O/0978/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3753109
IN THE NAME OF LUCY BLACK
TO REGISTER AS A SERIES OF 2 TRADE MARKS

BIOME

biome

IN CLASSES 3 & 4

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 436022
BY GIVAUDAN SA

BACKGROUND AND PLEADINGS

1. On 10 February 2022, Lucy Black ("the applicant") applied to register trade mark number UK00003753109 as a series of two trade marks, for the marks shown on the cover page of this decision, in the United Kingdom.

2. The application was accepted and published for opposition purposes on 3 June 2022, in respect of the following goods:

Class 03: *Reed diffusers; Air fragrance reed diffusers; Scented wax melts; wax melts [fragrancing preparations]; Wax melts [fragrancing preparations]; Scented wax melts; Fragrance sachets; Room fragrances; Fragrance emitting wicks for room fragrance; Air fragrance preparations; Aromatics for fragrances; Room fragrancing products; Air fragrancing preparations; Room fragrancing preparations; fragrances for automobiles.*[1]

Class 04: *Candles; Candle torches; Soy candles; Perfumed candles; Tallow candles; Floating candles; soy candles; Tealight candles; Scented candles; Fragranced candles; Candles (Perfumed -); Table candles; Fruit candles; Nightlights [candles]; Candle wax; Votive candles; Candle assemblies; Church candles; Tea light candles; Christmas tree candles; Candles and wicks for candles for lighting; Wicks for candles; Aromatherapy fragrance candles; Candles in tins; Candles (Christmas tree -); Candles for lighting Christmas lights [candles]; Special occasion candles; Musk scented candles; Candles containing insect repellent; Candles for night lights; Wax for making candles; Grave candles, non-electric; Candles for absorbing smoke; Candles for use as nightlights; Wicks for candles for lighting; Candles and wicks for lighting; Christmas tree decorations for illumination [candles]; Christmas tree ornaments for illumination [candles]; Bougies in the nature of wax candles; Beeswax for use in the manufacture of candles.*

[1] I note that the goods in Class 3 as applied for were restricted to the above goods only prior to publication.

3. The application is opposed by Givaudan SA (“the opponent”). The opposition was filed on 5 September 2022 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon the following mark:

Z-BIOME

International Registration No. WO0000001645822
International Registration date: 17 December 2021
UK Date of Designation: 17 December 2021
Priority date claimed: 21 June 2021[2]
Date Protection Granted in the UK: 12 May 2022
Relying on all the protected goods, namely:

Class 1: *Chemical products used for the manufacture of perfumes, cosmetics, shampoos, soaps, detergents, deodorants for personal use and deodorizers other than for personal use; chemical products used for the manufacture of compositions for perfumery, cosmetics, shampoos, soaps, detergents, deodorants for personal use and deodorizers other than for personal use; chemical products used for the manufacture of perfume compositions and preparations for masking and neutralizing odors.*

Class 3: *Perfumery products; perfume base; perfumes; perfume compositions for neutralizing and masking body odors; cosmetics; soaps; shampoos; detergents; deodorants for personal use; perfumes intended for the cosmetic industry, the perfume industry and the detergent and cleaning product industry.*

[2] From Swiss trade mark No. 771838.

4. The above mark qualifies as an earlier mark under section 6(1) of the Act. As the trade mark had not been protected for more than five years at the date the application was filed, it is not subject to the use provisions contained in section 6A of the Act.

5. The opponent submits that the competing marks are visually, phonetically and conceptually highly similar, and that the applicant's goods in classes 3 and 4 are identical/similar to the goods protected under classes 1 and 3 of the opponent's mark. It submits that there is a likelihood of both direct and indirect confusion and/or association between the marks, and accordingly, it requests that the application be refused in its entirety.

6. The applicant filed a counterstatement denying the claims.

7. Both parties filed written submissions in lieu which will be referred to as and where appropriate during this decision. Only the applicant elected to file evidence, neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Lane IP Limited and the applicant is unrepresented.

EVIDENCE

The Applicant's evidence

9.The applicant filed evidence in support of the defence in the form of three witness statements.

10. The first witness statement is in the name of Lucy Black, being the applicant, and is dated 23 April 2023.[3] A second witness statement by Ms Black is dated 23 April 2023, and is accompanied by twenty three exhibits. The main purpose of the witness

[3] I note that although the document is headed "SUBMISSIONS", it takes the form of a witness statement and contains a statement of truth which refers to "the facts in this witness statement".

statements is in support of the defence and to provide background on the applicant's business.

11. A further witness statement is in the name of Lucy Knight, being a former distributor of the applicant's goods, and is dated 19 April 2023. The main purpose of the witness statement is to confirm the relationship between the applicant and Ms Knight as a distributor of the applicant's goods.

12. I have taken the evidence into account in reaching my decision and will refer to it during the decision to the extent I consider necessary.

DECISION

13. Although the UK has left the European Union, 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 on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

14. Section 5(2)(b) is relied on and read as follows:

> "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".

15. Section 5A states:

> "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."

16. I am guided by the following principles which are gleaned from the decisions of the EU courts 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

17. Section 60A of the Act provides:

"(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

18. The goods to be compared are:

Opponent's goods	**Applicant's goods**
Class 1 *Chemical products used for the manufacture of perfumes, cosmetics, shampoos, soaps, detergents, deodorants for personal use and deodorizers other than for personal use; chemical products used for the manufacture of compositions for perfumery, cosmetics, shampoos, soaps, detergents, deodorants for personal use and deodorizers other than for personal use; chemical products used for the manufacture of perfume compositions and preparations for masking and neutralizing odors.*	
Class 3 *Perfumery products; perfume base; perfumes; perfume compositions for neutralizing and masking body odors; cosmetics; soaps; shampoos; detergents; deodorants for personal use; perfumes intended for the cosmetic industry, the*	Class 3 *Reed diffusers; Air fragrance reed diffusers; Scented wax melts; wax melts [fragrancing preparations]; Wax melts [fragrancing preparations]; Scented wax melts; Fragrance sachets; Room fragrances; Fragrance emitting wicks for*

perfume industry and the detergent and cleaning product industry	*room fragrance; Air fragrance preparations; Aromatics for fragrances; Room fragrancing products; Air fragrancing preparations; Room fragrancing preparations; fragrances for automobiles.*
	Class 4 *Candles; Candle torches; Soy candles; Perfumed candles; Tallow candles; Floating candles; soy candles; Tealight candles; Scented candles; Fragranced candles; Candles (Perfumed -); Table candles; Fruit candles; Nightlights [candles]; Candle wax; Votive candles; Candle assemblies; Church candles; Tea light candles; Christmas tree candles; Candles and wicks for candles for lighting; Wicks for candles; Aromatherapy fragrance candles; Candles in tins; Candles (Christmas tree -); Candles for lighting Christmas lights [candles]; Special occasion candles; Musk scented candles; Candles containing insect repellent; Candles for night lights; Wax for making candles; Grave candles, non-electric; Candles for absorbing smoke; Candles for use as nightlights; Wicks for candles for lighting; Candles and wicks for lighting; Christmas tree decorations for illumination [candles]; Christmas tree ornaments for illumination [candles]; Bougies in the nature of wax candles; Beeswax for use in the manufacture of candles.*

19. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".[4]

20. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("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".[5]

21. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996] R.P.C. 281 include an assessment of users and the channels of trade of the respective goods or services.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "...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".[6]

[4] Paragraph 29
[5] Paragraph 23
[6] Paragraph 82

23. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."[7]

24. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. … Nevertheless the principle should not be taken too far. ... 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."[8]

25. In its written submissions in lieu, the opponent submits that the term "perfumery products" means simply products which perfume, i.e. which give a pleasant smell to. It submits that the entirety of the applicant's Class 3 goods have the purpose to perfume and so fall within the earlier mark's broad term "*perfumery products*". It further submits that the same could be said of the applicant's various perfumed/scented/fragranced candles in Class 4, however, even if the Class 4 goods are not considered to be identical, then they are "without question highly similar/complementary".

[7] Paragraph 5
[8] Paragraph 12

26. The applicant has provided the following definition of the word “perfume” which she states has been taken from the Collins English Dictionary: “*a mixture of alcohol and fragrant essential oils extracted from flowers, spices, etc, or made synthetically, used esp to impart a pleasant long-lasting scent to the body*”.[9] She submits that the definition and use of the word “perfume” clearly link it to personal use and for use on the skin.

Contested goods in Class 3

Reed diffusers; Air fragrance reed diffusers; Scented wax melts; wax melts [fragrancing preparations]; Wax melts [fragrancing preparations]; Scented wax melts; Fragrance sachets; Room fragrances; Fragrance emitting wicks for room fragrance; Air fragrance preparations; Aromatics for fragrances; Room fragrancing products; Air fragrancing preparations; Room fragrancing preparations; fragrances for automobiles.

27. All of the applicant’s goods in class 3 are intended to fragrance the air in which the product is situated. I acknowledge both parties’ interpretation of the terms “perfume” and “perfumery”. I am mindful of the guidance in *YouView* not to apply too liberal an interpretation of the goods at issue. To my mind, the average consumer of the opponent’s “*perfumery products”* will interpret the ordinary and natural meaning of the term as referring to goods which perfume the human body, rather than the likes of the applicant’s various air fragrancing products. I consider the competing goods to be different in their fundamental nature and method of use, although they both share the purpose of imparting fragrance. Neither are the goods in competition. However, both sets of goods may be purchased through general retail stores and their online equivalents, and there is an element of complementarity inasmuch that users of a particular perfume may seek out the same perfume in order to fragrance their home. It would not be unreasonable for the average consumer of the applicant’s various room fragrancing preparations to expect them to originate from the same or economically-linked undertakings as the opponent’s perfumery products. Taking all

[9] See paragraph 7(d) and (e) of the applicant’s written submissions dated 3 July 2023.

of these factors into account, I find there to be a medium degree of similarity between the applicant's goods and the opponent's "*perfumery products".*

Contested goods in Class 4

Candles; Candle torches; Soy candles; Perfumed candles; Tallow candles; Floating candles; soy candles; Tealight candles; Scented candles; Fragranced candles; Candles (Perfumed -); Table candles; Fruit candles; Nightlights [candles]; Votive candles; Candle assemblies; Church candles; Tea light candles; Christmas tree candles; Candles for lighting; Aromatherapy fragrance candles; Candles in tins; Candles (Christmas tree -); Candles for lighting Christmas lights [candles]; Special occasion candles; Musk scented candles; Candles containing insect repellent; Candles for night lights; Grave candles, non-electric; Candles for absorbing smoke; Candles for use as nightlights; Candles for lighting; Christmas tree decorations for illumination [candles]; Christmas tree ornaments for illumination [candles]; Bougies in the nature of wax candles.

28. The applicant's goods in Class 4 are all forms of candles. To my mind, candles perform the joint function of providing light and, in the case of candles which are scented, of fragrancing the atmosphere. In accordance with section 60A of the Act, just as the appearance of respective goods in the same class is not sufficient in itself to find similarity between those goods, neither are goods to be automatically found to be dissimilar simply because they fall in a different class. For the same reasons as given earlier in relation to the applicant's Class 3 goods, I find the above-listed goods in Class 4 similar to the earlier "*perfumery products"* in Class 3 to a medium degree.

Candle wax; wicks for candles for lighting; Wicks for candles; Wax for making candles; wicks for lighting; Beeswax for use in the manufacture of candles.

29. While the above goods are used as a component of a finished candle, they are different in nature, purpose and method of use to the opponent's "*perfumery products"* in Class . The users will be different and the goods, which are neither in competition nor complementary, are unlikely to be sourced from the same channels of trade. In the absence of evidence to the contrary, I find the goods to be dissimilar.

30. A degree of similarity between the goods is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA. In relation to the goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

31. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

32. In my view, the average consumer of the overlapping goods will be the general public. The goods are sold through a range of channels including drugstores, department stores and online. In retail outlets, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. In these circumstances, visual considerations will dominate the process, however I do not discount the aural element as the consumer may seek advice from sales staff. Although the price of the goods can vary considerably, on balance it seems to me that the cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. Overall, I consider the level of attention paid during the selection of the goods will be medium, although it is likely to be slightly higher for the most expensive perfumery products.

Comparison of marks

33. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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."[10]

34. 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.

35. The respective trade marks are shown below:

Opponent's trade mark	**Applicant's trade marks**
Z-BIOME	Series of 2 BIOME biome

Overall impression

36. The opponent's mark consists of the letter Z which is separated from the subsequent word "BIOME" by a hyphen. The whole is presented in a standard black

[10] Paragraph 34

typeface in capital letters. Neither element dominates and as the mark contains no other elements, the overall impression rests in the hyphenated letter/word combination.

37. The applicant's mark has been accepted and published as a series of two marks, pursuant to section 41(2) of the Act. They each comprise identical elements, being the word "BIOME". The first mark in the series is presented in capital letters in a mid-blue typeface, with the second mark presented in the same mid-blue typeface in lower case. The registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. While I note that the marks are stylised, I do not consider the typeface to deviate from a standard font. For convenience, I will from this point refer to the series in the singular, though my comments should be taken as referring equally to both marks in the series, unless expressed otherwise. As the mark contains no other elements, the overall impression rests in the word as presented.

Visual comparison

38. The opponent's mark and the contested mark share visual similarity by way of the word "BIOME", which makes up the entirety of the contested mark and is wholly incorporated in the opponent's mark. In *El Corte Inglés, SA v OHIM*,[11] the GC noted that the beginnings of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. The word "BIOME" in the earlier mark is preceded by the letter "Z" and a hyphen, which in my view will not go unnoticed by the average consumer. The later mark is presented in the colour blue, although I note that registration of a mark in black and white covers use of the mark in colour.[12] Considering the marks as a whole, I find there to be at least a medium degree of visual similarity between them.

Aural comparison

[11] Cases T-183/02 and T-184/02 at [81].
[12] See paragraph 5, *Specsavers* [2014] EWCA Civ 1294.

39. The common element in the competing marks is the word “BIOME”, which would be pronounced as either three syllables, BY-OH-ME, or as two syllables BY-OHM. It is the only element to be voiced in the applicant’s mark, and is the second element of the opponent’s mark. I consider that both the letter and the word elements in the earlier mark would be articulated, being voiced as either ZED-BY-OH-ME or ZED-BY-OHM. Whichever way the BIOME element is voiced, it will be articulated identically in both marks. Overall, I consider the competing marks to be aurally similar to at least a medium degree.

Conceptual comparison

40. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][13].

41. The opponent submits that the word “BIOME” means “a large and naturally occurring community of flora and fauna occupying a major habitat”. It further submits that the prefix “Z” of the earlier mark may be lost and receive less attention, and that the marks are therefore conceptually highly similar.[14]

42. To those consumers who recognise the meaning of the word “BIOME” as defined by the opponent, in spite of the word in the earlier mark being prefixed by the letter “Z”, taking into account the shared word “BIOME” I consider the marks to be conceptually similar to a high degree. The same can be said for those consumers who see the letters “BIO” in each of the marks as alluding to goods which are biological in nature.

43. However, I consider that a significant proportion of the average consumer will be unaware of any meaning attached to the word “BIOME” and will see it as an invented word with no clear and recognisable semantic content. I do not consider that the

[13] Paragraph 56.
[14] Paragraph 19 of the opponent’s written submissions in lieu dated 3 July 2023.

additional letter Z adds anything to the concept of the earlier mark. As such, in these circumstances, the marks are conceptually neutral.

Distinctive character of the earlier marks

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

45. 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 *WindsurfingChiemsee* 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)."

46. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

47. The opponent submits that the term “Z-BIOME” has no direct meaning of any kind in relation to the goods, and is therefore highly distinctive per se. Given the opponent’s earlier definition of the word “biome”,[15] to those consumers who recognise the meaning as being in relation to flora and fauna, the mark is allusive of the perfume present in the goods which has been sourced from such a habitat, and as such, the mark is inherently distinctive to a low to medium degree. As also mentioned earlier in the decision, for those consumers who see the letters “BIO” as alluding to goods which are biological in nature, the mark overall is again inherently distinctive to a low to medium degree.

48. Earlier in my decision, I found that the opponent’s marks would be perceived as an invented word by a significant proportion of the relevant consumer and therefore to those consumers who see no allusive qualities, the earlier mark will be inherently distinctive to a high degree.

Likelihood of confusion

49. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to

[15] At paragraph 42 of this decision.

make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

50. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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).”

51. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

52. Earlier in this decision, I found the majority of the contested goods to be similar to a medium degree to the opponent’s goods, with the remaining goods dissimilar. I considered that the level of attention of the average consumer, being the general public, would be medium when selecting the goods in common, although it would be slightly higher for the most expensive perfumery items. The goods, whilst not ignoring aural considerations, would be selected by predominantly visual means. I found the competing trade marks to be visually and aurally similar to at least a medium degree, and conceptually similar to a high degree where a meaning is attached to the word BIOME, but conceptually neutral when it is perceived as an invented word. The earlier mark is inherently distinctive to a high degree when seen as an invented word, but to a low to medium degree where it is considered allusive of the goods.

53. In her counterstatement, the applicant submits that she operates in different market sectors to the opponent, and that there is no risk of confusion. However, I must make my assessment based on how the goods might fairly be used now or in the future: *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P. Ms Black further submits that she has been using the mark BIOME prior to the opponent’s registration and that there has been no actual confusion, but in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. found that absence of evidence of confusion does not necessarily mean an absence of actual confusion.[16]

[16] At [80].

54. I note that the applicant has provided examples of trade marks which include the word "Biome" which are registered in classes 1 and 3 for goods which she submits are the same or similar goods to those of the opponent, and as such she sees no reason why her own application should not also be registered. However, this has no bearing on my assessment. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

55. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. I acknowledge the degree of visual and aural similarity between the marks, however, the differences between them appear at the start of each mark, which, as mentioned earlier in my decision, tends to have more impact on consumers than differences positioned at the end of a mark. It is my view that the average consumer, being reasonably well informed and reasonably circumspect, will notice and recall the differences between the marks. Consequently, I do not consider there to be a likelihood of direct confusion between the marks.

56. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

57. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

58. I note that there needs to be "a reasonably special set of circumstances for a finding of a likelihood of indirect confusion": *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.[17]

59. Keeping in mind the global assessment of the competing factors in my decision, it is my view that the average consumer will assume that the mark "BIOME" is the house mark, with the variant "Z-BIOME" representing a sub-brand, or they would assume that there is an economic connection between the undertakings. I therefore find that there is a likelihood of indirect confusion in relation to all the goods for which I found similarity.

60. The opposition under section 5(2)(b) of the Act succeeds in respect of the following goods:

Class 3 – *in its entirety.*
Class 4 - *Candles; Candle torches; Soy candles; Perfumed candles; Tallow candles; Floating candles; soy candles; Tealight candles; Scented candles; Fragranced candles; Candles (Perfumed -); Table candles; Fruit candles; Nightlights [candles]; Votive candles; Candle assemblies; Church candles; Tea light candles; Christmas tree candles; Candles for lighting; Aromatherapy fragrance candles; Candles in tins; Candles (Christmas tree -); Candles for lighting Christmas lights [candles]; Special occasion candles; Musk scented candles; Candles containing insect repellent; Candles for night lights; Grave candles, non-electric; Candles for absorbing smoke; Candles for use as nightlights; Candles for lighting; Christmas tree decorations for*

[17] At [13].

illumination [candles]; Christmas tree ornaments for illumination [candles]; Bougies in the nature of wax candles.

61. The opposition fails in respect of the remaining goods which I found to be dissimilar, shown below under paragraph 62.

CONCLUSION

62. Subject to any successful appeal, the application by Lucy Black may proceed to registration in respect of the following goods only:

Class 4 - *Candle wax; wicks for candles for lighting; Wicks for candles; Wax for making candles; wicks for candles for lighting; wicks for lighting; Beeswax for use in the manufacture of candles.*

COSTS

63. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. I have made a slight reduction to the costs on account of the partial success of the opponent. Applying the guidance in that TPN, I award the opponent the sum of £800, which is calculated as follows:

Official fee:	£100
Preparing a statement and considering the counterstatement:	£200
Filing written submissions:	£300
Considering the other side's evidence:	£200
Total:	**£800**

64. I therefore order Lucy Black to pay Givaudan SA the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 19th day of October 2023

Suzanne Hitchings
For the Registrar,
the Comptroller-General