

O/0058/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004022477

BY

GRAHAM BARR, MICHAEL JAMES PARDOE AND CHARLIE READ

TO REGISTER:



AS A TRADE MARK IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000448814

BY STARBUZZ TOBACCO, INC.

BACKGROUND AND PLEADINGS

1. On 6 March 2024, Graham Barr, Michael James Pardoe and Charlie Read (“the applicants”) 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 26 April 2024. The applicants seek registration for *Tobacco free oral nicotine pouches [not for medical use]* and *Snus without tobacco* in class 34.
2. On 26 July 2024, the application was opposed by Starbuzz Tobacco, Inc. (“the opponent”). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies on the following mark:

BUZZ

UKTM No. 3600272²

UK Filing date: 24 February 2021

EU filing date: 24 September 2018

Registration date: 30 July 2021

Relying on the following goods in class 34: Hookahs and electronic hookahs and accessories thereof; tobacco products; Tobacco substitutes, in particular those made out of tea and tea plants; cut and uncut tea for smoking as tobacco substitute; cigarette tobacco; chewing tobacco; pipe tobacco; shisha tobacco; smokers' articles of all kinds, in particular matches; shishas and electronic shishas and accessories thereof; electronic cigarettes; cigars; small cigars;

¹ 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 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.

² On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The opponent's EUTM number 017960178 was filed at the EUIPO on 24 September 2018, whereas its UK application was filed on 24 February 2021. Accordingly, the UK registration retains its EU filing date of 24 September 2018.

electronic cigars; electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smoking pipes; steam stones, in particular steam stones for water pipes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; all the aforesaid goods not for medical purposes.

3. The mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the goods identified.
4. The opponent claims that the marks are similar and that the respective goods are identical or highly similar, with the result that there is a likelihood of confusion.
5. The applicants filed a counterstatement denying the claims.³
6. The opponent is represented by Keltie LLP and Graham Barr, one of the named applicants, is acting on their behalf.
7. Neither party filed evidence. However, the applicants filed submissions during the course of the proceedings. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

³ The applicants failed to file a counterstatement within the two months specified by Rule 18(1) of the Trade Marks Rules 2008. However, decision BL O/0087/25 was issued on 30 January 2025, in which the late-filed defence was admitted into the proceedings.

PRELIMINARY ISSUES

8. Several points have been raised by the applicants in their written submissions.⁴ Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.
9. The applicants' submissions refer to the opponent's mark as "Starbuzz" and claim that the addition of "Star" in the opponent's mark is highly distinctive and changes the overall perception.⁵ This is not accurate as the register shows the opponent's mark consists solely of the word "BUZZ" as shown in paragraph 2 of this decision. For the avoidance of doubt, the comparison I shall undertake will be based upon the mark depicted in paragraph 2.
10. The applicants also point to the differing target markets of the respective parties and their goods, submitting that such differences will prevent a likelihood of confusion.⁶ However, I must carry out a notional assessment based upon the parties' respective marks and the goods contained in their specifications. The actual target market and the activities they carry out are not relevant to my assessment.⁷
11. The applicants go on to list several UK trade marks that contain the word "Buzz" and claim that this demonstrates that multiple brands can coexist without confusion.⁸ The decision I am required to make is based on a notional assessment of the likelihood of confusion and the mere presence of "Buzz" marks on the Register is not evidence of how many of such trade marks are in fact used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks.⁹ As such, this line of argument does not assist the applicants.

⁴ Applicants' written submissions dated 17 March 2025.

⁵ Paragraph A3 of the applicants' written submissions.

⁶ Paragraphs B5 & B6 of the applicants' written submissions.

⁷ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66]; *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22].

⁸ Paragraphs C5 & C6 of the applicants' written submissions.

⁹ *Zero Industry Srl v OHIM*, Case T-400/06.

12. Finally, the applicants submit that the opponent has failed to provide any actual evidence of confusion among consumers.¹⁰ In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

13. I have no evidence before me of how (or to what extent) the parties' marks have been used in practice. Consequently, it is impossible to assess whether the absence of evidence of confusion is due to the fact that the marks at issue are not confusingly similar or due to other matters relating to the way in which the marks have been used (or not, as the case may be). Therefore, this line of argument does not assist the applicants.

DECISION

Section 5(2)(b)

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

"(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,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

¹⁰ Paragraphs C6 & C7 of the applicants' written submissions.

Section 5(2) case law

15. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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

16. The full specification relied upon by the opponent is set out in paragraph 2 above. I have identified only those goods that I consider represent the opponent's best case in the table below. With that in mind, the goods to be compared are as follows:

| Opponent's goods | Applicants' goods |
|--|---|
| Class 34: Tobacco substitutes, in particular those made out of tea and tea plants. | Class 34: Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco. |

17. In *Gérard Meric v OHIM*,¹¹ (“*Meric*”), the General Court (“GC”) held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

18. I acknowledge the opponent’s use of “*in particular*” following the term “*Tobacco substitutes*”. In *Häfele GmbH & Co. KG v OHIM*,¹² the GC stated that the words “in particular” used in a description are merely indicative of an example, rather than limiting those goods or services to those listed following the term. Accordingly, I find that the opponent’s term *Tobacco substitutes, in particular those made out of tea and tea plants* would encompass the applicants’ *Tobacco free oral nicotine pouches [not for medical use]* and *Snus without tobacco*. These goods are identical based on the principle outlined in *Meric*.

The average consumer and the purchasing act

19. The case law, as set out earlier, requires that I 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

¹¹ Case T-133/05
¹² Case T-336/09

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.”

20. The average consumer of the parties’ goods is a member of the general public. In my view, the goods will be inexpensive and purchased relatively frequently. When buying the goods, the average consumer will pay attention to the nicotine content and the flavour of the product, as well as the price. Overall, I find that consumers will exercise a medium degree of attention during the purchasing process.

21. As the goods at issue do not contain tobacco, they are not subject to the same UK restrictions and legislation as tobacco products and vapes. However, they are likely to be sold alongside such products. I therefore consider that the goods will either be self-selected from shelves of retailers or sold over the counter. When sold over the counter, in order to make a purchase, the consumer will need to request them from a shop assistant. The goods will also be sold online, where the goods will be selected by consumers after viewing information on a website. I therefore find that both visual and aural considerations will play a role during the purchasing process.

Comparison of the marks


22. It is clear from *Sabel 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.

23. 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.”

24. 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.

25. The respective trade marks are shown below:

| The opponent's mark | The applicants' mark |
|---------------------|--|
| BUZZ |  |

26. The opponent's mark is in word-only format and consists of the word “BUZZ”, presented in an upper-case font. The overall impression lies in the word itself.

27. The applicants' mark consists of consists of the word “BUZZ” presented in a stylised typeface formed of parallel lines. The letters “BU” appear in white, while the conjoined letters “ZZ” appear in blue, forming a lightning bolt white shaped space between them. Beneath this, the descriptive words “NICOTINE

POUCHES” appear in smaller, standard lettering. The wording is set against black rectangular background. I find that the dominant and most distinctive component of the mark is the word “BUZZ” which appears front and centre in a large font. The stylisation and lightning bolt device which sits between the letters “ZZ” play a lesser role, and the background plays a much lesser role. The wording “NICOTINE POUCHES” is descriptive of the applied-for goods and, whilst not being negligible, has little weight in the overall impression.

28. Visually, the marks overlap through use of the word “BUZZ”. This is the entirety of the earlier mark and the dominant and distinctive feature of the applicants’ mark. I note that the earlier mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used.¹³ Differences arise between the opponent’s mark and the applicants’ mark by way of the lightning bolt device element, the background and the wording “NICOTINE POUCHES” which appear in the applicants’ mark but have no counterpart in the earlier mark. Considered as a whole and taking into account what I have said about the overall impressions of each mark, I find the earlier mark to be visually similar to the applicants’ mark to between a medium and high degree.

29. The word “BUZZ” is an ordinary English dictionary word and will be pronounced in the normal way. The point of aural overlap lies in the word “BUZZ” which will be pronounced identically in both marks. I consider that the applicants’ mark may be shortened to “BUZZ”, as I have found the wording “NICOTINE POUCHES” to be descriptive and therefore it may not be verbalised. In making this finding, I have borne in mind the decision of Mr Phillip Johnson, sitting as the appointed person, in *Enrich Learning*.¹⁴ At paragraph 18, he said he thought it was perfectly acceptable to find that descriptive matter would not usually be articulated. Overall, I find that if “NICOTINE POUCHES” is not verbalised, the marks are aurally identical, whereas if that wording is verbalised, the marks are similar to a medium degree.

¹³ *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39

¹⁴ BL O/1141/25

30. The word “BUZZ” has a number of meanings, the most likely of which in relation to the goods at issue is “a pleasant sensation, as from a drug such as cannabis” or “a sense of excitement; kick”.¹⁵ The meaning of that word will be the same in both marks; even if the average consumer perceives a different meaning of “BUZZ”, the same meaning will be attributed to the other mark.

31. “NICOTINE POUCHES” in the applicants’ mark will convey a clear meaning to consumers. However, it is descriptive/non-distinctive in respect of the goods at issue and therefore does not create a distinctive conceptual difference between the marks.

32. Taking into account my assessment of the overall impression of the marks, the marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

33. 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

¹⁵ <https://www.collinsdictionary.com/dictionary/english/buzz> [accessed 22 January 2026]

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).”

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

35. There has been no claim that the mark enjoys an enhanced level of distinctive character, nor has there been any evidence filed to that effect. Consequently, I have only the inherent position to consider.

36. The opponent submits that the word “BUZZ” is inherently highly distinctive as it has no meaning in relation to the goods. I disagree. “BUZZ” is a known dictionary defined term and, although it is not descriptive of the goods, it may allude to the sensation experienced after consuming nicotine. In light of this, I find the earlier mark possesses between a low and medium degree of distinctive character.

Likelihood of confusion

37. 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. As I mentioned above, 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 or she has retained in their mind.

38. I have found the goods to be identical. I have found that the average consumer will comprise of members of the general public. Those consumers will pay a medium degree of attention during the purchasing process. I found that both visual and aural aspects of the mark will play a role in the purchasing process. I have found the marks to be visually similar to between a medium and high degree. Depending on how the mark is articulated, I have found the marks to be either aurally identical or aurally similar to a medium degree. I have found the marks to be conceptually similar to a high degree. I found the earlier mark to hold between a low and medium degree of inherent distinctiveness.

39. I first note that the respective marks share the dominant and distinctive element "BUZZ". The applicants' mark contains additional elements which have no counterpart in the earlier mark. However, I did not find these elements to play a dominant role in the overall impression. During the purchasing process, both visual and aural elements will play a role, and I have already found that in some cases the marks will be articulated identically. Bearing this in mind, along with all of the relevant factors, it is my view that the additional elements in the applicants' mark are unlikely to distinguish the parties' marks from one another. The marks may be misremembered by way of imperfect recollection and will be imperfectly recalled as the "BUZZ" marks. The average consumer will be directly confused as a result.

40. I will proceed to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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)”.

41. These examples are not exhaustive but provide helpful focus.

42. If the differences between the marks are identified, the common presence of the word “BUZZ” is likely to lead a significant proportion of average consumers to conclude that the marks originate from the same or economically linked undertakings. I remind myself that I have found that the overall impression of the earlier mark lies solely in the word “BUZZ”. This word also plays a more dominant and distinctive role in the overall impression of the applicants’ mark with the additional wording being non-distinctive of the goods at issue. If consumers recognise the differences between the marks, they will not, in this case, be put down to coincidence. The addition of the words NICOTINE POUCHES will be viewed as a non-distinctive addition and the stylisation/device used in the applicants’ mark will be viewed as a logo version of the opponent’s mark. In such circumstances, I consider there to be a likelihood of indirect confusion.

CONCLUSION

43. The opposition under section 5(2)(b) of the Act is successful. Subject to any appeal against this decision, the application shall be refused protection in the UK.

COSTS

44. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 1 of 2023. Using that TPN as a guide, I award the opponent the sum of **£700** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

| | |
|---|------|
| Official fee for filing Form TM7: | £100 |
| Preparing the Statement of Grounds and considering the Counterstatement: | £250 |

Preparing written submissions: £350

Total: £700

45. I therefore order Graham Barr, Michael James Pardoe and Charlie Read to pay Starbuzz Tobacco, Inc. the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of January 2026

Catrin Williams
For the Registrar