

O/1127/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK4013230

BY SB FRAGRANCES LTD

TO REGISTER THE TRADE MARK:



scent Elysian

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 447780

BY ROJA PARFUMS HOLDINGS LIMITED

Background and pleadings

1. On 11 February 2024, SB Fragrances 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 1 March 2024. Registration is sought for the following goods:

Class 3: Perfume; Perfumes; Perfumery and fragrances; Fragrances; Perfume oils; Oils for perfumes and scents; Fragrance sachets; Cosmetics; Aromatics for perfumes; Perfume oils for the manufacture of cosmetic preparations; Skincare cosmetics; Amber [perfume]; Musk [perfumery]; Skin fresheners [cosmetics]; Liquid perfumes; Aromatics for fragrances; Fragrance emitting wicks for room fragrance; Moisturisers [cosmetics]; Perfumery products; Fragrance preparations; Body deodorants [perfumery]; Deodorants for personal use [perfumery]; Perfume water; Perfumery; Room perfume sprays; Fragrance refills for non-electric room fragrance dispensers; Scents; Household fragrances; Colognes; Body fragrances; Extracts of perfumes; Natural oils for perfumes; Cologne; Perfumed powder [for cosmetic use]; Cosmetics in the form of lotions; Extracts of flowers [perfumes]; Flowers (Extracts of -) [perfumes]; Extracts of flowers being perfumes; Perfumes for cardboard; Cedarwood perfumery; Skin moisturizers used as cosmetics; Beauty lotions; Air fragrance preparations; Perfumeries; Room fragrances; Scented body lotions; Feminine deodorant sprays; Perfumed soaps; Vanilla perfumery; Synthetic perfumery; Scented body lotions and creams; Cosmetics and cosmetic preparations; Scented oils; Perfumed creams; Fragrance for household purposes; Beauty care cosmetics; Scented soaps; Natural cosmetics.

2. The application was opposed by Roja Parfums Holdings Limited (“the opponent”) on 3 June 2024. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) against all applied for goods.

3. The opponent relies on the following trade mark:

UK3917930

ELYSIUM

Filing date: 1 June 2023

Registration date: 29 December 2023

Relying on all goods for which it is registered as follows:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; perfumes and perfumery products; aromatic substances for use in the manufacture of perfumes; fine fragrance; perfumed shower gels and other shower preparations; perfumed bath foam preparations; perfumed bath salts; perfumed milks; perfumed lotions; perfumed sprays; perfumed creams; perfumed soaps.

4. The opponent claims that the marks are similar and the goods are either identical or similar and that this will give rise to a likelihood of confusion.

5. The applicant filed a counterstatement in which it denied the claims made by the opponent.

6. The applicant represents themselves and the opponent is represented by J A Kemp LLP.

7. The applicant filed evidence (together with submissions). Neither party requested a hearing but both filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

8. 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

9. The applicant provided evidence by way of a witness statement from Narmeen Zehra, who is the Creative Director of SB Fragrances Ltd. This statement was dated 10 December 2024 and is accompanied by 4 exhibits. The evidence contains an image of their own mark, google searches of each of the marks and the corresponding results together with a search for 'Elysium' on Instagram. This is supported by submissions from Narmeen Zehra which goes on to discuss the differences between the marks.

10. I note that the applicant's evidence is either undated or dated after the relevant date in these proceedings. Nevertheless, the applicant's above evidence which shows use of its mark in the market 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 marks applied for might be used if they were registered.¹

11. I also bear in mind that the applicant has filed evidence of google searches that pertains to the opponent's mark. However, the opponent's trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods they have identified without showing the use of its mark.

12. Taking all of the above into account, I do not consider that the evidence is of any assistance in these proceedings and therefore, I will consider it no further.

Decision

13. Section 5(2)(b) is being relied upon and is as follows:

¹ *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

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

[...]

(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”.

14. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6. (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

16. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions.

Case law

17. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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

18. 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”.

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

20. 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 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 that the responsibility for those goods lies with the same undertaking”.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) (‘Meric’)*, Case T-133/05, the 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 für Lernsysteme

v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

23. The goods at issue are as follows:

| Contested goods | Earlier goods |
|--|---|
| Class 3: Perfume; Perfumes; Perfumery and fragrances; Fragrances; Perfume oils; Oils for perfumes and scents; Fragrance sachets; Cosmetics; Aromatics for perfumes; Perfume oils for the manufacture of cosmetic preparations; Skincare cosmetics; Amber [perfume]; Musk [perfumery]; Skin fresheners [cosmetics]; Liquid perfumes; Aromatics for fragrances; Fragrance emitting wicks for room fragrance; Moisturisers [cosmetics]; Perfumery products; Fragrance preparations; Body deodorants [perfumery]; Deodorants for personal use [perfumery]; Perfume water; Perfumery; Room perfume sprays; Fragrance refills for non-electric room fragrance dispensers; Scents; Household fragrances; Colognes; Body | Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; perfumes and perfumery products; aromatic substances for use in the manufacture of perfumes; fine fragrance; perfumed shower gels and other shower preparations; perfumed bath foam preparations; perfumed bath salts; perfumed milks; perfumed lotions; perfumed sprays; perfumed creams; perfumed soaps. |

| | |
|--|--|
| fragrances; Extracts of perfumes; Natural oils for perfumes; Cologne; Perfumed powder [for cosmetic use]; Cosmetics in the form of lotions; Extracts of flowers [perfumes]; Flowers (Extracts of -) [perfumes]; Extracts of flowers being perfumes; Perfumes for cardboard; Cedarwood perfumery; Skin moisturizers used as cosmetics; Beauty lotions; Air fragrance preparations; Perfumeries; Room fragrances; Scented body lotions; Feminine deodorant sprays; Perfumed soaps; Vanilla perfumery; Synthetic perfumery; Scented body lotions and creams; Cosmetics and cosmetic preparations; Scented oils; Perfumed creams; Fragrance for household purposes; Beauty care cosmetics; Scented soaps; Natural cosmetics. | |
|--|--|

24. In paragraph 12 of the applicant's submissions in lieu they accept that some goods are identical or similar however, they have not provided me with any details as to which goods they believe this applies to, nor the level of similarity thereof. I must, therefore, continue with a full comparison.

Perfume; Perfumes; Perfumery products; Liquid perfumes; Cedarwood perfumery; Perfumeries; Vanilla perfumery; Synthetic perfumery; Extracts of flowers being perfumes; Scents; Extracts of perfumes;

25. I consider the above terms from the applicant's specification to fall within 'perfumes and perfumery products' and therefore, I find them to be identical as per the principle set out in *Meric*.

Perfumery and fragrances;

26. I find that the above term encompasses the opponent's 'perfumes and perfumery products' and therefore, I consider them to be identical as per the principle set out in *Meric*.

Fragrances;

27. The above term encompasses the opponent's 'fine fragrance' and therefore, I consider them to be identical as per the principle set out in *Meric*.

Perfume oils; Oils for perfumes and scents; Aromatics for perfumes; Amber [perfume]; Musk [perfumery]; Perfume water; Flowers (Extracts of -) [perfumes]; Extracts of flowers being perfumes; Natural oils for perfumes; Aromatics for fragrances;

28. I consider the above terms from the applicant's specification to fall within 'aromatic substances for use in the manufacture of perfumes' and therefore, I consider them to be identical as per the principle set out in *Meric*.

Cosmetics; Skincare cosmetics; Skin fresheners [cosmetics]; Moisturisers [cosmetics]; Perfumed powder [for cosmetic use]; Cosmetics in the form of lotions; Skin moisturizers used as cosmetics; Beauty care cosmetics; Natural cosmetics

29. Cosmetics is clearly found identically in both specifications and I consider that the other terms above fall within the opponent's 'cosmetics' and therefore, applying the principle in *Meric*, these goods are identical.

Cosmetics and cosmetic preparations;

30. I consider that the above encompasses the opponent's 'cosmetics' and therefore, applying the principle in *Meric*, these goods are identical.

Colognes; Cologne;

31. Colognes are fragrances to be worn on the body however, they contain a lower concentration of perfume oils than the opponent's 'perfumes and perfumery products'. Nevertheless, the goods overlap in nature, purpose and method of use. They would be sold via the same trade channels and be purchased by the same consumer group. There would also be a degree of competition between the same but they are not complementary. I consider these goods to be similar to a very high degree.

Body deodorants [perfumery]; Deodorants for personal use [perfumery]; Body fragrances; Feminine deodorant sprays;

32. I note that these goods and the opponent's 'perfumes' are for personal use, both applied by being sprayed onto the body, improving 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, with deodorants being used to reduce bodily smells. I therefore do not consider that the goods are in competition nor are they complementary. However, I find that there is an overlap in user as well as trade channels because they could be sold by the same undertakings. On this basis, I consider that the goods are similar to a medium degree.

Fragrance emitting wicks for room fragrance; Room perfume sprays; Fragrance refills for non-electric room fragrance dispensers; Household fragrances; Air fragrance preparations; Room fragrances; Fragrance preparations; Fragrance for household purposes; Scented oils; Perfumes for cardboard;

33. The applicant's above goods are all preparations which are dispersed/used 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 and perfumery products" which are fragrant liquids 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.

Perfume oils for the manufacture of cosmetic preparations;

34. I compare the above with ‘aromatic substances for use in the manufacture of perfumes’. I consider the user and purpose to be different. The applicant’s goods will be used by cosmetics manufacturers to create perfumed cosmetics whereas the opponent’s goods will be used by perfume manufacturers to create perfumes. There is no overlap in trade channels, nor is there any competition or complementarity. There may be an overlap in nature however, this is not enough on its own to make a finding of similarity. They are, therefore, dissimilar.

35. I also considered comparing these goods to the end product (i.e. cosmetics) and noted the case of *Les Éditions Albert René v OHIM*, Case T-336/03, where the General Court found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

36. I find that the nature, user, purpose and trade channels are all different. There is no competition or complementarity. I therefore find these goods to also be dissimilar.

Beauty lotions; Scented body lotions; Scented body lotions and creams;

37. I find that the above terms include ‘perfumed lotions’ from the opposition’s specification and therefore, consider them to be identical under the *Meric* principles.

Perfumed creams; Perfumed soaps; Scented soaps;

38. 'Perfumed creams' and 'perfumed soaps' are found identically in both specifications. Further, I consider that scented soaps include perfumed soaps and therefore, find them identical under the *Meric* principles.

39. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

40. As I have found no similarity for 'Perfume oils for the manufacture of cosmetic preparations; Fragrance emitting wicks for room fragrance; Room perfume sprays; Fragrance refills for non-electric room fragrance dispensers; Household fragrances; Air fragrance preparations; Room fragrances; Fragrance preparations; Fragrance for household purposes; Scented oils; Perfumes for cardboard'. The opposition in relation to these goods fails here.

41. I shall continue the opposition in relation to:

Class 3: Perfume; Perfumes; Perfumery and fragrances; Fragrances; Perfume oils; Oils for perfumes and scents; Cosmetics; Aromatics for perfumes; Skincare cosmetics; Amber [perfume]; Musk [perfumery]; Skin fresheners [cosmetics]; Liquid perfumes; Aromatics for fragrances; Moisturisers [cosmetics]; Perfumery products; Fragrance preparations; Body deodorants [perfumery]; Deodorants for personal use [perfumery]; Perfume water; Perfumery; Scents; Colognes; Body fragrances; Extracts of perfumes; Natural oils for perfumes; Cologne; Perfumed powder [for cosmetic use]; Cosmetics in the form of lotions; Extracts of flowers [perfumes]; Flowers (Extracts of -) [perfumes];

Extracts of flowers being perfumes; Cedarwood perfumery; Skin moisturizers used as cosmetics; Beauty lotions; Air fragrance preparations; Perfumeries; Scented body lotions; Feminine deodorant sprays; Perfumed soaps; Vanilla perfumery; Synthetic perfumery; Scented body lotions and creams; Cosmetics and cosmetic preparations; Perfumed creams; Beauty care cosmetics; Scented soaps; Natural cosmetics.

The average consumer and the nature of the purchasing act

42. 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.”

43. The average consumer for the goods will be members of the general public (although I do not discount professionals such as manufacturers, especially for the goods being used in the manufacture of perfumes). 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.

44. 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 or catalogues. 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 marks

45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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:

| Contested mark | Earlier mark |
|---|---|
|  | <p data-bbox="991 450 1203 495" style="text-align: center;">ELYSIUM</p> |

48. 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.

49. The contested mark consists of two words ‘scent’ and ‘Elysian’ presented in a script-like gold font. I note that ‘scent’ is descriptive or allusive to the applicant’s class 3 goods. Above the words is a gold device in the shape of an octagonal perfume bottle with a sparkling diamond shaped stopper. In the centre of the bottle is an upside down heart shape and at the bottom of the bottle are some vines/flowers extending sideways. I consider that the perfume bottle and the vines/flowers are descriptive or allusive to perfumes or pleasant scents. 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 element of the mark, which therefore plays a greater role in the overall impression. The ‘scent’ element together with the decorative elements and colouring will play a lesser role.

50. Visually, the marks coincide in the letters E, L, Y, S, and I. 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, singular colour and in upper and lower-case lettering. The applicant’s mark also includes the word “SCENT” at the beginning and the device element. These act as visual points of difference. Therefore, taking the above into account, I consider that the marks are visually similar to a medium degree.

51. Aurally, the device in the applicant's mark will not be articulated, and therefore its mark is likely to be pronounced as SCENT EL-EE-SEE-AN. The opponent's mark is likely to be pronounced as EL-EE-SEE-UM. Therefore, the first 3 syllables of ELYSIAN/ELYSIUM are aurally identical, in addition to the "AN" and "UM" sounds which are quite similar when preceded with those same syllables. The contested mark will have 'SCENT' given its everyday pronunciation at the beginning which has no counterpart in the earlier mark. On this basis, the marks are aurally similar to between a medium and high degree.

52. 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.

53. The word "SCENT" at the beginning of the applicant's mark is an ordinary dictionary word which the average consumer will recognise as meaning a smell (usually pleasant). This meaning is likely to be reinforced by the perfume bottle and flower elements. The opponent submits that the 'SCENT' element is descriptive in relation to the class 3 goods however, when assessing the conceptual similarity of two marks, this is usually done without reference to the goods in question.² This additional word creates a conceptual distinction. When comparing the dominant and distinctive elements, the marks are conceptually neutral. When considering the marks as a whole (i.e. inclusive of the extra word and device element of the contested mark), those additional elements make the marks conceptually dissimilar.

² Mr Philip Johnson, sitting as 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

54. 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).”

55. 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.

56. I note that at paragraph 5.2 of their written submissions in lieu, the opponent states that they do not rely upon enhanced distinctiveness through use and they have not provided any evidence in relation to it. I therefore only have the inherent position to

consider. As I have found above, the earlier mark is likely to be viewed by the average consumer as an invented term with no particular meaning and no relation to the goods registered. Therefore, the opponent's mark is inherently distinctive to a high degree.

Likelihood of Confusion

57. 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.

58. 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 medium 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 "SCENT" and the device, as a whole, the marks are conceptually dissimilar.

- I have identified the average consumer as the general public (not discounting professionals), 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 medium and a very high degree.

59. I note that the differences in concepts between the marks may counteract the visual and phonetic similarities between them and therefore, point in favour of the applicant.³ However, this is not always the case as found in *Nokia Oyj v OHIM, Case T-460/07*. By way of an example, Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Diramode S.A. v Richard Turnham and Linda Turnham* (BL O/566/19) overturned a decision that the conceptual differences between PIMKIE and PINKIE were sufficient to outweigh the visual and aural similarities between them, stating:

'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. I must therefore consider this on the facts before me. As explained above, the differences in concept lie in the elements of the applied for mark which play a lesser role in the overall impression. I do not believe that these different concepts would be enough, in this instance, to overcome the visual and aural similarities (bearing in mind the visual and aural purchasing processes). Further, I remind myself that the opponent's mark is likely to be viewed as an invented term and therefore, is inherently distinctive to a high degree and that the distinctive elements of the competing marks are conceptually neutral.

³ *Picasso Estate v OHIM, Case C-361/04 P* Paragraph 20

61. The distinctive elements of the marks share the letters 'ELYSI' with the endings being different (UM vs AN). These differences are likely to be overlooked. I have explained that 'SCENT' is descriptive of the applicant's goods and therefore, is a less distinctive element of the mark and, despite its position at the beginning of the mark, would also be overlooked. As the device features a perfume bottle and flowers/vines and therefore, also descriptive of the goods (with the floral element being allusive to scents/perfumes also), the same can be said in relation to it. Taking into account the identity and medium to high levels of similarity between the competing goods and due to the interdependency principles, I consider there could be direct confusion between the marks.

62. In case I am wrong in this finding, I will now go on to consider indirect confusion, which 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."

63. 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.

64. Given that the average consumer rarely has the chance to compare the marks side-by-side and are likely to encounter them in different settings at different times, I find that there is a likelihood of indirect confusion based on imperfect recollection. That is, they are likely to imperfectly recall the differences between the distinctive elements: ELYSIAN vs ELYSIUM, especially as they are likely to be viewed as invented terms and that the earlier mark is highly distinctive.

65. Additionally, the elements of the contested mark that have no counterpart in the earlier mark (i.e. ‘SCENT’ and the device) are descriptive/allusive of the goods applied for and therefore, I believe the average consumer will see the contested mark as an alternative mark being used by the same or economically linked undertakings or a rebranding effort especially due to the levels of similarity between the goods. It follows therefore, that I find there to be a likelihood of indirect confusion.

CONCLUSION

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

Class 3: Perfume; Perfumes; Perfumery and fragrances; Fragrances; Perfume oils; Oils for perfumes and scents; Cosmetics; Aromatics for perfumes; Skincare cosmetics; Amber [perfume]; Musk [perfumery]; Skin fresheners [cosmetics]; Liquid perfumes; Aromatics for fragrances; Moisturisers [cosmetics]; Perfumery products; Fragrance preparations; Body deodorants [perfumery]; Deodorants for personal use [perfumery]; Perfume water; Perfumery; Scents; Colognes; Body fragrances; Extracts of perfumes; Natural oils for perfumes; Cologne; Perfumed powder [for cosmetic use]; Cosmetics in the form of lotions; Extracts of flowers [perfumes]; Flowers (Extracts of -) [perfumes]; Extracts of flowers being perfumes; Cedarwood perfumery; Skin moisturizers used as cosmetics; Beauty lotions; Air fragrance preparations; Perfumeries; Scented body lotions; Feminine deodorant sprays; Perfumed

soaps; Vanilla perfumery; Synthetic perfumery; Scented body lotions and creams; Cosmetics and cosmetic preparations; Perfumed creams; Beauty care cosmetics; Scented soaps; Natural cosmetics.

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

Class 3: Perfume oils for the manufacture of cosmetic preparations; Fragrance emitting wicks for room fragrance; Room perfume sprays; Fragrance refills for non-electric room fragrance dispensers; Household fragrances; Air fragrance preparations; Room fragrances; Fragrance preparations; Fragrance for household purposes; Scented oils; Perfumes for cardboard.

COSTS

68. In these proceedings, the opponent 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.

| | |
|--|-------------------------|
| Official fee | £100 |
| Preparing the Notice of Opposition and Considering the counterstatement | £250 |
| Preparing submissions in lieu | £350 |
| Total | £700⁴ |

69. I therefore order SB FRAGRANCES LTD to pay ROJA PARFUMS HOLDINGS LIMITED the sum of £700. This sum should be paid within 21 days of the expiry of the

⁴ I have not made any award for the evidence provided by the applicant as it was limited in volume and made no assistance in the determination of the proceedings.

appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of November 2025

**L Nicholas
For the Registrar**