

O/1085/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003862390

BY ELYSIAN SPA LTD

TO REGISTER THE TRADE MARK:



IN CLASSES 3 AND 4

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 441346

BY ROJA PARFUMS HOLDINGS LIMITED

BACKGROUND AND PLEADINGS

1. On 23 December 2022, Elysian Spa Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 17 March 2023.

2. The application was partially opposed by Roja Parfums Holdings Limited (“the opponent”) on 13 June 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods of the application:

Class 3 Bath salts; Bath soaps; Bath and shower foam; Bubble bath; Shower and bath preparations; Bath and shower gels; Bath milk; Bath powder; Bath oils; Bath bombs; Cosmetic bath salts; Bath crystals; Bath herbs; Liquid bath soaps; Liquid bath soap; Foaming bath liquids; Bath soak for cosmetic use; Aromatic oils for the bath; Shower cream; Skin creams; Skin lotion; Moisturising skin creams [cosmetic]; Hair cream; Skin moisturizers; Anti-aging cream; Anti-wrinkle cream; Skin moisturizer masks; Cosmetic creams for firming skin around eyes; Cuticle cream; Body cream; Skin hydrators; Shaving cream; Skin emollients; Cleansing cream; Aftershave moisturising cream; Skin toner; Skin cleansers; Facial creams; Skin balms [cosmetic]; Exfoliating creams; Shaving creams; Facial masks [cosmetic]; Facial scrubs; Skin masks; Hair masks; Facial washes; Facial soaps; Body and facial oils; Facial cleansing milk; Facial massage oils; Facial preparations; Cosmetic mud masks; Face powder; Foot scrubs; Pumice stones for use on the body; Exfoliating body scrub; Exfoliating scrubs for the face; Scented wax melts; Massage waxes; Aromatherapy oils; Aromatherapy lotions; Aromatherapy creams; Essential oils for aromatherapy; Aromatherapy preparations; Massage oils and lotions; Perfume oils; Essential oils as fragrances for laundry use; Shower oils; Essential oils and aromatic extracts; Essential oils; Room fragrancing products; Hair oil; Beard oil; Cleansing oil; Cuticle oil; Cosmetic facial masks; Cosmetic creams; Cosmetic soap; Cosmetic masks; Lip balms; Lip tints; Lip cream; Lip cosmetics; Lip care

preparations; Eyebrow gel; Shaving balms; Skin calming serum; Hair serums; Anti-ageing serum; Beard balm; Hair shampoo; Shampoo bars; Hair conditioner; Hair moisturizers; Hair conditioner bars; Soap products; Facial wash; Liquid soaps for hands and face; Exfoliating scrubs for cosmetic purposes; Loofah soaps; Essential oils for use in the manufacture of scented products; Essential oil-based creams for aromatherapy use; Air fragrance preparations; Air fragrance reed diffusers; Perfume; Fragrance refills for non-electric room fragrance dispensers; Fragrance sachets; Room perfume sprays; Reed diffusers; Scented linen sprays; Solid perfumes; Liquid perfumes; Deodorants and antiperspirants.

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

ELYSIUM

Comparable UK trade mark (EU) registration no. UK00915541055¹

Filing date 14 June 2016.

Registration date 7 November 2016.

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

Class 3 Perfumery.

4. The opponent claims that there is a likelihood of confusion because the marks and goods are similar.

5. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use.

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

6. The opponent is represented by J A Kemp LLP and the applicant is unrepresented. The opponent filed evidence in chief. Neither party requested a hearing but the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE AND PRELIMINARY ISSUE

8. The opponent's evidence consists of the witness statement of Ms Audrey Minard dated 8 December 2023. Ms Minard is the Chief Executive of the opponent, a position she has held since 2021. Ms Minard's statement is accompanied by 6 exhibits (AM1-AM6).

9. I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

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 opponent’s mark qualifies as earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of the applicants’ mark. As the opponent’s mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

12. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

13. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicants' mark, i.e. 24 December 2017 to 23 December 2022.

15. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the entirety of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence

that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Evidence of use

17. I note the following from the opponent’s evidence:

- a) Ms Minard states that the opponent is a “luxury perfume house”, and its ELYSIUM perfume has been on sale continuously since 2017 both online and in store.
- b) **Exhibit AM1** contains a “PR report” from its launch in 2017 which contains a record of EU and UK print, social media and TV promotion for the “ELYSIUM fragrance at the time of its launch”. This exhibit contains 23 screenshots from articles and magazines which all show the ELYSIUM fragrance, with the majority of them pricing the fragrance at £225 for 100ml, with the opponent’s website listed for the customer to purchase it. Each page from this exhibit also lists the number of viewers for the publications. I note a sample number of examples contained within this exhibit:

- a. The GQ article has 15,053,332 monthly page views.
 - b. The VOGUE Italy article has 39,482,439 monthly page views.
 - c. A Sunday Times Style Magazine dated 24 September 2017 with a circulation of 770,000.
 - d. The Times LUXX magazine has a circulation of 607,000.
 - e. The Sunday Telegraph ST Men Magazine has a circulation of 355,000.
 - f. The Mayfair Magazine dated 2017 has a circulation of 44,000.
 - g. The David Magazine (from Solvenia/Croatia) dated 2017 has a circulation of 35,000.
 - h. The Imagine Magazine (from Ireland) has a circulation of 28,000.
 - i. The Yorkshire post advertisement has a circulation of 43,000
- c) The above all show the following photos of the opponent's perfume:



- d) **Exhibit AM1** also contains screenshots of the ELYSIUM fragrance being advertised on different Instagram accounts of influencers from the UK, Germany, France, Italy, Spain, Switzerland, Greece, Portugal and Ireland. I also note that the influencer's number of followers are provided which range between 3,900 to 515,000. The undated posts clearly show the above bottle, as follows:



e) The last page of **exhibit AM1** shows a screenshot from a BBC new world interview which states that ELYSIUM was seen by over 300 million people.

f) **Exhibit AM3** contains screenshots from the Wayback Machine dated 2018, 2019, 2020, 2021 and 1 July 2022 showing its ELYSIUM goods for sale on the opponent's rojaparfums.com website. The website screenshots show the goods as follows:



Elysium Pour Homme Parfum Cologne 100 ml
£225.00



Elysium Edition Speciale Parfum 100 ml
£595.00



ELYSIUM POUR HOMME £245.00
"HEROIC, VIRTUOUS"

SIZE | 100ML

ADD TO CART - £245.00

DESCRIPTION | NOTES | ROJA'S MUSING

The kind of fragrance which draws the world to its charm, Elysium evokes the perfect balance of fiery, glowing brightness with sophisticated depth of character. This intensely beautiful creation opens with a warm, resinous richness that soon allures in bright bursts of Citrus and Jaws notes, and further filled by an intoxicating Musk top note that adds weight to the mix. A juicy spritz of Apple, Blackcurrant and Juniper Berry combine the vibrant personality, which dives down into a base of vetiver, the depth and mystery. An ideal in the world of male perfumery. Pink Pepper - reaches the forefront, with a dominant Cedarwood note that opens the entry into a notably fresh, bloodily citrus scent, which has aspects of sensuality deep in the base to lend a redemptive masculinity.

KEY INGREDIENTS: Bergamot, Lemon, Powdered Thyme, Musk, Pink Pepper, Cedarwood, Juniper Berry, Geranium, Musk.

- g) The opponent has provided the following table showing “in excess of” the number of units of ELYSIUM sold in the UK:²

2018	2019	2020	2021	2022	2023 year to date
19,000	18,000	17,000	35,000	30,000	35,000

- h) The opponent has also provided the following table showing “in excess of” the value of sales of ELYSIUM sold in the UK:

2018	2019	2020	2021	2022	2023 year to date
£1 million	£1 million	£1 million	£2 million	£2 million	£2 million

- i) The above is supported by 15 of the opponents invoices contained in **exhibit AM6** which are dated between 28 March 2018 to 28 March 2022. It shows the goods being sold to Selfridges Manchester, Harrods Berkshire, Karl Barrett Brighton, Fenwicks Newcastle and Fortnum and Mason London. I also note that the goods are all described within the invoices as “ELYSIUM PAR COLOGNE PH”.
- j) **Exhibit AM4** contains 143 social media posts dated between 2018 to 2022. I note that the posts are from the opponent’s official Instagram page (@rojaparfums), and the likes on these posts range between 408 to 1,844. The ELYSIUM goods are clearly presented in the same bottles depicted above. The comments on these posts are all positive, for example, commenting that it’s “the best fragrance in the word”, that they “love it” and it is one of their favourites, or that it was a gift they loved.
- k) **Exhibit AM5** contains a range of photographs of the opponent’s ELYSIUM perfume on displays in Selfridges London dated 7 August 2022 and in the front window of the opponent’s flagship Roja Parfums store in Burlington Arcade. The goods are clearly displayed in the above depicted bottles.

² The precise data is confidential and there Ms Minard has provided “in excess of figures”, for example, in 2023 the opponent sold in excess of 35,000 units of ELYSIUM in the UK.

Assessment of genuine use and fair specification

18. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered on the invoices. For the sake of completeness, the evidence above shows that the word “ELYSIUM” appears on the perfume bottle alongside a golden triangular device, and the words “ROJA PARFUMS”. However, although it is used in conjunction with other signs (i.e. ROJA PARFUMS and the golden triangular device), the word “ELYSIUM” is clearly visible and still continues to indicate origin.³ I also note that the word “ELYSIUM” is presented in a minimally stylised gold upper-case typeface. However, the stylisation is very minimal and does not alter the distinctive character of the mark.⁴ Therefore the use of the opponent’s mark on its perfume bottles is acceptable variant use.

19. As I have found the variant mark used in the evidence to be acceptable, I will now consider whether the evidence shows that the earlier mark has been genuinely used. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵ As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

20. I am satisfied that based on all of the above, including the UK sales and unit figures amounting to in excess of £7 million from the sale of in excess of 119,000 bottles of ELYSIUM perfume between 2018 and 2022, which is supported by UK invoice evidence and screenshots from the opponent’s website, as well as magazine, newspaper and influencer advertising, that the opponent’s earlier ELYSIUM mark has been put to genuine use in the UK in relation to perfumes during the relevant period.

³ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

⁴ *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

21. While I have concluded that there is genuine use, I do not consider that the use is sufficient to allow the opposition to continue in respect of all of the goods relied upon.⁶ This is on the basis that the opponent's specification consists of one broad term, being "perfumery", which, as noted by the opponent in its submissions in lieu, is defined as "the products made by a perfumer". I therefore consider that this could encapsulate more than just "perfume", i.e. a fragrant liquid applied directly to the user's body to make them smell nice, being the only goods the opponent has shown use for. I therefore consider that "perfume" is an appropriate sub-category of "perfumery".

22. Consequently, I consider a fair specification for the opponent's mark to be:

Class 3 Perfume.

Section 5(2)(b) - case law

23. In making this decision, I bear in mind the following principles 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

⁶ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

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

24. The applicant's opposed class 3 goods are contained within paragraph 2 of this decision.

25. The opponent's class 3 fair specification is contained within paragraph 22 above .

26. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the 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.”

27. 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.

28. In *G rard Meric v OHIM*, 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 f r 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.”

Applicant’s submissions

29. I note that in the applicant’s counterstatement, they state that their ethos is “based on natural, organic ingredients [...] using 100% essential oils and plant resins in order to achieve an aromatherapeutic benefit, as advertised” on their website. The applicant also states that “unlike ELYSIUM, we would never use, and never will use artificial fragrance compounds as they do not contribute to aromatherapy”. The applicant also highlights that their skincare products range from  10 to  60 whereas the opponent’s perfumes and their gift sets range from  265 to  525. However, the applicant’s above submissions regarding how the parties’ goods are used and sold in practice, which impacts the price of the goods, is not relevant to my assessment. I have to carry out a notional assessment based upon the specifications before me (how the goods within the parties’ specifications could be used and sold), and all the circumstances in which the mark applied for might be used if it were registered.⁷

⁷ *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.

Class 3 goods comparison

Perfume.

30. This term appears identically in both specifications.

Solid perfumes; Liquid perfumes; Perfume oils.

31. I consider that the applicant's above goods fall within the opponent's broader category of "perfume". They are identical on the principle outlined in *Meric*.

Deodorants and antiperspirants.

32. I consider that the applicant's above goods are similar to the opponent's "perfume". I note that the goods are both applied by being sprayed onto the body, and are used to improve the user's smell. Therefore they overlap in nature and purpose. However, I appreciate that the applicant's goods are specifically applied to the armpits, and antiperspirants are used to prevent and reduce perspiration. I therefore do not consider that the goods are in competition nor complementary. However, I find that there is an overlap in user as well as trade channels because they would be sold by the same undertakings. I also note that they could be fragranced with the same scent. On this basis, I consider that the goods are similar to between a low and medium degree.

Essential oils and aromatic extracts; Essential oils.

33. The applicant's above goods can be applied to the user's skin and body for fragrancing purposes. I therefore consider that the goods overlap in method of use and purpose with the opponent's "perfume". The goods may overlap in trade channels, and I consider that all of the goods will be distributed and sold in beauty retail outlets and pharmacies in close proximity. They will also overlap in user. Therefore, taking all of the above into account, I find the goods are parties' goods are similar to between a low and medium degree.

Essential oils as fragrances for laundry use.

34. Unlike the essential oils referred to in paragraph 35 above, the applicant's goods are specifically for laundry use, which would be added to detergent and used in the washing machine. I therefore consider that these goods do not overlap in nature, method of use and purpose with the opponent's "perfume" which is a fragrant liquid applied directly to the user's body to make them smell nice. Consequently, the goods are neither in competition nor complementary. Although I have found above that the same undertaking selling essential oils may share the same trade channels as those selling perfumes, I find in this instance, since the essential oils are specifically for laundry use rather than for use on the body, it is improbable that they would share the same trade channels. I also consider that the goods would not be located in close proximity in general retail outlets and supermarkets as the applicant's goods will most likely be located in the laundry aisle next to detergent and fabric softener, for example. On this basis, I find the goods are dissimilar.

Essential oils for use in the manufacture of scented products.

35. As set out in *Les Éditions Albert René v OHIM*,⁸ it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

36. I consider that whilst the opponent's "perfume" goods may contain the applicant's above essential oils, they clearly do not overlap in method of use and purpose (being used in a manufacturing process vs being applied to a user's body to make them smell nice). The nature of the goods differ as the applicant's goods are ingredients used in a manufacturing process whereas the opponent's goods are a finished product containing such ingredients. The goods will not be sold by the same undertakings, and thus do not overlap in trade channels. The users will differ, as the applicant's goods will be bought by manufacturers that create scented products, whereas the opponent's

⁸ Case T-336/03

goods will be bought by the general public. They are neither in competition nor complementary. I therefore find them dissimilar.

Room fragrancing products; Air fragrance preparations; Air fragrance reed diffusers; Fragrance refills for non-electric room fragrance dispensers; Fragrance sachets; Room perfume sprays; Reed diffusers; Scented linen sprays.

37. The applicant's above goods are all preparations which are dispersed in a room or home to fragrance it. I therefore consider that they differ in purpose and method of use with the opponent's "perfume" which is a fragrant liquid applied directly to the user's body to make them smell nice. Therefore the goods are clearly neither in competition nor complementary. I do not have any evidence before me to establish that the goods would be sold by the same undertakings, however, if they are, the goods would not be sold in the same section of the undertaking's website (home goods vs perfume), and they will not be sold in the same aisle or in close proximity within supermarkets and retail outlets. On this basis, I find the goods are dissimilar.

Bath soaps; Soap products; Liquid soaps for hands and face; Bath and shower foam; Shower and bath preparations; Bath and shower gels; Bath oils; Shower oils; Liquid bath soaps; Liquid bath soap; Aromatic oils for the bath; Shower cream; Bath salts; Bubble bath; Bath milk; Bath powder; Bath bombs; Cosmetic bath salts; Bath crystals; Bath herbs; Foaming bath liquids; Bath soak for cosmetic use.

38. The applicant's above goods are all used in the bath or shower, and they have cleaning and/or moisturising properties. I also note that they can be unscented to perform their above purpose, but they can also be perfumed. In this regard, I bear in mind *Les Éditions Albert René v OHIM*. Therefore, whilst the applicant's goods could contain the opponent's "perfume" as an ingredient, the goods clearly do not overlap in nature or method of use as the opponent's "perfume" is merely a fragrant liquid applied directly to the user's body to make them smell nice. The goods also would not be substituted for each other because they have different purposes. On this basis, the goods are clearly neither in competition nor complementary. I also do not have any evidence that the parties' goods are created by the same undertaking, and even if they are, I also appreciate that separate undertakings will create and sell the parties' goods;

with perfumers specialising in creating perfume and bath and cosmetic undertakings specialising in creating the applicant's above goods. Although the goods may all be distributed in beauty retailers and pharmacies, this is not sufficient in and of itself to find similarity especially when considering that none of the other *Treat* criteria apply. In addition, they are unlikely to be sold in the same aisle or close proximity, and I have nothing before me to suggest otherwise. I find the parties' goods are dissimilar.

Skin creams; Skin lotion; Moisturising skin creams [cosmetic]; Skin moisturizers; Cuticle cream; Body cream; Body and facial oils; Aftershave moisturising cream; Anti-aging cream; Anti-wrinkle cream; Skin moisturizer masks; Cosmetic creams for firming skin around eyes; Facial masks [cosmetic]; Skin masks; Cosmetic mud masks; Cosmetic facial masks; Cosmetic masks; Skin hydrators; Skin emollients; Skin toner; Facial creams; Skin balms [cosmetic]; Cosmetic creams; Skin calming serum; Anti-ageing serum.

39. The applicant's above goods are all types of creams, masks and emollients that are applied to the user's face and body for beautifying, anti-aging and moisturising purposes. Therefore these goods do not overlap in nature, purpose and method of use with the opponent's "perfume", which is a fragrant liquid applied directly to the user's body to make them smell nice. Consequently, the goods are neither in competition nor complementary. Whilst it is plausible that these goods could be created by the same undertakings, I also appreciate that separate undertakings will create and sell the parties' goods; with perfumers creating perfume and skin care and cosmetic undertakings creating the applicant's above goods. Whilst the goods could all be distributed in beauty retailers, pharmacies and supermarkets; they will not be located in the same aisle or in close proximity. The applicant's above goods can be unscented to perform their above purpose, but they can also be perfumed. I therefore bear in mind *Les Éditions Albert René v OHIM*, and as noted above, these goods do not overlap in nature, method of use or purpose. Therefore, taking all of the above into account, I find that the parties' goods are dissimilar.

Cleansing cream; Skin cleansers; Cleansing oil; Facial cleansing milk; Facial preparations; Facial washes; Facial wash; Facial soaps; Cosmetic soap; Loofah soaps; Exfoliating scrubs for cosmetic purposes; Exfoliating creams; Facial scrubs;

Exfoliating body scrub; Exfoliating scrubs for the face; Foot scrubs; Pumice stones for use on the body.

40. The applicant's above goods are all used to exfoliate, cleanse and wash the user's skin (including removing make-up and dirt). Therefore these goods clearly do not overlap in nature, purpose and method of use with the opponent's "perfume". The goods are also clearly neither in competition nor complementary. I do not have any evidence that the parties' goods are created by the same undertakings, and even if they are, I also appreciate that separate undertakings will create and sell the parties' goods; with perfumers creating perfume and skin care and cosmetic undertakings creating the applicant's above goods. I also note that the goods could all be distributed in beauty retailers, pharmacies and supermarkets; but not in the same aisle or located in close proximity. Even if the applicant's goods are fragranced, I have determined that these goods are used in a fundamentally different way, and for a fundamentally different purpose, to the opponent's goods. I find the parties' goods are dissimilar.

Lip balms; Lip cream; Lip care preparations.

41. I do not consider that the applicant's above goods, which moisturise and improve the appearance of the user's lips, are similar to the opponent's "perfume". The goods clearly do not overlap in nature, method of use and purpose, and they are neither in competition nor complementarity. I do not have any evidence before me that the goods would be created by the same undertakings. However, if they are, they would not be sold under the same heading on a website for example (cosmetics vs perfume). I also appreciate that separate undertakings will create and sell the parties' goods; with perfumers creating perfume and skin care and cosmetic undertakings making the applicant's above goods. If the goods are all sold within beauty retailers, pharmacies and supermarkets, they will not be sold in the aisle or in close proximity. On this basis, I find the goods are dissimilar.

Face powder; Eyebrow gel; Lip tints; Lip cosmetics.

42. The applicant's above goods are all types of make-up which are applied to the users' face to improve their appearance. Whilst I consider that the parties' goods could

be made by the same undertaking, I also appreciate that separate undertakings will create and sell the parties' goods; with perfumers creating perfume and cosmetic undertakings making the applicant's above goods. Whilst these goods may all be distributed in beauty retailers, pharmacies and supermarkets, this is not sufficient for a finding of similarity. Fundamentally, make-up does not share the same nature and purpose of perfume, and they would not be used in the same way. They are neither in competition with each other, and they are neither indispensable or important for the use of the other, meaning they are not complementary. Consequently, I find the goods are dissimilar.

Hair cream; Hair masks; Hair oil; Beard oil; Hair serums; Beard balm; Hair shampoo; Shampoo bars; Hair conditioner; Hair moisturizers; Hair conditioner bars.

43. The applicant's above goods are all used to moisturise and improve the appearance of the user's hair. Therefore, these goods clearly differ in nature, method of use and purpose to the opponent's "perfume". Consequently, they are neither in competition nor complementarity. I do not have any evidence before me that the goods are made by the same undertakings, and whilst they would be distributed in beauty retail stores, pharmacies and supermarkets, they will not be sold in the same aisle or located in close proximity. I find the goods are dissimilar.

Shaving cream; Shaving creams; Shaving balms.

44. The applicant's above goods are all applied to the skin, to help the user shave. The goods do not overlap in nature, method of use and purpose, nor are they complementary or in competition with, the opponent's "perfume". I do not have any evidence before me that the goods are made by the same undertakings, and whilst they would all be distributed in beauty retail stores and pharmacies, they would not be sold in the same aisle or located in close proximity. I find the goods are dissimilar.

Facial massage oils; Massage oils and lotions; Massage waxes.

45. The applicant's above goods are all products used for massages. These goods clearly do not overlap in nature, method of use and purpose with the opponent's

“perfume”. Consequently, the goods are neither in competition nor complementary. I do not consider there to be an overlap in trade channels, especially as the applicant’s goods are more specialist and therefore would be sold by massage undertakings. Albeit they may all be distributed within beauty retail stores and pharmacies, they will not be sold in the same aisle or in close proximity. Therefore, taking all of the above into account, I find the parties’ goods are dissimilar.

Aromatherapy oils; Aromatherapy lotions; Aromatherapy creams; Essential oils for aromatherapy; Aromatherapy preparations; Essential oil-based creams for aromatherapy use.

46. The applicant’s above goods are all products used for aromatherapy. These goods therefore do not overlap in nature, method of use and purpose, nor are they complementary or in competition with, the opponent’s “perfume”. I do not consider there to be an overlap in trade channels, especially as the applicant’s goods are more specialist and therefore are likely to be sold by aromatherapy undertakings. Whilst all of the goods are fragranced with pleasant scents, I do not consider that this is enough on its own to establish similarity between the goods. Consequently, I find the goods are dissimilar.

Cuticle oil.

47. The applicant’s above goods are used on the cuticles to improve nail health. These goods clearly do not overlap in nature, method of use and purpose, and are neither in competition nor complementary, to the opponent’s “perfume” which is a fragrant liquid applied directly to the user’s body to make them smell nice. I do not have any evidence before me that the same undertakings create these goods and whilst they all would be distributed in beauty retail stores, pharmacies and supermarkets, they would not be sold in the same aisle or in close proximity. I find the goods are dissimilar.

Scented wax melts.

48. The applicant’s above goods clearly differ in nature, method and purpose with the opponent’s “perfume”. They are also neither in competition nor complementary. The

goods will not be sold by the same undertaking. They may all be sold within supermarkets, but not within the sale aisle or in close proximity. Whilst the goods will overlap in user, and are goods are all fragranced with pleasant scents, I do not consider that this is enough to establish similarity between the goods. Taking all of the above into account, I find that the opponent's goods and the applicant's goods are dissimilar.

49. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.⁹

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

Class 3 Bath salts; Bath soaps; Bath and shower foam; Bubble bath; Shower and bath preparations; Bath and shower gels; Bath milk; Bath powder; Bath oils; Bath bombs; Cosmetic bath salts; Bath crystals; Bath herbs; Liquid bath soaps; Liquid bath soap; Foaming bath liquids; Bath soak for cosmetic use; Aromatic oils for the bath; Shower cream; Skin creams; Skin lotion; Moisturising skin creams [cosmetic]; Hair cream; Skin moisturizers; Anti-aging cream; Anti-wrinkle cream; Skin moisturizer masks; Cosmetic creams for firming skin around eyes; Cuticle cream; Body cream; Skin hydrators; Shaving cream; Skin emollients; Cleansing cream; Aftershave moisturising cream; Skin toner; Skin cleansers; Facial creams; Skin balms [cosmetic]; Exfoliating creams; Shaving creams; Facial masks [cosmetic]; Facial scrubs; Skin masks; Hair masks; Facial washes; Facial soaps; Body and facial oils; Facial cleansing milk; Facial massage oils; Facial preparations; Cosmetic mud masks; Face powder; Foot scrubs; Pumice stones for use on the body; Exfoliating body scrub; Exfoliating scrubs for the face; Scented wax melts; Massage waxes; Aromatherapy oils; Aromatherapy lotions; Aromatherapy creams; Essential oils for aromatherapy; Aromatherapy preparations; Massage oils and lotions; Essential oils as fragrances for laundry use; Shower oils;

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Room fragrancing products; Hair oil; Beard oil; Cleansing oil; Cuticle oil; Cosmetic facial masks; Cosmetic creams; Cosmetic soap; Cosmetic masks; Lip balms; Lip tints; Lip cream; Lip cosmetics; Lip care preparations; Eyebrow gel; Shaving balms; Skin calming serum; Hair serums; Anti-ageing serum; Beard balm; Hair shampoo; Shampoo bars; Hair conditioner; Hair moisturizers; Hair conditioner bars; Soap products; Facial wash; Liquid soaps for hands and face; Exfoliating scrubs for cosmetic purposes; Loofah soaps; Essential oils for use in the manufacture of scented products; Essential oil-based creams for aromatherapy use; Air fragrance preparations; Air fragrance reed diffusers; Fragrance refills for non-electric room fragrance dispensers; Fragrance sachets; Room perfume sprays; Reed diffusers; Scented linen sprays.

The average consumer and the nature of the purchasing act

51. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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 (as he then was) 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.”

52. 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 goods will be purchased relatively frequently. The average

consumer will take various factors into consideration such as the cost, quality, aesthetic and scent. Therefore, the level of attention paid during the purchasing process will be medium.

53. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or online equivalent. Alternatively, the goods may be purchased following the 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 a sales assistant.


Comparison of the trade marks

54. 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.”

55. 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.

56. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<p>ELYSIUM</p>	

57. The opponent's mark consists of the 7-letter word "ELYSIUM". There are no other elements to contribute to the overall impression which lies in the word itself.

58. The applicant's mark consists of the 7-letter word "ELYSIAN" presented in a large minimally stylised black capitalised typeface. Underneath, in the middle, in a much smaller size, is the word "SPA" presented in the same black capitalised typeface, with a black line on either side. I note that the word "SPA" is allusive of where the applicant's class 3 goods could be used, or the undertaking that they originate from. Above the word "ELYSIAN" is a gold and mint-coloured device which will be recognised by the average consumer as a lotus flower. The eye is naturally drawn to the element of the mark that can be read. Therefore, for reasons I will come to discuss in the conceptual comparison, the word "ELYSIAN" is the dominant and distinctive part of the mark, which plays a greater role in the overall impression, with the smaller and allusive "SPA" element, the stylisation and lotus flower playing a lesser role.

59. Visually, the marks coincide in the letters E, L, Y, S, and I. I note that these letters appear at the beginning of the words, a position to which the average consumer pays more attention to.¹⁰ The opponent's mark ends in the letters U and M, whereas the applicant's mark ends in the letters A and N. I also bear in mind that normal and fair use of the opponent's word mark means that it may be used in any standard typeface, as well as in upper and lower-case lettering. Consequently, the letters M and N in

¹⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

capital letters are visually similar, with the letter M only having one additional angular straight line. The applicant's mark also includes the word "SPA", the two vertical lines and the lotus flower device. These all act as visual points of difference. Therefore, taking the above into account, I consider that the marks are visually similar to between a medium and high degree.

60. Aurally, the lotus flower device in the applicant's mark will not be articulated, and therefore its mark is likely to be pronounced as EL-EE-SEE-AN SPA. The opponent's mark is likely to be pronounced as EL-EE-SEE-UM. Therefore the beginning 3 syllables are aurally identical, in addition to the "AN" and "UM" sounds which are quite similar when preceded with those same syllables. On this basis, the marks are aurally similar to between a medium and high degree.

61. Conceptually, the opponent submits that the word "ELYSIUM" is defined by the Merriam Webster dictionary as "the abode of the blessed after death in classical mythology" or "paradise". However, I do not consider that a significant proportion of average consumers would know this definition. Instead, I consider that they would see it as an invented word with no conceptual meaning. I also consider that the word "ELYSIAN" in the applicant's mark will be seen as an invented word with no conceptual meaning. On this basis, it is the dominant and distinctive element of the applicant's mark. The word "SPA" at the end of the applicant's mark is an ordinary dictionary word which the average consumer will recognise as a place where a user goes to improve their health or relax. I note that the opponent submits that this element is descriptive in relation to the goods, however, when assessing the conceptual similarity of two marks, this is usually done without reference to the services in question.¹¹ Therefore the word "SPA" acts as a conceptual point of difference. I also note that the lotus flower device in the applicant's mark is a conceptual point of difference. Consequently, taking the above into account, the opponent's "ELYSIUM" mark and the dominant and distinctive word "ELYSIAN" in the applicant's mark are conceptually neutral. However, as the applicant's mark has the additional conceptual elements of the word "SPA" and the lotus flower device, the marks, as a whole, are conceptually dissimilar.

¹¹ Mr Philip Johnson, sitting as the AP in *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia, (2) Chiarli 1860 – Pr.I.V.I Srl And (3) Medici Ermete E Figli Srl O/054/22*.

Distinctive character of the earlier trade mark

62. 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).”

63. 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 and services, 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.

64. I note that at paragraph 4.2 of their written submissions in lieu, the opponent states that they do not rely upon enhanced distinctiveness through use. Nonetheless, as noted above, I consider that the average consumer will see the word ELYSIUM as an

invented word with no meaning. Therefore, the opponent's mark is inherently distinctive to a high degree.

Likelihood of confusion

65. 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 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 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 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.

66. 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 between a medium and high degree.
- I have found the marks to be aurally similar to between a medium and high degree.
- Conceptually, I have found that the opponent's "ELYSIUM" mark and the dominant and distinctive word "ELYSIAN" in the applicant's mark are conceptually neutral. However, as the applicant's mark have the additional conceptual elements of SPA and the lotus flower, as a whole, the marks are conceptually dissimilar.
- I have found the earlier mark to be inherently distinctive to a high degree.

- I have identified the average consumer as the general public, who will select the goods 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.
- The parties' goods are identical or similar to between a low and medium degree.

67. 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.”

68. However, I recognise that conceptual differences do not always overcome visual and/or aural similarities.¹² 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’.

69. 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

¹² *Nokia Oyj v OHIM*, Case T-460/07

case, I consider it unlikely that the conceptual differences between the marks (which only arise from the elements that play a lesser role in the overall impression of the applicant's mark) will offset the visual similarities, particularly as I have found the purchasing process to be predominantly visual. This is also particularly the case bearing in mind that the opponent's mark, "ELYSIUM", is an invented word and therefore inherently distinctive to a high degree, which is conceptually neutral to the applicant's "ELYSIAN" word element, which is the dominant and distinctive part of the mark, and the principle of imperfect recollection. I also bear in mind that even where aural considerations play a greater role in the purchasing process, the between a medium and high degree of aural similarity between the marks will have the same result.

70. The marks share the letters "ELYSI" at the beginning of the marks (which the average consumer pays more attention to) with the different letters appearing at the end of the parties' marks (UM vs AN). These will, therefore, be easily overlooked or imperfectly recalled by the average consumer, especially as noted above, the letter M and N are visually similar. Moreover, I note that the word "SPA" is allusive of where the parties' class 3 goods could be used, or the undertaking that they originate from. Thus it would also be easily overlooked. Lastly, I consider that the lotus flower device would also be easily overlooked or misremembered by the average consumer. In my view, this results in a likelihood of direct confusion, even where there is between a low and medium degree of similarity between the goods, due to the effect of the interdependency principle.

71. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

72. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

73. Bearing in mind that the average consumer rarely has the chance to compare the marks side-by-side, will encounter them in different settings at different times, and therefore must rely upon the imperfect picture of them retained in its mind, I consider there to be a likelihood of indirect confusion, on the basis of imperfect recollection.

74. I am of the view that if the average consumer remembers the lotus flower device and the word “SPA”, that they are still likely to imperfectly recall the differences in spelling between the words “ELYSIUM” and “ELYSIAN”. This is on the basis that they are both invented words with no conceptual meanings. Consequently there is no significant conceptual hook in order to differentiate the words. This is particularly the case bearing in mind the high level of distinctiveness of the opponent’s invented word mark, which is neither allusive nor descriptive of the goods.

75. Moreover, I note that the word “SPA” is allusive of where the parties’ class 3 goods could be used, or the undertaking that they originate from. Therefore, it is my view that the average consumer will view the applicant’s mark as an alternative mark being used on identical or similar goods, by the same or economically linked undertakings, perhaps denoting a specialist range or it could be viewed as being an updated version of the same mark and therefore indicative of re-branding. I consider that it is not

uncommon for undertakings re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, I consider there to be a likelihood of indirect confusion, even where there is a between a low and medium degree of similarity between the goods, due to the effect of the interdependency principle.

CONCLUSION

76. The opposition is partially successful in respect of the following goods, for which the applications are refused:

Class 3 Perfume oils; Essential oils and aromatic extracts; Essential oils; Perfume; Solid perfumes; Liquid perfumes; Deodorants and antiperspirants.

77. The application can proceed to registration in respect of the following goods for which the opposition has been unsuccessful:

Class 3 Bath salts; Bath soaps; Bath and shower foam; Bubble bath; Shower and bath preparations; Bath and shower gels; Bath milk; Bath powder; Bath oils; Bath bombs; Cosmetic bath salts; Bath crystals; Bath herbs; Liquid bath soaps; Liquid bath soap; Foaming bath liquids; Bath soak for cosmetic use; Aromatic oils for the bath; Shower cream; Skin creams; Skin lotion; Moisturising skin creams [cosmetic]; Hair cream; Skin moisturizers; Anti-aging cream; Anti-wrinkle cream; Skin moisturizer masks; Cosmetic creams for firming skin around eyes; Cuticle cream; Body cream; Skin hydrators; Shaving cream; Skin emollients; Cleansing cream; Aftershave moisturising cream; Skin toner; Skin cleansers; Facial creams; Skin balms [cosmetic]; Exfoliating creams; Shaving creams; Facial masks [cosmetic]; Facial scrubs; Skin masks; Hair masks; Facial washes; Facial soaps; Body and facial oils; Facial cleansing milk; Facial massage oils; Facial preparations; Cosmetic mud masks; Face powder; Foot scrubs; Pumice stones for use on the body; Exfoliating body scrub; Exfoliating scrubs for the face; Scented wax melts; Massage waxes; Aromatherapy oils; Aromatherapy lotions; Aromatherapy creams;

Essential oils for aromatherapy; Aromatherapy preparations; Massage oils and lotions; Essential oils as fragrances for laundry use; Shower oils; Room fragrancing products; Hair oil; Beard oil; Cleansing oil; Cuticle oil; Cosmetic facial masks; Cosmetic creams; Cosmetic soap; Cosmetic masks; Lip balms; Lip tints; Lip cream; Lip cosmetics; Lip care preparations; Eyebrow gel; Shaving balms; Skin calming serum; Hair serums; Anti-ageing serum; Beard balm; Hair shampoo; Shampoo bars; Hair conditioner; Hair moisturizers; Hair conditioner bars; Soap products; Facial wash; Liquid soaps for hands and face; Exfoliating scrubs for cosmetic purposes; Loofah soaps; Essential oils for use in the manufacture of scented products; Essential oil-based creams for aromatherapy use; Air fragrance preparations; Air fragrance reed diffusers; Fragrance refills for non-electric room fragrance dispensers; Fragrance sachets; Room perfume sprays; Reed diffusers; Scented linen sprays.

78. The opposition was not directed against the following goods for which the application can proceed to registration:

Class 4 Candles; Tealight candles; Scented candles; Aromatherapy fragrance candles.

COSTS

79. In these proceedings, the applicant has enjoyed a greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

80. The applicant has been successful and would normally be entitled to a contribution towards their costs. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities

associated with the proceedings. They were informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

81. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 15th day of November 2024

**L FAYTER
For the Registrar**