

OPPOSITION No B 3 199 946

Artessence FZC, ELOB Office No. E2-127G-14, Hamriyah Free Zone, Sharjah, United Arab Emirates (opponent), represented by **Altes**, 6 avenue George V, 75008 Paris, France (professional representative)

a g a i n s t

Vinicio S.R.L., Via Felice Musazzi, 2, 20025 Legnano, Italy (applicant), represented by **Bird & Bird Società tra Avvocati s.r.l.**, Via Porlezza 12, 20123 Milano, Italy (professional representative).

On 08/07/2024, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 199 946 is partially upheld, namely for the following contested goods and services:

Class 3: All the goods in this class.

Class 35: All the services in this class, except for *retail services in relation to: virtual goods, namely soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, the aforesaid goods for use in virtual reality.*

2. European Union trade mark application No 18 790 458 is rejected for the goods and services as reflected above under point 1 of this dictum. It may proceed for the remaining goods and services.
3. Each party bears its own costs.

REASONS

On 18/07/2023, the opponent filed an opposition against some of the goods and services of European Union trade mark application No 18 790 458

(figurative mark), namely against all the goods in Class 3 and some of the services in Class 35. The opposition is based on EUTM registration

No 18 444 724 (figurative mark) The opponent invoked Article 8(1)(b) EUTMR.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) EUTMR

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods and services

The goods on which the opposition is based are the following:

Class 3: *Perfumery and fragrances; extracts of perfumes; deodorants for human beings; eau de cologne; toilet water; amber [perfume]; oils for perfumes and scents; essential oils for personal use; natural oils for cosmetic purposes; scented oils; blended essential oils; perfumery, essential oils; air fragrancing preparations; cosmetics in the form of lotions; skin care creams [cosmetic]; cosmetic kits; massage gels, other than for medical purposes; body cream; hair balm; scented bathing salts; bath salts, not for medical purposes; bath oils for cosmetic purposes; ethereal oils; cosmetics; hair spray.*

Class 4: *Candles; perfumed candles.*

The contested goods and services are the following:

Class 3: *Soap; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cosmetics; antiperspirants [toiletries], joss sticks, potpourris and sachets, kits and gift sets containing skin, hair and/or nail care preparations.*

Class 35: *The bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, **that is**: soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, via retail stores; the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, **that is**: soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, via a general merchandise internet website; the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, **that is** soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, via a general merchandise catalogue by mail order or telecommunications; retailing and wholesaling (for others), in relation to the following goods: soaps, perfumery, essential, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations; retail services in relation to: virtual goods, **namely** soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty*

and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, the aforesaid goods for use in virtual reality.

An interpretation of the wording of the list of services is required to determine the scope of protection of these services.

The terms 'that is' and 'namely', used in the applicant's list of services to show the relationship of individual goods and services to a broader category, are exclusive and restrict the scope of protection only to the services specifically listed.

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition or complementary.

Contested goods in Class 3

Cosmetics (included twice in the contested sign's list of goods); *perfumery, essential oils* are identically contained in both lists of goods.

The contested *soap; hair lotions; antiperspirants [toiletries]* are included in, or overlap with, the broad category of the opponent's *cosmetics*. Therefore, they are identical.

The contested *joss sticks; potpourris and sachets* are identical to the opponent's *perfumery and fragrances*, because the opponent's goods include, or overlap with, the contested goods.

The contested *kits and gift sets containing skin, hair and/or nail care preparations* are at least similar to a high degree to the opponent's *cosmetic kits* because they at least coincide in the following relevant factors: nature, purpose, method of use, distribution channels, relevant public, and producer.

The contested *dentifrices* are similar to the opponent's *cosmetics*. On the one hand, the broad category of cosmetics includes preparations for enhancing or protecting the appearance, odour or fragrance of the body, while on the other hand, dentifrices are paste, powder or liquid preparations used for cleaning teeth, for personal hygiene purposes, for beautification purposes, or to make the breath smell pleasant. Cosmetics are similar to dentifrices as they have the same purpose, namely to enhance or protect the appearance or the odour of the body, including the teeth. Additionally, they usually coincide in relevant public and distribution channels. The goods under comparison may also be produced by the same producers when the cosmetic preparations are intended for mouth and teeth care.

Contested services in Class 35

Retail services concerning the sale of specific goods are similar to an average degree to these specific goods. Although the nature, purpose and method of use of these

goods and services are not the same, they are similar because they are complementary and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public.

There is a low degree of similarity between the retail services concerning specific goods and other goods which are either highly similar or similar to those specific ones. This is because of the close connection between them on the market from consumers' perspective. Consumers are used to a variety of highly similar or similar goods being brought together and offered for sale in the same specialised shops or in the same sections of department stores or supermarkets. Furthermore, they are of interest to the same consumers.

The same principles apply to services rendered in connection with other types of services that consist exclusively of activities revolving around the actual sale of goods, such as the contested wholesale services, retail services via catalogues, mail order retail services or online retail store services in Class 35. Furthermore, services specified as 'the bringing together, for the benefit of others, of a variety of specific goods enabling customers to conveniently view and purchase those goods from various sales outlets' are considered analogous to retail services concerning the specified goods.

Part of the goods under the contested services, namely soaps, perfumery, essential oils, cosmetics, hair lotions, joss sticks, pot-pourri and bags, are identical to the opponent's *cosmetics, perfumery and fragrances or essential oils for personal use*, as explained above. The remaining goods, namely *beauty and care preparations for the body; deodorants*, at least overlap with the opponent's *cosmetics*. It follows that these goods are identical to the opponent's goods as well.

Therefore, the contested *bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, that is: soaps, perfumery, essential oils, cosmetics, hair lotions, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, via retail stores; the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, that is: soaps, perfumery, essential oils, cosmetics, hair lotions, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, via a general merchandise internet website; the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, that is soaps, perfumery, essential oils, cosmetics, hair lotions, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, via a general merchandise catalogue by mail order or telecommunications; retailing and wholesaling (for others), in relation to the following goods: soaps, perfumery, essential, cosmetics, hair lotions, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags* are similar to the opponent's *cosmetics, perfumery and fragrances or essential oils for personal use* in Class 3, respectively. Although the nature, purpose and method of use of these goods and services are not the same, they are complementary and share the same distribution channels. Furthermore, they belong to the same market sector and, therefore, are of interest to the same consumers.

Furthermore, as explained above, *dentifrices* are similar to the opponent's *cosmetics*, and *kits and gift sets containing skin, hair and/or nail care preparations* are at least similar to a high degree to the opponent's *cosmetic kits*.

Therefore, the contested *the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, that is: dentifrices, kits and gift sets containing skin, hair and/or nail care preparations, via retail stores; the bringing together*

of a variety of goods enabling customers to conveniently view and purchase those goods, that is: dentifrices, kits and gift sets containing skin, hair and/or nail care preparations, via a general merchandise internet website; the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods, that is dentifrices, kits and gift sets containing skin, hair and/or nail care preparations, via a general merchandise catalogue by mail order or telecommunications; retailing and wholesaling (for others), in relation to the following goods: dentifrices, kits and gift sets containing skin, hair and/or nail care preparations are similar to a low degree to the opponent's cosmetics or cosmetic kits in Class 3, respectively. The goods involved are commonly offered for sale in the same specialised shops or in the same sections of department stores or supermarkets, belong to the same market sector and, therefore, are of interest to the same consumers.

As for the remaining contested services, namely *retail services in relation to: virtual goods, namely soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, the aforesaid goods for use in virtual reality*, these are retail services of virtual goods in Class 3, such as cosmetics, perfumery and fragrances for use online and in virtual environments. While the goods covered by the contested retail services are virtual goods for use online and in virtual environments, the earlier mark is registered for real-world goods in Classes 3 and 4.

In general terms, virtual goods are understood to be non-physical items intended for use in the course of trade in online or virtual environments. They may perform various functions: for instance, they may (i) depict real-world goods; (ii) emulate the functions of real-world goods; or (iii) represent objects with no equivalent in the real world. These goods entail new technologies that have emerged in the context of the creation and development of virtual environments (e.g. those also referred to as 'metaverses' or 'virtual worlds').

In the present case, the goods covered by the earlier mark in Class 3 and most of the goods that are the subject of the earlier retail services in Class 35, are the real-world counterparts of the virtual goods that are covered by the contested retail services (see the comparison of the goods in Class 3 above).

However, in the present case, this is not per se sufficient for a finding of similarity between the goods and services in conflict.

The degree of similarity of the goods and services is a matter of law, which must be assessed *ex officio* by the Office (16/01/2007, T53/05, Calvo, EU:T:2007:7, § 59). However, this *ex officio* examination is restricted to well-known facts, that is to say, 'facts which are likely to be known by anyone or which may be learned from generally accessible sources', which excludes facts of a highly technical nature (03/07/2013, T106/12, Alpharen, EU:T:2013:340, § 51).

Consequently, what does not follow from the evidence or arguments submitted by the parties or is not commonly known should not be speculated on or extensively investigated *ex officio* (09/02/2011, T222/09, Alpharen, EU:T:2011:36, § 31-32). This follows from Article 95(1) EUTMR, according to which, in opposition proceedings, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties.

Even if the concept of virtual goods for use online and in virtual environments is not

entirely new, these have become more technically feasible and present in the market only recently thanks to rapid technological advances. Given the novelty of the aspects related to these new technologies, it cannot be assumed that a certain market practice has yet been established in this field. Therefore, facts related to virtual goods for use online and in virtual environments cannot be defined as well-known facts. This also applies when the virtual goods are the subject of retail services.

Consequently, in this context, the importance of the parties' submissions in providing specific and substantiated information may have a decisive impact on the outcome of the case.

In principle, in order to compare the goods or services covered by the marks at issue, all the relevant factors relating to those goods and services should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose, their method of use and whether they are in competition or complementary. Other factors may also be taken into account, such as the distribution channels of the goods or services concerned, or the fact that those goods or services are often sold in the same specialist sales outlets, which is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the impression that the same undertaking is responsible for the production of those goods or provision of those services (02/06/2021, T177/20, *Hispano Suiza / Hispano Suiza*, EU:T:2021:312, § 44 and the case-law cited).

When comparing the contested retail services relating to virtual perfumery, dentifrices, cosmetics, etc. for use online and in virtual environments in Class 35 and the earlier cosmetics, perfumery and fragrance in Class 3, the nature, purpose and method of use of these goods and services are not the same. Moreover, although in certain circumstances there can be a complementarity between retail services of certain goods and other specific goods because of the possible close connection between them on the market from the consumer's perspective, such a connection, and therefore complementarity, cannot be found in the present case.

In fact, no market practice can be established *ex officio* in relation to the virtual goods that are covered by the contested retail services in Class 35. It is not a well-known fact whether it is customary to bring together and offer for sale virtual goods and their real-world counterparts through the same distribution channels.

When the comparison of goods and services involves virtual goods, this implies the application of similarity criteria in novel situations that cannot be regarded as 'well-known', at least for the time being. Consequently, it is crucial that the parties provide arguments and evidence showing in which respects the respective goods and services are similar. Nonetheless, in this case, there is no argument or evidence that could suggest, for instance, whether it is usual to trade virtual and real-world goods through the same distribution channels, or to what extent they could target the same relevant public.

In its observations, the opponent merely stated that the goods and services in question are similar by referring to Section 5.6.2.1 'Retail services of specific goods versus the same specific goods' of the Office's Guidelines, without any further arguments regarding the virtual nature of the goods. However, first, real-world goods and their virtual counterparts are not part of the same category of goods: indeed, the fact that virtual goods may depict or emulate the functions of real-world goods does not make them identical to their real-world counterparts. Second, as stated above, the fact that a certain product is the virtual equivalent of a real-world good is not *per se* sufficient for a

finding of similarity.

Consequently, the Opposition Division has no substantive evidence on file to find whether the goods and services at issue are complementary, whether they are distributed through the same channels, or to what extent they could target the same relevant public.

Therefore, no similarity can be found between the earlier goods in Classes 3 and 4 and the contested *retail services in relation to: virtual goods, namely soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, beauty and care preparations for the body, deodorants, joss sticks, pot-pourri and bags, kits and gift sets containing skin, hair and/or nail care preparations, the aforesaid goods for use in virtual reality*, in Class 35. Therefore, they are considered dissimilar in the absence of a cogent line of arguments or evidence to the contrary by the opponent.

b) Relevant public – degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical or similar to varying degrees target the public at large and business customers with specific professional knowledge or expertise.

The public's degree of attentiveness may vary from average to high, depending on the price, specialised nature, or terms and conditions of the goods and services purchased.

c) The signs