

O-242-17

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1255327
AND THE REQUEST BY SYMAROM (ASIA) PTE LTD TO PROTECT, IN THE UK,
THE TRADE MARK**



IN CLASS 30

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 405539
BY SILESIA GERHARD HANKE GMBH & CO KG**

Background and pleadings

1) On 4 May 2015, Symarom (Asia) pte Ltd (“the holder”) applied to protect, in the UK, International Trade Mark number 1255327 for the following mark:



Colours claimed: Green, blue and red.

Colour indication: S in green (PMS 361C); background in blue (PMS 072C); Symarom word in red (PMS 179C).

2) The International Registration (“IR”) was accepted and published in the Trade Marks Journal on 28 August 2015 in respect of the following goods:

Class 30: *Food flavourings (other than essential oils) for use in beverages, confectionery, biscuits, dairy and ice cream.*

3) Silesia Gerhard Hanke GmbH & Co KG (“the opponent”) opposes the IR on the basis of section 5(2)(b), of the Trade Marks Act 1994 (“the Act”). It is based upon a claim that the holder’s mark is in respect of a mark similar to that of the opponent, and in respect of identical or similar goods. It relies upon an earlier IR designating the UK, the relevant details of which are:

Mark and relevant dates	Goods relied upon
<p data-bbox="177 253 796 338">International Registration designating the UK, number 703284</p> <p data-bbox="177 416 312 450">Silarom</p> <p data-bbox="177 528 796 613">International registration date: 9 May 1998</p> <p data-bbox="177 692 796 725">Designation date: 9 May 1998</p> <p data-bbox="177 804 796 889">Date of Protection of the International Registration in UK: 6 August 1999</p>	<p data-bbox="798 253 1410 999">Class 30: <i>Essences for industrial purposes with the exception of ethereal essences and oils, vinegar essences, fruit flavors (except ethereal oils), coffee flavors, vanilla flavors, butter flavors, cheese flavors, almond flavors, tea flavors, lemon flavors, spice extracts, plant extracts for seasoning purposes, tea extracts, tomato extracts, cocoa extracts, flavours and essences for the manufacture of spirits, coffee substitutes, spices, sauces, cooking salt; flavors and essences for baking and sugar confectionery, coffee and mocha pastes.</i></p>

4) This IR qualifies as an “earlier mark” under section 6(1)(a) of the Act by virtue article 3(3)(c) of the International Registrations Order 2008 because the date in which the request for extension to the UK (9 March 1998) predates the date in which the holder requested extension of its IR to the UK (4 May 2015).

5) The holder filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier IR.

6) Both sides filed evidence and both sides provided written submissions in lieu of a hearing. The opponent was represented by Harrison IP Ltd. The holder was represented by Mr Jeffrey Lee.

Opponent’s evidence

7) This takes the form of a witness statement by Clemens Hanke, managing director of Hanke GmbH, the legal representative and general partner of the opponent. The

purpose of the evidence is to demonstrate that the opponent has made genuine use of its mark in respect of all the goods relied upon in the opposition. He states that sales in the UK are made through Silesia Flavours Limited, a wholly owned subsidiary of the opponent, but the goods are delivered to customers directly from the opponent.

8) Mr Hanke provides a selection of invoices from the period 2011 to 2015, broken down into 68 exhibits covering the goods matching all the terms listed in its specification of goods. These invoices are redacted to remove references to customer names and the monetary value of the orders, but customer addresses and product quantities are shown. From this it is clear that the opponent supplies goods referred to by its mark to numerous customers in the UK. There is a dominance of addresses in Yorkshire, but there are also invoices in other parts of the UK.

Holder's evidence

9) This takes the form of a witness statement by Seah Chee Lai, director of the holder. Mr Lai provides a history of the holder that it is not necessary for me to detail here. He also states that the name "SYMAROM" represents the first three countries the holder traded in and is pronounced, in Chinese, as "SAI MAH LONG" with SAI meaning "lion" and representing Singapore, MAH meaning "horse" and representing Malaysia and LONG meaning "dragon" and representing China. He also states that the figurative element of the green "S" shape and the blue background is intended to represent a dragon swimming in the sea. He relies upon this when submitting that the respective marks are conceptually dissimilar.

10) Mr Lai states that both parties operate a business-to-business model where the customers are industrial consumers and not retail consumers. He states that such consumers have in-depth industry knowledge and utilise a high level of discernment to decide upon their flavourings supplier. Mr Lai explains that goods provided to these industry customers are customised and that such customisation and refining of flavours to client's specifications is a protracted process requiring at least several weeks. He concludes that as a result of this, the purchasing process involves an enhanced level of care and consideration.

11) Mr Lai states that the holder has never received queries regarding a link with the opponent.

12) Mr Lai provides evidence of use of its mark. I do not need to detail this here other than to record that the only evidence that is relevant in illustrating use in the UK (use outside the UK is not relevant to these proceedings) is at Exhibit 13 where it is stated that between 1 January 2016 and 3 August 2016, 18.81% of hits to the holder's website were from the UK and between 1 July 2016 and 3 August 2016 it was as high as 32.51%. This was some 12 months after the relevant date in these proceedings (being the date that protection in the UK was requested).

13) Mr Lai's statement also contains numerous submissions (rather than evidence of fact) that I will not detail here but I will keep in mind and refer to them as appropriate later in my decision.

Opponent's evidence-in-reply

14) This takes the form of a second witness statement by Mr Hanke. It contains a number of submissions that I will not detail here, but that I will keep in mind.

15) Mr Hanke also states that neither parties' goods are sold in a store or from shelves where the figurative elements of marks can be taken into account. Rather, the opponent's customers order goods via email, fax or phone.

16) In response to Mr Lai's claim that the industry customers of both parties undertake a high level of care during the purchasing process, Mr Hanke concedes that the relevant consumer of both parties' goods are industry based but despite this, the parties' goods are the basis of common and high volume products.

17) Mr Hanke provides links to advertisements available on *YouTube* that allegedly demonstrate that, contrary to the holder's submission, where words begin with "SY" the beginning can be pronounced as "SI" as in "sill" or "simmer" and that words that begin with "SI" can be pronounced as in "sinus" or "sign" or alternatively as in "sick".

DECISION

Genuine Use

18) The relevant part of the Act reads as follows:

“6A. - (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), (b) 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 period of five years ending with the date of publication.

(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.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

and:

“3.- ...

(3) The provisions of the Act (except those listed in Schedule 1, Part 1), the Relative Grounds Order and the Trade Marks Rules (except those listed in Schedule 1, Part 2) shall apply to international trade marks (UK) and requests for extension with the following modifications;

...

(e) references to registration of a trade mark shall include the conferring of protection on an international registration which is the subject of a request for extension;”

19) The date that the holder’s IR was published for opposition purposes was 28 August 2015. The opponent’s IR achieved protection in the UK on 6 August 1999 which, in accordance with article 3(3)(e) of the International Registrations Order 2008, is the date it completed its registration process for the purposes of calculating

whether an IR designating the UK is subject to the genuine use provisions. It is clear from these dates that the opponent's earlier IR completed its registration procedure more than five years before the publication of the holder's IR and is subject to the genuine use provisions set out in section 6A(1) of the Act.

20) Section 6A(3)(a) of the Act states that where an earlier mark is subject to proof of use, the relevant five year period in which use must be shown ends with the date that the opposed mark was published. In these proceedings, the holder's IR was published for opposition purposes on 28 August 2015. Therefore, the opponent must demonstrate use between 29 August 2010 and 28 August 2015 ("the relevant period").

21) The opponent has provided evidence in the form of numerous invoices spanning a period of five years between 2011 and 2015 broken down into groups that correspond to each item of goods listed in its specification. Its mark appears in all the product descriptions in these invoices. It is not challenged by the holder that this evidence illustrates genuine use of the opponent's mark in respect of the full range of goods listed in its specification. I conclude that the use is sufficient to demonstrate that the opponent has genuinely used its mark in the UK in the relevant period.

22) As a consequence of this, the opponent is entitled to rely upon the full list of goods upon which it relies in class 30 of its earlier IR.

Section 5(2) (b)

23) Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

Comparison of goods

24) I keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market (MERIC)*, Case T- 133/05:

“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 fur 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”.

25) The respective goods are reproduced below:

Opponent’s goods	Holder’s goods
Class 30: <i>Essences for industrial purposes with the exception of ethereal essences and oils, vinegar essences, fruit flavors (except ethereal oils), coffee flavors, vanilla flavors, butter flavors, cheese flavors, almond flavors, tea flavors, lemon flavors, spice extracts, plant extracts for seasoning purposes, tea extracts, tomato extracts, cocoa extracts, flavours and essences for the manufacture of spirits, coffee substitutes, spices, sauces, cooking salt; flavors and essences for baking and sugar confectionery, coffee and mocha pastes.</i>	Class 30: <i>Food flavourings (other than essential oils) for use in beverages, confectionery, biscuits, dairy and ice cream.</i>


26) The holder refers to the judgment of the CJEU in *Alecansan v OHIM*, C-196/06, [2007] ECR I-36, paragraph 37 where the court stated that it is necessary to adduce evidence of similarity between respective goods and that the opponent has failed to

do so. The guidance from the CJEU is from a case where there was no obvious similarity between the goods and services at issue. In such circumstances, there is a clear onus upon the opponent to provide evidence that there is similarity. This is not the case in the current proceedings as I will explain below.

27) The holder submits that the goods are not identical. The holder's goods are *Food flavourings (other than essential oils) for use in beverages, confectionery, biscuits, dairy and ice cream*. Many of the opponent's goods are also flavourings and when keeping the guidance from *MERIC* in mind, the respective goods are self-evidently identical. Evidence is not necessary for me to reach this obvious conclusion. Further, an essence is “an extract or concentrate obtained from a plant or other matter and used for flavouring or scent”¹. Therefore, it is also clear to me that the opponent’s *essences for industrial purposes...* are also identical to the holder’s goods.

Comparison of marks

28) The respective marks are:

Opponent’s marks	Holder’s mark
Silarom	

29) It is clear from the judgment of CJEU in *Sabel BV v Puma AG*, Case C-251/95 (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

¹

<http://www.oxfordreference.com/search?btog=chap&isQuickSearch=true&pageSize=10&q=essence&sort=relevance&type=englishdictionaries>

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.”

30) It would be wrong, therefore, to artificially dissect the 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.

31) The opponent's mark consists of the single word "Silarom" and is, therefore, self-evidently the dominant and distinctive element of its mark. The holder's mark consists of a prominent device consisting of a green, s-shaped swoosh appearing over a blue background square with soft, rounded corners. The word SYMAROM appears under the device and is presented in capital letters in red. The device and the word are both distinctive elements sharing equal dominance in the mark.

32) Visually, the marks share similarity in that both marks contain a seven letter word beginning with "S" and sharing the same final four letters "arom". They differ in that the second and third letters are different being "ym" and "il" respectively, and because of the presence of the device in the holder's mark (that is absent in the opponent's mark). The holder submits that the respective marks are not similar because the word element of its mark is presented in capitals and in the colour red and because the fonts are different. It also points to the presence of the device element in its mark. I do not agree. Firstly, as submitted by the opponent, its mark is a word mark and therefore it is entitled to be used in any common typeface and in lowercase or uppercase. Therefore, the opponent's registration entitles it to use its mark in the same, or at least a very similar typeface to the word in the holder's mark. Similarly, a mark applied for as a word mark is not limited to colour. Consequently, it

may be used in any colour, including the same colour that the word element in the holder's mark is presented. Taking account of all of this, I conclude that the respective marks share some visual similarity but this is reasonably low.

33) From an aural perspective, only the word element of the holder's mark is likely to be referred to. The holder submits that the respective marks will be pronounced as "SIL-LAROM" and "SYM-MAROM". I do not agree because this is based upon an unsubstantiated assumption that the end of the first syllable of both marks will be repeated at the start of the second syllable. Even if I am wrong, it is my view that such a subtle difference to a pronunciation where there is no repetition of the "L" and "M" sound respectively, is such that it will go unnoticed by the average consumer. The holder also submits that the first syllables are dissimilar with the first syllable of the opponent's mark being pronounced as SILE (as in "silent", "sinus" or "sign"). I accept that this is an alternative way in which this first syllable may be pronounced. However, it is equally the case that it may be pronounced in the identical way as the first syllable of the holder's mark (that will be pronounced as in "syllable" or "symmetry"), namely, as in "sill", "simmer".

34) It is my view that the word element of the holder's mark naturally splits into the three syllables SIM-A-ROM and, similarly, the opponent's mark naturally splits into the syllables SIL-A-ROM. The opponent submits that the marks will be expressed as SI-LAROM and SY-MAROM respectively. I note this, but I do not see that this is materially different to my findings. The respective marks coincide in that the second and third syllables are identical and the respective first syllables are identical, or at least very similar. Taking all of this into account, I conclude that the respective marks share a high level of aural similarity. Even if I am wrong and the holder's claims are correct, it is my view that this still results in a high level of aural similarity, albeit marginally lower than if my impression is correct.

35) Conceptually, the holder submits that its mark is a transliteration of three Chinese characters that represent the first three countries in which it began trading. I dismiss any notion that such a concept will be evident to the relevant UK consumer of the respective goods. Further, it is inconsistent with its other submission that the "arom" aspect of the respective marks is descriptive because it is a reference to

“aroma”. Whilst the letters “arom” in both marks consist of four of the five letters present in the word “aroma”, it is my view that the connection to the known word is somewhat obscured when combined with the prefix SIL or SYM to the point that if the “arom” element strikes the consumer as having any meaning at all, it will be no more than the faintest of an allusion to “aroma”. Rather, the overwhelming impression created by both marks is that of invented words. The holder states that the green “S” shaped device presented on a blue background is intended to represent a swimming dragon. Such an impression will not be perceived by the average consumer who is highly likely to perceive it as no more than a reference to the letter “s” and to the first letter of the word element of the mark. Consequently, I conclude that neither mark has a conceptual identity beyond being perceived as fanciful. The marks are not, therefore, conceptually similar or dissimilar. If I am wrong, then they nevertheless have only the faintest allusion to the word “aroma” and this will apply equally to both marks. I conclude that, in such circumstances, the marks share a low level of conceptual similarity.

Average consumer and the purchasing act

36) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

37) 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.”

38) The holder submits that the average consumer comprises "sophisticated customers with specific industrial knowledge" and, as a result, will "exercise a high level of discernment and scrutiny". It explains that the consumers of the holder's goods are industrial customers who manufacture food, beverages, biscuits, candy, dairy, tobacco and oral care products. It is stated that the holder "utilises the business-to-business (B2B) model". The holder submits that because its flavours are customised for its customers, there is a protracted purchasing process and that even commonly required flavours such as strawberry cannot be duplicated exactly between suppliers and leads to customers working with suppliers for a long time.

39) In his second witness statement, Mr Hanke, for the opponent, accepted that the consumers of the “goods discussed in this matter are industry rather than household consumers”. He submitted that, despite this, it does not result in the relevant consumers exercising a high level of scrutiny when searching for, and ordering the goods because the flavourings are a common product in the manufacturing process and they are high volume products.

40) I must point out that the holder’s list of goods is not limited in any way and it therefore includes goods both for industrial use and those available to ordinary members of the public. I must, therefore, consider the issue from the perspective of average retail consumers as well as those from the food and other manufacturing industries. In respect of the list of goods covered by the opponent, with the exception of *Essences for industrial purposes with the exception of ethereal essences and oils*, its remaining goods are not limited to being for industrial purposes either. Consequently there are at least two distinct average consumers. Firstly, there are the business customers who purchase the goods for industrial purposes. Here, I note the holder’s submissions that the purchasing process is subject to a high level of scrutiny. Certainly, the larger quantities involved in such business transactions will invariably lead to a higher level of attention during the purchasing process than when the general public select the goods from a shop shelf or online equivalent. The holder submits that there are slight variations in flavour across different providers of

the goods leading to the business customer paying close attention to ensure that their particular requirements are met. The opponent's submission that the goods are high volume, common products in the manufacturing process does not detract from this. I conclude that in respect of industry consumers there is a higher than normal level of care and attention during the purchasing process and the process will involve a combination of visual and aural aspects.

41) Secondly, there are ordinary consumers who may purchase the parties' goods (that are not limited as being for industrial purposes). Here, the goods are likely to be bought as part of a normal grocery shop where visual considerations are important and whilst they may not be purchased every day, they are not infrequent purchases. I conclude that the purchasing process is likely to involve an average level of care and attention, being neither particularly high nor low.

Distinctive character of the earlier trade mark

42) 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).

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).”

43) The earlier mark consists of the word “Silarom”. The holder submits that the opponent’s mark “has a minimal capacity to identify the goods for which it is registered”. It claims that this is because it “contains the suffix “arom” which is an element descriptive of the goods for which it is registered – i.e. flavourings”. It further claims that because of its descriptive character this element of the opponent’s mark should not be considered to contribute to the mark’s distinctiveness. I reject this approach. As the holder itself recognises elsewhere in its submissions, “arom” is allusive of the word “aroma” (rather than descriptive). There is no evidence before me that “arom” is descriptive. Whilst I recognise that “arom” is the first four of the five letters present in the word “aroma”, when it is combined with “Sil” the impression created is of an invented word with no obvious meaning. It is not clear to me that the mark as a whole creates any allusion, but even if I am wrong, it is only a weak allusion to flavourings. I conclude that the opponent’s mark is endowed with a reasonably high level of inherent distinctive character.

44) The opponent provides evidence of use of its mark, but it makes no claim to an enhanced distinctive character as a result of this use. From the guidance above, it is clear that I must consider the issue by taking account of such matters as market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the opponent in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods as originating from the opponent and statements from chambers of commerce and industry or other trade and professional associations. The opponent merely presented redacted invoices spanning a number of years from 2011. It is clear from these that it has an established trade with a number of customers in the UK, I am, however, unable to place this trade in the context required other than to say, despite a predominance of invoices sent to customers in Yorkshire, there are also invoices sent to customers elsewhere in the UK and so its trade is reasonably widespread across the UK. However, there is insufficient

information for me to conclude that the distinctive character of its mark is enhanced through use. However, even if I am wrong, given the reasonably high level of inherent distinctive character, it would not alter the position to any material extent.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

45) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

46) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case and in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

47) I have found that:

- the respective goods are identical;
- The respective marks share a reasonably low level of visual similarity, a high level of aural similarity and that the marks are neither conceptually similar nor dissimilar. I also recognised that where the average consumer perceives the “arom” part of the parties’ marks as a faint allusion to the word “aroma” there is a low level of conceptual similarity;
- The purchasing process is a combination of visual and aural considerations in respect of industry consumers and predominantly visual in nature in respect of consumers from the general public. I have also found that the level of attention paid by the industry consumer during the purchasing process is higher than normal and with ordinary consumers there is an average level of care and attention, neither particularly high or low;
- The opponent's mark is endowed with a reasonably high level of inherent distinctive character and, on the basis of the evidence provided, I am unable to conclude that this has been enhanced as a result of the use made of it.

48) The respective goods being identical, the earlier mark being endowed with a reasonably high level of distinctive character, the marks sharing a high level of aural similarity and there being no conceptual dissidence between the marks are all pointers towards a finding of likelihood of confusion. Countering this is that the marks share a reasonably low level of visual similarity and that (at least in respect of industry consumers) there is a higher than normal level of care taken during the purchasing process.

49) The opponent submits that the word element of the holder’s mark is more distinctive than the figurative element (and relies on the guidance provided by the GC in *NewSoft Technology v OHIM*, T-205/06). I have found that they share equal dominance in the mark, but I accept the premise made by the court that the consumer will easily reference the goods in question by quoting their name rather

than by describing the figurative element. I reflected this in my analysis of aural similarity. This issue is important in the current proceedings because it is my view that the figurative element present in the holder's mark will not go unnoticed by the average consumer and, as a consequence, it is unlikely that the consumer will confuse one mark for the other (so called "direct confusion"). However, because of the visual similarities between the respective word elements and the high level of aural similarity, when factoring in the other factors detailed earlier, I find that the consumer is likely to mistakenly believe that goods provided under the respective marks originate from the same or linked undertaking (so called "indirect confusion") and this leads to a likelihood of confusion overall.

50) Even if I am wrong regarding how the respective marks are perceived aurally, and the holder is correct that the first syllable of the opponent's mark will be expressed as SILE and the first syllable of its mark as SIM, such a subtle aural difference would not lead me to reach a different conclusion. Similarly, if I am wrong and the holder is correct that the average consumer will perceive the AROM element of the respective marks as an allusion to the word "aroma", I have found that this will introduce an element of conceptual similarity. In this case, confusion is at least equally likely.

51) In reaching this conclusion, I have also kept in mind the holder's submission that aural similarity is of lesser importance when considering likelihood of confusion but recognise that in nonetheless is likely to play a role in circumstances where enquiries are made or orders are placed over the phone or where choice of suppliers may be discussed.

52) There is no claim to concurrent use and further, the only evidence presented by the holder that may be interpreted as indicating use of its mark in the UK consists of information regarding UK hits to its website. This relates to a period after it applied to extend protection to the UK and it is, therefore, after the relevant date in these proceedings.

53) The parties both approach the issue of likelihood of confusion on the mistaken premise that it should be considered from the perception of industry consumers. This

appears to have arisen from the fact that the current business models of both parties only target industry consumers. However, because the respective specifications of goods include goods not limited to being for industrial purposes, I must take into account that both specifications cover goods that can be provided to non-industrial consumers (see to this effect, the comments of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, paragraph 59).

54) Finally, I note the holder's submission that there was no intention on its part to cause confusion. However, the intention of the holder is not relevant in respect of grounds under Section 5(2) of the Act. There is no claim in this case that its mark has been chosen in anything other than good faith.

55) In summary, the opposition is successful in its entirety and the application to extend the protection of the holder's International Trade Mark to the UK is refused.

COSTS

56) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence and that both sides filed submissions in lieu of attendance at a hearing. I award costs as follows:

Preparing a statement and considering the counterstatement (including fee)	£500
Preparing evidence and considering other side's evidence	£800
Preparing written submissions in lieu of attending hearing	£450
Total:	£1750

57) I order Symarom (Asia) Pte Ltd to pay Silesia Gerhard Hanke GmbH & Co KG the sum of £1750 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 19TH day of May 2017

Mark Bryant

For the Registrar

The Comptroller-General