

O-771-22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3581611

BY MICHAEL JAMES HOLMES

FOR THE TRADE MARK

OROMA

IN CLASSES 3, 5 AND 11

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 425979

BY AROMATIZE LIMITED

BACKGROUND AND PLEADINGS

1. On 19 January 2021, Michael James Holmes (“**the Applicant**”) applied to register the plain text word “OROMA” as a UK trade mark. On 30 April 2021 the mark was published in the Trade Marks Journal in respect of goods in classes 3, 5 and 11.

2. On 30 July 2021, the application was opposed, by Aromatize Limited¹ (“**the Opponent**”). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). It is noted that in submissions filed on 28 January 2022, the Opponent provided an amended statement of grounds. Under this statement the Opponent confirmed its decision to forgo the opposition under section 5(4)(a). In addition, the scope of the opposition was limited to Class 11 of the contested application, with the Opponent only relying on the goods under Class 11 of its trade marks. The Opponent therefore opposes the Applicant’s mark, in part, in respect of the following goods:

Class 11: Air freshening apparatus; air freshener dispensing systems; room deodorant dispensing systems; electric dispensers for room deodorants; air purifiers; deodorising apparatus for dispensing scents in motor vehicles; electric warmers to melt scented wax tarts; scent dispensing apparatus; scent diffusing apparatus; parts and fittings for the aforesaid goods.

3. The Opponent relies on its registrations for the following trade marks:

The “989” mark



Trade mark no. 3147989

Filing date 04/02/2016

Registration date 15/07/2016

Relying on goods in Class 11

¹ Another opposition has been filed against the application by Aroma Home Limited. That Opposition is in the cooling off period.

The “992” mark



Trade mark no. 3147992

Filing date 04/02/2016

Registration date 08/07/2016

Relying on goods in Class 11

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark or international trade mark (UK), which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

5. The filing dates of the Opponent’s marks are prior to the filing date of the contested mark. The Opponent’s marks therefore constitute earlier marks under the Act.

6. Under section 6A of the Act, a proprietor has a period of five years following registration in which to use its trade mark. As five years had not passed between the dates of registration of the earlier marks and the application for the contested mark, the Opponent can rely on all of the goods and services under its trade marks and is not required to show that its mark has yet been used at all.

The Opponent’s case

7. As set out above, the Opponent limited the scope of the opposition after proceedings had commenced. The submissions filed on 28 January 2022 stated that the grounds of opposition under section A of the Notice of opposition were repeated, but at the same time the opposition was limited to Class 11 of the respective marks. Reading the original statement of grounds, in conjunction with the statement of 28 January, the Opponent submits that:

(i) the contested mark is extremely similar and almost identical to the 989 mark, with only one letter of difference;

- (ii) the term “ACCESSORIES” in the 992 mark is descriptive and non-distinctive and therefore, there is only one letter of difference between the contested mark and the dominant element of the 992 mark;
- (iii) the marks are visually, aurally and conceptually almost identical;
- (iv) the goods under Class 11 of the Applicant’s and Opponent’s marks are identical and highly similar;
- (v) given the similarities between the marks and the specifications, there is a very high risk of confusion between the marks.

The Applicant’s case

8. In response, the Applicant:

- (i) denies that the goods are all identical or highly similar to the Opponent’s goods;
- (ii) denies that the earlier marks are visually, aurally and conceptually similar to the Applicant’s mark, when the distinctive and dominant elements are taken into account;
- (iii) denies there would be a likelihood of confusion between the marks;
- (iv) submits that the earlier marks consist of descriptive words, presented in highly stylised forms and the Opponent has no exclusivity in the descriptive words “aroma” used in relation to products intended to have a pleasant fragrance;
- (v) submits that the word “aroma” is used widely in the marketplace in respect of products sold on the basis of their pleasant fragrance, the term is therefore non-distinctive and no confusion can therefore exist between the marks.

Representation and papers filed

9. In these proceedings, the Opponent is represented by Brabners LLP; the Applicant by Murgitroyd & Company. Both parties have filed evidence, with the Opponent filing the witness statement of Colin Bell, Partner at Brabners LLP. Mr Bell introduces four exhibits, numbered CB1 to CB4 which contain printouts of products from four retailers offering candles and fragrance products for the home. The Opponent’s evidence aims to show that the goods under the respective marks are “*identical, practically identical or highly similar*”. The Applicant’s evidence comprises the witness statement of the

proprietor of the contested mark, Michael James Holmes. Mr Holmes introduces three exhibits, numbered MJH1 to MJH3, aimed at showing the descriptive nature of the word “aroma” and the use that is made of it in trade in respect of the goods at issue. The Opponent filed submissions together with its evidence, under the title “*Further Submissions*” the Applicant did not file submissions beyond those provided in its counterstatement. Neither party requested a hearing and neither party filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers and evidence filed.

DECISION

10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

11. Section 5(2)(b) of the Act states:

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

[...]

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

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

12. The following principles are gleaned from the decisions of the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG*, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04; *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

(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 greater 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.

My approach

13. The goods relied upon by the Opponent under its two earlier marks are identical and the Opponent's 992 mark is the same as its 989 mark, except for the word "ACCESSORIES" which appears in the 992 mark. Given that the term "ACCESSORIES" does not appear in the Applicant's mark, I do not consider the 992 mark puts the Opponent in a stronger position than the 989 mark. Furthermore, the Opponent, in its submissions, seeks to downplay the importance of the additional word, submitting that "ACCESSORIES" designates the nature of the goods and is non-dominant. This being the case, I will focus my assessment on the 989 mark.

Comparison of the goods

14. The goods at issue are:

Opponent's goods	Applicant's goods
Class 11: Air freshener dispensing systems; burners (incandescent-); burners for lamps; candle lamps; candle lanterns; candle lighters; ceramic	Class 11: Air freshening apparatus; air freshener dispensing systems; room deodorant dispensing systems; electric dispensers for room deodorants; air

<p>fragrant wax warmers [electric], metal fragrant wax warmers [electric] and fragrant wax warmers [electric]; Chinese lanterns; domestic gas lighters; electric candles; electric dispensers for air fresheners; electric fragrance dispensers; electric warmers to melt scented wax; flameless candles; flameless light-emitting diode candles; gas lighters; incandescent burners; lamp globes; lamps (burners for-); lanterns for lighting; lanterns made of ceramics; lanterns made of glass; lanterns made of non-precious metals; lanterns made of precious metals; lanterns; lighters (gas-); lighters; novelty oil burners; oil burners; oil lanterns; shades for lanterns; candle jar lamp shades; decorative rotary fan.</p>	<p>purifiers; deodorising apparatus for dispensing scents in motor vehicles; electric warmers to melt scented wax tarts; scent dispensing apparatus; scent diffusing apparatus; parts and fittings for the aforesaid goods.</p>
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15. In considering the extent to which there may be similarity between the goods, I take account of the guidance from relevant case law. Thus, in Canon the CJEU stated that:

*“In assessing the similarity of the goods or services concerned, ... 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”.*²

16. The relevant factors identified by Jacob J. (as he then was) in the Treat³ case for assessing similarity were:

² Case C-39/97, at paragraph 23.

³ British Sugar PLC v James Robertson & Sons Ltd., 1996 R.P.C. 281.

- (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.

electric warmers to melt scented wax tarts

17. The Applicant's goods listed above are plainly identical to the Opponent's *electric warmers to melt scented wax*.

Air freshening apparatus; air freshener dispensing systems; room deodorant dispensing systems; electric dispensers for room deodorants; deodorising apparatus for dispensing scents in motor vehicles; scent dispensing apparatus; scent diffusing apparatus; parts and fittings for the aforesaid goods.

18. The Applicant's goods listed above are all for freshening, deodorising, or adding scent to the air. The Opponent's list of goods includes *air freshener dispensing systems* and *electric dispensers for air fresheners*. I consider these goods to be identical, or at least highly similar, being the same in their nature, intended purpose, relevant consumer and channels of trade.

air purifiers

19. *Air purifiers* under the Applicant's mark will remove a range of substances from the air such as allergens and dust. I consider that they would also remove bad smells. This being the case, I find that the Applicant's *air purifiers* and the Opponent's *air freshener dispensing systems* and *electric dispensers for air fresheners* share the same intended purpose, relevant consumer and channels of trade and therefore the goods have a high degree of similarity.

Average consumer and the purchasing act

20. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them.

21. In *Hearst Holdings Inc*,⁴ Birss J. explained that:

"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 relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical ..."

22. The goods concerned are apparatus for freshening, purifying or adding fragrance to the air. Such goods will be used in the home and in places of business, public areas and hospitals. I consider that the price of these goods will vary from a few pounds for a simple air freshener dispenser, to several hundreds of pounds for a technologically advanced air purifier. I find therefore that the average consumer will include both the general public and a professional consumer, with the level of attention paid varying from relatively low for simple air fresheners for use in the home, to above average for those products used in businesses, public areas and hospitals.

⁴ *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), at paragraph 60.

23. Products purchased by the general public will usually be selected from a display in a shop, or online. I consider that the products targeted at a professional public will usually be selected from a catalogue or website specialising in air purifying and freshening products. For both publics, I consider that the purchase will be primarily visual in nature, however, I do not discount that aural factors will come into play, for example, through advice from retailers and word of mouth recommendations.

Distinctive character of the earlier mark

24. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

25. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words. The inherent distinctive character may be enhanced through the use that has been made of the mark.

26. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark's distinctive character should be made:

“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)."*

27. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited Sabel v Puma at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

28. I remind myself of the Applicant's view, expressed in their counterstatement that the earlier marks consist of descriptive words, presented in highly stylised forms. The Opponent disagrees with the Applicant and describes the earlier marks as "*stylised figurative marks, containing a decorative element, but not an element indicating the commercial origin of the Opponent's goods*". In its comparison of the conceptual

nature of the marks, I note that the Opponent submits that the Applicant's and Opponent's marks "evoke thoughts of a smell or fragrant scent".

AROMA

30. The word "AROMA" is defined as "a strong, pleasant smell"⁵. Many of the goods under the Opponent's mark relate to air freshening and adding scent to the air, particularly through scented wax or oil. The Applicant's evidence in Exhibits MJH2 to MJH3 show that a number of different traders use the word "aroma" in relation to various forms of air freshening or scenting apparatus. Taking account of these factors and the Opponent's own view that the mark evokes thoughts of smells, I consider the word "aroma" to allude strongly to the nature of the goods, which concern freshening, or adding pleasant scent – "aroma" – to the air. In my view, the stylised candle wick and flame, and the manner in which this is incorporated into the letter "O" in the Opponent's mark, provide a greater level of distinctive character than the word "AROMA" on its own. These more distinctive features are not found within the Applicant's mark and so, in accordance with the decision in *Kurt Geiger*, it is the distinctive character of the word "aroma" that is most relevant to my assessment.

31. Other goods under the Opponent's mark are forms of lanterns, their parts; electronic candles; lighters; and decorative fans. I acknowledge that these goods do not involve the removal of bad smells, or the addition of pleasant smells to the air, however, these goods do not have a counterpart in the goods under Class 11 of the Applicant's mark.

32. Taking the above points into consideration, I find the word "AROMA" in the Opponent's mark to possess a very low degree of distinctive character.

⁵ Collins English Dictionary, reproduced in Exhibit MJH1.

33. The Opponent has filed no evidence of how it has used its earlier marks and therefore no consideration of whether the distinctive character of the Opponent's mark has been enhanced can be made.



Comparison of the marks

34. It is clear from *Sabel BV v. Puma AG*⁶ (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 *Bimbo SA v OHIM*,⁷ 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.”

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

36. The Applicant's and Opponent's marks are shown below:

Opponent's mark	Applicant's mark
 The logo for the Opponent's mark consists of the word "AROMA" in a serif font. The letter "O" is stylized with a yellow and orange circular graphic element.	 The logo for the Applicant's mark consists of the word "OROMA" in a bold, sans-serif font.

⁶ Case C-251/95.
⁷ Case C-591/12P.

37. The overall impression of the Opponent's mark is of the dictionary word "AROMA", which refers to a pleasant smell. The letter "O" in the centre of the mark contains a stylised candle wick and flame (as already described). While I acknowledge that the verbal elements tend to have a greater impact, I consider that, taking account of the descriptive connotations of the Opponent's mark, the incorporation of the figurative element into the letters of the word, the contrasting colour of the flames, and the fact that they stretch above the upper outline of the letter "O", mean that the figurative element has roughly equal impact in the overall impression, to the words considered alone. In support of this, I note the General Court of the European Union's judgment in *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253 (Museum of Illusions):

57 According to the case-law, the public will not generally consider a descriptive or weakly distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see judgment of 5 April 2006, Madaus v OHIM – Optima Healthcare (ECHINAID), T- 202/04, EU:T:2006:106, paragraph 54 and the case-law cited; judgment of 28 October 2009, CureVac v OHIM – Qiagen (RNAiFect), T- 80/08, EU:T:2009:416, paragraph 49).

58 It does not therefore automatically follow that, where a sign consists of both figurative and word elements, it is the word element which must always be considered to be dominant. In certain cases, in a composite sign, the figurative element may therefore rank at least equally with the word element (see, to that effect, judgment of 24 October 2018, Grupo Orenes v EUIPO – Akamon Entertainment Millenium (Bingo VIVA ! Slots), T- 63/17, not published, EU:T:2018:716, paragraph 43 and the case-law cited).

38. The overall impression of the Applicant's mark is of the invented word "OROMA".

Visual comparison

39. Visually, the marks align in that they consist of a single word, five letters in length and which share the same four letter sequence "ROMA". Visually the marks differ in

respect of their first letters and the figurative features in the letter “O” of the Opponent’s mark. I disagree with the Opponent’s submission that the marks may be “almost identical”, as (i) the difference in the letters in the marks concerns the first letter in the mark, and consumers normally attach more importance to the first part of words⁸; and (ii) for the reasons already stated, I consider that the figurative features in the letter “O” in the Opponent’s mark play an equal part in the overall impression and so this difference will be noticed by consumers. I find the marks to be visually similar to a medium degree.

Aural comparison

40. Aurally, I agree with the Opponent’s view that both marks comprise three syllables, with the Opponent’s mark being pronounced “A-RO-MA” and the Applicant’s mark being pronounced “O-RO-MA”. Two of the syllables in the marks are therefore identical, with the only difference being in the first consonants “A” and “O”. I find the marks to be aurally similar to a high degree.

Conceptual comparison

41. The Opponent submits that the marks are conceptually “*identical, highly identical and/or highly similar*” on the basis that they “*evoke thoughts of smell or fragrant scent*”. I disagree with the Opponent on this point as I consider that consumers will view the word “OROMA” as an invented term. While I accept that four letters from the word “AROMA” are reproduced in the word “OROMA”, I think that, at most, consumers will have only a fleeting thought to fragrance and smell, in the event that they view “OROMA” as an alternative spelling of “AROMA”. I find the marks to be conceptually similar to a low degree.

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

Likelihood of confusion

42. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all of the factors, weighing them, and looking at their combined effect, in accordance with the authorities set out earlier, in particular at my paragraph 12.

43. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking.

44. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply

even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

45. 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.

46. In this case I have found the goods under the respective marks to be either identical, or highly similar. I have found the average consumer of the goods to include the general public and the professional public, whose level of attention will vary between relatively low and above average. I have found the purchase of the goods concerned to be primarily a visual purchase, but that aural considerations may also play a part. I have found the word element in the Opponent’s mark, which is the only element which has a counterpart in the Applicant’s mark, to possess a very low level of distinctive character. In comparing the Applicant’s and Opponent’s marks, I have found a medium degree of visual similarity, a high degree of aural similarity and a low degree of conceptual similarity.

47. Considering direct confusion first, the differences between the marks in terms of the first letter and the figurative features in the Opponent’s mark mean that the consumer is unlikely to confuse the marks directly, that is to mistake one mark for the other, even for identical goods. I find that there is no likelihood of direct confusion.

48. I now turn to consider whether there is a likelihood of indirect confusion between the Applicant's and Opponent's marks. I remind myself that indirect confusion is based upon a thought process whereby the average consumer recognises there are differences between the marks, but the common element leads the consumer to consider the later mark to be another brand of the owner of the earlier mark. I note here the Opponent's submission that the relevant consumer will perceive the contested mark as sub-brand of the Opponent.

49. Taking account of my findings up to this point, on the one hand, I have found the goods to be identical, or highly similar, and there to be a high degree of aural similarity between the marks, and a medium degree of visual similarity, with visual considerations being most relevant in the purchase of the goods. In addition to this, I have identified that for some of the goods concerned, the average consumer will pay only a low level of attention when purchasing them. On the other hand, I have found the common element in Opponent's mark to possess a very low degree of distinctive character. I have also found the marks to be conceptually similar to a low degree.

50. Weighing these factors, and keeping in mind the principle that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, I consider it to be unlikely that the average consumer, paying even a low degree of attention, in respect of identical goods, would indirectly confuse the marks. I acknowledge that there is only a single letter of difference between the words in the marks, however, the word "AROMA" in the Opponent's mark has only a very low degree of distinctive character in respect of the relevant goods. I consider that the average consumer is likely to understand the Opponent's mark as alluding to the goods being related to fragrance, whereas the Applicant's mark will be viewed as an invented word. Taking account of all these factors, I find that there is no likelihood that the marks will be indirectly confused. I find that the same outcome applies to the Opponent's 992 mark, which includes the word "ACCESSORIES", this being a further, albeit non-distinctive, difference between the Applicant's and Opponent's marks.

OUTCOME

51. The Opposition under section 5(2)(b) fails. The application will not proceed to registration due to a second opposition by AROMA HOME LIMITED, which is ongoing.

COSTS

52. The Applicant has successfully defended the opposition and is entitled to a contribution towards their costs in line with the scale published in the Annex to Tribunal Practice Notice (2/2016). The costs award takes account of the fact that the Applicant filed no submissions beyond those made in the counterstatement.

Preparing a counterstatement	£400
Preparing evidence and considering the Opponent's evidence	£1,000
TOTAL	£1,400

53. I order Aromatize Limited to pay Michael James Holmes the sum of £1,400. The sum is to be paid within 21 days of the end of the period allowed for appeal, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 8th day of September 2022

Charlotte Champion
For the Registrar