

**o/859/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003665879**

**BY ARFAN ALI CHOCHAN**

**TO REGISTER THE TRADE MARK:**

**Bath Bliss**

**IN CLASSES 3, 4, 21, 24 AND 27**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 600002170**

**BY BLISS PRODUCTS HOLDINGS LLC**

## BACKGROUND AND PLEADINGS

1. On 8 July 2021, Arfan Ali Chohan (“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 the 22 October 2021 and registration is sought for the goods set out in the Annex to this decision.

2. On 21 January 2022, the application was partially opposed by Bliss Products Holdings LLC (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods of the application:

Class 3      Bath Bombs.

3. Under section 5(2)(b) the opponent relies upon the following trade mark:

# BLISS

UK registration no. UK00003448543

Filing date 2 December 2019.

Registration date 8 August 2020.

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

Class 3      Bleaching preparations and other substances for laundry use; cleaning, polishing scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, dentifrices; skincare preparations, moisturizers, lotions, creams, scrubs, serum, balms, masks, gels, cleansers and toners; fragrances; bath salts, cosmetic preparations for baths; shower gels and creams; body firming gels and lotions, nail polishes, lipsticks, makeup, sun block, deodorants; face and body oils.

4. The opponent claims that there is a likelihood of confusion because of the similarity of the marks and the identity/similarity of the goods.

5. The applicant filed a counterstatement denying the claims made.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

8. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. The opponent is represented by HGF Limited, and the applicant is unrepresented. A hearing was neither requested nor considered necessary, however, the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **PRELIMINARY ISSUE**

11. In its counterstatement, the applicant has submitted the following:

“There are dozens of Trade marks with the name “BLISS” and many fall in the same Class 3 which is mentioned by the opposition. The important aspect is that some of those Trademarks were registered before and some were registered AFTER the opposition Trademark was registered. It is strange that they were not opposed by the opponent.

Here are some trade mark number for reference;

UK00003448543

UK00003530503

UK00003532997

UK00003657217.”

12. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 the General Court (“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). “

13. Firstly, as highlighted by the opponent in its submissions in lieu, the first three marks listed above stand in the name of the opponent, including the mark it is relying upon for these proceedings (UK00003448543). Regardless, the mere fact that there are multiple BLISS marks on the Register (either in this jurisdiction or in the EU) is not

relevant to my assessment. I have no evidence of how (if at all) these marks have been used in practice. This submission, therefore, does not assist the applicant.

## **DECISION**

14. 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.”

15. 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 ... 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]"

16. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

[...]"

17. 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(1)(a) of the Act. As the opponent's mark had not completed its registration process more than 5 years before the filing date of the mark in issue, it is not subject to proof of use pursuant to section 6A(1) and (1A) of the Act. The opponent is entitled to rely upon all of the goods for which the mark is registered.

### **Section 5(2)(b) case law**

18. 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**

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. 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.”

20. I consider that the applicant’s “bath bombs” falls within the broader category of “cosmetic preparations for baths” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

### **The average consumer and the nature of the purchasing act**

21. 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.”

22. The average consumer for the goods will be members of the general public. The cost of the goods in question is likely to be relatively low and will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, ingredients and fragrance. Therefore, the level of attention paid during the purchasing process will be medium.

23. The goods are likely to be obtained by self-selection from the shelves of a (beauty) retail outlet, or online equivalent. Visual considerations are, therefore, likely to

dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

### **Comparison of the trade marks**

24. 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 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.”

25. 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.

26. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<b>BLISS</b>	<b>Bath Bliss</b>

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

28. The applicant's mark consists of the words Bath Bliss. Albeit the consumer tends to pay more attention to the beginning of marks, I consider that the word 'Bath' is descriptive of the applicant's 'bath' bombs, and how/where to use them. Therefore, I consider that the word 'Bliss' will play a greater role in the overall impression, with the word 'Bath' playing a lesser, non-distinctive role.

29. Visually, the marks coincide in the word BLISS. This acts as a visual point of similarity. However, the applicant's mark begins with the word 'Bath' which acts as a visual point of difference. Consequently, I consider that the marks are visually similar to at least a medium degree.

30. Aurally, the marks overlap in the pronunciation of the word BLISS. However, the applicant's mark will start with the pronunciation of the word 'Bath'. Therefore, I consider that the marks are aurally similar to no more than a medium degree.

31. Conceptually, both marks overlap in the meaning of the word BLISS, which is defined as a state of complete happiness.<sup>1</sup> I consider that this is allusive of the state the consumer would be in after using the opponent's and applicant's products. The applicant's mark also contains the word bath, which as established above, is descriptive of the applicant's goods which are to be used within the bath. I also note that the overall meaning of bath and bliss together would mean a state of happiness in the bath. Regardless, as both marks share the meaning of the word BLISS, I consider that the marks are conceptually similar to between a medium and high degree.

### **Distinctive character of the earlier trade mark**

32. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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<sup>1</sup> <https://www.collinsdictionary.com/dictionary/english/bliss>

“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).”

33. 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, 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.

34. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

35. As established above, the word BLISS evokes the concept of complete happiness, which is allusive/suggestive of the state or feeling the consumer would be in using the opponent’s goods. Therefore, I consider that the distinctive character of the opponent’s mark is between a low and medium degree.

## Likelihood of confusion

36. 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 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 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.

37. 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 at least a medium degree.
- I have found the marks to be aurally similar to no more than a medium degree.
- I have found the marks to be conceptually similar to between a medium and high degree.
- I have found the opponent's mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer to be members of the general public 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 for the goods.
- I have found the parties' goods to be identical.

38. I recognise that the word BLISS is allusive/suggestive of the way in which the opponent's goods will make the user feel, and therefore is inherently distinctive to between a low and medium degree. However, I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

39. Taking all of the factors listed in paragraph 37 into account, bearing in mind the principle of imperfect recollection, I consider that there is a likelihood of direct confusion. This is particularly the case given the relatively high visual similarity (to at least a medium degree) between the marks and the predominantly visual purchasing process. Albeit the beginnings of marks tend to make more of an impact than the ends, in these circumstances, the word 'Bath' in the applicant's mark is entirely descriptive of how to use the goods (bath bombs) and therefore would be easily overlooked by the average consumer. Consequently, I consider there to be a likelihood of direct confusion between the two marks.

40. In the event that I am wrong in that regard, and for the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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."

41. I consider that the shared common use of the word BLISS in both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the additional word 'Bath' which is descriptive of how/where to use the applicant's goods, and will perceive it as an alternative mark for a sub-brand of 'BLISS' specifically focussed on products intended to be used in the bath. Therefore, as the average consumer will perceive the marks as originating from the same or economically linked undertakings, I also consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

42. The opposition is successful in its entirety and the application is, in respect of the following goods, refused:

Class 3      Bath Bombs.

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

Class 4      Bath Candles.

Class 21     Bath Trays.

Class 24     Bath Towels.

Class 27     Bath Mats.

## **COSTS**

44. Award of costs in fast track proceedings are governed by TPN 2/2015. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of **£500** 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	£200
Official Fee	£100
<b>Total</b>	<b>£500</b>

45. I therefore order Arfan Ali Chohan to pay Bliss Products Holdings LLC the sum of £500. 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 4<sup>th</sup> day of October 2022**

**L FAYTER**  
**For the Registrar**



## ANNEX

### **The applicant's mark**

#### Class 3

Bath Bombs.

#### Class 4

Bath Candles.

#### Class 21

Bath Trays.

#### Class 24

Bath Towels.

#### Class 27

Bath Mats.