. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM* Case T-105/05², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded:

(i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to

¹ Case C-411/13P

² paragraphs [30] to [35] of the judgment

envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

32. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording 'namely' should be interpreted as covering only the named services within that specification. Therefore, the specification is limited to only those services.

33. The applicant submits that the opponent's "air fragrancing preparations" is similar to the applicant's "the bringing together of a variety of goods (namely air fragrancing preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops" services. As set out in the case law above, the GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Consequently, I consider that the opponent's goods are similar to the applicant's services to a medium degree.

34. The applicant also submits that the opponent's "air fragrancing preparations" is similar to the applicant's "online retail services relating to room fragrances". I consider that the same considerations apply in paragraph 33 above, the goods and services are distributed through the same trade channels (which produce and sell air fragrances for the users home) and are therefore complementary. Therefore the goods and services are similar to a medium degree.

35. I consider that the opponent's "room perfumes in spray form" overlaps with the applicant's "the bringing together of a variety of goods (namely perfumery), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops" services. As highlighted by the case law above, as these goods and services are complementary and can be distributed through the same trade channels (an undertaking which specialises in fragrance), I consider that they are similar to a medium degree.

36. I consider that the opponent's "room perfumes in spray form" is similar to the applicant's "online retail services relating to perfumery". The goods and services would be distributed through the same trade channels, online undertakings which specialise in fragrance, and are therefore complementary. Consequently, I consider that they are similar to a medium degree.

37. I do not consider that the applicant's "the bringing together of a variety of goods (namely beauty products, cosmetics, skin care products), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops", and "online retail services relating to cosmetic and beauty preparations, skin care products" overlaps with the opponent's class 3, 4 and 5 household fragrance and air deodorising goods. They do not overlap in trade channels, as the applicant's services would be provided by undertakings which specialise in cosmetics, such as cosmetic stores, beauty retail outlets and their online equivalents, whereas the opponent's goods would be produced and sold by undertakings which specialise in fragrance. I also do not consider that the goods and services overlap in nature, purpose and method of use. They are neither in competition nor complementary because the goods and services are not important nor indispensable for each other. Consequently, I consider that the goods and services are dissimilar.

38. The applicant's "marketing services" and "advertising" services are dissimilar to all of the opponent's class 3, 4 and 5 household fragrance and air deodorising goods. The services do not overlap in nature, purpose and method of use. They also do not overlap in trade channels as the applicant's services would be provided by marketing and advertising undertakings. The goods and services are neither in competition nor

complementary. There may be an overlap in user, but this is not enough on its own to establish similarity. Therefore, the goods and services are dissimilar.

39. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the above goods and services that I have found to be dissimilar.³

40. The opposition fails under section 5(2)(b) for the following goods and services:

Class 3 Soaps; cosmetics, Preparations for the care of the hair, skin and body; Hair lotion; Dentifrices; Antiperspirants [toiletries]; Depilatory preparations; All the aforesaid goods being included in this class.

Class 35 The bringing together of a variety of goods (namely beauty products, cosmetics, skin care products), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops; Marketing services, Online retail services relating to cosmetic and beauty preparations, skin care products; Advertising.

The average consumer and the nature of the purchasing act

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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

³ eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

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.”

42. The average consumer for the goods will be members of the general public. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, ingredients and fragrance. Therefore, the level of attention paid during the purchasing process will be medium.

43. The average consumer for the services will also be members of the general public. The services will be used relatively frequently, and the average consumer will take various factors into consideration when selecting the services such as the location, cost, availability of products and the range of products on offer. Therefore, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

44. The goods and services will be obtained from a general retail outlet, supermarket or online equivalent. Alternatively, the goods and services may be purchased following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Comparison of the trade marks



45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant

components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

46. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

47. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

48. The opponent's mark consists of the word “Respira” in a stylised font, with the letters “pira” underlined, with 5 dots underneath (with smaller dots on the outside, and bigger dots in the middle). I consider that the word “Respira” plays a greater role in the overall impression of the mark, with the stylisation and design playing a lesser role.

49. The applicant's mark consists of the word “respire” in a fairly standard typeface. I consider that the word respire plays a greater role in the overall impression with the stylisation playing a lesser role.

50. Visually, the marks coincide in the beginning 6 letters; R, E, S, P, I and R. I also bear in mind that the average consumer pays more attention to the beginning of the marks. These act as visual points of similarity. The opponent's mark ends in the letter A, with its end letters underlined with a line and dot device, and the applicant's mark ends in the letter E. The applicant's mark is presented in a standard typeface and the opponent's mark is presented in a stylised typeface. Due to the stylisation of the opponent's mark, the letter S is presented in the same size as the capitalised letter "R", which is slightly bigger than the other lower-case letters. However, I consider that a significant proportion of average consumers will overlook this due to the marks stylisation. Therefore, taking the above into account, I consider that the marks are visually similar to a high degree.

51. Aurally, the opponent's mark will be pronounced as RES-PIER-RA. The applicant's mark will be pronounced as RES-PIER. Therefore, as the pronunciation of the applicant's mark is fully encased at the beginning of the opponent's mark, I consider that they are aurally similar to a high degree.

52. Conceptually, the applicant submits that the opponent's mark, respire, would be "readily recognised" by the average consumer to mean "to breathe". I agree. The opponent submits that both of the parties' marks, conceptually, are a reference or allude to the word "respire" or "respiration", however, I do not consider that this concept would be assigned to the opponent's mark. I consider that, when viewed as a whole, the word "Respira" will be viewed as an invented word which would be attributed no particular meaning. Consequently, I consider that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

53. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

55. As highlighted above, I consider that the stylised word *Respira* will be viewed as an invented word which is neither allusive nor descriptive in relation to the goods and services for which the mark is registered. Therefore, I consider the opponent’s mark to be inherently distinctive to a high degree.

Likelihood of confusion

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

57. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally similar to a high degree.
- I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to a high degree.
- I have identified the average consumer to be members of the general public who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods and services.
- I have found the parties' goods and services to identical or similar to a medium degree.

58. The conceptual dissimilarity between the marks could point in favour of the applicant. In *Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences

observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

59. However, I recognise that conceptual differences do not always overcome visual and/or aural similarities.⁴ For example, in *Diramode S.A. v Richard Turnham and Linda Turnham* (BL O/566/19), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, overturned a decision that the conceptual differences between PIMKIE and PINKIE were sufficient to outweigh the visual and aural similarities between them. Mr Geoffrey Hobbs QC found that:

‘Even though one of the marks in issue refers to a clear and immediately apparent concept and the other does not have a clear meaning which can be immediately perceived by the relevant public, the degree of visual and aural similarity between them may still be sufficient to give rise to the existence of a likelihood of confusion’.

60. Whether or not the conceptual differences are sufficient to outweigh the visual and aural similarities must be decided on the facts of each particular case. However, in this case, I consider it unlikely that the conceptual differences between the marks will offset the high visual similarities between the marks, particularly in what I have found to be a predominantly visual purchasing process. This is particularly the case bearing in mind the high level of distinctiveness of the opponent’s mark and the principle of imperfect recollection. Even where aural considerations play a greater role, the relatively high aural similarity between the marks will have the same result.

61. Therefore, I consider that because the marks share the same first beginning 6 letters, in the same order (R, E, S, P, I and R), with the only differences being the marks last letter (A v E), and the stylisation of the typefaces, these will be easily overlooked by the average consumer. Consequently, in my view, this results in a likelihood of direct confusion.

⁴ *Nokia Oyj v OHIM*, Case T-460/07

CONCLUSION

62. The opposition is partially successful in respect of the following goods and services, for which the application is refused:

Class 3 Perfumery, essential oils, Air fragrancing preparations; All the aforesaid goods being included in this class.

Class 35 The bringing together of a variety of goods (namely beauty products, perfumery and air fragrancing preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops; Online retail services relating to Perfumery and Room fragrances.

63. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful, and those for which the opposition was not directed against:

Class 3 Soaps; cosmetics, Preparations for the care of the hair, skin and body; Hair lotion; Dentifrices; Antiperspirants [toiletries]; Depilatory preparations; All the aforesaid goods being included in this class.

Class 5 Food supplements.

Class 35 The bringing together of a variety of goods (namely beauty products, cosmetics, skin care products), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops; Marketing services, Online retail services relating to cosmetic and beauty preparations, skin care products; Advertising.

Class 44 Cosmetic skin care services; Providing hot tub facilities; Beauty consultancy, namely, Beauty analysis for the identification of the most appropriate cosmetics for particular individuals.

COSTS

64. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 21st day of March 2023

L FAYTER

For the Registrar

ANNEX

The applicant's mark

Class 3

Soaps; Perfumery, essential oils, cosmetics, Preparations for the care of the hair, skin and body; Hair lotion; Dentifrices; Antiperspirants [toiletries]; Depilatory preparations; Air fragrancing preparations; All the aforesaid goods being included in this class.

Class 5

Food supplements.

Class 35

The bringing together of a variety of goods (namely beauty products, cosmetics, skin care products, perfumery and air fragrancing preparations), enabling customers to conveniently view and purchase those goods, the aforesaid services being provided via websites and in shops; Marketing services, Online retail services relating to cosmetic and beauty preparations, skin care products, Perfumery and Room fragrances; Advertising.

Class 44

Cosmetic skin care services; Providing hot tub facilities; Beauty consultancy, namely, Beauty analysis for the identification of the most appropriate cosmetics for particular individuals.