

O/033/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003425586
BY BEAU MONDE (HONG KONG) COMPANY LIMITED
TO REGISTER THE TRADE MARK:**

BLOOMIST

IN CLASS 21, 26, 31 and 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418715
BY FISKARS FINLAND OY AB**

Background and pleadings

On 3 September 2019, Beau Monde (Hong Kong) Company Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 13 September 2019. The applicant seeks registration for the following goods and services:¹

Class 21 Decorative Vases; Decorative Pots; Decorative Flower pots; Decorative Plant pots; Decorative Bowls for plants; Decorative Dishes; Decorative Plates; Decorative Flower vases; Decorative Holders for flowers and plants [flower arranging]; Decorative Baskets for household purposes; all the aforesaid goods being decorative home furnishings.

Class 26 Artificial Christmas garlands; Artificial Christmas wreaths; Artificial flower arrangements; Artificial flowers; Artificial fruit; Artificial garlands; Artificial plants; Embroidery; Fancy goods [embroidery]; Hair bands; Wreaths of artificial flowers; Needle cushions; Ribbons and bows, not of paper, for gift wrapping.

Class 31 Dried flower arrangements; Dried flowers; Dried plants for decoration.

Class 35 Presentation of companies and their goods and services on the Internet; Provision of commercial information via the Internet; Providing consumer product information via the Internet; Arranging commercial transactions, for others, via online shops; Retail services relating to flowers; Retail services in relation to furnishings; Import-export agency services; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses].

The application was partially opposed by Fiskars Finland Oy Ab (“the opponent”) on 10 December 2019. The opposition is based upon section 5(2)(b) of the Trade Marks

¹ Following an amendment to the applicant’s specifications on 10 June 2020

Act 1994 (“the Act”). For the purposes of its opposition based upon section 5(2)(b), the opponent relies on the following trade mark:

BLOMST

EUTM registration no. EU017966077

Filing date 8 October 2018; registration date 7 February 2019.

Relying upon all goods for which the earlier mark is registered, namely:

Class 21 Household or kitchen utensils and containers; tableware, other than knives, forks and spoons; dinnerware; tea services [tableware]; coffee services [tableware], dishes and plates; drinking glasses and mugs; bowls and tureens; cookie jars; jugs and jars; sugar bowls; pepper pots; salt shakers; flower pots and vases; glassware, porcelain and ceramic ware [household or kitchen utensils]; decorative plates and figurines or glass, porcelain or ceramic.

The opponent claims that its mark is similar to the applicant’s mark and is opposing all goods covered in class 21 for which the applicant seeks protection.

The applicant filed a counterstatement denying the claims made.

The opponent is represented by Mewburn Ellis LLP and the applicant is represented by CSY Herts. Neither party filed evidence nor requested a hearing. However, the applicant and opponent both filed written submissions in lieu. Whilst I do not propose to summarise those submissions here, I have taken them into consideration, and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

Section 5(2)(b)

Section 5(2)(b) reads 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.”

An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) case law

The following principles 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 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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

The applicant submitted that “The Opponent’s broad terms “household or kitchen utensils and containers” and “decorative plates and figurines of glass, porcelain or ceramic” encompasses the Opposed Goods. So the parties’ respective goods are identical”. I will, therefore, proceed on the basis that all of the goods are identical.

The average consumer and the nature of the purchasing act

As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings*

Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

As submitted by the applicant, the average consumer “could be a professional interior designer or someone purchasing a decorative item for their own home, or as a gift”. I consider that the average consumer is most likely to be a member of the general public, however, I do not discount that it could also include a professional user. I note the applicant’s submission that a high level of attention will be paid during the purchasing process. However, although prices can vary considerably, on balance it seems the cost of the purchase is likely to be relatively low. The majority of the goods are long lasting and therefore will have a low frequency of purchase. The average consumer will take various factors into consideration such as the aesthetic, material and size. Therefore, I consider the level of attention paid during the purchasing process will be medium.

The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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.

The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
BLOMST	BLOOMIST

The opponent's mark consists of the invented word BLOMST. There are no other elements to contribute to the overall impression of the mark which lies in the word itself.

The applicant's mark consists of the invented word BLOOMIST. There are no other elements to contribute to the overall impression of the mark which lies in the word itself.

Visually, the parties agree that the words BLOMST and BLOOMIST overlap to the extent that they both begin with the letters “BLO” and end with the letters “ST”. The marks both share the letter “M” in the middle, however, the applicant’s mark has two additional letters either side of the “M”, an “O” and “I”. The different letters are in the middle of the words which makes them less striking. I consider the marks to be visually similar to between a medium and high degree.

Aurally, the opponent’s mark will be pronounced BLOM-ST and the applicant’s mark will be pronounced as BLOOM-IST or as the applicant argues in their submissions BLUE-MIST/BLOO-MIST.

As submitted by the opponent, the pronunciation of “BL” at the beginning of both marks acts as a point of aural similarity between the two. The common ending of “ST” is also a point of aural similarity. I note the opponent’s submission that the “change from a single “O” to a double “O”, is an utterly insignificant difference”. However, in my view this difference does change the pronunciation. Taking all of this into account, I consider that the marks are aurally similar to between a low and medium degree.

Conceptually, both parties submit that BLOMST is the Danish word for bloom or flower. However, the opponent submits that “only a tiny fraction” of the UK average consumer will know this. I agree. I do not consider that a significant proportion of average consumers would know this meaning. In my view, the opponent’s mark is likely to be viewed as an invented word which would be attributed no particular meaning. The applicant’s mark is also an invented word. The applicant submits that the word BLOOMIST would be recognised and understood by the average consumer as “blue mist” as “bloo” is a common misspelling of “blue”. However, I disagree. It is far more likely that the average consumer would recognise the word BLOOM which appears in the applicant’s mark because it is an ordinary dictionary word, which the average consumer is likely to understand and recognise. Consequently, as one mark conveys a recognisable concept and the other does not, I consider that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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 that has been made of it.

The opponent has not pleaded enhanced distinctiveness, nor has it filed any evidence. I have, therefore, only the inherent position to consider. The word BLOMST is an invented word which is neither allusive nor descriptive in relation to the goods for which the mark is registered. Therefore, I consider the opponent's mark to be inherently distinctive to a high degree.

Likelihood of confusion

Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a medium and high degree.
- I have found the marks to be aurally similar to between a low and medium degree.
- I have found the marks to be conceptually dissimilar.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer to be a member of the general public or a professional user, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties goods to be identical.

The conceptual dissimilarity between the marks could point in favour of the applicant. In *Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

However, I recognise that conceptual differences do not always overcome visual and/or aural similarities.² For example, in *Diramode S.A. v Richard Turnham and Linda Turnham* (BL O/566/19), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, overturned a decision that the conceptual differences between PIMKIE and PINKIE were sufficient to outweigh the visual and aural similarities between them. Mr Geoffrey Hobbs QC found that:

‘Even though one of the marks in issue refers to a clear and immediately apparent concept and the other does not have a clear meaning which can be immediately perceived by the relevant public, the degree of visual and aural similarity between them may still be sufficient to give rise to the existence of a likelihood of confusion’.

Whether or not the conceptual differences are sufficient to outweigh the visual and aural similarities must be decided on the facts of each particular case. However, in this case, I consider it unlikely that the that the conceptual differences between the marks will offset the visual similarities, particularly in what I have found to be a predominantly visual purchasing process. This is particularly the case bearing in mind the principle of imperfect recollection, the distinctiveness of the opponent’s mark and the fact that the marks are registered/applied for identical goods. I am satisfied that the average consumer is likely to mistakenly recall or misremember one mark for the other,

² *Nokia Oyj v OHIM*, Case T-460/07

overlooking the additional “O” and “I” in the applicants mark. I consider there to be a likelihood of direct confusion.

Conclusion

The opposition based upon section 5(2)(b) is successful in its entirety and the application is refused for the following goods:

Class 21 Decorative Vases; Decorative Pots; Decorative Flower pots; Decorative Plant pots; Decorative Bowls for plants; Decorative Dishes; Decorative Plates; Decorative Flower vases; Decorative Holders for flowers and plants [flower arranging]; Decorative Baskets for household purposes; all the aforesaid goods being decorative home furnishings.

The opposition was not directed against the following goods and services for which the application can proceed to registration:

Class 26 Artificial Christmas garlands; Artificial Christmas wreaths; Artificial flower arrangements; Artificial flowers; Artificial fruit; Artificial garlands; Artificial plants; Embroidery; Fancy goods [embroidery]; Hair bands; Wreaths of artificial flowers; Needle cushions; Ribbons and bows, not of paper, for gift wrapping.

Class 31 Dried flower arrangements; Dried flowers; Dried plants for decoration.

Class 35 Presentation of companies and their goods and services on the Internet; Provision of commercial information via the Internet; Providing consumer product information via the Internet; Arranging commercial transactions, for others, via online shops; Retail services relating to flowers; Retail services in relation to furnishings; Import-export agency services; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses].

Costs

The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£650** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing and filling written submissions in lieu	£350
Official Fee	£100
Total	£650

I therefore order Beau Monde (Hong Kong) Company Limited to pay Fiskars Finland Oy Ab the sum of £650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 13th day of January 2021

L FAYTER

For the Registrar