

O/0534/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK DESIGNATION OF INTERNATIONAL REGISTRATION
NO. WO0000001781595 BY OSAÜHING GRENKEM
FOR PROTECTION OF THE FOLLOWING TRADE MARK



IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000449668
BY SUPREME IMPORTS LTD

BACKGROUND AND PLEADINGS

1. Osaühing Grenkem (“the holder”) designated the international registration (“the IR”) shown on the front cover of this decision for protection in the UK on 21 February 2024. This is also its international registration date. Protection is sought for the following goods:

Class 34: Tobacco free oral nicotine pouches [not for medical use]; liquid nicotine solutions for electronic cigarettes.

2. On 16 September 2024, the application was opposed by Supreme Imports Ltd (“the opponent”) based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).¹
3. Under both Sections 5(2)(b) and 5(3), the opponent opposes the IR in its entirety and relies on the following mark:

KIK

UKTM No. 2644922

UK Filing date: 6 December 2012

Registration date: 8 March 2013

Relying on the following goods in class 34: Electronic cigarettes; electronic smoking devices; smokeless cigarette vaporiser pipe; tobacco substitutes (other than for medical purposes); cartridges and refill cartridges for electronic smoking devices and electronic cigarettes; parts and fittings for all of the aforesaid goods.

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.

4. Under section 5(2)(b), the opponent claims that the marks are similar and that the respective goods are highly similar, with the result that there is a likelihood of confusion.
5. Under Section 5(3), the opponent claims that its earlier mark enjoys a reputation in relation to all of the goods identified above and that use of the IR in relation to the goods concerned will take unfair advantage of, and be detrimental to, the distinctive character or repute of the opponent's earlier mark.
6. The holder filed a defence and counterstatement, denying the opponent's claims and putting the opponent to proof of use and reputation in respect of its earlier mark.
7. The opponent is represented by HGF Limited, and the holder is represented by TRADEMAKR.
8. Only the opponent filed evidence during 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.

EVIDENCE

9. The opponent's evidence came in the form of a witness statement from Sandeep Singh Chadha dated 30 January 2025. Their witness statement is accompanied by 21 exhibits (being those labelled exhibit 1-21). Mr Chada is a Director for the opponent, a position he has held for more than 19 years. His evidence serves to show the use the opponent has made of its earlier mark and the reputation it claims to hold.
10. I do not intend to summarise the opponent's evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

11. The opponent's mark qualifies as an earlier trade mark under section 6 of the Act by virtue of its earlier filing date. As it completed its registration process more than five years before the UK designation of the IR in issue, it is subject to the use provisions in section 6A of the Act.

12. The relevant statutory provision is Section 6A of the Act, which states:

“(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

(a) within the relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

13. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the UK designation date of the IR, being 21 February 2024. The relevant period is, therefore, 22 February 2019 to 21 February 2024 (“the relevant period”).

Evidence of use

15. I note the following from Mr Chada’s evidence:

16. The opponent owns the brand “KIK”. The brand was launched in 2013 with the intention of helping people to stop smoking tobacco. The “KIK” mark commenced use with e-liquids in 2013 and later the products were expanded to include vape pens, e-cigarettes and accessories.²

Sales

17. Goods bearing the “KIK” mark are sold in store and online at the website www.kik.co.uk. In exhibit 4, Mr Chada produces printouts from the website which shows the “KIK” mark on goods such as e-liquids, e-cigarettes, vape pens and vape coils. The dates of the printouts range from 20 November 2017 to 19 August 2024. An example dated 21 November 2019 is now reproduced below:

² Paragraphs 7 and 8 of the witness statement of Mr Chada.



18. Mr Chada states that the opponent's "KIK" UK sales between 21 February 2019 and 20 February 2024 are a total of £3,174,480 and provides a breakdown of these figures by product range:

Product Range	Sales (£)
Archived vaping	1,051,602
Disc vaping	100,293
KIK cloud liquids	240,256
KIK e-liquids	1,666,017
KIK short fill	116,311

19. The sales figures during the relevant period are also broken down by year:

Year	Sales (£)
2024	4,054
2023	135,780
2022	399,379
2021	631,780
2020	861,149
2019	1,142,338

20. Mr Chada provides further information about the individual pricing of the goods and explains that the KIK short fill e-liquids are sold at a price range between £4.99 and £10.00 and the single e-liquids are sold for £1.99 each or in packs of 20 for approximately £40.00. He claims that this demonstrates that the opponent has a significant volume of sales per year.

21. Mr Chada produces invoices at exhibit 16 which demonstrate sales of “KIK” products such as e-liquids, vaping/e-cigarette devices, clearomizers and replacement coils. Although the invoices do not expressly identify the location of the customers, prices are shown in pounds sterling, include VAT, and are provided in the context of UK turnover figures. Particularly in the absence of any challenge from the holder, I accept that they relate to sales to customers in the UK.

22. Mr Chada also states that the opponent has various distributors and channel partners that sell products bearing the “KIK” mark. These distributors include The Electronic Tobacconist Limited, QD Commercial Group Holdings Limited, A&E Distributors Limited, T.J Morris Limited (Home Bargains Corporate) and The Yorkshire Trading Co. Exhibit 17 contains sample invoices to these distributors based in various locations around the UK such as Devon, Liverpool and Nottingham. I note however that they are undated.

Online presence and marketing

23. Mr Chada provides Google Analytics User Data from the UK showing how many users engaged with the KIK website from January 2019 to January 2025. Over that period, it is shown that the website had 309,031 visitors. Further figures are provided from this period showing that there were over 36,000 orders placed on the website during this time.³

³ Paragraphs 36 and 37 of the witness statement of Mr Chada.

24. The opponent is said to have a dedicated Instagram account within which it promotes its “KIK” products. Undated printouts are provided of the “KIK” Instagram page and appear to show the account has 1,038 followers.⁴

25. The opponent also has an e-cigarette training series on its YouTube channel which Mr Chada says was launched in 2014. The printouts provided at exhibit 10 show that the “KIK e-cigarettes” YouTube channel has 297 subscribers and 24 videos. I note that the videos shown all appear to have been uploaded in 2014 or 2015. One of the videos titled “KIK e-cigarette training series: entry level product the vape p1 ideal e-cig for beginners” is dated 23 December 2014 and has amassed a total of 41,239 views. However, the printouts are undated, so I assume that these figures reflect the position at the date of the witness statement and, therefore, after the relevant period.

26. Whilst I note that no figures have been provided in relation to advertising expenditure during the relevant period, Mr Chada refers to an advertising campaign and launch events for “KIK” brand which include the following:

- A £1 million TV and billboard advertising campaign in 2014 that was played during primetime TV programs such as Coronation Street, Emmerdale and the Champions League Final on Sky Sports. A news article about the campaign was published on the BBC News website on 10 November 2014. A copy of the article is provided at exhibit 12.
- An activity day organised by “KIK” to launch its e-cigarettes. The event took place in 2014 at the Three Sisters racetrack in Wigan and guests were given the opportunity to drive a Lamborghini around the track with Ben Collins, former Stig from BBC’s Top Gear program. Exhibit 10 includes an article taken from the website www.thecarexpert.co.uk about this event. The article is dated 31 January 2014.
- A launch party for “KIK” which took place in Manchester in 2014. The party was attended by celebrities such as Peaches Geldof and Helen Flanagan. Exhibit 20 includes articles about this event from online news publications

⁴ Exhibit 19

Manchester Evening News and Mail Online. The articles are dated 29 January 2014 and 30 January 2014 respectively.

Market share and brand awareness

27. Mr Chada provides a printout of an article from www.grocerytrader.co.uk that contains information about the UK vaping market.⁵ The article claims that a 2023 report revealed that the vaping market was worth around £1.2 billion and was expected to reach £1.4 billion over the next three years.

28. Mr Chada submits that these figures are significant because the opponent holds a material share of the UK vaping market. Exhibit 9, an extract from the London Stock Exchange website, shows that the opponent reported £76.1 million in revenue from its vaping division for the financial year ending 31 March 2023. While I accept this figure, the report refers to another vaping brand owned by the opponent known as “88vape”. “88vape” is described as the opponent’s core brand. Viewed in this context, and against the turnover figures for goods sold under the “KIK” mark, I consider that only a very small proportion of the £76.1 million revenue relates to “KIK”-branded goods.

29. Exhibit 14 contains two articles published in 2023. Mr Chada explains that the articles confirm that “KIK” was the second most recognised brand in the UK e-cigarette industry. One of the articles explains that the report was conducted by Salience Search Marketing and analysed 11 performance indicators including year-on-year visibility, search volume trends, and brand awareness for 50 e-cigarette brands. The website kik.co.uk was shown to have 40,500 searches per month.

Variant use

30. Before I consider whether the evidence constitutes sufficient use of the earlier mark, it is necessary to address the mark shown in use and determine whether

⁵ Exhibit 8

this is either use of the mark as registered and/or use of an acceptable variant of the same.

31. The opponent's registration is for the word mark "KIK"; however, the evidence includes use of the earlier mark in its registered form and as follows:



32. I first note the opponent's mark is registered in word-only format and, as such, it is protected for the word itself, not the form in which it is presented. As such, the font in the evidenced mark must not be taken into account.⁶ It is also settled law that use of a trade mark includes its independent use and its use as part of a composite mark, provided that it continues to be indicative of the origin of the product.⁷ With this in mind, I find that the additional wording or stylization elements shown above does not alter the distinctive character of the mark as registered. I say this because the word 'KIK' still retains its independent distinctive character when used in conjunction with wording such as "cloud" and this will be recognised as house brand - sub brand use. The same finding applies to the small

⁶ See *La Superquímica v EUIPO*, Case T-24/17, *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, and *PW Branding, Inc v Zabou Group Limited*, BL O/0234/25.

⁷ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

device above the letter “I”, I do not consider this alters the distinctive character of the mark as registered. The variants shown above therefore are acceptable and may be relied upon for the purposes of the genuine use assessment.

Assessment of the evidence

33. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.⁸ Genuine use depends upon a variety of factors, including the nature of the goods and the characteristics of the market, the consistency of sales over time and whether the use is warranted to create or maintain a share in that market.

34. The turnover figures show that consistent sales have taken place each year during the relevant period and the invoices provided demonstrate sales in relation to all of the registered goods. Whilst advertising expenditure has not been provided and the promotional activity in relation to the mark pre-dates the relevant period, when viewed as a whole, I am satisfied that the evidence demonstrates ongoing commercial activity. The opponent may therefore rely on all of its goods for the purpose of its opposition.

Section 5(2)(b)

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

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

[...]

⁸ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T 415/09

(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.”

Section 5(2) case law

36. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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

37. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

39. In *Gérard Meric v OHIM*,⁹ (“*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.

40. The goods to be compared are as follows:

Opponent’s goods	Holder’s goods
------------------	----------------

⁹ Case T-133/05

Class 34: Electronic cigarettes; electronic smoking devices; smokeless cigarette vaporiser pipe; tobacco substitutes (other than for medical purposes); cartridges and refill cartridges for electronic smoking devices and electronic cigarettes; parts and fittings for all of the aforesaid goods.	Class 34: Tobacco free oral nicotine pouches [not for medical use]; liquid nicotine solutions for electronic cigarettes.
---	--

41. The holder's *tobacco free oral nicotine pouches [not for medical use]* are tobacco-free nicotine goods intended to provide an alternative to tobacco products. In my view, they fall within the broad term *tobacco substitutes (other than for medical purposes)*. The goods are therefore identical in line with *Meric*. If I am wrong about that, I consider the goods to be highly similar, as they share the same nature, purpose, users and trade channels, and are in competition.

42. The earlier specification includes the term *tobacco substitutes (other than for medical purposes)*. I consider that this would include liquids such as vaping juices and e-liquids. Accordingly, I find the earlier goods to be identical to *liquid nicotine solutions for electronic cigarettes* based on the principle outlined in *Meric*. If I am wrong about that, I consider the goods to be highly similar, as they share a similar nature, purpose and user. They will share the same trade channels and are in direct competition.

The average consumer and the purchasing act

43. As the case law above indicates, it is necessary to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which the goods and services are likely to be selected by the average consumer.

44. 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.

45. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

46. The average consumer of the parties' goods is an adult 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.

47. 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, it is not uncommon for them 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

48. 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.

49. 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.”

50. 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.

51. The respective trade marks are shown below:

The opponent's mark	The holder's mark
KIK	

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

53. The holder's mark consists of the word “KICK” presented in a stylised form within a circular black background. The word “KICK” appears in white letters, with a large grey letter “K” positioned behind it. The wording “PREMIUM QUALITY” appears in small lettering along the upper edge of the circle. The overall

impression is dominated by the word “KICK”, which appears front and centre of the mark. The additional figurative elements, including the stylisation, background and the large grey “K” play a secondary role. The wording “PREMIUM QUALITY” is likely to be perceived as laudatory and, whilst not negligible, carries very little weight in the overall impression.

54. Visually, the marks coincide in the letters “KIK/KI–K”, sharing the same sequence of initial and final letters. The additional letter “C” in the contested mark creates a point of difference, as does the stylisation, figurative presentation and wording “PREMIUM QUALITY”. However, I have found that the stylisation, background and additional wording in the holder’s mark play lesser roles in the overall impression. Taking these factors into account, I find that the marks are visually similar to a medium degree.

55. The word “KICK” is an ordinary English dictionary word and will be pronounced in the normal way. The point of aural overlap lies in the word “KICK/KIK” which will be pronounced identically in both marks despite the difference in spelling. I consider that the IR will be simply articulated as “KICK”. The words “PREMIUM QUALITY” perform a purely laudatory function and are much smaller. Whilst not entirely negligible, they are certainly secondary to the word ‘KICK’. As such, they are unlikely to be verbalised.¹⁰ Further, I do not consider that the letter “K” in the background will be verbalised either as it would be regarded as representing the first letter of the word “KICK” and is merely part of the background. Consequently, I find the marks to be aurally identical.

56. The word “KICK” has a number of meanings, such as “to hit with the foot or feet”.¹¹ To my mind, the word “KIK” would be seen by a significant proportion of consumers as a misspelling of the word “KICK”. I therefore find that the meaning of that word will be the same in both marks; even if the average consumer perceives a different meaning of “KIK/KICK”, the same meaning will be attributed to both marks.

¹⁰ *Enrich Learning* BL O/1141/25 at [18]

¹¹ <https://www.collinsdictionary.com/dictionary/english/kick> [accessed 3 June 2026]

57. “PREMIUM QUALITY” in the holder’s mark will convey a clear meaning to consumers. This meaning has no counterpart in the opponent’s mark. However, it is laudatory in nature and carries very little weight in the overall impression of the holder’s mark.

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

Distinctive character of the earlier mark

59. 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).”

60. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence of use for its earlier mark. I will, therefore, consider whether this is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

61. The earlier mark consists solely of the word "KIK". Earlier in this decision I considered that a significant proportion of consumers would perceive this as a misspelling of the dictionary word "kick". This word is not descriptive or allusive to the goods at issue; however, it is an ordinary word that has a well-known meaning. Therefore, I consider that the opponent's earlier mark enjoys a medium degree of inherent distinctive character.

62. I now turn to consider the position with regards to an enhanced degree of distinctive character. I have already outlined the opponent's evidence when assessing genuine use.

63. The evidence shows that the use of the mark "KIK" for its earlier registered goods such as vape juices, e-cigarettes, vape coils has been longstanding and consistent, with continuous sales over a number of years. Whilst the sales figures are not insignificant, neither can they be described as substantial. Further, the sales figures themselves are modest when taken in the context of the market as a whole, for the goods in issue.

64. The opponent claims that their revenue for vaping goods is approximately £76.1 million and relies on a 2023 report valuing the vaping market at around £1.2 billion. However, the revenue figure provided by the opponent includes their other vaping brands such as "88vape". Further, the turnover figures provided by the opponent in relation to the "KIK" mark are a total of £3,174 480 between 2019 to

2024. This indicates that only a very small proportion of the opponent's £76.1 million revenue relates to "KIK"-branded goods.

65. The opponent submits that they have significantly invested in promoting its mark over the last five years, however advertising and marketing expenditure figures have not been provided. The promotional activity is not shown to be extensive and the evidence indicates only a fairly modest social media presence. However, the opponent has provided evidence to confirm that in July 2023, "KIK" was the second most recognised brand in the UK e-cigarette industry.

66. Overall, the evidence shows consistent and geographically widespread sales of the goods in the UK over a number of years. Having considered the evidence as a whole, I find that the opponent has demonstrated some enhancement to the distinctive character of its earlier mark as a result of use, but only to a limited extent. The distinctive character of the earlier mark has therefore been enhanced to above medium, but not significantly so.

Likelihood of confusion

67. 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.

68. 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 a medium degree. I have found the marks to be aurally identical. I have found the marks to be conceptually similar to a very high degree. I found the earlier mark to hold a medium degree of inherent distinctiveness and that this has been enhanced to above a medium degree but not significantly.

69. I note that the dominant and distinctive element in both marks is highly similar. The holder's mark contains additional elements which have no counterpart in the earlier mark; however, I have found these to play a lesser role in the overall impression. During the purchasing process, both visual and aural elements will play a role, and I have already found that the marks will be articulated identically. From a visual perspective, I have found the marks to be similar to a medium degree, and conceptually they are very highly similar, given that their distinctive elements are identical in meaning. Even where the purchase is primarily visual, it is plausible that "KIK" and "KICK" will be perceived as the same word, with any misspelling going unnoticed. The average consumer is also likely to imperfectly recall the marks, potentially misremembering the particular stylisation, whether the dominant word appeared against a background, or the presence of any smaller, laudatory wording. Bearing all of these factors in mind, it is my view that the additional elements in the holder's mark are unlikely to distinguish the parties' marks from one another. The marks may therefore be misremembered by way of imperfect recollection and recalled as the same "KIK/KICK" mark. The average consumer will be directly confused as a result.

70. I will now consider whether there is a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, 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”).

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

72. Having previously concluded that there is a high degree of visual similarity and aural identity between “KIK/KICK” (and that the difference between them may be imperfectly recalled), I am of the view that even if the average consumer recognises the differences created by the stylisation, the background and the words “PREMIUM QUALITY” in the holder’s mark, they are still likely to imperfectly recollect the differences in spelling between the dominant word elements. In those circumstances, it is my view that the other differences between the marks would likely be attributed to the use of variant marks, rather than denoting identical or similar goods from different undertakings. The addition of the words “PREMIUM QUALITY” will be viewed as a non-distinctive addition, and the stylisation and background used in the holder’s mark will be viewed as a logo version of the opponent’s mark. I also consider that it is not uncommon for undertakings to use such variant presentations of their marks in different commercial contexts. Due to the similarities between the marks, in addition to the goods being identical or highly similar, I find that if the average consumer notices these stylistic differences, these will not be put down to coincidence, but they will instead regard the holder’s mark as an alternative version of the opponent’s mark. Consequently, I find there is a likelihood of indirect confusion.

Conclusion

73. The section 5(2)(b) ground succeeds in its entirety.

Section 5(3)

74. Section 5(3) of the Act states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage

of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

75. Section 5(3A) of the Act states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

76. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is

clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

77. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are identical or similar, and I have discussed their level of similarity in paragraphs 54 to 58 above. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the designation date of the IR i.e. 21 February 2024.

Reputation

78. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

79. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

80. I have already found that the evidence was sufficient for the purposes of establishing that the distinctive character of the opponent's mark had been enhanced at the relevant date. Whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same.¹² For the same reasons as given at paragraphs 63 to 66, I am satisfied that the opponent's mark had a qualifying reputation at the relevant date for all of its earlier goods, but only to a modest degree.

Link

81. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

¹² *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

I have already found that the marks are visually similar to a medium degree, aurally identical and conceptually similar to a very high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

I have found the parties' goods considered above to be identical or highly similar. I apply the same findings in relation to the relevant public and purchasing process as set out above in paragraphs 46 and 47.

The strength of the earlier mark's reputation

The earlier mark enjoys a modest reputation in relation to the goods for which its mark is registered.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

As set out previously, I find the opponent's mark to hold a medium degree of inherent distinctive character. I am satisfied, however, that the mark's distinctiveness has been enhanced to above a medium degree (but not significantly) in respect of the relied upon goods.

Whether there is a likelihood of confusion

Earlier in my decision I found a likelihood of direct and indirect confusion between the parties' marks in respect of all the designated goods.

Damage

82. I must now consider whether any of the possible damage which has been pleaded will arise.

Unfair advantage

83. In its submissions in lieu, the opponent writes as follows in respect of unfair advantage:

“Use of the Contested Sign by the Applicant will clearly take unfair advantage of the reputation enjoyed by the Opponent in the KIK mark. The Applicant will be able to promote its goods and is likely to obtain custom because of the link that will be made.”

84. I note that in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

85. Unfair advantage does not require proof of a subjective intention by the applicant to benefit from the reputation of the opponent's mark. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is

nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

86. For there to be an unfair advantage, it means that consumers are more likely to buy the goods of the contested mark than they would otherwise have been if they had not been reminded of the earlier mark. I have already found that there is a likelihood of direct and indirect confusion between the marks, whereby the marks may be mistaken for one another, or the holder’s goods may be purchased in the mistaken belief that they are provided by, or economically connected with, the opponent. In such circumstances, it is clearly foreseeable that the holder will secure an unfair commercial advantage by benefitting from the opponent’s repute (albeit modest) without paying financial compensation. Consequently, I find that damage is made out in respect of all the designated goods.

87. As I have found there to be unfair advantage, I do not consider it necessary to assess the other pleaded heads of damage.

Conclusion

88. The opposition under section 5(3) succeeds.

CONCLUSION

89. The opposition under sections 5(2)(b) and 5(3) of the Act is successful. Subject to any appeal against this decision, the IR shall be refused protection in the UK.

COSTS

90. 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 **£1,600** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for filing Form TM7:	£200
Preparing the Statement of Grounds and considering the Counterstatement:	£250
Filing evidence:	£800
Preparing written submissions in lieu:	£350
Total:	£1,600

91. I therefore order Osaühing Grenkem to pay Supreme Imports Ltd the sum of **£1,600**. 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 June 2026

Catrin Williams
For the Registrar