O/1138/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION DESIGNATING THE UK NO. 1748563

IN THE NAME OF SECHE ENVIRONNEMENT

TO REGISTER THE FOLLOWING TRADE MARK:

SPEICHIM

IN CLASSES 1, 35, 40 AND 42

AND

AN OPPOSITION THERETO UNDER NUMBER 444704

BY

SIPCHEM INNOVENT SA

Background and pleadings

1. SECHE ENVIRONNEMENT ("the applicant") applied to protect the International Registration ("IR") as shown on the front cover of this decision in the UK on 17 May 2023 (application number: WO0000001748563), claiming a priority date of 18 November 2022. The IR was accepted and published in the Trade Marks Journal on 15 September 2023 (European Union Intellectual Property Office ("EUIPO")) in respect of the following goods/services:

> Class 1 - Chemicals for the pharmaceutical industries; chemicals for the veterinary industries; chemicals for the cosmetic industries; chemicals for the agri-food industries; chemicals for the treatment of waste; chemcial distillates; solvents for industrial use for manufacturing processes; chemicals for the petrochemical industries.
>
> Class 35 - Retail or wholesale services for chemicals; commercial intermediary services concerning chemicals.
>
> Class 40 – Chemical treatment of waste; reclamation of industrial waste through the implementation of chemical processes; services for the purification of chemicals; distillation services; regeneration of solvents; recycling of solvents; purification of solvents.
>
> Class 42 - Chemical engineering services, namely, engineering services relating to the design of industrial manufacturing processes for chemicals; technical evaluations concerning design (engineers' services); scientific research; technical research; conducting of technical project studies.

2. On 15 December 2023, SIPCHEM Innovent SA[1] ("the opponent") opposed the IR on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK Trade Mark, SIPCHEM (UKTM No: UK00801470136). The following goods and services are relied upon in this opposition:

[1] At the time that proceedings were commenced, the opponent was SIPCHEM EUROPE SA. The trade mark was subsequently re-assigned to SIPCHEM Innovent SA and an amended TM7 was filed dated 16 December 2024.

Class 1 - Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics.

Class 35 - Retail and wholesale services.

3. The opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods/services are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the IR should be refused registration.

4. The applicant filed a counterstatement denying the claims made and submitting as follows:

"2. It is admitted that the Applicant's goods and services in Classes 1 and 35 are identical or similar to the Opponent's goods and services in Classes 1 and 35.

3. It is denied that the Applicant's services in Classes 40 and 42 are similar to the Opponent's Class 1 goods, as claimed by the Opponent. The Opponent is put to proof of its claim. Goods are, by their very nature, different to services. In the present case, some of the Applicant's services involve chemicals but that does not of itself make them similar to chemicals. A manufacturer of chemical products would not typically be involved in, for example, the provision of chemical treatment services or chemical engineering services. The differences are even more pronounced when it comes to the Applicant's "technical evaluations concerning design (engineers' services)' scientific research; technical research; conducting of technical project studies" in Class 42. Such services have no obvious connection to the Opponent's chemicals and unprocessed resins/plastics.

4. For completeness it is also denied that the Applicant's services in Classes 40 and 42 are similar in any way to the Opponent's Class 35 services.

5. It is denied that the Applicant's mark, SPEICHIN, is confusingly similar to the Opponent's mark, SIPCHEM. Whilst it is acknowledged that the marks are

similar in length and all of the letters of the Opponent's mark also feature in the Applicant's mark, the differences between the marks are immediately noticeable, such that there is no likelihood of confusion. This is particularly the case when accounting for the fact that the relevant public will pay a high level of attention during the purchasing process. Neither the Opponent's nor the Applicant's goods and services are every day products. The relevant public will be both observant and careful."

5. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. The mark had not been registered for five years as at the priority date of application for the IR and so, in accordance with section 6A of the Act, it is not subject to proof of use; the opponent may rely upon all the goods/services of its registration as claimed.

Representation

6. The opponent is represented by Vault IP Limited, and the applicant is represented by Dehns. Only the opponent filed evidence but both parties filed written submissions during the evidence rounds. A hearing was not requested, but both sides filed written submissions in lieu of a hearing which will not be summarised but will be referred to as and where appropriate during this decision. 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 submissions

8. The opponent has filed evidence in the form of a witness statement dated 20 December 2025 of Eric Bouchardy who is the General Manager of SIPCHEM InnoVent

SA, a position that he has held since 14 July 2023. The statement is accompanied by seven exhibits. Mr Bouchardy does not expressly set out the purpose of his evidence, however, he provides background information relating to the opponent's company, details of the work that the opponent does within its industry, as well as setting out its regulatory obligations. Mr Bouchardy also sets out information about other companies within the chemical industry who are involved in the manufacture of chemicals, as well as the provision of associated services.

9. The opponent also filed written submissions in support of their opposition dated 24 December 2024.

10. The applicant has filed written submissions during the evidence rounds dated 24 February 2025.

11. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions as appropriate within my decision.

Preliminary issues

12. Insofar as the opponent's witness evidence of Mr Bouchardy, most of the information provided within his statement relates to the work that the opponent does within its industry and other companies it works alongside. I note that much of the evidence appears to relate to numerous other companies operating in the relevant industry, who are not the owner of the earlier mark, and many of whom appear from the evidence to trade outside of the UK. The evidence does not go to claiming an enhanced distinctive character. I also note that much of the evidence is undated.

13. Given the above, I am not entirely clear as to the purpose of Mr Bouchardy's evidence as it does not appear to provide evidence to go towards a comparison between the respective goods/services. The evidential burden in these proceedings is on the opponent to demonstrate that there is similarity between the goods and services at issue[2]. Regarding the mark in use, the claim under section 5(2)(b) and the assessment as to a likelihood of confusion is one to be taken on a notional and fair

[2] *Commercy AG v OHIM* Case T-316/07

basis in relation to the marks as registered/applied for and not in fact how they are being used in the marketplace. The commercial use of the opponent's mark may have relevance to a claim for damages under other grounds, but such a claim is not being relied on in these proceedings. When assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark might be used if it were registered[3]. My assessment under that ground must take into account only the IR, its specification, and any potential conflict with the earlier marks. I do not consider that the opponent's witness statement assists me in my assessment of this matter and therefore I will not consider this any further.

Decision

Section 5(2)(b)

14. Section 5(2)(b) of the Act is as follows:

> "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".

15. Section 5A of the Act states as follows:

> "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."

Relevant law

16. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon*

[3] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C-533/06, paragraph 66

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 C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. The competing goods/services are shown in the table below:

The IR	**The earlier mark**
Class 1 - Chemicals for the pharmaceutical industries; chemicals for the veterinary industries; chemicals for the cosmetic industries; chemicals for the agri-food industries; chemicals for the treatment of waste; chemcial distillates; solvents for industrial use for manufacturing processes; chemicals for the petrochemical industries.	Class 1 - Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics
Class 35 - Retail or wholesale services for chemicals; commercial intermediary services concerning chemicals.	Class 35 - Retail and wholesale services

Class 40 – Chemical treatment of waste; reclamation of industrial waste through the implementation of chemical processes; services for the purification of chemicals; distillation services; regeneration of solvents; recycling of solvents; purification of solvents.	
Class 42 - Chemical engineering services, namely, engineering services relating to the design of industrial manufacturing processes for chemicals; technical evaluations concerning design (engineers' services); scientific research; technical research; conducting of technical project studies.	

18. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

> "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 *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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."

21. 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/services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the GC stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

> may think that the responsibility for those goods lies with the same undertaking."

22. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> ".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

23. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly,

general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

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

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

25. I bear in mind that it is permissible to group goods/services together for the purposes of the assessment[4].

26. Within their counterstatement, the applicant submits:

> "2. It is admitted that the Applicant's goods and services in Classes 1 and 35 are identical or similar to the Opponent's goods and services in Classes 1 and 35".

The applicant denies any similarity between their services in classes 40 and 42 and the opponent's goods/services.

[4] *Separode Trade Mark* O/399/10

Class 1

Chemicals for the pharmaceutical industries; chemicals for the veterinary industries; chemicals for the cosmetic industries; chemicals for the agri-food industries; chemicals for the treatment of waste; chemicals for the petrochemical industries.

27. The opponent's specification includes the term, *chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry*. I consider this to be a broad term which would encompass the terms within Class 1 of the applicant's specification, above, and therefore is identical on the principles outlined in *Meric*.

Chemical distillates; Solvents for industrial use for manufacturing processes;

28. The applicant's above terms relate to distilled chemicals and solvents for industrial use. I would consider that both the applicant's terms refer to types of chemicals which could be used in a number of different ways, including in industry. The opponent's specification includes the term *chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry* in Class 1, which I would consider to encompass the applicant's above terms and therefore to be identical on the principles outlined in *Meric*. If I am wrong about that, I consider that there may be an overlap in the nature and purpose of the goods and that the uses of the same may overlap. As such, there will be an overlap in users and trade channels. There may be competition between the goods. I do not find complementarity. I find these goods to be similar to a high degree.

Class 35

Retail or wholesale services for chemicals;

29. The opponent's specification includes the term *retail and wholesale services* in Class 35, which is a wider term than the opponent's and encompasses the same. It is therefore identical on the principles outlined in *Meric*.

Commercial intermediary services concerning chemicals.

30. I understand a commercial intermediary to be an entity that acts as a broker between buyers and sellers in commercial transactions. In this instance, those transactions relate to chemicals. The opponent's specification includes the term *retail and wholesale services* in Class 35. A wholesaler or distributor can be considered a commercial intermediary, and as the opponent's specification includes wholesale services, I find that the opponent's specification would encompass the applicant's term and thus be identical on the principles outlined in *Meric*.

Class 40

31. The opponent submits as follows:

> "The earlier mark has been registered for "Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics" in Class 1.
>
> "Chemical treatment of waste; reclamation of industrial waste through the implementation of chemical processes; services for the purification of chemicals" as claimed in the Opposed Application, would all involve the use of industrial chemicals. Furthermore, chemical treatment of waste products, would include recycling and regeneration services, which produces new chemical products. For example, the Applicant is involved in the regeneration of solvents, with the end result being regenerated solvent products for reuse. The services "Chemical treatment of waste; reclamation of industrial waste through the implementation of chemical processes; services for the purification of chemicals" are therefore, confusingly similar and complimentary to "chemicals used in industry".
>
> "Distillation" is a chemical process where a mixture made of two or more liquids, with different boiling points, can be separated from each other. This can include processes such as extracting petrol and diesel from crude oil. "Distillation services" can, therefore, be used in the production of chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry. "Distillation services" claimed in the Opposed Application are, therefore, complimentary to "chemicals used in industry, science, photography,

as well as in agriculture, horticulture and forestry" in the Earlier Mark. The respective goods/services are, therefore, confusingly similar.

"Regeneration of solvents; recycling of solvents" are a form of waste reduction, which involves the taking of exhausted solvents and transforming them into new/clean solvents for reuse. The regenerated/recycled solvents have the same properties as virgin solvents. Regeneration/recycling of solvents is, therefore, a process for manufacturing solvents. "Solvents" are chemicals which can be used in a multitude of industries such as the cosmetic, perfumery, automotive and pharmaceutical industries and the end product of the regeneration process is a chemical product. Whilst the Applicant may be carrying out a service on behalf of their customers, this involves either handing back the regenerated/recycled solvents to the client after the regeneration process has occurred or taking ownership of the product for sale to 3rd parties. Either way, the process of regenerating/recycling involves the manufacture of a chemical product which is sold, or returned to the original owner. The process of recycling/regenerating solvents is, therefore, confusingly similar to "Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry" claimed in the Earlier Mark, since the process results in the production of such chemicals. Furthermore, "Retail and wholesale services" claimed in the Earlier Mark, would include retail services in the field of solvents and are, therefore, confusingly similar to "Regeneration of solvents; recycling of solvents".

"Purification of solvents" - as with the above, the process of purifying a solvent, results in the manufacture of a chemical product and as such, these services are confusingly similar to "Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry" and "Retail and wholesale services" in relation to such products, as claimed in the Earlier Mark."

32. The applicant submits as follows:

"11. As stated in Paragraph 3 of the Counterstatement, it is denied that the Holder's services in Class 40 are similar to the Opponent's Class 1 goods:

(i) Throughout the Opponent's Submissions, it is asserted that the respective Class 40 services and Class 1 goods are "confusingly similar" on the basis that the rendering of the former produces the latter. The Opponent has not provided any cogent evidence to substantiate this claim, as illustrated by the Holder's Submissions addressing the Opponent's Evidence. In any event, a fleeting relationship of this kind is not a valid basis for concluding that the respective goods and services are similar in a trade mark sense. The correct assessment must consider the relevant legal factors, as has been well-established in the Canon and Treat cases.

(ii) The Holder's Class 40 services concern the treatment and recovery of industrial waste and chemicals, including chemical waste processing, purification, distillation, and the regeneration and recycling of solvents. Compared to the Opponent's chemicals, and unprocessed resins and plastics in Class 1, these services self-evidently differ in their nature, intended purpose, and method of use. These goods and services are also not in competition.

(iii) It is denied that the Opponent's Class 1 goods and the Holder's Class 40 services originate from common undertakings, or are provided through shared distribution channels. It is submitted that the Opponent has not discharged its burden of proving that such a relationship exists between the relevant goods and services in the UK marketplace, for the reasons stated in the Holder's Submissions.

(iv) It is also denied that a complementary relationship exists between the Holder's Class 40 services and the Opponent's Class 1 goods. As established by the EU General Court in Boston Scientific Ltd v OHIM ([2008] T-325/06), "complementarity" means that "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" (emphasis added).

(v) It is not sufficient for a finding of complementarity that the goods and services at issue may be used together. This issue was considered in the decision of Mr Daniel Alexander QC (as he then was), sitting as the Appointed

Person in Sandra Amelia Mary Elliot v LRC Holdings Limited ([2013] BL O/255/13). In that case, the Appointed Person acknowledged that wine glasses are "almost always used with wine", but held that this does not mean wine and glassware are similar for trade mark purposes. He further clarified that *"it is neither necessary nor sufficient for a finding of similarity that the goods [or services] in question must be used together or that they are sold together"*."

Chemical treatment of waste; reclamation of industrial waste through the implementation of chemical processes;

33. Both of the applicant's above terms relate to the use of chemical treatments/processes of waste and reclamation of waste. The opponent's specification in Class 1 includes the term, *chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry*, which I find to be a broad term. I note that the opponent has made submissions as to how the applicant will use their terms within their business, however, for the purposes of this comparison it is necessary for me to confine the terms used to the substance or core of their possible meanings[5]. The nature and method of use of the goods/services in this instance will differ, as the opponent's specification includes *chemicals used in industry* in the form of goods, whereas the applicant's specification in Class 42 is in relation to services for the treatment and reclamation of waste through chemical processes. The purpose of the goods/services will also differ as a result of this, as will their nature. There may be an overlap in trade channels. I do not consider that the goods/services are competitive. In respect of complementarity, I note the comments of Ms Emma Himsworth AP in *Everest Dairies Limited*[6], where she stated, "the question of whether goods are 'complementary' is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience." In this instance, I consider that the average consumer is likely to consider that any chemicals used in industry may be manufactured by a company who provides the services for which the chemical will be used, and therefore there is a close connection between them such that there may be complementarity. I find the goods/services to be similar to a low degree.

[5] *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36
[6] [23] O/0107/23

Services for the purification of chemicals; distillation services; regeneration of solvents; recycling of solvents; purification of solvents.

34. The above terms all relate to services involved in the breaking down, purifying and regenerating of solvents and chemicals. The opponent's specification in Class 1 includes the term, *chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry.* The opponent states that "the process of regenerating/recycling involves the manufacture of a chemical product which is sold or returned to the original owner". The nature and method of use of the goods/services may differ for the same reasons as given above. The purpose of the goods/services will also likely differ. There may be an overlap in trade channels. I do not consider that the goods/services are competitive. I do find complementarity. I find the goods/services to be similar to a low degree.

Class 42

35. The opponent submits as follows:

> "The chemical industry is a highly regulated industry and there are many rules and regulations surrounding the production of chemicals and the manufacture of goods using those chemicals. As indicated in the Witness Statement of Eric Bouchardy, there are laws, regulations and directives concerning the management of waste and recycling, which imposes obligations on companies to recycle products, and manufacturers of chemical products can no longer simply product [SIC] products. They are, therefore, involved in the recycling, upcycling and downcycling of their products, which has resulted in companies investing in chemical treatment processes along with associated research and developmental services."

And further:

> ""Chemical engineering services, namely, engineering services relating to the design of industrial manufacturing processes for chemicals" – the manufacture of "Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics"

involves industrial manufacturing processes and it is feasible that consumers would see a link between the manufacture of chemicals and any associated engineering/design services relating to manufacturing processes.

The broad services “Technical evaluations concerning design (engineers' services); scientific research; technical research; conducting of technical project studies” would cover services in the field of chemical manufacturing and regeneration and is clearly the field of interest to the Applicant. As such, they are associated or complimentary to chemical products and these services are confusingly similar to “Chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics” as claimed in the Earlier Mark.”

36. The applicant submits as follows:

“It is also denied that the Holder’s Class 42 services are similar to the Opponent’s Class 1 goods.

(i) As in the case of the Holder’s Class 40 services, the Opponent has not provided persuasive evidence to show that the Class 42 services at issue are similar to the Opponent’s Class 1 goods.

(ii) The Class 42 services concern chemical engineering services for the design of industrial manufacturing processes for chemicals, technical evaluations, scientific and technical research, and the conducting of technical project studies. There is no self-evident similarity between these services and the Opponent’s Class 1 goods, as they differ significantly in their nature, intended purpose, and method of use. These goods and services also do not compete in the marketplace, as they do not serve as alternatives for one another.

(iii) With reference to the case law references outlined in Paragraphs 11(iv) and (v) of these submissions, there is no evidence that the relevant public would perceive a common undertaking as being responsible for providing both the Opponent’s Class 1 goods and the Holder’s Class 42 services. Therefore, there cannot be a complementary relationship between these goods and services.

(iv) It is noted that the Opponent's submissions refer to the activities of the Holder, including the fact that the Designation includes both Class 1 goods and Class 42 services. The Opponent suggests that this implies some similarity between the respective goods and services. However, it is respectfully submitted that this argument is flawed. As held in *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), "the trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer". The mere inclusion of Class 1 goods and Class 42 services in the same Designation cannot be said to result in a presumption of similarity in the eyes of the relevant public, who assess the position in the marketplace rather than that on trade mark registers".

Chemical engineering services, namely, engineering services relating to the design of industrial manufacturing processes for chemicals; technical evaluations concerning design (engineers' services);

37. Both of the applicant's above terms relate to engineering services, and whilst the latter term is broadly drafted, I consider that both terms do/could include services within the chemical industry. Chemical engineering involves the production and manufacturing of products through chemical processes. The opponent's specification includes *chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry* in Class 1. The goods/services may overlap as the chemical goods in the opponent's specification may be used in the production and manufacturing services offered by the opponent. Therefore, users may overlap, although the method of use will differ. In respect of trade channels, whilst I appreciate that the goods/services may relate to similar (or the same) sectors, I have nothing before me to suggest that the producer of the opponent's goods would also provide the above services. For example, it does not necessarily follow that just because an undertaking is responsible for producing chemicals which are used in industry, that it also offers the chemical engineering services themselves. The opponent submits that the applicant's above terms "would cover services in the field of chemical manufacturing and regeneration and is clearly the field of interest to the Applicant". However, in my assessment I must confine the terms used to the substance or core of their possible meaning and I find that the core purpose of the goods and services

differ. I do not find competition and neither do I find complementarity. Taking all of this into account, I find the goods/services to be similar to a low degree.

Scientific research; technical research; conducting of technical project studies.

38. The above relate to services involved in scientific and technical research and technical project studies. The opponent's specification includes *chemicals used in industry, science, photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics* in Class 1 and *retail and wholesale services* in Class 35. It may be that the opponent's terms would involve research in relation to chemicals used in science, and in this instance, there would be an overlap in uses and users. The nature of the goods/services and method of use will differ, as will the purpose of the goods/services. Further, while the above services may be reserved for use in relation to scientific and technical research, I have nothing to suggest that they are provided by the same undertakings as those that provide the opponent's goods/services. As a result, these services are similar to a low degree.

Average consumer and the purchasing act

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which the goods/services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

40. The opponent submits:

"Chemical products are used to produce products for most industry sectors worldwide. Products manufactured with chemicals are purchased by all. However, raw materials are unlikely to be purchased by the general public and the average consumer is likely to be a professional or business in the manufacturing sector who will have some knowledge of the chemical industry. In fact, the largest consumer in the chemical industry is the chemical industry itself. As such, the average purchaser is likely to have sufficient knowledge of the industry to appreciate that the chemical products and chemical services are complimentary to one another and can be provided by the same undertaking".

41. The applicant submits that:

"14. The average consumer of the Class 1 goods at issue will be a member of the professional public, including industry specialists, manufacturers, and procurement professionals operating in the pharmaceutical, veterinary, cosmetic, agri-food, petrochemical, and waste treatment sectors. These consumers will pay a high level of attention during the purchasing process, carefully evaluating factors such as the chemical composition, quality, and suitability of the goods to ensure that they meet their specific requirements. They will also consider regulatory compliance, ensuring the goods adhere to industry standards. Additionally, factors such as cost, supplier reliability, and environmental impact will play a role in their decision-making.

15. In support, we would refer to the decision of the UKIPO Hearing Officer in *Corning Incorporated v Oriental Yeast Co., Ltd.* ([2024] O/1035/24). In that case, it was held that 'Chemical test reagents for cell and microbiological research use, other than for medical and veterinary purposes' in Class 1 (which are encompassed by the Holder's 'Chemicals for the pharmaceutical industries') are "specialist goods for use in a specialist field", with the relevant public paying a "high level of attention" when selecting such goods, considering various factors such as cost, ingredients/formulations, and whether the goods meet the specific needs of the research being conducted. We would also refer to the decision of the EU General Court in Evonik Oil Additives GmbH v OHIM ([2014] T-138/13), in which the Court upheld the Fifth Board of Appeal's findings that Class 1 goods including 'Chemicals for industry and science' are "aimed at

a professional public" and thus the level of attention for the relevant public of such goods is high.

16. The Holder's Class 1 goods are the subject of its Class 35 retail, wholesale, and commercial intermediary services. Accordingly, the Holder's Class 35 services will be directed at the same relevant public as its Class 1 goods. For the reasons outlined in Paragraphs 14 and 15 of these" submissions, these goods command a high level of attention during the purchasing process. It follows that the relevant public for the Class 35 services for these same goods will also be highly attentive.

17. The Holder's Class 40 services are aimed at a professional public, including businesses and professionals in industries that generate or process waste, such as industrial manufacturers. In view of the specialised and regulatory-sensitive nature of these services, the relevant public will exercise a high degree of attention and care when selecting a provider. They will assess factors such as the provider's technical capabilities, compliance with environmental regulations, operational efficiency, and cost-effectiveness.

18. The Holder's Class 42 services are also directed towards a professional public, comprising professionals and businesses involved in the development and production of industrial manufacturing processes, as well as those seeking specialist scientific and technical research services. The relevant public will pay a high degree of attention when sourcing these services, assessing factors such as the provider's level of technical expertise, compliance with industry regulations and environmental requirements, cost-effectiveness, and reliability.

42. I consider that the average consumer of the goods/services is likely to be a member of the professional public. I have no evidence before me regarding the cost or frequency of purchase of the goods/services. However, I agree with the applicant that a high level of attention would likely be paid during the purchasing process due to the specialist nature of the goods/services on offer. The opponent has stated that their goods/services are subject to regulation within their industry, and I consider that this supports the fact that a high level of attention would likely be paid, as the average consumer would want to ensure that any purchase conformed with regulation.

43. I consider that the goods/services are most likely to be selected following perusal of physical signage, whether it be on product containers/packaging or on a supplier's website/catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that discussions may be had with sales representatives prior to purchase.

Comparison of marks

44. 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 Court of Justice of the European Union 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."

45. It would be wrong, therefore, to dissect the trade marks artificially, 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.

46. The respective trade marks are shown below:

The IR	The earlier mark
SPEICHIM	**SIPCHEM**

47. The opponent submits:

"Visual Comparison

The marks contain a similar number of letters, with SIPCHEM containing 7 letters and SPEICHIM containing 8. The marks are, therefore, of a very similar length and the difference between the number of letters/length would go unnoticed. The two marks contain the identical first and last letters and almost the same letters in between, just in a slightly different order. Both marks also contain a 'CH' in a very similar position within the marks. The marks are, therefore, visually similar and when considering that consumers rarely get a chance to view marks side by side, thus relying on imperfect recollection, it is highly likely that confusion would occur.

Phonetic Comparison

Both marks contain 2 syllables 'SIP-CHEM' and 'SPEI-CHIM'. Given that the first syllable of both marks contains the same initial letter and are comprised of similar letters, when these elements are combined with the highly similar suffixes 'CHEM' and 'CHIM', there is a phonetic similarity between the marks. The Applicant has argued that 'CHEM' would be pronounced 'KEM', whereas 'CHIM' would be pronounced with a "ch" sound. However, whilst there are many words in the English language with the initial letters 'CH' which are pronounced with a 'ch' sound, there are many 'CH' words which are pronounced with an initial 'k/c' sound, such as chord, chemo, chasm, chaos, cham, chorus, choric, chromo. In fact, many chemical related words beginning with CH are pronounced with a 'c/k' sound rather than a 'ch sound, such as chemical, chemistry, chlorine, chromium, chemosynthesis, chlorate and chloroprene. The fact that the Applicant is involved in the chemical field means that the 'CHIM'

element could be pronounced as ‘KIM’. which is highly similar to the pronunciation of ‘CHEM. The marks could, therefore, respectively be pronounced as ‘SIP KEM’ and ‘SPY KIM’. Again, when considering the concept of imperfect recollection, confusion could arise.

Conceptual Comparison

Neither mark has any meaning in the English language, and they cannot be differentiated on a conceptual basis”.

48. The applicant submits:

“5. It is denied that the Applicant’s mark, SPEICHIM, is confusing similar to the Opponent’s mark, SIPCHEM. While it is acknowledged that the marks are similar in length and all of the letters of the Opponent’s mark also feature in the Applicant’s mark, the differences between the marks are immediately noticeable, such that there is no likelihood of confusion. This is particularly the case when accounting for the fact that the relevant public will pay a high level of attention during the purchasing process. Neither the Opponent’s nor the Applicant’s goods and services are everyday products. The relevant public will be both observant and careful.

6. To a native English speaker, the Opponent’s mark immediately breaks down into two distinct elements – SIP and CHEM. The first element has a very clear, unequivocal pronunciation. The second element immediately brings to mind ‘chemical’ or ‘chemistry’, something that will be recognised by the relevant public, and resulting in that element having a low level of distinctiveness in the context of the Opponent’s goods/services. The mark will be pronounced SIP-KEM. In contrast, the Applicant’s mark does not obviously break down and does not have an immediately obvious pronunciation, The most likely pronunciations are SPEE-CHIM or SPY-CHIM, both of which with a ‘ch’ sound. Overall, the parties’ marks are visually and phonetically dissimilar”.

Overall impression

49. The opponent's mark is a word only mark and consists of the word, SIPCHEM, which is presented in a plain typeface. There are no other elements to contribute to the overall impression of the mark which resides in the word itself. I consider that the word, SIPCHEM, as a whole will be understood to be a made-up word, however, the CHEM element of the mark will be understood as being an abbreviation of chemical/chemistry and due to the goods/services on offer, will be considered allusive of the goods/services.

50. The applicant's mark, SPEICHIM, is a word only mark which is presented in plain typeface. There are no other elements to contribute to the overall impression of the mark which resides in the word itself.

Visual impression

51. The opponent's mark comprises of a word made up of seven letters, whereas the applicant's mark is made up of eight letters, each mark beginning with the letter S and ending with the letter M. The applicant's mark shares six out of its eight letters with the opponent's mark; however, the letters appear in a different order in the middle, and this will act as a point of visual difference within the marks. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise which means that either mark is capable of being presented in any typeface. I consider that the respective marks are visually similar to a medium degree.

Aural impression

52. Aurally, the opponent's mark has two syllables and will be pronounced SIP-KEM. It is unclear as to how the applicant's mark will be pronounced, however, I consider that it will likely be pronounced as either SPY-CHIM or SPY-KIM. I do not agree with the opponent's submission that there is a phonetic similarity between the marks due to them sharing the same initial letter, and the marks being comprised of similar letters. The GC have previously noted that the beginnings of a word tend to have more impact than the ends[7], and in this case, I find the beginning of each mark to be aurally

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

different, despite sharing the same first letter. I therefore find the marks aurally similar to between a low and medium degree.

Conceptual impression

53. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU[8].

54. Neither mark has an obvious meaning, however, as stated above, I consider that conceptually the opponent's mark, SIPCHEM, in its entirety will be understood to have no meaning, however the CHEM element of the mark may be seen as an abbreviation for the word chemical/chemistry, given the goods and services on offer, and will therefore be considered allusive. The applicant's mark will be perceived as an invented word that has no meaning. As such, the marks overall are conceptually neutral.

Distinctive character of the earlier trade mark

55. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

[8] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

56. 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/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has filed evidence in respect of this matter; however, this does not go to claiming an enhanced distinctive character and therefore I only have the inherent position to consider. In this instance, as acknowledged above, I consider SIPCHEM to a made-up word, although the CHEM element of the mark may be considered as allusive of the opponent's goods/services, as set out above. Consequently, I find that the earlier mark has a high degree of inherent distinctive character.

Conclusions on Likelihood of Confusion

57. 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/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

I remind myself that I made the following findings:

- The goods/services at issue range from being identical upon the principles outlined in *Meric* to similar to a low degree.

- I have identified that the average consumer will be professionals. They will select the goods/services primarily by visual means, although I do not discount an aural component;

- I have concluded that a high degree of attention will be paid during the purchasing process;

- The IR is visually similar to the earlier mark to a medium degree;

- The IR is aurally similar to the earlier mark to between a low and medium degree;

- I have found the IR and the earlier mark to be conceptually neutral or dissimilar;

- I have found the earlier mark as a whole to be inherently distinctive to a high degree;

58. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I do not consider that consumers would misremember or inaccurately recall which mark was which. Conceptually, both marks will be considered to be made-up words, although the CHEM element of the opponent's mark may be considered as allusive for the reasons set out above, however, even if the CHEM element is extracted from the mark, this will not assist as there is no corresponding element within the opponent's mark, and the first syllable of the marks differs. The marks are different lengths, and although the applicant's mark shares six of its eight letters with the opponent's mark, I consider that consumers - paying a high degree of attention - would notice the differences within the marks and that the letters appear in a different order. Whilst I accept that the applicant's mark may bring the opponent's mark to mind (but not the reverse), this in itself is insufficient for a finding of confusion and I consider that any similarity would be put down to coincidence by the average consumer.

Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods/services.

59. This leads me to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

60. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[9]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[10]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.

61. For indirect confusion to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods/services provided under one are regarded as a brand extension or sub brand of the other, for example.

62. In this instance, both marks share overlapping elements in the form of the majority of the same letters appearing within each mark, albeit in a different order. Both marks will be considered to be invented words. In my view, none of the categories set out in *LA Sugar* apply in this case and I can see no other basis upon which the average consumer would conclude that there is an economic connection between the marks. Sharing some of the letters within a mark but them appearing in a different order is not consistent with a sub-brand or brand extension. Taking all of the above into account, I do not consider that there exists a likelihood of indirect confusion between the marks, even when used on identical goods/services.

Conclusion

63. The opposition fails in its entirety. Therefore, subject to appeal, the application may proceed to registration for all goods/services.

Costs

64. The applicant has been successful and therefore, is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023 which governs costs in proceedings issued after 1 February 2023. In the

[9] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[10] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

circumstances, I award the applicant the sum of £1200.00 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Considering notice of opposition and preparing a counterstatement:	£250.00
Considering evidence of the opponent and commenting on the same	£600.00
Preparing written submissions	£350.00
TOTAL	**£1200.00**

65. I therefore order SIPCHEM Innovent SA to pay SECHE ENVIRONNEMENT the sum of £1200.00. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 4th day of December 2025

LA Bailey

For the Registrar