

O/0989/24

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO. 3798127
IN THE NAME OF CRYSTAL INTERNATIONAL COMPANY LIMITED
TO REGISTER**

BEEBLISS

**AS A TRADE MARK IN CLASS 14
AND
OPPOSITION THERETO (UNDER NO. 437843)
BY
DAMIANI INTERNATIONAL SA**

Background and pleadings

1. On 13 June 2022, CRYSTAL INTERNATIONAL COMPANY LIMITED (“***the Applicant***”) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003798127 (“***the Contested Mark***”). Details of the application were published for opposition purposes on 2 September 2022. Registration is sought for the following goods:

Class 14 Agates; jewellery of yellow amber; spun silver [silver wire]; silver thread [jewellery]; bracelets [jewellery]; chains [jewellery]; necklaces [jewellery]; threads of precious metal [jewellery]; jewellery; olivine [gems]; peridot; gold thread [jewellery]; pearls [jewellery]; semi-precious stones; precious stones; rings [jewellery]; jade sculptures; silver figurines; rubelite [precious stones]; spinel [precious stones].

2. On 2 December 2022, DAMIANI INTERNATIONAL SA (“***the Opponent***”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”). The Opponent relies upon the prior trade mark registration set out in the Annex to this decision (“***the Earlier Mark***”). The opposition is directed against all the goods in class 14.
3. For the purposes of the opposition, the Opponent relies upon some of the goods and services for which the Earlier Mark is registered as indicated in the Annex.
4. The Earlier Mark claims a priority date of 17 December 2020 from the (EU) trade mark number 018356822. By virtue of its earlier filing date, the prior registration set out in the Annex constitute an earlier mark within the meaning of section 6 of the Act.
5. Given the registration date of the Earlier Mark (as indicated in the Annex), it had not completed its registration process more than five years before the filing date of the application in issue. Thus, 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 and services it has identified without having to demonstrate use.

6. In its notice of opposition,¹ the Opponent essentially contends that the Contested Mark is conceptually, aurally, and visually similar to the Contested Mark as they share the dominant component “BLISS” and that the contested goods are identical or highly similar to the Opponent’s goods and services, giving rise to a likelihood of confusion under section 5(2)(b) of the Act, including a likelihood of association.
7. On 16 February 2023, CRYSTAL INTERNATIONAL COMPANY LIMITED filed its defence and counterstatement, denying the grounds of opposition. More specifically, the Applicant argued that the respective marks merely share the word “bliss” which has a low level of distinctiveness; first, because it is laudatory and, second, because different businesses use and have registered trade marks containing “BLISS”. Thus, consumers are accustomed to seeing various “bliss” businesses in the jewellery market. Furthermore, the Applicant argued that the respective marks are visually, aurally, and conceptually different given their respective structure, with the result that the attentive relevant consumer will not confuse or associate the competing marks.
8. Subsequent to the filing of the counterstatement, a preliminary indication was issued to the parties under the provision of Rule 19 of The Trade Marks Rules 2008.² That indication was that the opposition would fail. The Applicant gave notice that it wished to proceed to evidence rounds.³ The preliminary indication, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision.
9. The Opponent is represented by Beck Greener LLP. The Applicant is represented by Gateley Plc.

Relevance of EU law

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

¹ Dated 16 December 2022.

² Official letter dated 21 March 2023.

³ As per form TM53, filed on 24 April 2023.

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

11. During the evidence rounds the Opponent filed submissions and evidence in the form of a witness statement from Christian Rowland Buehrlen with Exhibits CRB1 – CRB4.⁴ The Applicant filed a witness statement, dated 18 October 2023, from Paven Munder and Exhibits PKM1 – PKM3. The Opponent filed evidence in reply, dated 31 January 2024, in the form of a witness statement from Christian Rowland Buehrlen and Exhibits CRB5 – CRB10. Neither party requested a hearing, but the Applicant⁵ and the Opponent⁶ filed submissions in lieu. The evidence and submissions will not be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Decision

The law

12. The relevant parts of section 5 of the Act are as follows:

“5(1) [...]

(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.”

“5A 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

⁴ Both submissions and evidence dated 18 August 2023.

⁵ Dated 8 March 2024.

⁶ Dated 8 March 2024.

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

13. The leading authorities which guide me are from the Court of Justice of the European Union (“CJEU”): *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.

The Principles

(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 and services

14. The competing goods and services are as follows:

Opponent's goods	Applicant's goods
<u>Class 14</u>	<u>Class 14</u>
Jewellery; Jewellery being articles of precious stones; Jewellery findings; Articles of jewellery with ornamental stones; Jewellery incorporating diamonds; Jewellery containing gold; Pearls [jewellery]; Jewellery made from silver; Horological articles; Semi-precious articles of bijouterie; Paste jewellery; Rings [jewellery]; Gold rings; Chronoscopes; Chronometric	Agates; jewellery of yellow amber; spun silver [silver wire]; silver thread [jewellery]; bracelets [jewellery]; chains [jewellery]; necklaces [jewellery]; threads of precious metal [jewellery]; jewellery; olivine [gems]; peridot; gold thread [jewellery]; pearls [jewellery]; semi-precious stones; precious stones; rings [jewellery]; jade sculptures; silver figurines; rubelite [precious stones]; spinel [precious stones].

apparatus and instruments; Silver and its alloys; Bracelets; Bracelets [jewellery]; Bracelets of precious metal; Jewel chains; Chains [jewellery]; Closures for necklaces; Clasps for jewellery; Pendants; Trinkets coated with precious metal; Jewelry charms in precious metals or coated therewith; Key charms coated with precious metals; Necklaces [jewellery]; Chronographs [watches]; Chronometers; Diadems; Diamonds; Wedding rings; Tie clips of precious metal; Cuff links of precious metal; Gems; Pearl; Semi-finished articles of precious metals for use in the manufacture of jewellery; Semi-finished articles of precious stones for use in the manufacture of jewellery; Threads of precious metal [jewellery]; Silver thread [jewellery]; Threads of precious metals; Precious and semi-precious gems; Gold alloys; Gold; Imitation precious stones; Alloys of precious metal; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Platinum [metal]; Semi-wrought precious stones and their imitations; Natural gem stones; Precious and semi-precious stones; Unwrought precious stones; Natural pearls; Topaz; Sapphires; Emeralds;

Jades; Jewellery being articles of precious metals; Jewellery incorporating precious stones; Jewellery made of precious metals; Jewellery fashioned from non-precious metals; Processed or semi-processed precious metals; Objet d'art made of precious stones; Earrings; Earrings of precious metal; Ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof; Time instruments; Watches made of precious metals; Wristwatches; Pocket watches; Cases for clock- and watchmaking; Clock hands; Table clocks; Jewel pendants; Cabochons; Precious stones; Platinum and its alloys; Key fobs of precious metals; Pins [jewellery]; Silver; Spun silver [silver wire]; Unwrought silver; Figurines made from silver; Silver-plated bracelets; Silver-plated earrings; Silver-plated rings; Silver, unwrought or beaten; Clips of silver [jewellery]; Silver-plated necklaces; Cuff links made of silver plate; Silver rings; Silver necklaces; Silver earrings; Silver bracelets; Silver alloys; Silver watches; Sterling silver jewellery; Unwrought silver alloys; Objet d'art of enamelled silver; Silver objets d'art; Silver alloy ingots; Shoe

<p>jewellery; Precious jewellery; Trophies coated with precious metals; Jewellery made of precious stones; Cases of precious metals for horological articles; Tie chains of precious metal; Tie pins; Jewelry boxes of precious metal; Jewellery chain of precious metal for anklets; Wire thread of precious metal; Works of art of precious metal; Hat jewellery; Jewellery chain of precious metal for necklaces; Jewellery chain of precious metal for bracelets; Model figures [ornaments] coated with precious metal; Watches made of precious metals or coated therewith; Key fobs [rings] coated with precious metal; Presentation boxes for gemstones; Key chains of precious metal; Articles of jewellery coated with precious metals; Watch bands; Clocks; Plastic costume jewellery; Imitation jewellery ornaments; Jewellery charms; Body jewellery; Body costume jewellery; Artificial stones [precious or semi-precious]; Fancy keyrings of precious metals; Key chains as jewellery [trinkets or fobs]; Key rings [split rings with trinket or decorative fob]; Key rings [trinkets or fobs] of precious metal.</p>	
<p><u>Class 35</u></p>	

Retail services in relation to jewellery; Online retail services relating to jewelry; Shop window dressing; Retail shop window display arrangement services; Display services for merchandise; Bill-posting.	
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15. The Applicant conceded⁷ that the contested goods in class 14 are similar to the Opponent's goods and services. I agree with the Applicant. More specifically, for the purposes of this opposition and the global appreciation test, I find the respective goods to be identical as indicated below.

- “*jewellery of yellow amber*”; “*silver thread [jewellery]*”; “*bracelets [jewellery]*”; “*chains [jewellery]*”; “*necklaces [jewellery]*”; “*threads of precious metal [jewellery]*”; “*jewellery*”; “*gold thread [jewellery]*”; “*pearls [jewellery]*”; “*rings [jewellery]*”

16. The terms above fall within the Opponent's wider category of “*Jewellery*”. Thus, they are identical in line with *Meric*.

- “*spun silver [silver wire]*”

17. The Applicant's “*spun silver [silver wire]*” is self-evidently identical to the Opponent's “*Spun silver [silver wire]*”.

- “*Agates*”; “*olivine [gems]*”; “*peridot*”; “*semi-precious stones*”; “*precious stones*”; “*rubelite [precious stones]*”; “*spinel [precious stones]*”

18. The terms above fall within the wider category of Opponent's “*Precious and semi-precious gems*”. Thus, they are identical in line with *Meric*.

- “*silver figurines*”

19. Albeit worded differently, the Applicant's “*silver figurines*” is identical to the Opponent's “*Figurines made from silver*”.

⁷ Submissions in lieu dated 8 March 2024 at paragraph 27.

- “jade sculptures”

20. The Applicant’s “jade sculptures” falls within the Opponent’s wider term “*Objet d’art made of precious stones*”. Therefore, these goods are identical based on *Meric*.

21. The Opponent relies upon the Earlier Mark’s goods in class 14 and the services in class 35. The Contested Mark was filed exclusively for class 14 and the Opponent’s specification in class 14 fully encompasses the Applicant’s goods. In light of the above considerations, it seems to me that the Opponent’s strongest case clearly lies in the assessment of the likelihood of confusion based upon class 14. If the Opponent does not succeed on the basis of identical goods, it would not succeed on the basis of its services which, at best, would be no more than similar to the Applicant’s goods. Thus, I will proceed accordingly.

The average consumer and the nature of the purchasing act

22. It is necessary to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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”.

23. The average consumer of the category of goods concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

24. For the purposes 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 in question.⁸

25. The average consumer for the goods in Class 14 (jewellery and precious or semi-precious stones) will be a member of the general public as well as professionals (i.e., jewellers or jewel makers). I consider the costs of the goods to range from relatively low (for jewels made with low-cost materials) to possibly fairly high (for products crafted from valuable metal such as gold and that may be adorned with precious or semi-precious stones). The average consumer will likely consider the material of which the goods are made, size, fit, and make aesthetic considerations. The professional public is likely to carry out further considerations on the materials' quality and, hence, will pay a higher level of attention. I therefore find the degree of attention will vary from medium (average) for the general public to above average for the professionals. However, the likelihood of confusion must be assessed from the perspective of the former (the general public) since they are the group who will pay the lower degree of attention.⁹ I consider the purchase of the goods to be mainly visual with the mark being placed on or next to the goods on display in retail premises, in dedicated jewellery shops, or online (i.e., pictures of jewellery on websites); however, I do not discount aural considerations will play their part, particularly when advice is sought from sales representatives or for word of mouth recommendations.

Comparison of trade marks

26. 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.

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

⁹ Case T-356/14, [25] – [26].

27. 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”.

28. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

29. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
	BEEBLISS

Overall impression

30. The Earlier Mark features the word “bliss” represented in a stylised font with the rounded part of the letter “b” extending outside the letter itself and the letters “l” and “i” having a prolonged base. Underneath “bliss” the Earlier Mark features the all-capitalised word “GIOIELLI” being smaller in size and spaced to match the length of “bliss” above. Both words are contained in a bold-edged square. Whilst “bliss” is placed in a visually prominent position and “GIOIELLI” is smaller in size

and placed in a less prominent position, the latter is still clearly visible and is also the more distinctive of the two words in the mark because it is likely to be perceived as an invented word or one of foreign origin and unknown meaning. Bearing this in mind, I find that both words equally contribute to the overall impression of the mark. The bold-edged square device plays the least role in the overall impression of the mark.

31. The overall impression of the Contested Mark resides in the single word of which it is composed.

Visual similarity

32. The Earlier Mark consists of the two words “bliss” and “GIOIELLI” contained in a black square. The Contested Mark is comprised of the all-capitalised, eight-letter word “BEEBLISS”. The marks overlap to the extent that they both contain the letter sequence “bliss”. In the Earlier Mark “bliss” stands as an individual word (accompanied by “GIOIELLI” underneath) whilst in the Contested Mark “bliss” forms the ending part of the letter combination “BEEBLISS”. The additional word “GIOIELLI” and the black square, although having a reduced visual impact in respect to the more visually prominent word “bliss”, introduce elements of further visual differentiation between the respective marks. Therefore, I find the respective marks to have a below medium degree of visual similarity.

Aural similarity

33. The Earlier Mark is comprised of the one-syllable word “bliss” and the word “GIOIELLI” which may be pronounced in various ways. For example, as “joe-elly” or “joe-ee-elly”. The Contested Mark features the two-syllable word “BEEBLISS” which will be pronounced “BEE-BLISS”.

34. Therefore, the relevant consumer will voice in both marks the word “bliss”. However, in the Contested Mark “bliss” is placed at the end of the mark and since the relevant consumers are likely to pay more attention to the beginnings of marks,¹⁰ I find that the point of similarity between the marks is lessened by its position. Additionally, the relevant consumers will find the Earlier Mark longer in its

¹⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

enunciation than the Contested Mark owing to the additional syllables created by the word 'GIOIELLI'.

35. Overall, I find the marks to be aurally similar to a below-medium degree.

Conceptual similarity

36. Both parties submitted that “bliss” corresponds to the English dictionary word meaning a state of “perfect happiness”, “extreme happiness”, or “supreme happiness”.¹¹ Thus, in the Earlier Mark the relevant consumers are likely to understand the mark as conveying the meaning of extreme happiness. The word “GIOIELLI” stands for the Italian word for “jewels”, however the English relevant consumer is unlikely to understand such meaning and will likely perceive the word as an invented or unknown foreign word with no immediately graspable meaning. In the Contested Mark, the relevant consumer is likely to read the dictionary words “bee” (indicating an insect with a yellow-and-black striped body that flies and can sting) and “bliss” (indicating a state of perfect joy). Therefore, both marks evoke the idea of extreme happiness, however the addition of “bee” in the Contested Mark lessens the conceptual similarity between the marks. Overall, I find the marks to have a low degree of conceptual similarity.

Distinctive character of the Earlier Mark

37. 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 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

¹¹ Witness statement from Paven Munder dated 18 October 2023 and witness statement from Christian Buehrlen dated 31 January 2024.

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).”

38. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words.

39. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.

40. The Earlier Mark features the English dictionary word “BLISS” and “GIOIELLI” (which is the Italian word for “jewels” but the average UK consumer will not be aware of this). Of itself, the word ‘GIOIELLI’ is therefore highly distinctive. However, I remind myself that it is the distinctiveness of the common element which is important and the common element in the case before me is the word ‘bliss’. It is the distinctiveness of that element which is key¹². In its counterstatement, the Applicant argued that “BLISS” is the dictionary definition of “perfect happiness” or “serene joy” and, thus, the Earlier Mark possesses low distinctiveness as it is a laudatory term indicating “*the feelings evoked in customers by jewellery goods*”. The Opponent argued that “BLISS” is not a laudatory term, and it merely indicates a state of mind.¹³. I appreciate that “BLISS” evokes the concept of complete happiness, which is, in my view, allusive/suggestive of the state or feeling the consumers would be in using the Opponent’s goods. As such, I find that that

¹² *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, [38] – [39].

¹³ Witness statement from Christian Rowland Buehrlen dated 31 January 2024.

element of the earlier mark has a below-medium degree of inherent distinctiveness. The evidence before me from the applicant showing that various businesses use the word “bliss” to market their jewellery in the UK and that there are various marks on the register containing the word ‘bliss’ has had no bearing on this finding. That evidence is not sufficient to show that the word “bliss” is so widespread for the relevant goods that such use has had any bearing on the earlier mark’s distinctive character. Nevertheless, as I have said, inherently, I consider that ‘bliss’ has a below-medium degree of distinctiveness. Therefore, whilst I find that the Earlier Mark has a high degree of distinctiveness overall, that degree of distinctiveness is attributable to the word ‘GIOIELLI’ which has no counterpart in the contested mark. The common element between the marks has a below-medium degree of inherent distinctive character.

Likelihood of confusion

41. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).
42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).
43. I have found the respective goods to be identical. The level of attention is medium for the general public. The distinctiveness of the Earlier Mark is high but the distinctiveness of the common element is below-medium. The degree of visual and aural similarity is below-medium and the conceptual similarity is low. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. Weighing these factors, I find that the marks are unlikely to

be mistakenly recalled or misremembered as each other and I do not consider there to be a likelihood of direct confusion.

44. It now falls to me to consider the likelihood of indirect confusion. The concept of 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.

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. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.¹⁴ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹⁵ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.¹⁶

46. Following the considerations above, I found “bliss” not to be so strikingly distinctive to the extent that consumers, when confronted with a mark containing “bliss”, are likely to believe that it must exclusively refer to the Opponent. Also, I do not believe the relevant consumers will perceive the Contested Mark as a sub-brand or brand extension deriving from the Earlier Mark. This is because the addition of “bee” to “bliss” (to form one word) is unlikely to lead the consumers to believe that the Contested Mark represents a sub-brand or brand extension of the Earlier Mark. The later mark also does not strike me as being entirely logical or consistent with a brand extension of the earlier mark. Therefore, I do not find that there is a likelihood of indirect confusion.

Conclusion

47. The opposition fails under section 5(2)(b) of the Act.

48. The Applicant has been successful. Subject to any successful appeal, the application by CRYSTAL INTERNATIONAL COMPANY LIMITED may proceed to registration.

Costs

49. The Applicant has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 2/2016. Bearing that scale in mind, I award costs to the Applicant as follows:

¹⁴ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

¹⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

¹⁶ *Liverpool Gin Distillery*.

Considering the notice of opposition and preparing the counterstatement	£200
Preparing evidence and considering and commenting on the other side's evidence	£500
Submissions in lieu	£300
Total:	£1,000

50.I order DAMIANI INTERNATIONAL SA to pay CRYSTAL INTERNATIONAL COMPANY LIMITED the sum of **£1,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of October 2024

Andrea Rossi

For the Registrar

ANNEX

The Opponent's Earlier Mark

1) UK00003655426



Mark:

Goods and services relied upon for the opposition:

Class 14 Jewellery; Jewellery being articles of precious stones; Jewellery findings; Articles of jewellery with ornamental stones; Jewellery incorporating diamonds; Jewellery containing gold; Pearls [jewellery]; Jewellery made from silver; Horological articles; Semi-precious articles of bijouterie; Paste jewellery; Rings [jewellery]; Gold rings; Chronoscopes; Chronometric apparatus and instruments; Silver and its alloys; Bracelets; Bracelets [jewellery]; Bracelets of precious metal; Jewel chains; Chains [jewellery]; Closures for necklaces; Clasps for jewellery; Pendants; Trinkets coated with precious metal; Jewelry charms in precious metals or coated therewith; Key charms coated with precious metals; Necklaces [jewellery]; Chronographs [watches]; Chronometers; Diadems; Diamonds; Wedding rings; Tie clips of precious metal; Cuff links of precious metal; Gems; Pearl; Semi-finished articles of precious metals for use in the manufacture of jewellery; Semi-finished articles of precious stones for use in the manufacture of jewellery; Threads of precious metal [jewellery]; Silver thread [jewellery]; Threads of precious metals; Precious and semi-precious gems; Gold alloys; Gold; Imitation precious stones; Alloys of precious metal; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Platinum [metal]; Semi-wrought precious stones and their imitations; Natural gem stones; Precious and semi-precious stones; Unwrought precious stones; Natural pearls; Topaz;

Sapphires; Emeralds; Jades; Jewellery being articles of precious metals; Jewellery incorporating precious stones; Jewellery made of precious metals; Jewellery fashioned from non-precious metals; Processed or semi-processed precious metals; Objet d'art made of precious stones; Earrings; Earrings of precious metal; Ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof; Time instruments; Watches made of precious metals; Wristwatches; Pocket watches; Cases for clock- and watchmaking; Clock hands; Table clocks; Jewel pendants; Cabochons; Precious stones; Platinum and its alloys; Key fobs of precious metals; Pins [jewellery]; Silver; Spun silver [silver wire]; Unwrought silver; Figurines made from silver; Silver-plated bracelets; Silver-plated earrings; Silver-plated rings; Silver, unwrought or beaten; Clips of silver [jewellery]; Silver-plated necklaces; Cuff links made of silver plate; Silver rings; Silver necklaces; Silver earrings; Silver bracelets; Silver alloys; Silver watches; Sterling silver jewellery; Unwrought silver alloys; Objet d'art of enamelled silver; Silver objets d'art; Silver alloy ingots; Shoe jewellery; Precious jewellery; Trophies coated with precious metals; Jewellery made of precious stones; Cases of precious metals for horological articles; Tie chains of precious metal; Tie pins; Jewelry boxes of precious metal; Jewellery chain of precious metal for anklets; Wire thread of precious metal; Works of art of precious metal; Hat jewellery; Jewellery chain of precious metal for necklaces; Jewellery chain of precious metal for bracelets; Model figures [ornaments] coated with precious metal; Watches made of precious metals or coated therewith; Key fobs [rings] coated with precious metal; Presentation boxes for gemstones; Key chains of precious metal; Articles of jewellery coated with precious metals; Watch bands; Clocks; Plastic costume jewellery; Imitation jewellery ornaments; Jewellery charms; Body jewellery; Body costume jewellery; Artificial stones [precious or semi-precious]; Fancy keyrings of precious metals; Key chains as jewellery [trinkets or fobs]; Key rings [split rings with trinket or decorative fob]; Key rings [trinkets or fobs] of precious metal.

Class 35 Retail services in relation to jewellery; Online retail services relating to jewelry; Shop window dressing; Retail shop window display arrangement services; Display services for merchandise; Bill-posting.

Filed: 15/06/2021

Priority date (EU): 17/12/2020

Date of entry in the register: 31/12/2021