

O/0077/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001769865

IN THE NAME OF BLAUBERG CYPRUS LTD

TO REGISTER THE FOLLOWING TRADE MARK:

**BLAU**AIR

IN CLASS 11

AND

THE OPPOSITION THERETO UNDER NUMBER 448670

BY BLUEAIR AB

## Background and pleadings

1. BLAUBERG CYPRUS LTD is the holder of the International Registration (“the IR”) shown on the cover page. The IR was registered on 21 July 2023. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR. The holder seeks protections in the UK for the following goods:<sup>1</sup>

*Class 11: Ventilation [air-conditioning] installations and apparatus; air handling units; air handling units with heat recovery; air handling units with counterflow heat exchangers; air handling units with rotary heat exchangers; air humidifiers; fans (parts of air conditioning equipment); extractors for ventilation and air handling units; filters and dampers for ventilation and air handling units; all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.*

2. On 18 July 2024, Blueair AB (“the opponent”) opposed the trade mark based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK comparable trade mark:<sup>2</sup>



UK registration number: UK00906007009

Filing date: 15 June 2007

Registration date: 29 May 2008

Relying on all goods, namely:

*Class 10: Air mattresses and ergonomic pillows for medical purposes, hydrostatic beds and beds specially made for medical purposes; draw sheets and covers for specially made beds and mattresses, for medical*

---

<sup>1</sup> The holder originally sought protection for a wider range of goods in class 11 but this was limited on 7 August 2025. On this point, the Tribunal sought confirmation from the opponent as to whether the opposition was maintained against the limited specification, to which the opponent confirmed on 9 October 2025 that it was.

<sup>2</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original priority date.

*purposes; parts and fittings for the aforesaid goods, included in this class.*

*Class 11: Air purifying, air deodorising and air filtering apparatus and installations; filters for the aforesaid apparatus and equipment; filters (parts of household installations); water filtering, water treatment, water sterilising and water purifying apparatus; filters for drinking water; water purifying filters; parts and fittings for the aforesaid goods, included in this class.*

*Class 20: Mattresses, air mattresses, pillows, bedding (except linen), beds and hospital beds; parts and fittings for the aforesaid goods, included in this class.*

3. By virtue of its earlier filing date, the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act. As the opponent's mark had been registered for more than five years before the filing date of the IR, it is, in principle, subject to the use provisions set out in section 6A of the Act. In its pleadings, the opponent states that it has used the mark for all the registered goods.

4. The opponent claims that the respective goods are identical or similar and that the marks are highly similar. As such, the opponent submits there will be a likelihood of confusion between the marks, leading to a likelihood of association.

5. The IR holder filed a counterstatement in which they disagree that there is any similarity between the marks and the goods and therefore deny that there is any prospect of confusion. The IR holder requested the opponent to file proof of use for the opponent's earlier registration relied upon.

6. Both parties filed evidence. No hearing was requested and both parties filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

7. The opponent is represented by Baker & McKenzie LLP. The holder is represented by Vault IP Ltd.

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 opponent's evidence was filed in the form of a witness statement of Steve Beale dated 16 December 2024. Mr Beale is Trade Mark Counsel of Unilever PLC, the parent company of the opponent. The witness statement introduces fourteen exhibits labelled SB1 to SB14. The purpose of the evidence is to address the holder's request for the opponent to show proof of use for the opponent's mark.

10. The holder's evidence was filed in the form of a witness statement of Angelos Stylianou dated 14 February 2025. Mr Stylianou is the director of the holder. The witness statement introduces four exhibits labelled AS1 to AS4, which show the history of the IR holder's company, the goods for sale on the holder's website and brochures relating to products bearing the IR holder's mark. If such evidence was filed in order to prove honest concurrent use or lack of actual confusion, then it is of no assistance as the evidence does not meet the requirement. Considering there is no evidence shown of the opponent's mark, the evidence does not show coexistence of the marks in the marketplace without confusion. However, I note that, even if this were provided, an absence of evidence of confusion need not lead to a finding of no likelihood of confusion.<sup>3</sup> I will proceed to conduct a notional assessment of the marks and their goods and services as registered. I will therefore not address this evidence any further.

11. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

---

<sup>3</sup> *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

## **Decision**

### **Relevant period**

12. Section 6A of the Act states:

“(1) This Section applies where—

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

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

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

(3) The use conditions are met if –

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

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor),  
and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

13. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

14. While section 6A of the Act (cited above) is silent on the issue of IRs, the Trade Marks (International Registration) Order 2008 sets out that this section of the Act extends to apply to IRs. As such, the relevant period for the present assessment is the five-year period prior to the designation date of the IR, being 21 July 2023. The relevant period is, therefore, 22 July 2018 to 21 July 2023 (“the relevant period”). I note that the relevant territory will be considered the EU (including the UK) from 22 July 2018 to 31 December 2020, and the UK only from 1 January 2021 to 21 July 2023.

## **PROOF OF USE**

### **Relevant case law**

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the Act and *Ferrari* at [73]-[83]. The General Court (“GC”) has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. *Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional

evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24, Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. [...]

22. [...] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal [...] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

16. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

### **Genuine use**

17. In his witness statement, Mr Beale states that the evidence relates to the following goods:

*Class 11: Air purifying, air deodorising and air filtering apparatus and installations; filters for the aforesaid apparatus and equipment; filters (parts of*

*household installations); parts and fittings for the aforesaid goods, included in this class.*

18. It is not clear whether this statement is a concession that the mark has not been used for the goods that are not listed. However, for reasons that will come to light later, whether or not this is a concession will not affect the outcome of the decision.

19. Mr Beale states that the opponent was founded in 1996 and was acquired by Unilever in 2016. He further states that, in 2007, the Blueair ECO10 purifier was launched and became the most energy-efficient in the world, according to the US Environmental Protection Agency. Exhibit SB-1 includes a screenshot of the opponent's US website, which Mr Beale states redirects to the UK-dedicated website, although this is not shown. The website is undated so it is unclear if it was available during the relevant period. The exhibit also includes a screenshot of an article from the Unilever website about the 'Freedom to Breathe' campaign launched by the opponent, which was published on 17 December 2021 and therefore was available during the relevant period.

20. Mr Beale states that the opponent's mark has been used in a variety of colours, including a bright blue, a black and a white on blue background. Given that the mark is registered in a greyscale, I consider this use to be an acceptable variant use of the mark as filed.<sup>4</sup>

21. Mr Beale states that Blueair is a global leader in air purification and has heavily promoted its products in the UK. Exhibit SB-4 includes printouts from various third-party websites providing reviews or information about Blueair products. The first review is dated 10 September 2019 and is available on a UK website. The second and third screenshots are not dated. The second screenshot, although taken from a '.com' website, has a UK telephone number at the bottom so it is reasonable to conclude that this webpage was directed at UK consumers. The third screenshot is also from a '.com' website and refers to multiple regulatory bodies in the United States; however, it also includes a UK telephone number at the bottom of the webpage, so it is reasonable to conclude that this webpage was also directed at UK consumers.

---

<sup>4</sup> *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

22. Mr Beale states that products using the Blueair mark have received worldwide recognition and numerous accolades. Exhibit SB-5 includes press releases and news articles related to this. Exhibit SB-6 includes reviews for Blueair products. Some of the articles are undated or are dated outside of the relevant period. Those that are dated within the relevant period show portable air filters and purifiers bearing the opponent's mark.

23. Exhibit SB-7 includes screenshots of Blueair's Facebook, Instagram, LinkedIn and YouTube pages. Mr Beale states that all of the social media pages have followers or subscribers numbered in the thousands. While this is noted, this evidence is of no real assistance because the follower counts are not particularly high and, given the international nature of social media, it is possible that some of the followers are from outside the relevant territory for the present assessment. Additionally, the screenshots were taken outside of the relevant period and it is not possible to determine the follower counts during the relevant period.

24. Exhibit SB-8 includes screenshots of third-party websites selling Blueair products. The first screenshot is dated July 2020 and shows air purifying products and filters for said products bearing the Blueair mark. The retailer is UK-based and the products are priced in GBP. The remaining screenshots are undated or dated outside of the relevant period.

25. The first Exhibit SB-9 includes screenshots of the Wayback Machine showing the opponent's website on 1 December 2023, detailing retailers that stock goods bearing the opponent's mark. As I have set out above, the relevant period is 22 July 2018 to 21 July 2023, so this evidence is of little assistance.

26. The Blueair mark can be seen on the packaging of goods shown in Exhibit SB-10. This exhibit further includes a product brochure for various Blueair products. None of the documents in Exhibit SB-10 are dated so it is unclear whether they were available during the relevant period.

27. Exhibit SB-11 includes VAT returns in the name of Blueair AB for each three month period between 1 November 2020 and 31 October 2023. The first ten VAT returns show sales figures of between approximately £42,000 and £148,000 per three month period, between 1 November 2020 and 31 July 2023. I note that the final VAT return

shows sales figures of £331 for the period between 1 August 2023 and 31 October 2023; however, this period falls outside of the relevant period. This exhibit demonstrates reasonable sale figures during the relevant period. However, I note that the goods sold are not detailed so it is not possible to determine if they fall under the scope of the opponent's specification or if they bear the opponent's mark.

28. Exhibit SB-12 includes the opponent's UK sales report, which includes the date of the transaction, the item sold and the cost. The reports are dated between 2 January 2019 and 31 May 2024. I note that a number of the transactions fall outside of the relevant period, however, given that there are a large number of transactions within the relevant period, the exhibit still shows a high volume of sales during that time. Many of the product names include the Blueair mark. The products sold appear to relate to air purifying goods and filters for said air purifiers. These exhibits show hundreds of thousands of sales, which Mr Beale states are all related to products under the Blueair mark sold across the entire of the UK.

29. Exhibit SB-13 includes a screenshot of the opponent's website dated 20 October 2020. It shows products with the Blueair mark being sold. Exhibit SB-14 includes screenshots of business-focused pages of the opponent's website, which appears to allow businesses to buy products under the Blueair mark in bulk. These pages are undated.

30. The evidence is not without its limitations. For example, there is no information provided regarding the amount spent on marketing the goods in the UK, nor is there any reference to the size of the relevant market.

31. An assessment of genuine use is a global assessment, which includes looking at the evidence as a whole.<sup>5</sup> The evidence presented demonstrates that air purifying filters bearing the opponent's mark were sold across the UK during the relevant period. Taking all of the evidence into account, I am satisfied that the opponent has shown genuine use of its mark on air purifying and filtering apparatus.

---

<sup>5</sup> *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

32. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

33. While the opponent has proven that it has genuinely used its mark, the evidence is clear that it only shows use for air purifying and filtering apparatus, and filters for said apparatus. I am therefore satisfied that a fair specification for the earlier mark is as follows:

*Class 11: 'Air purifying and air filtering apparatus and installations; filters for the aforesaid apparatus and equipment'.*

34. I do not consider the opponent to have shown genuine use in relation to the following services:

*Class 10: Air mattresses and ergonomic pillows for medical purposes, hydrostatic beds and beds specially made for medical purposes; draw sheets and covers for specially made beds and mattresses, for medical purposes; parts and fittings for the aforesaid goods, included in this class.*

*Class 11: Air deodorising apparatus and installations; filters (parts of household installations); parts and fittings for the aforesaid goods, included in this class; water filtering, water treatment, water sterilising and water purifying apparatus; filters for drinking water; water purifying filters; parts and fittings for the aforesaid goods, included in this class.*

*Class 20: Mattresses, air mattresses, pillows, bedding (except linen), beds and hospital beds; parts and fittings for the aforesaid goods, included in this class.*

35. The opposition will proceed only on the fair specification I have determined for the earlier mark.

### **Section 5(2)(b)**

36. 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”.

37. 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.”

38. 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 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 the goods**

39. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

40. 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.

41. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 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.”

42. 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.”

43. Further, in *Kurt Hesse v OHIM*,<sup>6</sup> 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*,<sup>7</sup> the GC stated that “complementary” means:

“...there is 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.”

44. With this in mind, the goods for comparison are as follows:

<b>Opponent's goods:</b>	<b>The holder's goods:</b>
--------------------------	----------------------------

---

<sup>6</sup> Case C-50/15 P

<sup>7</sup> Case T-325/06

<p>Class 11: <i>Air purifying and air filtering apparatus and installations; filters for the aforesaid apparatus and equipment.</i></p>	<p>Class 11: <i>Ventilation [air-conditioning] installations and apparatus; air handling units; air handling units with heat recovery; air handling units with counterflow heat exchangers; air handling units with rotary heat exchangers; air humidifiers; fans (parts of air conditioning equipment); extractors for ventilation and air handling units; filters and dampers for ventilation and air handling units; all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.</i></p>
---	--

*Ventilation [air-conditioning] installations and apparatus;*

45. I do not consider that the opponent's 'air purifying and air filtering apparatus and installations' includes air conditioning apparatus. However, the nature of the goods overlaps as both goods cover large air-related installations. The purpose differs as the above goods typically cool or warm the air in a room while the opponent's goods purify or filter the air. Users and trade channels likely overlap. There is no competition or complementarity. Overall, I find the above goods to have a medium similarity to the opponent's 'air purifying and air filtering apparatus and installations'.

*Air handling units; air handling units with heat recovery; air handling units with counterflow heat exchangers; air handling units with rotary heat exchangers; all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.*

46. The above goods are all large installations and apparatus for the handling of air in a commercial building. I consider that the opponent's 'air purifying and air filtering apparatus and installations' overlap with the above goods. Although the opponent's

goods will likely include smaller apparatus for domestic or portable use, they may also include larger apparatus for commercial use. These goods are therefore considered identical according to the principles set out in *Meric*.

*Air humidifiers; all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.*

47. Although it is possible for an air humidifying apparatus to include other functions, such as filtering or purifying, I consider the above goods to relate to apparatus that emits water vapour into the air in order to increase the humidity in a room. I do not consider the opponent's 'air purifying and air filtering apparatus and installations' to include air humidifying apparatus. The purpose and nature of the goods differs. Users may overlap as consumers wanting to humidify the air in a commercial building may also wish to purify or filter the air. Trade channels overlap as it is likely that an entity selling air humidifiers to commercial consumers would also sell air purifying or filtering apparatus. There is no competition or complementarity between the goods. Overall, I find a low level of similarity between the above goods and the opponent's 'air purifying and air filtering apparatus and installations'.

*Fans (parts of air conditioning equipment); all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.*

48. As noted above, I do not consider the opponent's 'air purifying and air filtering apparatus and installations' to include air conditioning. The opponent's goods may include fans, so there may be a small overlap in nature but the purpose clearly differs. Trade channels and users may also overlap. There is no competition or complementarity. Overall, I find a low level of similarity between the above goods and the opponent's 'air purifying and air filtering apparatus and installations'.

*Filters and dampers for ventilation and air handling units; all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.*

49. The above goods fall under the scope of the opponent's 'filters for [air purifying and air filtering apparatus and installations]'.

50. *Extractors for ventilation and air handling units; all the aforementioned being large industrial products for physical installation into commercial buildings and none being domestic, portable or stand-alone units.*

51. The above goods are parts for air purifying and air filtering apparatus. The users, purpose and trade channels overlap. The nature of the goods differs. There is no competition. However, air purifying and filtering equipment requires extractors to function, and it is likely that a consumer would conclude that the apparatus and the parts would be sold by the same entity. There is therefore complementarity. Overall, I find a medium level of similarity between the above goods and the opponent's 'air purifying and air filtering apparatus and installations'.

### **Comparison of marks**

52. 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.”

53. 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.

54. The respective trade marks are shown below:

The opponent's earlier mark	The IR holder's contested mark
	

55. In its pleadings, the opponent states that the marks are highly similar, sharing five identical characters.

56. In its counterstatement, the holder disagrees that the marks are confusingly similar, noting that the opponent's mark would be viewed as "blue" being a colour and "air" relating to the goods, while the contested mark would be viewed as "Blau", being the first part of the holder's company name, and the descriptive element "air".

#### *Overall impression*

57. The opponent's mark is a figurative mark consisting of a circle with the letters "Blueair" next to it. The font used is not significant. The word plays a dominant role, with the circle element playing a smaller role. The consumer would see the mark as the conjoining of two words: "blue" and "air". The word "air" will have a smaller impact than the word "blue" because "air" is descriptive of the goods at issue.

58. The IR is a figurative mark consisting of the letters "BLAUAIR", with "BLAU" being in a darker colour and a different font than "AIR", resulting in the two elements appearing to be separate words. The darker "BLAU" element stands out slightly, but I consider that both terms play a dominant role in the mark. As above, the element "air" will have a smaller impact than the element "BLAU" because "air" is descriptive of the goods at issue.

#### *Visual comparison*

59. The visual similarity between the marks resides in the first two letters B and L, and the final letters "AIR" at the end of both marks. The earlier mark further contains a circle element and the middle letters U and E, while the IR further contains the middle

letters A and U. The fonts used also differ, and the earlier mark has the first letter in an uppercase font and the remaining letters in a lowercase font, while the contested mark is entirely in an uppercase font.

60. Although the letter differences between the marks are in the middle of the word elements, they are significant, especially given the overall impressions of both marks. Additionally, the circle element in the earlier mark and the differences in font and capitalisation will not be overlooked. Overall, I consider that the marks are visually similar to just below a medium degree.

#### *Aural comparison*

61. The opponent's earlier mark consists of the word "Blueair". This word will be pronounced as the two dictionary words "blue" and "air". The circle element will have no effect on the aural nature of the mark.

62. The contested mark consists of the letters "BLAUAIR". This word will be pronounced as two syllables, with the first syllable rhyming with the word "plough" and the second element being pronounced as the dictionary word "air".

63. The first syllables of the marks differ and the beginnings of marks tend to have more aural impact.<sup>8</sup> However, the first part of the first syllable, and the second syllable are identical. Overall, I consider that the marks are aurally similar to a medium degree.

#### *Conceptual comparison*

64. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and the CJEU including *Ruiz Picasso v OHIM*.<sup>9</sup> The assessment must be made from the point of view of the average consumer.

65. As noted above, the opponent's mark will be viewed as the two dictionary words "blue" and "air". The word blue will be understood to relate to the colour and the word air will be understood to be descriptive or allusive of the goods. I do not consider the

---

<sup>8</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>9</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

term “blue air” to have an obvious meaning as a whole and in the context of the goods. The colour green is often associated with eco-friendly products but I am not aware of any similar connotations with the colour blue and there have been no submissions on this point. The circle element will have no effect on the conceptual nature of the mark.

66. In its counterstatement, the IR holder states that the consumer will view the contested mark as the word “Blau”, being the first part of the IR holder’s company name, Blauberg, joined with the descriptive element “air”. I accept the submission that the element “air” is descriptive or allusive of the goods. However, considering the mark would be viewed on a product, the average consumer would not be aware of the company name. In its submissions in lieu, the opponent states that “blau” is the German for blue. I do not consider that the average consumer would recognise this meaning. Given that “blau” is not an English dictionary word, I consider that the consumer will understand this to be a foreign or invented word with no apparent meaning. The mark as a whole will therefore be understood by the average consumer as an invented word with the descriptive word “air” alluding to the goods.

67. The marks overlap in concept with regard to the word “air”, however, considering this word is descriptive or allusive of the goods, it does not have a considerable impact on the overall similarity of the marks. The concepts of the terms “blue” and “blau” differ. Overall, I consider the marks to have a low conceptual similarity.

### **Average consumer and the purchasing act**

68. As the case law above indicates, it is necessary 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. 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.”

69. The goods at issue will be purchased by professionals for commercial use. These consumers will consider factors such as suitability, specification, quality and price. These consumers will pay a medium degree of attention during the purchasing process.

70. Some of the goods will also be purchased by the general public for domestic use. These consumers will consider factors such as size, quality and price. I consider that these consumers will pay a medium degree of attention during the purchasing process.

71. The goods at issue will primarily be purchased in a store (where they will be placed on shelves), online (where they will be viewed on webpages) or over the phone (after having viewed products in a catalogue). I consider that visual considerations will play a major role in the purchasing process, but I do not discount that guidance may be given by sales associates, so aural considerations play a small role.

### **Distinctive character of the opponent’s mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

74. In its submissions in lieu, the opponent submits that the earlier mark has an exceptionally high level of distinctiveness.

75. The earlier mark consists of a circle and the letters “Blueair”. As noted above, I consider that the average consumer would understand this mark as the two dictionary words ‘blue’ and ‘air’. The word ‘air’ is descriptive or allusive of the goods at issue. The word ‘blue’ is not allusive or descriptive of the goods. The font used for the letters is standard and I do not consider it to have an effect on the distinctiveness of the mark. The circle element before the letters does not significantly increase the distinctiveness of the mark. Overall, I consider the earlier mark to have a low level of inherent distinctiveness.

76. As the opponent has filed evidence of use of their marks, I will consider whether this evidence demonstrates enhanced distinctiveness of the marks. The VAT and sales reports provided alongside Mr Beale's witness statement show significant sales, which Mr Beale states are across the UK. The evidence also shows that the products are listed for sale across various third-party websites. However, no information is provided as to the marketing expenditure or the size of the relevant market. Additionally, there is no breakdown provided for the sales figures. Although I can conclude that the sales figures were at a relatively high level, the other evidence is not

sufficient to demonstrate that the opponent's mark benefits from an enhanced degree of distinctive character. The inherent position outlined above therefore applies.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

77. 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 (or services) and vice versa (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing act. 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

78. 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.

79. Earlier in this decision, I found that the goods to be either similar or identical. I found the marks to be visually similar to a just below medium degree, to be aurally similar to a medium degree, and to have a low conceptual similarity. I found the opponent's earlier mark to possess a low level of inherent distinctive character for the relevant goods. I identified two groups of average consumers, professionals and members of the general public, both paying a medium degree of attention. I found that the goods would be selected primarily by visual means, although I did not discount aural considerations.

80. As noted above, 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

81. Considering direct confusion, I note the similarities between the marks, being the initial two letters “BL” and the final three letters “AIR”. I also note the differences, being the third and fourth letters of the mark, which result in differing pronunciation and concept. I do not consider that these differences between the marks would go unnoticed by the average consumer, particularly considering that the common element, “air” is descriptive, resulting in consumers being more likely to recollect the “blau” and “blue” elements of the marks, which differ. I am satisfied that the average consumer would not directly mistake the parties’ marks for each other on the applied for goods. I therefore do not find there to be a likelihood of direct confusion between the parties’ marks for the IR holder’s goods.

82. I will proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, as James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16], “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”.

83. 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)."

84. Earlier I found that the earlier marks have a medium degree of distinctive character. I found the word 'air' to be descriptive or allusive of the goods in both marks, and I found that the word 'blue' would be understood by the average consumer, but the letters 'blau' would be assumed to be an invented word. Given that the common element "air" is descriptive, the average consumer would conclude that this is a coincidental use of a descriptive word by two different undertakings. The change from "blue" to "blau" would be noticed by the consumer and would not be considered consistent with a brand extension or sub-band. A consumer who is aware of the opponent's mark may note the use of the initial two letters "BL" in both marks; however, this is mere association and not indirect confusion.<sup>10</sup>

85. I therefore do not consider there to be a likelihood of indirect confusion, even when considered on goods that are identical.

### **Final Remarks**

86. The opposition has been unsuccessful and, subject to any successful appeal, the IR will proceed to be granted protection in the UK.

---

<sup>10</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

## **COSTS**

87. The holder has achieved success in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the holder the sum of £1200 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the TM7 and statement of grounds and preparing and filing the TM8 and counterstatement:	£250
Preparing evidence and considering on the other side's evidence:	£600
Filing submissions in lieu:	£350
<b>Total:</b>	<b>£1200</b>

88. I therefore order Blueair AB to pay BLAUBERG CYPRUS LTD the sum of £1200. 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 30<sup>th</sup> day of January 2026**

**K HARBACH**

**For the Registrar**