

O-138-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2421687 BY
THE BOOTS COMPANY PLC TO REGISTER THE
TRADE MARK SPIRIT IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION NO 95346 BY
SPIRIG PHARMA AG**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2421687
By The Boots Company Plc to register the trade mark
SPIRIT in Class 3**

And

**IN THE MATTER OF Opposition No 95346 by
Spirig Pharma AG**

BACKGROUND

1. On 12 May 2006 The Boots Company Plc applied to register the mark SPIRIT in relation to:

Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants; anti-perspirants; deodorising body sprays; anti-perspirants deodorants; all for personal use.

2. On 13 July 2007 Spirig Pharma AG filed notice of opposition to this application citing a single ground of opposition under Section 5(2)(b) of the Act. The opposition is based on a single International registration No 860652 designating the Community. The registration has achieved protected status in the UK for four Classes of goods and services though the opponent only relies on the Class 3 goods for the purpose of this opposition. These goods are:

“Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cosmetic goods (included in this Class)”.

3. The International registration holder was not required to show proof of use of the mark.

4. The applicant filed a counterstatement denying that the marks are similar or that the application offends against the provisions of Section 5(2)(b). In support of that position reference is made to some 16 registrations on the UK Trade Marks Register incorporating the word SPIRIT which are said to co-exist with the opponent’s mark. The applicant also offers a number of submissions on the visual, aural and conceptual differences between the marks and the meaning or signification of the respective words. I will come to these submissions in due course.

5. Neither side has filed evidence. Neither side has availed itself of the opportunity to be heard (or to file written submissions). I, therefore, give this decision on the basis of the case as pleaded above.

DECISION

6. The relevant part of Section 5(2) of the Act is as follows:

“(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.”

7. On 27 April 2006, the European Court of Justice (ECJ) handed down a reasoned Order disposing of the appeal in Case C-235/05P *L’Oreal SA v. OHIM*. The relevant legal principles, drawn from the Court’s earlier judgments in *Sabel* [1998] RPC 199, *Lloyd Schuhfabrik Meyer* [2000] FSR 77 and *Canon* [1999] RPC 117 are set out in the summary in that Order, the relevant part of which is re-produced below (references omitted):

“34 It is settled case-law that likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

35 That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Thus, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Accordingly, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services covered.

36 In that regard, as the more distinctive the earlier mark, the greater the risk of confusion, marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

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40 .. it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual,

aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.

41. In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion.”

Comparison of goods

8. It is abundantly clear from the specifications set out above that there is a large measure of identity in the respective sets of goods. In particular the terms soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices feature in both specifications. The remaining goods in the applied for specification (that is to say deodorants, anti-perspirants, deodorising body sprays and anti-perspirant deodorants; all for personal use) are also personal care products and likely to be similar to the opponent’s goods. For reasons which will emerge it is unnecessary to enter into further discussion on the extent and nature of that similarity at this point.

The average consumer and the purchasing process

9. All the goods are common cosmetic/toiletry/personal care products used by the public at large. They are consumable items in the sense that they require replenishment or replacement at regular intervals. Hence, consumers will come into contact with them on a reasonably regular basis. They are likely to vary in price. Perfumes can be very expensive with the result that consumers are likely to expend some time and care in making their selection. Other items such as soaps are rather more mundane purchases and so command rather less attention. Yet other goods such as dentifrices are lowish cost functional items though that is not to say that the consumer will be entirely careless in his or her choice.

10. In general products of the kind at issue are the subject of visual inspection (and, in the case of perfumes and perhaps some other items such as lipsticks, testing) prior to purchase with the consumer having to make a choice from a wide range of competing goods on display.

Similarity of marks

11. The competing marks are SPIRIT and SPIRIG. It is well established that the comparison has to be made on the basis of visual, aural and conceptual considerations. Self-evidently, both marks consist of six letters with the first five in common. This point of visual similarity is reinforced by the fact that the similarity is at the start of the respective words with only the final letter creating a point of difference. Nevertheless, in relatively short words, a single letter difference can have a marked impact on visual character. That is the case here. The final letters are easily

distinguishable and, more importantly, shape the consumer's visual perception of the marks.

12. The reason for that turns on, and brings me to, conceptual considerations. The applicant's counterstatement refers to the following definition of SPIRIT contained in The Concise Oxford Dictionary, sixth edition

“animating or vital principle of man; intelligent or immaterial part of man; soul; rational or intelligent being not connected with material body; person's mental or moral nature or qualities; mental or moral condition or attitude, mood”

13. The dictionary goes on to give other meanings of the word. Suffice to say that I accept that SPIRIT is a well known word of the English language with a number of meanings.

14. The applicant also claims that SPIRIG “appears to be a surname”. That may be so but no evidence has been filed to support that view and, for my part, I am unwilling to accept that it is a surname or at least one that will be recognised by a significant number of people. It is more likely to be seen as an invented word.

15. The European Courts have held that conceptual differences between trade marks can be of importance. Thus in Case C-361/04P (*Picaro/Picasso*) the ECJ noted the following paragraph in the CFI's judgment:

“Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS) [2003] ECR II-4335, paragraph 54].”

and approved the point in paragraph 20 of its own judgment.

16. The *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel* case referred to in the above passage contains the following:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark.

It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

17. I find that SPIRIT has a clear conceptual meaning that counteracts the visual similarity between the respective marks.

18. From an aural point of view it is clear that both words are made up of two syllables with the stress on the first syllable (or probably so in the case of SPIRIG). The ear is attuned to hear and react to known words, particularly relatively common ones such as SPIRIT. Even allowing for the tendency to slur the endings of words I see no reason to suppose that the different terminal letters would go unremarked. Nor are those letters similar in sound (unlike an ‘m’ and ‘n’ for instance).

19. Taking the words as wholes I find a low level of aural similarity. However, as indicated above, I regard visual considerations as being more applicable in the context of the goods at issue and conceptual dissimilarity to be a key distinguishing point.

Distinctive character of the earlier trade mark

20. The position can be shortly stated. No evidence has been filed to establish an enhanced degree of distinctive character. Nevertheless, as an invented word with no allusive or descriptive reference to the goods SPIRIG must be held to be highly distinctive.

Likelihood of confusion

21. I note in this context the applicant’s reference to various SPIRIT marks that are said to co-exist with SPIRIG. It is well established that the position on the trade marks register does not in itself say anything about the position in the marketplace and hence consumer reaction to, or ability to distinguish between, marks. I also note that all the SPIRIT marks referred to in the counterstatement are composite word marks. Thus, the first three are SPIRIT AROMAHUE, SPIRIT CHANNEL and SPIRIT HENKEL. The presence of other matter in these marks further diminishes the value of such ‘register comparisons’.

22. The position is, therefore, that there are identical goods, a highly distinctive earlier trade mark but a low level of similarity between the competing marks. Crucially, there is a clear conceptual distinction which also mitigates against imperfect recollection. The net effect is that I consider there is no likelihood of one mark being mistaken for the other (direct confusion). There remains the question of whether consumers would nevertheless make an association between the marks and consider that goods sold under those marks come from the same or related undertakings. I have been told nothing about the nature of the opponent’s trade and how it uses its mark. Furthermore, there is nothing in the make-up of the marks that causes me to think that consumers would be likely to attribute a common trade source to goods

offered under the respective marks. I can see no basis for reaching a view adverse to the applicant on the basis of a finding of indirect confusion. The opposition fails.

COSTS

23. The applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of **£500**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of May 2008

**M Reynolds
For the Registrar
The Comptroller-General**