

O/0557/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003997331

IN THE NAME OF JIANHUI NIE

FOR THE FOLLOWING TRADE MARK:

Xlim Plus

IN CLASS 34

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. CA000507792 BY

SHENZHEN FUTURE TECH CO., LIMITED.

Background and pleadings

1. Jianhui Nie (“the proprietor”) is the owner of the trade mark shown on the cover page of this decision (“the contested mark”). The contested mark was filed on 02 January 2024 and registered on 29 March 2024 in respect of the following goods:

Class 34: Oral vaporizers for smokers; Smokeless cigarette vaporizer pipes; Electronic cigarette cartomizers; Electronic cigarette atomizers; Vaporizers for smoking purposes; Hookah tobacco; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Shisha tobacco; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Cigar humidifiers; Menthol pipe tobacco; Menthol cigarettes; Humidifiers for tobacco; Flavored tobacco; Snus with tobacco; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Hemp for smoking; Cigar pouches; Electronic nicotine inhalation devices; Humidifiers for cigars; Cigarette tobacco; Refill cartridges for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Tobacco free oral nicotine pouches [not for medical use]; Roll-your-own tobacco; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Cigars for use as an alternative to tobacco cigarettes; Smokeless tobacco; Smoking tobacco; Cigar lighters; Electronic shisha pipes; Snus without tobacco; Mentholated tobacco; Pipes for smoking mentholated tobacco substitutes; Tobacco tar for use in electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Tobacco containers and humidors; Flavourings for tobacco; Tea for smoking as a tobacco substitute; Portable cigarette ash pouches; Mouthpieces for cigarettes; Cartridges for electronic cigarettes; Liquids for electronic cigarettes; Cigar filters; Liquid for electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Tobacco pouches; Pouches for tobacco; Pouches (Tobacco -); Smokers (Lighters for -); Lighters for smokers; Cigar tubes; Pipe tobacco; Electronic hookahs; Hookahs; Inhalers for use as an alternative to tobacco cigarettes; Snus; Flavorings, other than essential oils,

for tobacco; Electronic devices for the inhalation of nicotine containing aerosol; Flavourings, other than essential oils, for use in electronic cigarettes; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; Shisha pipes; Cigarillos; Tobacco; Replaceable cartridges for electronic cigarettes; Gas containers for cigar lighters; Cigar lighters (Gas containers for -); Cigar clippers; Tobacco pipe cleaners; Electronic cigarette cleaners; Flavourings, other than essential oils, for tobacco; Electronic cigars; Electric cigarettes [electronic cigarettes]; Devices for extinguishing heated cigarettes and cigars as well as heated tobacco sticks; Cigarettes; Tobacco powder; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Hand-rolling tobacco; Cigarette lighters; Spittoons for tobacco users; Humidified cigar boxes; Tobacco free cigarettes, other than for medical purposes; Herbs for smoking; Devices for heating tobacco for the purpose of inhalation; Snuff with tobacco; Firestones for lighters for smokers; Smoking pipe cleaners; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Smoking sets for electronic cigarettes; Tobacco products; Humidors; Liquid solutions for use in electronic cigarettes.

2. On 12 September 2024, Shenzhen Future Tech Co., Limited (“the cancellation applicant”) applied to invalidate the contested mark in respect of all goods for which it is registered. The invalidation is brought under section 47 of the Trade Marks Act 1994 and is based upon section 5(2)(b). The cancellation applicant relies upon the following trade mark:

XLIM (“the earlier mark)

UK registration no: UK00003880087

Filing date: 20 February 2023; registration date: 12 May 2023

Relying on all goods being:

Class 34: Cigarettes containing tobacco substitutes, not for medical purposes; Electronic cigarettes; Liquid solutions for use in electronic cigarettes; Oral vaporizers for smokers; flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; tobacco

substitutes, not for medical purposes; electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigarette cases; liquid nicotine solutions for electronic cigarettes.

3. The cancellation applicant submits that the contested mark and the earlier mark are similar due to the main distinctive word “XLIM” and the services of each mark in Class 34 are identical or similar. On the basis of similarity of the marks and identity/similarity of the services, the cancellation applicant submits that there exists a likelihood of confusion on the part of the relevant public, which includes a likelihood of association with the earlier cancellation applicant’s mark.
4. The proprietor filed a counterstatement refuting the claims of the cancellation applicant and stating there were significant differences between the marks. The Tribunal confirmed in correspondence dated 22 May 2025 that the Form TM8 received on 6 December 2024 plus the additional document received on 27 January 2025 from the proprietor are sufficient in forming an adequate defence. The proprietor made reference to section 5(3), evidence of use and section 47(1) in its counterstatement but for the avoidance of doubt, those are not relevant here as the application for invalidation under section 47(2)(a) of the Act is based on section 5(2)(b) only, and consequently these references will be disregarded as irrelevant to the case
5. The proprietor is unrepresented. The cancellation applicant is represented by Trademark Tonic Limited. The cancellation applicant filed written submissions. Only the cancellation applicant filed evidence in these proceedings, and this will be summarised to the extent that it is considered appropriate. No hearing was requested and neither party filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.
6. 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.

EVIDENCE

7. The cancellation applicant filed evidence in chief in the form of a witness statement of Mr Justin Lai, dated 15 July 2025, accompanied by exhibits SF1 – SF12. Mr Lai is the CEO/Director of the cancellation applicant, a position he has held since November 2019.
8. The cancellation applicant filed written submissions dated 16 July 2025.
9. I have given due consideration to all of the documents filed but will only refer to the evidence/submissions as appropriate to the extent that it is necessary in my decision.

DECISION

10. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 of the Act reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) there is an earlier trade mark in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(5) Where the ground of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.

11. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

12. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

14. The earlier mark relied upon is deemed an earlier mark in accordance with the above provisions. It is noted that the proprietor included comments in its counterstatement wherein it requested proof of use. The earlier mark was not registered more than five years prior to the filing date of the contested mark meaning that the proof of use provisions under section 47(2A) of the Act do not apply. Consequently, the cancellation applicant may rely upon all of its goods as identified.

15. 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 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; 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 the goods

16. The parties goods are as follows:

The cancellation applicant's goods	The proprietor's goods
<u>Class 34</u> Cigarettes containing tobacco substitutes, not for medical purposes; Electronic cigarettes; Liquid solutions for use in electronic cigarettes; Oral vaporizers for smokers; flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; tobacco substitutes, not for medical purposes; electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigarette cases; liquid nicotine solutions for electronic cigarettes.	<u>Class 34</u> Oral vaporizers for smokers; Smokeless cigarette vaporizer pipes; Electronic cigarette cartomizers; Electronic cigarette atomizers; Vaporizers for smoking purposes; Hookah tobacco; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Shisha tobacco; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Cigar humidifiers; Menthol pipe tobacco; Menthol cigarettes; Humidifiers for tobacco; Flavored tobacco; Snus with tobacco; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Hemp for smoking; Cigar pouches; Electronic nicotine inhalation

	devices; Humidifiers for cigars; Cigarette tobacco; Refill cartridges for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Tobacco free oral nicotine pouches [not for medical use]; Roll-your-own tobacco; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Cigars for use as an alternative to tobacco cigarettes; Smokeless tobacco; Smoking tobacco; Cigar lighters; Electronic shisha pipes; Snus without tobacco; Mentholated tobacco; Pipes for smoking mentholated tobacco substitutes; Tobacco tar for use in electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Tobacco containers and humidors; Flavourings for tobacco; Tea for smoking as a tobacco substitute; Portable cigarette ash pouches; Mouthpieces for cigarettes; Cartridges for electronic cigarettes; Liquids for electronic cigarettes; Cigar filters; Liquid for electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Tobacco pouches; Pouches for tobacco; Pouches (Tobacco -); Smokers (Lighters for -); Lighters for smokers; Cigar tubes; Pipe tobacco;
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	Electronic hookahs; Hookahs; Inhalers for use as an alternative to tobacco cigarettes; Snus; Flavorings, other than essential oils, for tobacco; Electronic devices for the inhalation of nicotine containing aerosol; Flavourings, other than essential oils, for use in electronic cigarettes; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; Shisha pipes; Cigarillos; Tobacco; Replaceable cartridges for electronic cigarettes; Gas containers for cigar lighters; Cigar lighters (Gas containers for -); Cigar clippers; Tobacco pipe cleaners; Electronic cigarette cleaners; Flavourings, other than essential oils, for tobacco; Electronic cigars; Electric cigarettes [electronic cigarettes]; Devices for extinguishing heated cigarettes and cigars as well as heated tobacco sticks; Cigarettes; Tobacco powder; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Hand-rolling tobacco; Cigarette lighters; Spittoons for tobacco users; Humidified cigar boxes; Tobacco free cigarettes, other than for medical purposes; Herbs for smoking; Devices for heating tobacco for the purpose of inhalation; Snuff with tobacco; Firestones for lighters for smokers; Smoking pipe cleaners;
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	Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Smoking sets for electronic cigarettes; Tobacco products; Humidors; Liquid solutions for use in electronic cigarettes.
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17. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*¹ where the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgement:

“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.”

18. 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;

¹ Case C-39/97

- (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.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. In *Kurt v Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose

of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

22. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.²

24. The cancellation applicant submits that the goods are identical or highly similar. They submit that both marks cover electronic cigarettes, oral vaporizers for smokers, liquid/nicotine solutions for use in e-cigarettes and cigarette cases. The cancellation applicant submits that the goods are aimed at the same consumer groups, serve the same intended purpose (smoking/vaping) and are sold through the same trade channels, including vape shops and online marketplaces. They submit that the goods must be treated as identical, or at least closely similar for the purposes of the likelihood of confusion assessment.

25. The proprietor submits that although both trademarks are related to class 34 services, it is necessary to assess whether the actual categories of goods and services they target in the market are identical. The proprietor submits that even within similar categories, the two trademarks may cater to different consumer

² BL O/399/10

groups or market segments. While the proprietor's comments in the Form TM8 and the additional document received on 27 January 2025 are noted, when considering the likelihood of confusion under section 5(2)(b), the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties or the way in which they reach the market or the goods intended to be provided.³ Any differences between the actual goods offered by the parties or the parties' marketing/trading styles will, as a matter of law, have no bearing on the outcome of my assessment of similarity between the goods in issue, unless those perceived differences are apparent from the specifications.

Liquid solutions for use in electronic cigarettes; Electric cigarettes [electronic cigarettes]; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Oral vaporizers for smokers; Flavorings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Flavorings, other than essential oils, for tobacco; Flavourings, other than essential oils, for tobacco.

26. The above proprietor's goods all appear within the earlier mark's specification and, as such, are self-evidently identical to the corresponding goods of the cancellation applicant.

Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Liquids for electronic cigarettes; Liquid for electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Chemical flavorings in liquid form used to refill electronic cigarette cartridges.

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

27. The above proprietor's goods are all forms of liquid for use in electronic cigarettes. Consequently, they are identical under the principle outlined in *Meric* to the cancellation applicant's "Liquid solutions for use in electronic cigarettes".

Electronic devices for the inhalation of nicotine containing aerosol; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor.

28. Whilst the above goods are worded differently, they are goods that are commonly referred to as electronic cigarettes. Given this, they are self-evidently identical to the cancellation applicant's "electronic cigarettes" as opposed to being identical under the principle outlined in *Meric*.

Flavourings for tobacco;

29. The above proprietor's goods are identical under the principle outlined in *Meric* to the cancellation applicant's good "flavourings, other than essential oils, for tobacco".

Hookah tobacco; Shisha tobacco; Menthol pipe tobacco; Flavored tobacco; Cigarette tobacco; Roll-your-own tobacco; Smokeless tobacco; Smoking tobacco; Mentholated tobacco; Pipe tobacco; Tobacco; Tobacco powder; Hand-rolling tobacco; Snuff with tobacco; Tobacco products.

30. The above goods are all types of tobacco products. The closest comparable term in the earlier mark's specification is "cigarettes containing tobacco substitutes not for medical purposes". The purpose of both goods overlap as they are products intended for a consumer to obtain nicotine. The nature differs in that the above proprietor's goods are forms of tobacco used to insert into cigarettes, pipes or snorted for example, whereas the cancellation applicant's goods are cigarettes that are heated. The users overlap as both will be used by members of the public wanting to consume nicotine. The goods will be sold in the same retail premises (or online equivalents). There is no complementarity. However, there is an element of competition between the goods to the extent that the consumer wishing to consumer nicotine may purchase the above tobacco products themselves, or they

may buy a cigarette containing a tobacco substitute not for medical purposes. Overall, I consider the goods to be similar to a medium degree.

Menthol cigarettes

31. The above proprietor's goods are cigarettes infused with menthol to provide a mint flavour. The closest comparable cancellation applicant's term is "cigarettes containing tobacco substitutes, not for medical purposes". Both goods are a type of cigarette that share the same purpose, user, method of use and trade channels. The goods are in competition as the average consumer could choose *menthol cigarettes* over cigarettes containing tobacco substitutes. Taking all of this into consideration, I consider the goods to be similar to a high degree.

Tobacco containers and humidors; Humidors; Humidified cigar boxes; Humidifiers for cigars; Cigar humidifiers; Humidifiers for tobacco; Cigar tubes.

32. The above goods are containers used to store cigars and tobacco or other smoking articles, and to prevent them from drying out which is important to the flavour and longevity of the products. These goods will be used by consumers who smoke in conjunction with or alongside tobacco products but are not the tobacco product itself. The closest comparable cancellation applicant's term is "electronic cigarette cases". The purpose of both the proprietor's and cancellation applicant's goods is shared as they will be used to store and protect the article inside be that an electronic cigarette, a cigar or tobacco. The goods will not be in competition. The exact nature of the goods will vary, however, the average consumer may expect the goods to derive from the same undertaking. The respective goods may be sold via the same retailers. Although the respective goods are used alongside the respective smoking articles, I do not consider them to be complementary in the way set out in caselaw. Overall, I consider the goods to be similar to a low to medium degree.

Tobacco pouches; Pouches for tobacco; Pouches (Tobacco -); Cigar pouches;

33. The above goods could be interpreted as relating to nicotine pouches which deliver nicotine through the user's gums. In this case, the above proprietor's goods are most similar to the cancellation applicant's "liquid nicotine solutions for electronic cigarettes". The purpose of the goods overlaps as both goods allow a user to consume nicotine but differ where the above proprietor's goods are placed into the user's gums, and the cancellation applicant's goods are placed into an electronic cigarette to vaporise to allow the nicotine to be consumed. The nature of the goods overlaps to the extent that both contain nicotine but differ where the above proprietor's goods are pouches containing nicotine, while the cancellation applicant's goods are liquid solutions used to insert into an electronic cigarette to be vaporised. Users will overlap as both will be used by members of the general public who wish to consume nicotine. Trade channels will overlap. There is no complementarity. There may be an element of competition, as a consumer who wishes to consume nicotine may purchase tobacco pouches or liquid nicotine solutions for electronic cigarettes. Consequently, I consider these goods to be similar to a medium degree.

34. If I am wrong in this interpretation, the above goods could also be interpreted as containers for storing tobacco, cigars and related articles. The closest comparable cancellation applicant's term is "electronic cigarette cases". Following the same reasoning as per paragraph 32, I find these goods to be similar to a low to medium degree.

Tobacco free oral nicotine pouches [not for medical use];

35. I have interpreted the above goods as oral nicotine pouches, which deliver nicotine through the user's gums, being the same goods as those discussed at paragraph 33 above, albeit tobacco free. Following similar reasoning to that discussed at paragraph 33 above, I find that there is a medium degree of similarity between the above goods and the cancellation applicant's "liquid nicotine solutions for electronic cigarettes". As despite being tobacco free, the same findings apply.

Portable cigarette ash pouches.

36. The above goods are pouches/containers used to hold cigarette ash that is being disposed from a consumer's cigarette, be that a tobacco cigarette or not. The closest comparable cancellation applicant's good is "cigarettes containing tobacco substitutes, not for medical purposes". The purpose of the goods differs in that the cancellation applicant's good is a cigarette to smoke whereas the above proprietor's good is to collect the ash from the cigarette. The nature of the goods also differs in that the cancellation applicant's good is a pouch to collect ash and the above proprietor's good is a cigarette. The users overlap as all of the goods will be purchased by members of the general public who smoke cigarettes. The goods are not in competition. However, a significant proportion of consumers may consider that they are complementary with a significant proportion of consumers viewing the goods as indispensable to each other and such a relationship giving rise to a belief that they originate from the same undertaking. Overall, I find the goods to be similar to a low degree.

Cigarettes and other ready-for-use smoking articles; Cigarettes⁴.

37. The above goods are all cigarettes or other ready-for-use smoking articles which can include tobacco or tobacco-substitute products. I note the cancellation applicant's specification includes the term "cigarettes containing tobacco substitutes, not for medical purposes". The above proprietor's terms are not limited in any way so include "cigarettes containing tobacco substitutes, not for medical purposes" Given this, I find that the goods are identical under the principle outlined in *Meric*.

⁴ Cigarettes appears twice in the cancellation applicant's specification. Once as a stand alone term and again as part of a larger term consisting of additional goods that I will consider below.

Cigars, cigarillos and other ready-for-use smoking articles; Cigars for use as an alternative to tobacco cigarettes; Cigarillos.

38. The above goods are all articles for smoking, which can include tobacco or tobacco-substitute products. The closest comparable cancellation applicant's term is "cigarettes containing tobacco substitutes, not for medical purposes". The purpose of the goods overlap as all the goods are intended to allow the consumer to consume nicotine. The users overlap as all of the goods will be purchased by members of the general public wanting to consume nicotine. The nature of the goods overlap as they will all be of similar shapes and content and will be consumed in the same way via inhalation so the methods of use overlap. The goods may be sold in the same retail outlets (or online equivalents) to the same consumer. There is no complementarity. There may be an element of competition, as a consumer wishing to consume nicotine may buy either the above proprietor's goods or the cancellation applicant's goods to allow them to consume nicotine. Consequently, I find the goods to be similar to a high degree.

Snus; Snus with tobacco.

39. The above goods are tobacco products that are placed under the lip of the user to provide nicotine without the user smoking. The closest comparable cancellation applicant's good is "electronic cigarettes". Despite their differences in nature and method of use, the ultimate purpose of the goods overlap as they are intended to allow the consumer to consume nicotine. The users overlap as all of the goods will be purchased by members of the general public wanting to consume nicotine. The goods may be sold in the same retail outlets (or online equivalents) to the same consumer. There is no complementarity. There may be an element of competition, as a consumer wishing to consume nicotine may buy snus, or alternatively may buy an electronic cigarette. Consequently, I find the goods to be similar to a medium degree.

Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks;
Devices for extinguishing heated cigarettes and cigars as well as heated tobacco sticks.

40. The above goods are devices used to stop cigarettes, cigars and heated tobacco sticks burning. The closest comparable cancellation applicant's goods are "cigarettes containing tobacco substitutes, not for medical purposes". The purpose of the goods differs as the above proprietor's goods are used to extinguish a heated cigarette, cigar or tobacco stick and the cancellation applicant's goods are cigarettes used for smoking. The users overlap as all of the goods will be purchased by members of the general public who smoke cigarettes. The nature of the goods differ. The goods may be sold in the same retail outlets (or online equivalent) to the same consumer. There is no competition. However, there is an element of complementarity as the average consumer is likely to believe that an undertaking responsible for *devices for extinguishing heated cigarettes, cigars and heated tobacco sticks* would also provide "cigarettes containing tobacco substitutes, not for medical purposes" and view the goods as indispensable to each other. Consequently, I find the goods to be similar to a low degree.

Smokers (Lighters for -); Lighters for smokers; Cigar lighters (Gas containers for -); Cigar lighters; Cigarette lighters; Devices for heating tobacco for the purpose of inhalation; Firestones for lighters for smokers; Gas containers for cigar lighters.

41. The above goods are used to produce a flame which is used to light a product that can be smoked such as a cigar or cigarette. These proprietor's goods may overlap with the cancellation applicant's goods being "cigarettes containing tobacco substitutes, not for medical purposes" in trade channels at a general level, as some retailers may sell cigarettes and associated products such as lighters. However, I consider it unlikely that the same businesses would produce these goods. Their method of use and purpose clearly differs as lighters are used to produce a flame which is used to light something, including cigarettes. The users are likely to overlap as members of the general public wishing to consume nicotine may use both sets of goods. However, other members of the general public may use lighters for non-smoking purposes. The nature of the respective goods differs. There is no

competition. Additionally, there is no complementarity as whilst the goods are important to one another, their relationship isn't such that would lead consumers to believe them to originate from the same undertaking. It is quite common for lighters to be produced by companies other than companies who produce cigarettes. Overall, I consider the goods to be dissimilar.

Vaporizers for smoking purposes; Electronic nicotine inhalation devices; Electronic shisha pipes; Electronic hookahs; Inhalers for use as an alternative to tobacco cigarettes; Electronic cigars; Smokeless cigarette vaporizer pipes; Smoking sets for electronic cigarettes.

42. I understand "vaporizers" in the proprietor's goods specification to be devices which convert liquids (which may or may not contain nicotine) into a vapour to be inhaled. I consider that all of the above proprietor's goods are all types of vaporisers. I say this because they all work on the same principle, of heating a liquid (which may or may not contain nicotine) into a vapour which can be inhaled. I understand the cancellation applicant's "electronic cigarettes" to be battery-powered devices that heat a liquid (which may or may not contain nicotine) to create an inhalable aerosol or vapour. In view of this, I consider that the proprietor's above goods are encompassed within the cancellation applicant's wider category of "electronic cigarettes", and therefore identical under the principle outlined in *Meric*.

Hookahs; Shisha pipes; Pipes for smoking mentholated tobacco substitutes.

43. The above goods are all different types of pipes used to smoke tobacco or tobacco substitutes by heating the tobacco or tobacco substitutes. The closest comparable term in the cancellation applicant's specification is "electronic cigarettes". The purpose of the goods overlap as all the goods are intended to allow the consumer to consume nicotine. The users overlap as all of the goods will be purchased by members of the general public wanting to consume nicotine. The nature of the goods differs where the above goods are typically pipes containing tobacco or tobacco substitutes that are burnt to enable the consumer to obtain nicotine, while the cancellation applicant's goods involve a liquid solution containing nicotine being

vaporised to allow the consumer to obtain nicotine. However, the method of use overlaps as the goods are all inhaled by the consumer. The goods may be sold in the same retail outlets (or online equivalents) to the same consumer. There is no complementarity. There may be an element of competition, as a consumer wishing to consume nicotine may buy either the above proprietor's goods or electronic cigarettes to allow them to consume nicotine. Consequently, I find the goods to be similar to a medium degree.

Refill cartridges for electronic cigarettes; Cartridges for electronic cigarettes; Replaceable cartridges for electronic cigarettes; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes.

44. The above goods are component parts of an electronic cigarette which can all include cartridges filled with liquid. Given this, the above goods are identical under the principle outlined in *Merix* with the cancellation applicant's goods "liquid solutions for use in electronic cigarettes".
45. If any of the above proprietor's goods are not filled with liquid, they are still similar to the cancellation applicant's goods "liquid solutions for use in electronic cigarettes" as they can be filled with liquid solutions even if this is not expressly stated. The goods differ in nature as the cancellation applicant's goods are in liquid form which would need to be manually poured/added to a cartridge to be inserted into an electronic cigarette, while the proprietor's goods are cartridges containing a liquid which will be added to an electronic cigarette as a whole component part. The goods overlap in user, being members of the general public who use electronic cigarettes. The goods will be sold within the same retail premises (or online equivalent) such as a vape store. The goods are complementary, as the cancellation applicant's "liquid solutions for use in electronic cigarettes" are indispensable to the proprietor's goods and the average consumer is likely to believe that an undertaking responsible for liquid solutions for electronic cigarettes would also provide those liquids in pre-filled cartridge form. The cancellation applicant's "liquid solutions for use in electronic cigarettes" is broad and could contain liquids with chemical flavourings. I also consider that the goods would be

in competition, as they overlap in purpose, and a consumer may choose to buy a pre-filled cartridge rather than a liquid to refill an electronic cigarette manually. Overall, I find the goods to be similar to a high degree.

Tobacco free cigarettes, other than for medical purposes.

46. The above goods are identical under the principle outlined in *Meric* with the cancellation applicant's "cigarettes containing tobacco substitutes, not for medical purposes".

Electronic cigarette cartomizers; Electronic cigarette atomizers.

47. The above goods are component parts of electronic cigarettes. There is an overlap in intended purpose with the cancellation applicant's "electronic cigarettes" as they are used to enable consumers to inhale various vapours. However, they differ in nature and method of use as the proprietor's goods are part of the electronic cigarettes and fulfil specific functions based on its particular part or fitting. The goods overlap in user, being members of the general public who use electronic cigarettes. I consider that the respective goods will be produced by the same manufacturers and sold within the same type of retail premises (or online equivalent) such as a vape store. There is a degree of competition as a consumer may choose to buy component parts to modify or repair an electronic cigarette as required, rather than buy a new pre-assembled, ready to use product. The goods share a complementary relationship in that the proprietor's goods are component parts which are essential for electronic cigarettes to function, and the average consumer is likely to believe that the undertaking responsible for one good is also responsible for the other. Overall, I find the goods to be similar to a medium to high degree.

Hemp for smoking; Tea for smoking as a tobacco substitute; Herbs for smoking.

48. The above goods are types of tobacco substitutes which I consider to be encompassed by the cancellation applicant's wider category "tobacco substitutes,

not for medical purposes”. Therefore, I find the respective goods to be identical on the principle outlined in *Meric*.

Snus without tobacco.

49. The above goods are types of tobacco substitutes for people who wish to consume nicotine without tobacco. I consider this good to be encompassed by the cancellation applicant’s wider term of “tobacco substitutes not for medical purposes”. Consequently, I find the goods to be identical on the principle outlined in *Meric*.

Tobacco tar for use in electronic cigarettes.

50. Without any submissions from the parties, it is my understanding that tobacco tar is not routinely used in electronic cigarettes. Electronic cigarettes are generally considered not to be tobacco products, as their core function is the heating of a liquid to produce a vapour which can be inhaled. However, as the above proprietor’s term specifically states *tobacco tar for use in electronic cigarettes*, it is undeniably a tobacco product. On this basis, I consider the closest comparable cancellation applicant’s term to be “liquid solutions for use in electronic cigarettes”. Without submissions from the parties, and with the understanding that electronic cigarettes are filled with liquids, I presume that *tobacco tar for use in electronic cigarettes* is also in a liquid state. Given this, I find the goods to be identical on the principle outlined in *Meric*.

Mouthpieces for cigarettes.

51. The above goods are smoking accessories that are attached to a cigarette that can filter smoke. They can also reduce residue on the consumers fingers as the consumer can hold the mouthpiece instead of the cigarette itself. The closest comparable cancellation applicant’s term is “cigarettes containing tobacco substitutes, not for medical purposes”. The purpose of these goods differs as the above proprietor’s goods are used to enhance the smoking experience of smoking a cigarette and the cancellation applicant’s goods are cigarettes used for smoking.

The users overlap as all of the goods will be purchased by members of the general public who smoke cigarettes. The nature of the goods differ with the above proprietors goods being mouthpieces made of various materials such as wood, metal or glass and the cancellation applicant's goods being cigarettes containing tobacco substitutes, not for medical purposes. The goods may be sold in the same retail outlets (or online equivalents) to the same consumer. There is no competition. However, there is an element of complementarity as the average consumer is likely to believe that an undertaking responsible for *mouthpieces for cigarettes* would also provide "cigarettes containing tobacco substitutes, not for medical purposes". Consequently, I find the goods to be similar to a low degree.

Cigar filters.

52. The above goods are typically made of plastic or paper and are placed into cigars to reduce the harmful chemicals inhaled by smokers. The closest comparable cancellation applicant's term is "cigarettes containing tobacco substitutes, not for medical purposes". The purpose of the goods overlap as all the goods are intended to allow the consumer to smoke cigars or cigarettes, and differ where the above proprietor's goods are placed into the cigar before folding then inhaled through, while the cancellation applicant's goods are smoked by the user to consume nicotine. The users overlap as all of the goods will be purchased by members of the general public wanting to consume nicotine through the smoking of cigarettes or cigars. The goods differ in nature as the proprietors goods are filters that will be added to cigars whereas the cancellation applicant's goods are cigarettes. The goods will be sold in the same retail premises (or online equivalent) to the same consumer. The goods are not in competition. Consequently, I find the goods to be similar to a low degree.

Cigar clippers.

53. Without submissions to suggest otherwise, it is my understanding that the above goods are used to cleanly cut the closed end of a cigar. The closest comparable cancellation applicant's term is "cigarettes containing tobacco substitutes, not for medical purposes". These goods may overlap in trade channels at a general level,

as some retailers may sell “cigarettes containing tobacco substitutes, not for medical purposes” and associated products such as cigar clippers. However, I consider it unlikely that the same businesses would produce these goods. Their method of use and purpose clearly differs. The users are likely to overlap as members of the general public wishing to consume nicotine may use both sets of goods. The nature and purposes of the respective goods differs. There is no competition of complementarity. Overall, I consider the goods to be dissimilar.

Spittoons for tobacco users.

54. The above goods are receptacles that tobacco users can spit into. The closest comparable cancellation applicant’s term is “tobacco substitutes not for medical purposes”. Clearly these goods differ in purpose with the proprietor’s goods being used to spit into and the cancellation applicant’s goods being used as a substitute to tobacco to smoke, not for medical purposes. The nature differs with the proprietor’s goods being receptacles and the cancellation applicant’s goods being tobacco substitutes. The users are unlikely to overlap as consumers who smoke tobacco substitutes not for medical purposes may not require spittoons as they may not chew tobacco. I consider that the respective goods could be sold in the same retail premises and online stores, although I consider the above proprietor’s goods to be more niche. The respective goods are not in competition and are not complementary. Overall, despite the goods possibly being sold in the same establishments I do not think this is sufficient to find a level of similarity between the goods. Consequently, I find the goods to be dissimilar.

Tobacco pipe cleaners; Smoking pipe cleaners.

55. The above goods are tools used to clean tobacco pipes and smoking pipes. The closest comparable cancellation applicant’s good is “tobacco substitutes not for medical purposes”. The users are unlikely to overlap as consumers who smoke tobacco substitutes not for medical purposes may not smoke this through tobacco pipes or smoking pipes and therefore not require *tobacco pipe cleaners* or *smoking pipe cleaners*. The respective goods differ in nature, method of use and intended purpose as the above proprietors goods are products that are used for cleaning,

whereas the cancellation applicant's "tobacco substitutes not for medical purposes" are heated in pipes, cigarettes or other smoking articles. There is an overlap in trade channels, as stores that sell "tobacco substitutes not for medical purposes" are likely to also sell cleaning equipment especially for tobacco pipes and smoking pipes. The above proprietor's goods are not important or indispensable for the use of "tobacco substitutes not for medical purposes". The respective goods are not in competition. Consequently, I find that the goods are dissimilar.

Electronic cigarette cleaners.

56. The closest comparable term in the cancellation applicant's specification to the above good is "electronic cigarettes". The respective goods overlap in user as members of the general public who use electronic cigarettes may also purchase the cleaners to clean them. However, the respective goods differ in nature, method of use and intended purpose as the above proprietor's goods, *electronic cigarette cleaners*, are products that are used for cleaning, whereas the cancellation applicant's "electronic cigarettes" are used to inhale vapour. There is an overlap in trade channels, as stores that sell the electronic cigarettes are likely to also sell cleaning equipment especially for those devices. I consider that the respective goods may be produced by the same manufacturers. A significant proportion of consumers may consider the goods as complementary with a significant proportion of consumers viewing electronic cigarettes as important and indispensable to *electronic cigarette cleaners* and such a relationship giving rise to a belief that they originate from the same undertaking. The respective goods are not in competition as *electronic cigarette cleaners* cannot perform the role of electronic cigarettes themselves. Consequently, I find that the goods are similar to a low to medium degree.

Conclusion on the goods comparison

57. Where there is no similarity between goods, there can be no likelihood of confusion under section 5(2)(b) of the Act.⁵ As a result, my findings above mean that the invalidation must fail in respect of the following goods, being those that I have found dissimilar:

Class 34: Smokers (Lighters for -); Lighters for smokers; Cigar lighters (Gas containers for -); Cigar lighters; Cigarette lighters; Devices for heating tobacco for the purpose of inhalation; Firestones for lighters for smokers; Gas containers for cigar lighters; Cigar clippers; Spittoons for tobacco users; Tobacco pipe cleaners; Smoking pipe cleaners.

The average consumer and the nature of the purchasing act

58. 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.

59. In *Iconix Luxembourg Holdings* (cited above), 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;

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

- (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.

60. The cancellation applicant submits that “the relevant public comprises the general public, particularly adult consumers of vaping and tobacco alternative products”. They also submit that these low to mid-priced items are often purchased without much thought, either online or in person and buyers are unlikely to compare brands carefully and will frequently rely on their imperfect memory.

61. The proprietor submits that class 34 goods and services often include highly specialized products (e.g., vaping devices or tobacco alternatives) and consumers purchasing these products typically exhibit a higher level of attention, especially when it comes to health-related or high-cost products. The proprietor submits that

as a result consumers are more likely to notice the overall differences between the marks.

62. I consider the average consumer of the respective goods to be members of the general public who vape or smoke. In view of legislation around the sale of tobacco and smoking products, the average consumer will be over the age of 18. The cost of the goods will vary, from portable cigarette ash pouches, which are likely to be relatively inexpensive, to electronic cigarettes or humidors, which although more expensive are unlikely to be at the highest end of the spectrum. On average, consumers are likely to purchase these goods on a regular basis to sustain their smoking or vaping. However, some goods, such as humidors, will be purchased infrequently. During the purchasing process, consumers will consider factors such as safety of the product, technical features, nicotine content and flavour (where applicable). I do not agree with the proprietor's submission that consumers purchasing these products typically exhibit a higher level of attention, especially when it comes to health-related or high-cost products. As I have stated, not all of the products are high cost products and I would not consider them to be health related. Consequently, taking all factors into consideration, I consider that consumers will demonstrate a medium level of attention.

63. Many of the goods are likely to be kept behind a counter due to age restrictions and legislation on visual branding around the sale of cigarette and tobacco products. In these circumstances, consumers will request the goods from a retail assistant after viewing the products on a price list, or following their request to view them from behind the counter. However, some goods, such as portable cigarette ash pouches and cigar tubes, may be self-selected from shelves of retailers. The goods may also be sold online, where the goods will be selected by consumers after viewing information on a website. Overall, I consider that the selection process will be primarily visual but I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

Comparison of marks

64. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23)⁶ 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 mind their distinctive and dominant components.

65. 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.”

66. It would be wrong, therefore, to dissect the trade marks artificially, 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.

67. The respective trade marks are shown below:

The contested mark	The earlier mark
Xlim Plus	XLIM

⁶ C-251/95

68. The cancellation applicant submits that as the contested mark contains the entirety of the earlier mark at the beginning, this makes “Xlim” the dominant and distinctive element in both marks. The cancellation applicant submits that the additional word “Plus” in the contested mark is descriptive and commonly used across industries to signify an upgraded or extended version of a core product. They state the word “Plus” does not add distinctiveness and will not be seen as an indicator of trade origin. The cancellation applicant submits that the average consumer pays most attention to the first part of a mark and as “Xlim” is the first and visually dominant component of the contested mark, it will leave the strongest impression in the consumers minds. Due to the shared word “Xlim” which is the dominant syllable in both marks, the cancellation applicant submits there is a substantial degree of aural similarity between the marks. Additionally, the cancellation applicant submits that the marks are conceptually similar.

69. In its counterstatement, the proprietor submits that the contested mark has clear and inherent distinctiveness within the vaping market. The proprietor submits that the name combines unique phonetic and visual elements, ensuring it is distinguishable from other brands. Additionally, the proprietor submits that “Xlim” is a similar component in both marks, but the word “Plus” creates significant differences in visual appearance, pronunciation and meaning. They state that the word “Plus” is not merely a descriptive addition but serves as a distinguishing element that differentiates the marks. The proprietor submits that although “Xlim” is a distinctive term, the inclusion of “Plus” strengthens the brand’s identity, making it more specific and distinguishable. They state that the word “Plus” contributes to consumer recognition and helps separate it from the earlier mark.

Overall impression

70. The contested mark is a word only mark consisting of the words “Xlim” and “Plus”. There are no additional elements to the contested mark and while the consumer does not artificially dissect trade marks, for reasons I will come to discuss further below, I am of the view that the word “Xlim” will play the greater role in the overall impression of the contested mark, with “Plus” playing a lesser role.

71. The earlier mark is a word only mark consisting of the word “XLIM”. There are no additional elements to the mark and therefore the overall impression lies in the word itself.

Visual comparison

72. As both marks are word only marks, they are protected for use in any case. As such, the use of different cases is not a point of consideration for the present assessment. Visually, the contested mark and the earlier mark overlap through the use of the word “Xlim”, which is the first word in the contested mark and the entirety of the earlier mark. The marks differ in the presence of the word “Plus” in the contested mark. Regardless of its role within the mark, this point of difference will have an impact on the visual comparison of the marks. Overall, I am of the view that the shared use of the word “Xlim”, being the entirety of the earlier mark and the first word of the contested mark, (bearing in mind that consumers tend to focus on the beginning of marks),⁷ is sufficient to result in a finding that the marks at issue are visually similar to a medium to high degree.

Aural comparison

73. The earlier mark consists of one syllable and the contested mark consists of two syllables. When considering the word “Xlim” which makes up the entirety of the earlier mark and the first word of the contested mark, I am of the view that the majority of UK consumers will not know how to pronounce this word and consequently it could be pronounced in multiple ways. These could include “EX-LIM” or “Z-LIM”. Regardless of the way the consumer pronounces the earlier mark, they are likely to pronounce the first word of the contested mark in the same way. For example, logic dictates that the consumer using “EX-LIM” is likely to pronounce the first word of the contested mark in the same way. This results in a greater degree of aural similarity between the marks. Despite the role that “Plus “ plays in the contested mark (which I will discuss in further detail below), I consider that it

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

will be pronounced by the consumer.⁸ As such, “Plus” acts as a point of aural difference. In comparing the earlier mark and the contested mark, despite the additional different second syllable in the contested mark the dominant elements are identical. As a result, I find that the marks are aurally similar to a medium to high degree.

Conceptual comparison

74. For a mark to have a conceptual meaning, it must carry an immediately graspable meaning. ‘XLIM’ with either be viewed as either a made-up or foreign language word with no obvious meaning to the UK consumer. As a result it will have no conceptual meaning.

75. The contested mark consists of two words “Xlim Plus”. The concept of the word “Xlim” is as per the preceding paragraph. As for “Plus”, I am of the view that this will be seen as a suggestive word that points to the character or quality of the goods at issue i.e. that there is something “additional” or “enhanced” being offered to consumers. I find that this applies regardless of how consumers view the word “Xlim”. However, overall, I do not consider that it creates a significant conceptual difference over and above “Xlim”.

76. In comparing the marks, despite the cancellation applicant submitting that there is a degree of conceptual similarity, I find that because the dominant elements of the marks carry no meaning, they are not capable of a conceptual comparison. The only element across the parties’ marks that will be known is the word “Plus” which ultimately acts as a point of conceptual dissimilarity. Consequently, I find the marks to be conceptually neutral (as the dominant elements of the mark are conceptually neutral) with an element of dissimilarity, as the known word “Plus” create a point of difference.

⁸ I say this while bearing in mind the case of *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22, wherein Mr Philip Harris, sitting as the Appointed Person, found that the descriptiveness of an element does not necessarily make it aurally invisible.

Distinctive character of the earlier mark

77. 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).”

78. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. The cancellation applicant has not pleaded that its mark has obtained an enhanced level of distinctiveness and no evidence has been filed to that effect. As such, I only have the inherent position to consider.

79. The earlier mark comprises the word “XLIM”. As previously outlined in my comparison of the marks, I have found that the average consumer will see “XLIM” either as an invented word or a foreign language word with no meaning. It is not descriptive of, nor does it allude to the goods for which it is registered. Given this, I find that the earlier mark has a high degree of inherent distinctive character.

Likelihood of confusion

80. 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 they have retained in their mind.

81. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

82. Throughout the course of this decision, I have found that the respective goods range from being identical to similar to a low degree. The average consumers are members of the general public who vape or smoke over the age of 18, who will select the goods via primarily visual means (though I do not discount an aural

component) after having paid a medium level of attention during the purchasing process. I have found the marks to be similar to a medium to high degree from a visual and aural perspective. I have found the marks to be conceptually neutral with an element of dissimilarity and I have found the earlier mark to possess a high degree of inherent distinctive character.

83. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I consider the present case represents an example of direct confusion. I base the finding primarily in reliance upon the identity between the sole element of the earlier mark being “XLIM” and the dominant part of the contested mark being “Xlim”. I consider that the consumer would attempt to pin their recollection of the mark on the identical word “Xlim” and, as such, may misremember which mark contained the weaker “Plus” element and which did not. As a result, I consider that there exists a likelihood of direct confusion between the marks. Given that the dominant element of the marks (being that which the consumer will pin their recollection on) is identical, I am of the view that this finding applies even with consumers paying a medium degree of attention.

84. In the event I am incorrect about this case being an example of direct confusion, I will now consider if there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, 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”).

85. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*.⁹ This is mere association not indirect confusion.

86. The types of examples of indirect confusion as set out in *L.A. Sugar* (cited above) are not exhaustive. However, they are the most usual circumstances where indirect confusion may arise. In the present case, the sole element of the earlier mark, being “XLIM”, and the dominant part of the contested mark, being “Xlim”, are identical. The present assessment of indirect confusion is focused on the consumer noticing the second word of the contested mark being “Plus”. When confronted with the marks, I find that the contested mark will be interpreted to be a sub-brand of

⁹ BL O/547/17

the earlier mark. This is on the basis that the addition of the word “Plus” after “XLIM” will be seen as an indication that “XLIM” has expended its brand to offer an enhanced version of its goods. As such, consumers will believe that the marks originate from the same, or a linked undertaking. Taking all of this into consideration, I consider there to be a likelihood of indirect confusion. Given the identity of the “XLIM” element, I find that this applies even in circumstances where the goods are similar to a low degree.

CONCLUSION

87. The application for invalidation under section 5(2)(b) succeeds in respect of all the goods that I have found to be identical or similar. Therefore, subject to any successful appeal, the contested mark will be declared invalid and deemed as if it had never been applied for, in respect of the following goods:

Class 34: Oral vaporizers for smokers; Smokeless cigarette vaporizer pipes; Electronic cigarette cartomizers; Electronic cigarette atomizers; Vaporizers for smoking purposes; Hookah tobacco; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Shisha tobacco; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Cigar humidifiers; Menthol pipe tobacco; Menthol cigarettes; Humidifiers for tobacco; Flavored tobacco; Snus with tobacco; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Hemp for smoking; Cigar pouches; Electronic nicotine inhalation devices; Humidifiers for cigars; Cigarette tobacco; Refill cartridges for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Tobacco free oral nicotine pouches [not for medical use]; Roll-your-own tobacco; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Cigars for use as an alternative to tobacco cigarettes; Smokeless tobacco; Smoking tobacco; Electronic shisha pipes; Snus without tobacco; Mentholated tobacco; Pipes for smoking mentholated tobacco substitutes; Tobacco tar for use in electronic

cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Tobacco containers and humidors; Flavourings for tobacco; Tea for smoking as a tobacco substitute; Portable cigarette ash pouches; Mouthpieces for cigarettes; Cartridges for electronic cigarettes; Liquids for electronic cigarettes; Cigar filters; Liquid for electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Tobacco pouches; Pouches for tobacco; Pouches (Tobacco -); Cigar tubes; Pipe tobacco; Electronic hookahs; Hookahs; Inhalers for use as an alternative to tobacco cigarettes; Snus; Flavorings, other than essential oils, for tobacco; Electronic devices for the inhalation of nicotine containing aerosol; Flavourings, other than essential oils, for use in electronic cigarettes; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; Shisha pipes; Cigarillos; Tobacco; Replaceable cartridges for electronic cigarettes; Electronic cigarette cleaners; Flavourings, other than essential oils, for tobacco; Electronic cigars; Electric cigarettes [electronic cigarettes]; Devices for extinguishing heated cigarettes and cigars as well as heated tobacco sticks; Cigarettes; Tobacco powder; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Hand-rolling tobacco; Humidified cigar boxes; Tobacco free cigarettes, other than for medical purposes; Herbs for smoking; Snuff with tobacco; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Smoking sets for electronic cigarettes; Tobacco products; Humidors; Liquid solutions for use in electronic cigarettes.

88. That being said, the application for invalidation under section 5(2)(b) fails in respect of all of the goods that I have found to be dissimilar. Therefore, subject to any successful appeal of my decision, the contested mark may remain registered for the following goods:

Class 34: Class 34: Smokers (Lighters for -); Lighters for smokers; Cigar lighters (Gas containers for -); Cigar lighters; Cigarette lighters; Devices for heating tobacco for the purpose of inhalation; Firestones for lighters for smokers; Gas containers for cigar lighters; Cigar clippers; Spittoons for tobacco users; Tobacco pipe cleaners; Smoking pipe cleaners.

COSTS

89. Although both parties have achieved a measure of success in these proceedings, on balance, I consider the cancellation applicant has enjoyed the greater degree of success in partially invalidating the contested mark. Therefore, I consider that the cancellation applicant is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 1/2023. Given the proprietor has succeeded in registering some of their goods, I consider it appropriate to reduce the costs award to a degree in order to reflect the proprietor's success.

90. In the circumstances, I award the cancellation applicant the sum of £400 as a contribution towards the cost of proceedings. The sum is calculated as follows:

Official fee:	£200
Preparing the application for invalidity and considering the counterstatement:	£250
Reduction	-£50
Total:	£400

91. I therefore order Jianhui Nie to pay Shenzhen Future Tech Co., Limited the sum of £400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2026

N Barratt
For the Registrar