

**O-0092-26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3996128**

**IN THE NAME OF**

**SHENZHEN TCL NEW TECHNOLOGY CO., LTD.**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**BreezeIN**

**IN CLASS 11**

**AND**

**OPPOSITION THERETO (UNDER NO. 446889)**

**BY**

**SEELEY INTERNATIONAL PTY LTD**

## BACKGROUND

1) On 27 December 2023, SHENZHEN TCL NEW TECHNOLOGY CO., LTD. ('the applicant') applied to register the trade mark, 'BreezeIN', in the UK, in respect of the following goods:

**Class 11:** Air-conditioning installations; air-conditioning apparatus; fans [air-conditioning]; air purifying apparatus and machines; drying apparatus and installations; electric fans for personal use; humidifiers; dehumidifiers; air conditioners for vehicles; ventilation [air-conditioning] installations and apparatus.

2) The application was published in the Trade Marks Journal on 12 January 2024 and subsequently opposed by Seeley International Pty Ltd ('the opponent'). It is claimed that the trade mark application offends under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its grounds under sections 5(2)(b) & 5(3) of the Act, the opponent relies upon the trade mark registration shown below. Under section 5(2)(b) of the Act, only the goods in class 11 of the opponent's registration are relied upon. Under section 5(3) of the Act, the opponent relies upon all of the goods covered by its registration.

- **UKTM 3565920 (Series of 2 marks)**

The logo for BreezeIN, featuring the word 'Breeze' in a bold, sans-serif font, followed by 'IN' in a smaller, all-caps font. A stylized graphic of a fan or air flow is integrated into the 'I' and 'N'.The logo for BreezeIN, featuring the word 'Breeze' in a bold, sans-serif font, followed by 'IN' in a smaller, all-caps font. A stylized graphic of a fan or air flow is integrated into the 'I' and 'N'.

**Class 07:** Electric motors; pumps; water pumps; fans being parts of machines; parts and fittings for all the aforesaid.

**Class 09:** Electric and electronic control systems and apparatus for use with air conditioning equipment; temperature sensors and switches; electrical and electronic controllers for fans and pumps; speed controllers for motors and fans; electronic timers and thermostats for use with air conditioning equipment; remote control devices and wireless controllers for use with air conditioning equipment; touch screen controllers for use with air conditioning equipment; computer software for use in controlling air conditioning equipment; parts and fittings for all the aforesaid.

**Class 11:** Apparatus for heating, cooling, ventilating and air conditioning; air re-heaters and sterilisers; air filtration apparatus; evaporative air conditioning equipment; parts and fittings for the aforesaid, including fans, blowers, filters, controllers, drain and bleed valves, pumps, motors, air filter pads, water absorbent pads and chiller pads.

**Filing date:** 09 December 2020

**Date of entry in register:** 16 April 2021

4) It is claimed that the respective goods are identical or, at least, similar and that the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

5) Under section 5(3) of the Act, it is claimed that the earlier mark has a reputation in the UK in relation to all of the goods for which it is registered. It is said that use of the contested mark will result in the relevant public believing that there is an economic connection between the undertakings using the respective marks and that use of the contested mark will lead to unfair advantage being taken of the earlier mark and/or will cause detriment to the reputation and/or distinctive character of the earlier mark.

6) The trade mark relied upon by the opponent is an earlier mark, in accordance with section 6 of the Act. As the earlier mark had not been registered for five years or more at the filing date of the contested mark, it is not subject to the proof of use conditions, as per section 6A of the Act.

7) Under section 5(4)(a) of the Act, the opponent relies upon the use of two signs which are identical to those covered by its earlier registration, UKTM 3565920<sup>1</sup>. It is claimed that those signs have been used throughout the UK since 2013 in relation to the same goods as those covered by the opponent's earlier registered mark. It is claimed that the opponent has generated goodwill, of which each of the signs relied upon is distinctive, and that use of the contested mark will result in misrepresentation and damage to that goodwill.

8) The applicant filed a counterstatement denying all of the grounds of opposition.

9) The opponent is represented by Lewis Silkin LLP. The applicant is represented by Trademarkit LLP.

10) The opponent filed evidence which consists of a witness statement from Frederic Frank Seeley<sup>2</sup> with Exhibits FFS1-FFS7. That evidence was also accompanied by written submissions.<sup>3</sup> The applicant filed written submissions only during the evidence rounds.<sup>4</sup> Neither party requested a hearing nor filed written submissions in lieu. I now make this decision based upon all of the papers before me.

## **DECISION**

11) 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

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<sup>1</sup> I note that in paragraphs [4] and [18] of the 'Statement of Grounds' attached to the Form TM7, in its written submissions of 09 August 2024 and in the witness statement of Mr Seeley, the opponent refers to its 'unregistered mark' in word-only form as 'BREEZAIR'. However, the relevant part of the Form TM7 (Section C: Q1) only refers to the two stylised marks which are identical to those covered by the opponent's registered mark. That being so, and as there has been no request to amend the pleadings, I will proceed on the basis that only the latter (the two stylised marks) are relied upon under section 5(4)(a) and not the word-only mark.

<sup>2</sup> Dated 08 August 2024

<sup>3</sup> Dated 09 August 2024

<sup>4</sup> Dated 15 October 2024

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.

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

12) This section of the Act states:

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

(a)....

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

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

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.”

13) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **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**

14) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment that:

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

15) Guidance on this issue has also come from Jacob J, where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

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

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

17) In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found 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 was 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 Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“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.”

18) I also bear in mind that in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch) (*'YouView'*), 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."

19) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05), where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-

104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

20) The goods to be compared are:

Opponent’s goods	Applicant’s goods
<p><b>Class 11:</b> Apparatus for heating, cooling, ventilating and air conditioning; air re-heaters and sterilisers; air filtration apparatus; evaporative air conditioning equipment; parts and fittings for the aforesaid, including fans, blowers, filters, controllers, drain and bleed valves, pumps, motors, air filter pads, water absorbent pads and chiller pads.</p>	<p><b>Class 11:</b> Air-conditioning installations; air-conditioning apparatus; fans [air-conditioning]; air purifying apparatus and machines; drying apparatus and installations; electric fans for personal use; humidifiers; dehumidifiers; air conditioners for vehicles; ventilation [air-conditioning] installations and apparatus.</p>

Air-conditioning installations; air-conditioning apparatus; fans [air-conditioning]; electric fans for personal use; air conditioners for vehicles; ventilation [air-conditioning] installations and apparatus.

21) All of the goods listed above fall within the opponent’s ‘Apparatus for cooling and air conditioning’ and are therefore identical in accordance with *Meric*.

air purifying apparatus and machines

22) It seems to me that these goods of the applicant are identical to the opponent's 'air sterilisers' and/or 'air filtration apparatus'. If that is not right, I find that they are nevertheless highly similar given their similar intended purpose, nature, method of use, users, trade channels and that they may be in competition.

drying apparatus and installations

23) I find that these goods of the applicant are highly similar to, at least, the opponent's 'Apparatus for heating'. Although the precise purpose is not the same; one being for heating and the other for drying, the respective goods are likely to share users and trade channels. They may also have a similar method of use and there may be a complementary relationship in play. For example, drying apparatus may use heating apparatus to achieve the drying effect.

humidifiers; dehumidifiers.

24) I find that these goods of the applicant are highly similar to, at least, the opponent's 'Apparatus for air conditioning'. The respective goods are likely to share users and trade channels. They also have some overlap in purpose because both parties' goods are intended to improve air quality. Their respective method of use and nature may also be similar.

**Average consumer and the purchasing process**

25) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

26) The average consumer for the relevant goods includes the general public and businesses. The purchasing act will be primarily visual; all the goods being sought out by eye in catalogues or on Internet websites, for example. That is not to say, though, that the aural aspect should be ignored because the goods may sometimes be the subject of discussions, such as those with sales representatives. The cost of the goods is likely to vary. For example, an electric fan for personal use is likely to be inexpensive whereas an industrial air conditioning installation is likely to be considerably more expensive. I would expect the average consumer to take in to account various factors such as functionality and ease of use regardless of where the goods sit on the cost scale. I agree with the opponent that the level of attention paid during the purchase for the relevant goods is likely to vary from medium (average) to high.<sup>5</sup>

### **Comparison of marks**

27) 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.”

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<sup>5</sup> See the opponent’s written submissions, dated 09 August 2024, at paragraph 9.

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

28) The earlier registration covers two marks which are identical save for one is in colour and the other is not. I will make the comparison based upon the latter as the coloured version patently offers the opponent no greater prospect of success. The marks to be compared are, therefore, as shown in the table below.

Opponent's mark	Applicant's mark
 The image shows the word "Breeze" in a bold, sans-serif font, followed by "air" in a smaller, lighter font. The "air" is stylized with horizontal lines through it, suggesting motion or air.	BreezeIN

#### Overall impressions

29) Although the applicant's mark is likely to be instantly recognised as a conjoining of the two well-known words, 'Breeze' and 'In', neither of those words can be said to be more dominant or distinctive than other; I find that the overall impression of the applicant's mark lies in its totality. The opponent's mark is likely to be instantly recognised as a conjoining of the word 'Breez' (being an obvious misspelling of the well-known word, 'breeze') and the word 'air'. In the context of the relevant goods at issue, the 'Breez' part of the mark is marginally more distinctiveness than the word 'air' due to the misspelling of the former as compared with the conventional spelling of the latter. Nevertheless, and bearing in mind that the two words are combined, I do not consider that either word is more dominant than the other when the mark is viewed as

a whole. The overall impression of the opponent's mark is dominated by the word element, 'Breezair', with the stylisation of 'air', being reminiscent of air waves, playing a lesser role.

30) Visually, both marks include the same five letters, BREEZ, at the beginning. In this connection, I bear in mind, as the opponent points out, that consumers generally pay more attention to the beginning of marks. However, that is no more than a general rule of thumb rather than immutable rule; each case must be assessed on its own merits. In the case before me, the endings of the marks are visually very different, being 'air' in the opponent's mark as opposed to the three letters 'eIN' in the applicant's mark; that difference, although at the end of the marks, is striking on the eye. The particular stylisation used in the 'air' part of the opponent's mark (reminiscent of waves) is also not present anywhere in the applicant's mark nor is there is any similar stylisation. Viewing the marks overall, I find a medium degree of visual similarity between them.

31) Aurally, the opponent's mark will be pronounced in the same way as the two words, 'BREEZE AIR'; the applicant's mark will be pronounced as the two words, 'BREEZE IN'. Therefore, both marks consist of two syllables, the first of which is identical and the second of which is entirely different. I find there to be medium degree of aural similarity between the marks.

32) The concept that will immediately be perceived from the applicant's mark will be of a gentle wind entering into somewhere. The opponent's mark will immediately be perceived in the same way as the two words 'BREEZE AIR' given the very strong resemblance between the 'BREEZ' part of the mark and the well-known word 'Breeze' and that the consumer will immediately recognise the tail end of the mark as the word 'air'. The combination of those two words is grammatically unusual; they do not, to my mind, naturally and immediately combine to create a clear unitary concept. I find that the mark brings to mind the concept of a gentle wind together with the separate concept of air (the stylisation of 'air' is likely to be perceived as being reminiscent of air waves which merely reinforces the concept of air). To the extent that both marks send a message of a gentle wind there is therefore a good degree of conceptual similarity between them. However, I bear in mind that this concept has little, if any,

distinctiveness in relation to the relevant goods for obvious reasons i.e. the relevant goods may create a breeze or have a breeze-like effect.

### **Distinctive character of the earlier mark**

33) The distinctive character of the opponent's mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion between it and the contested mark (*Sabel BV v Puma AG*). 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).”

34) I have already explained that the opponent's mark will immediately be conceptualised in the same way as the two well-known words 'Breeze' and 'air'. Each of those concepts has little, if any, distinctiveness in relation to the relevant earlier

goods for obvious reasons. The misspelling of 'Breeze' as 'Breez' elevates the distinctiveness of that element to some degree. However, I still consider the level of distinctiveness of that element to be low notwithstanding the misspelling. Bearing in mind the stylisation of 'air' (reminiscent of air waves) and its combination with the word 'Breez', I find that the mark, as a whole, has a below-medium degree of distinctiveness.

35) I now turn to the question of whether the inherent distinctiveness of the opponent's mark has been enhanced through use. In this connection, it is necessary to consider the evidence from Mr Seeley. I summarise the most pertinent parts of his evidence below.

36) Mr Seeley is the founder and Chairman of F.F. Seeley Nominees Pty Ltd and Seeley International Pty Ltd. The latter is a wholly owned subsidiary of the former. Mr Seeley refers to these two companies collectively throughout his evidence as 'Seeley'.

37) Mr Seeley states that, since 1972, Seeley has grown to become Australia's largest air conditioning manufacturer and a global leader in the design and manufacture of cooling and heating solutions for the residential, commercial and industrial markets. It is said that Seeley currently exports its products to over 120 countries worldwide, including the UK and has an extensive network of distributors and retailers across the UK.

38) In the UK, the BREEZAIR direct evaporative model TNSI 580 won an award for 'Energy Efficient Product of the Year 2019' at the Energy Awards 2019 held in London, UK as well as the award for 'Energy Reduction Product for 2018' at the London Energy Management Awards 2018. The BREEZAIR SuperStealth and Supercool ranges were shortlisted as a finalist for 'Air Conditioning Product of the Year' at the ACR News Awards UK 2016.<sup>6</sup>

39) It is said that Seeley's products have had a reputation for being amongst the most reliable on the market and are market leaders in Australia, as well as in other countries around the world including the UK.

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<sup>6</sup> Exhibit FFS2

40) Mr Seeley states that BREEZAIR is a long-established brand of evaporative air conditioner. BREEZAIR branded products have been, and continue to be, exported to, distributed to, and/or sold in the UK since as early as 2007. An extract from the opponent's website at [www.seeleyinternational.com/eu](http://www.seeleyinternational.com/eu) is provided showing the current range of BREEZAIR products.<sup>7</sup> The exhibit shows a range of evaporative air coolers. The word-only mark, 'Breezair', is used to refer to the products throughout the extract. The following mark is also visible on one of the products which appears to be stylised in the same manner as the opponent's registered mark (with 'air' bearing the wave-like stylisation):



41) As of 15 October 2023, the opponent now uses a sole distributor as its UK national distributor for 'BREEZAIR' branded products. A copy of the media release announcing this appointment is provided.<sup>8</sup> The following mark, amongst others, is visible at the bottom of the release:



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<sup>7</sup> Exhibit FFS3

<sup>8</sup> Ibid.

There is also an extract from the website, [www.coolingpost.com/UK-news](http://www.coolingpost.com/UK-news), said to be the largest air conditioning news and refrigeration news website, announcing the appointment of the opponent's UK distributor. This is dated 8 November 2023.<sup>9</sup> The article states that 'Breezair evaporative coolers are designed to cool commercial and industrial spaces at a fraction of the cost of conventional AC systems'.

42) A document showing a range of 'BREEZAIR' products which are available in the UK is provided.<sup>10</sup> These are all described as evaporative coolers. The only date on this document is a copyright date of 2023. I reproduce below, part of one such product, bearing the earlier registered mark:



There is also a document described as a 'BREEZAIR reference book' which is said to be available on the opponent's website providing details about, amongst other things, 'Breezair installations all around the world', including the UK. It bears a copyright date of 2013. The following mark is present at the bottom of numerous pages therein:



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<sup>9</sup> Ibid.

<sup>10</sup> Exhibit FFS4

43) Mr Seeley provides copies of case studies conducted for UK customers of BREEZAIR branded products which he states are available to view on the opponent's website.<sup>11</sup> All of the products are evaporative air coolers.

44) A selection of prints from the Wayback Machine are provided<sup>12</sup> as follows: i) extracts of the website [www.seeleyinternational.com/uk](http://www.seeleyinternational.com/uk) from 2019 and 2021 showing use of the earlier registered mark in relation to evaporative air coolers, ii) extracts of the website [www.seeleyinternational.com/eu](http://www.seeleyinternational.com/eu) from 2016, 2017, 2018 and 2019 showing use of the earlier registered mark in relation to industrial/commercial evaporative coolers, iii) extracts of the website [www.breezair.org](http://www.breezair.org) from 2006 and 2007. There are no products on the pages from the latter website but the earlier registered mark is present at the top of the page. The words on the pages appear to be in the French language but there is a Union Jack flag at the bottom of the page amongst flags of other EU countries suggesting that the page was accessible to UK consumers, and iv) extracts of the website [www.seeleyeurope.com](http://www.seeleyeurope.com) from 2008, 2009, 2010 and 2011. No products are visible on these pages. However, under the heading 'Company Presentation' on each extract, it states that 'the BREEZAIR ICON SERIES comfort cooler can cool a whole (Australian) home for as little as the cost of running a light bulb'.

45) Mr Seeley provides the following table of Seeley's approximate annual sales for BREEZAIR branded products in the UK for the years 2007 to 2023:<sup>13</sup>

Year	Sales (£)
2007	13,751
2008	53,070
2009	59,475
2010	186,330
2011	114,816
2012	121,641
2013	152,518

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<sup>11</sup> Exhibit FFS5

<sup>12</sup> Exhibit FFS6

<sup>13</sup> Mr Seeley's witness statement, paragraph [26]

2014	123,531
2015	74,658
2016	60,254
2017	151,774
2018	178,394
2019	300,924
2020	131,703
2021	235,464
2022	101,074
2023	218,000

46) Mr Seeley states that Seeley is committed to the safety and effectiveness of the BREEZAIR products. He provides copies of CE certificates dated 2013, 2015, 2016, 2017 and 2019<sup>14</sup> for various BREEZAIR models, used to recognise product conformity in relation to manufactured goods placed on the UK market. All of the products are described as 'Breezair Evaporative Coolers'.

47) Having reviewed all of Mr Seeley's evidence, I find that it is not sufficient to show that the earlier mark enjoyed enhanced distinctiveness at the relevant date in the UK. Whilst the evidence shows that the opponent's products have won some awards in the UK, the most recent of these was four years prior to the filing date of the contested mark and it is not clear whether the relevant average consumer was aware of these awards at that date. Furthermore, I agree with the applicant that the annual UK sales figures appear to me to be modest (bearing in mind that the unit price of the goods sold by the opponent is unlikely to be inexpensive). There is also a complete absence of any expenditure figures relating to UK advertising/promotional spend such that I cannot tell how much has been spent on any such advertising/promotion in the UK. Finally, there is very limited promotional material before me showing exposure of the mark in the UK aside from use on the opponent's own websites and a single post on [www.coolingpost.com](http://www.coolingpost.com) just over one month before the relevant date. Therefore, I will proceed on the basis of the earlier mark's inherent degree of distinctiveness which is, as a whole, below-medium.

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<sup>14</sup> Exhibit FFS7

## Likelihood of confusion

48) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

49) On the matter of the degree of distinctiveness of the earlier mark as a whole and the degree of distinctiveness of the 'Breez' element within that mark<sup>15</sup>, it is also appropriate to bear in mind that in *L'Oréal SA v OHIM*, Case C-235/05 P ('L'Oréal') the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the

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<sup>15</sup> It is the distinctiveness of the common element which is of particular importance, as per *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, [38]-[39].

nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

50) However, I must also be mindful that in *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33. (*‘Whyte and Mackay’*), Mr Justice Arnold (as he then was) stated at [44] that:

“...what can be said with certainty is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

51) Further, in *Nicoventures Holdings Limited v The London Vape Company Limited* [2017] EWHC 3393, in [27] Mr Justice Birss (as he then was), having agreed with Arnold J’s statement of principle cited above, stated that:

“...If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive.”

In [31] he further stated that:

“The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.”

52) I will first consider the likelihood of direct confusion. The respective goods are identical or highly similar and the marks are visually and aurally similar to a medium

degree. However, although there is a good degree of conceptual similarity between the marks, the shared concept is one with little, if any, distinctiveness. I also bear in mind that the earlier mark, as a whole, has a below-medium degree of distinctiveness, and the 'Breez' element in the earlier mark (being the point of coincidence with the later mark) has a low degree of distinctiveness. Weighing all these factors, and whilst I bear in mind the principle of imperfect recollection, I find that there is no likelihood of direct confusion between the marks, on the part of an average consumer, whether paying a high or medium degree of attention.

53) I now turn to consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting 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)".

54) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

55) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

56) The similarity between the marks at issue stems from the common letters 'BREEZ'. It is that common element which gives rise to a medium degree of visual and aural similarity between the marks. However, the 'Breez' element of the earlier mark has a low degree of distinctiveness and, although the commonality of that element in both marks gives rise to a good degree of conceptual similarity between them, it is a concept with little, if any, distinctiveness. Bearing in mind the principle in *Whyte and Mackay*, this therefore points away from the consumer putting the similarities that exist between the opponent's mark and the applicant's mark down to the goods coming from the same/linked undertaking(s). Furthermore, a change of the respective words in the marks from 'Breezair' to 'Breezeln' does not strike me as a logical brand extension or the kind of change which one would expect to see in a sub-brand. This is because, firstly, the former contains a misspelling of 'Breeze'

which is not present in the later mark which does not seem consistent with a logical brand extension or sub-brand. Secondly, even allowing for the 'Breez' and 'Breeze' parts of the marks being imperfectly recalled as being the same, the applicant's mark results in a unitary concept of a gentle wind entering in to somewhere whereas the earlier mark contains two separate concepts of a breeze and the concept of air; this also does not seem consistent with a natural brand extension or sub-brand.

57) I therefore do not consider that the average consumer is likely to believe that the differences between the marks merely reflects a variation in the nature of the products or stems from marketing considerations denoting goods from the same/linked trader(s) as per the guidance in *L'Oréal*. Rather, I find that the average consumer is likely to put the common use of the letters 'BREEZ', and the resultant shared concept of a gentle wind (which has little, if any, distinctiveness) down to mere coincidence and nothing more. I make this finding in respect of all of the goods at issue even where there is identity between them. There is no likelihood of indirect confusion.

**58) The opposition under section 5(2)(b) of the Act fails.**

### **Section 5(3)**

59) Section 5(3) of the Act provides, as follows:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.” (my emphasis)

60) The relevant case law can be found in the following judgments of the CJEU: *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited*, 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L'Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future: *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair

advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: *L'Oréal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

## Reputation

61) The first hurdle that the opponent must overcome under section 5(3) of the Act is to show that its mark had a reputation in the UK on the filing date of the applicant mark. The relevant date in these proceedings is, therefore, **27 December 2023**. If the evidence does not establish the existence of such a reputation, the opponent's case must fail. This is because, without a qualifying reputation in the UK, there can be no link made in the consumer's mind between the respective marks and no unfair advantage taken of, or damage caused to, the earlier mark.

62) In *General Motors*, the CJEU gave guidance on what is required to establish the necessary reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

63) I have already summarised Mr Seeley's evidence of use earlier in this decision when I considered whether the distinctiveness of the earlier mark had been enhanced through use from the perspective of the average UK consumer; I found that it had not.

Bearing in mind my earlier comments in that regard I find that, although there have clearly been sales in the UK prior to the relevant date in relation to evaporative air coolers and the opponent has received some awards in the UK prior to the relevant date, there is insufficient evidence to satisfy me that the scale of UK use has been such as to acquire the necessary reputation. In reaching this conclusion, I have borne in mind, in particular, the apparently modest sales figures, the lack of any substantial UK advertising/promotion or details about promotional spend and the limited promotional material before me showing exposure of the mark in the UK. Without a reputation, the necessary link cannot be established in the average UK consumer's mind and there can be no damage.

**64) The opposition under section 5(3) of the Act fails.**

**Section 5(4)(a)**

65) Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

66) Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

67) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

#### Relevant date

68) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is

necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

In the instant case, the opponent must show that it had the necessary goodwill in the UK at the filing date of the contested mark, namely **27 December 2023**.

### What is Goodwill?

69) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

70) In terms of the evidence that is required to establish the existence of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

71) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in the application in the applicant’s specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

72) In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472.

The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

73) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

74) Bearing in mind my earlier comments about Mr Seeley’s evidence and the nature of the use shown therein, I accept that the opponent had the requisite level of goodwill (which I pitch at around a moderate level) in the UK at the relevant date in a business selling evaporative air coolers and that the following sign was distinctive of that goodwill:<sup>16</sup>



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<sup>16</sup> Although the evidence also shows use of ‘Breezair’ (word-only), the opponent’s pleaded case does not rely upon a word-only mark.

## Misrepresentation and Damage

75) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

76) The applicant's mark and the opponent's sign are visually and aurally similar to a medium degree and there is a good degree of conceptual similarity between them for reasons given earlier in this decision. However, that common concept has little, if any, distinctiveness for reasons already explained. The goods in which the opponent

enjoys goodwill are evaporative air coolers. These goods are similar to the goods which the applicant has applied for; the parties are in the same, or at least similar, field of activity. The relevant public is likely to pay a medium to high degree of attention during the purchase. The earlier sign, as a whole, has a below-medium degree of distinctiveness and the common element has a low degree of distinctiveness.

77) Bearing all of this in mind, together with the moderate level of goodwill in the opponent's business, I find that those familiar with the opponent's business will not assume that the goods provided under the applicant's mark are the responsibility of the opponent. Misrepresentation is not made out. Without misrepresentation, there can be no damage.

78) I consider it worth adding here that, even if the opponent had completed the necessary part of the Form TM7 to clearly rely upon the word-only mark, BREEZAIR, it would have been no better off under this ground. This is because, even accepting that the opponent had the requisite level of goodwill associated with that sign at the relevant date (which would again be moderate on the basis of the evidence before me), I still would have found no misrepresentation or damage for similar reasons as those expressed in paragraphs 76 - 77 above, bearing in mind that: i) the word-only sign, 'BREEZAIR', also has a below-medium degree of distinctiveness, ii) the common element is low in distinctiveness, iii) the aural and conceptual position is no better for the word-only sign than the stylised sign, and iv) the word-only sign is still only visually similar to the contested mark to around a medium degree despite the lack of the wave-like stylisation of the 'air' part of that sign.

**79) The opposition under section 5(4)(a) of the Act fails.**

## **OVERALL OUTCOME**

**80) The opposition fails.**

## **COSTS**

81) The applicant has been successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 1/2023, I award the applicant costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Written submissions	£350
<b>Total:</b>	<b>£650</b>

82) I order Seeley International Pty Ltd to pay SHENZHEN TCL NEW TECHNOLOGY CO., LTD. the sum of **£650**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 3<sup>rd</sup> day of February 2026**

**Beverley Hedley  
For the Registrar**