O/0636/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3690154

BY

UNBRANDED VAPE SUPPLIES LTD

TO REGISTER THE FOLLOWING TRADE MARK
IN CLASS 34

MY E-LIQUID SUPPLIES

AND OPPOSITION THERETO UNDER NUMBER 427457

BY

FAYAZ MUSSA

Background and Pleadings

1. On 3 September 2021, Unbranded Vape Supplies Ltd ("the Applicant") applied to register the UK trade mark numbered 3690154 **My E-Liquid Supplies** ("the contested mark") for goods in class 34, as set out in full later in my decision. It was accepted and published for opposition purposes on 8 October 2021.

2. On 8 October 2021, Fayaz Mussa ("the Opponent") filed an opposition to the application under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), relying on the following trade mark:

UKTM no. 3287592

Filed on 4 February 2018 and registered on 11 May 2018.

Class 34: 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; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges.

3. Under section 5(2)(b) Mr Mussa claims that as a result of the similarity between the marks and the identity/similarity between the goods there is a likelihood of confusion and in particular that:

"we have been contacted on many an occasion by consumers confusing the 2 companies….as we work in the same field of business we feel this to be similar to our mark as a result of these customer interactions."

4. The Applicant filed a defence and counterstatement denying that the marks are similar or similarity/identity as between the goods. The Applicant submitted in particular that the contested mark is for a complete word phrase and is its trading name and website name. It also submits that it has a very large client base with no incidents of confusion having arisen. It is said that its products are vastly different and are intended for different users and markets, supplying manufactured liquids and ingredients and DIY supplies that are unbranded in different bottles and sizes.

5. The trade mark upon which Mr Mussa relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark has completed its registration process no more than 5 years before the application, it is not subject to the proof of use requirements under section 6A of the Act and therefore it may rely upon all the goods of its registration without having to demonstrate the use it has made of them.

6. Neither party is represented. Other than filing the original pleadings neither party filed evidence or further submissions nor did they request a hearing. This decision is, therefore, taken following a careful perusal of all the papers.

Relevance of EU Law

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Decision

Section 5(2)(b)

8. Section 5(2)(b) of the Act states 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."

9. And Section 54A states:

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

General principles

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

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

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

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

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

permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly 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

11. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 that:

> "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."

12. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market,("OHIM")* 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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

14. 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".

15. Furthermore, terms used in specifications of goods should not be interpreted widely but confined to the core of the possible meanings attributable to the terms.[1]

16. The respective goods at issue are as follows:

Contested Goods	**Opponent's goods**
Class 34 Electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Electric cigarettes [electronic cigarettes];Liquid for electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Flavorings, other than essential oils, for use in electronic cigarettes; Personal vaporisers and electronic cigarettes,	Class 34 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; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges

[1] *Sky v Skykick* [2020] EWHC 990 (Ch) as per Arnold J.

and flavourings and solutions therefor; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges.	

17. In general, both parties' goods consist of liquids, favourings or articles/containers used for smoking. I shall therefore consider each term in turn, grouping terms together where appropriate.[2]

Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid for electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Flavourings, other than essential oils, for use in electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges.

18. These applied for goods are either the liquids or the flavourings used in electronic cigarettes. They are identical to the Opponent's *Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges 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; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin;* either self-evidently because the same term is used or in accordance with the principles in *Meric.*

[2] *Separode* Trade Mark BL O-399-10, Mr Geoffrey Hobbs K.C

Electronic cigarettes; Electric cigarettes [electronic cigarettes]; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor;

19. These goods are the actual articles/oral vaporisers used for smoking tobacco substitutes and whilst not identical to the Opponent's goods they are used together. The respective goods differ in nature and method of use but they overlap in user, trade channels, producer and purpose. I also consider that the respective goods are complementary in so far as the nicotine substitute liquids and flavourings are important or indispensable to the e-cigarettes themselves such that consumers would believe that the responsibility for the respective goods would be the same. On this basis, I consider that the goods are similar to a medium degree.

Average consumer and the nature of purchasing process

20. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.[3]

21. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch),* Birss J described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

22. The Applicant submits that the products it supplies are vastly different with a different user base and market. I disagree. Taking the terms as registered, I must have regard to all the potential uses of the goods and not how they are in reality marketed. The goods in question are consumable disposable items of relatively low value, directed at the part of the general population (over the age of 18) who use e-cigarettes,

[3] *Lloyd Schuhfabrik Meyer*, case c-342/97.

which will be the same as those consumers who use e-liquid/e-cigarette flavourings. Considerations such as price, ease of use, taste and nicotine content will be at the forefront of consumers' minds when selecting the goods. Taking these matters into account, I consider that an average degree of attention will be paid when selecting the goods.

23. E-cigarettes and the associated liquids and flavourings can be purchased in general retail premises or in specialised Vape stores. The goods are likely to be self-selected via visual means, however, since they are generally behind the counter goods, a request for the goods and then a supply by a member of staff is likely which gives rise to aural considerations. Even where this occurs, the consumer will still review the product visually. Both visual and aural considerations will, therefore, play a part in the selection process.

Comparison of the trade marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

25. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

26. The respective trade marks are shown below:

Applicant's mark	Opponent's mark
My E-Liquid Supplies	

Overall impression

27. The Opponent's mark consists of the word/letters MY which is presented in a graffiti styled font, coloured turquoise and green. Whilst the colour and stylisation contribute to the distinctiveness of the mark, it is the word/letters MY which play the greater role and in which the overall impression lies.

28. The Applicant's mark consists of the words My E-Liquid Supplies. The overall impression lies in the combination of these words but given the nature of the goods (all relating to electronic cigarettes, flavourings and liquids) the words E-Liquid Supplies are not especially distinctive and thus play a limited role in the overall impression of the mark as a whole.

Visual comparison

29. Visually both marks consist of the word/letters MY, which is the entirety of the earlier mark and the first word/letters of the contested mark. The marks differ in the addition of the words 'E-liquid Supplies' in the application, there being no counterpart in the earlier mark. The stylisation of the lettering and the use of colour used in the earlier mark is also a point of visual difference, however, given that the caselaw states that a word mark can be used in any font, colour or case this is not a determinative factor to act as a point of visual difference. Overall, given that as a general rule the beginnings of marks tend to make more visual and aural impact than their endings,[4] and weighing up the similarities against the differences, in my view the marks are visually similar to a medium degree.

[4] *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

Aural Comparison

30. No pronunciation will be given to the stylisation or the colour used in the earlier mark. Therefore, if it is seen as the word MY then it will be pronounced as MYE. Alternatively if it is seen as a series of letters, then it will pronounced letter by letter as 'EM-WHY'.

31. I find that there are two possible ways in which the contested mark will be articulated either in full where all the words are pronounced or, due to the descriptive nature of the words 'e liquid supplies' solely as 'MYE/EM-WHY'. In either scenario the word MY will be pronounced identically to the two versions I outlined as with the earlier mark.

32. Comparing these two likely pronunciations with the earlier mark, if only the My element is articulated the respective marks will be aurally identical regardless of whether they will be seen as a series of letters or as a word. Where all the words are pronounced in the contested mark then the aural similarity between the marks will be reduced, but there will still be similarity because the word My will be articulated first. In this scenario I consider that the aural similarity will be between low to medium.

Conceptual Comparison

33. The element MY in both marks will either be perceived as the arbitrary letters M and Y which have no meaning, or will be perceived as the word MY, a possessive determiner i.e. indicating as to whom the goods belong. Irrespective of what meaning is attributed to this element, it will apply equally to both marks rendering this element conceptually identical. The addition of the words E Liquid Supplies will act as a point of conceptual difference from the use of the possessive determiner/letters alone, understood to describe the business selling the goods.

Distinctive character of the earlier mark

34. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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)."

35. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

36. The Opponent has not filed evidence and therefore I only have the inherent position to consider. The word My is a common dictionary word with a recognisable meaning as a determiner in its possessive form. Alternatively an equal proportion of consumers will perceive the mark as two separate arbitrary letters. Neither alternatives are thus particularly distinctive but I remind myself that a registered trade mark must be afforded some distinctive character by virtue of its registration.[5] As a starting point as a word/series of letters, the earlier mark would be low in distinctive character, however, its presentation/stylisation adds to its distinctive character as a whole which elevates it to between a low and medium degree.

[5] *Formula One Licensing BV v OHIM,* Case C-196/11P

Likelihood of confusion

37. Confusion may be direct or indirect. Direct confusion arises where one mark is mistaken or imperfectly recalled one for the other by the average consumer, whereas indirect confusion is where the average consumer realises the marks are not the same but nevertheless puts the similarity that exists between the marks and the goods down to the responsibility of the same or related undertakings.

38. There are a number of factors to bear in mind in the global assessment in determining as to whether there is a likelihood of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the respective trade marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider 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 has retained in his mind.

39. I remind myself that I found the earlier mark and the contested mark to be visually similar to a medium degree and aurally, if all the words were articulated in the contested mark, similar to between a low and medium degree, otherwise aurally identical. I found the common element MY to be conceptually identical, with the words E-Liquid Supplies in the contested mark giving rise to a point of conceptual difference. The earlier mark was distinctive overall to between a low and medium degree. I identified the average consumer to be an adult member of the general public with an average level of attention being paid during the purchasing process. The goods would be selected predominantly by visual means but not discounting aural considerations. I found the respective goods to be either identical or similar to a medium degree.

40. Taking all these matters into account, I am of the view that in light of the descriptive nature of the words E-Liquid Supplies for the Applicant's goods, that consumers will likely view or refer to the contested mark as purely MY, leading to the marks being imperfectly recalled or mistaken one for the other. I have taken account that the visual similarity between the marks is only between a low and medium degree, but bearing in mind the interdependency principle, I consider that there is a greater capacity for

the marks to be confused where the applied for mark is used in the same font or colour combination as the earlier mark, bringing it visually closer in terms of similarity. Notwithstanding my finding that the word/letters MY is fairly weak in distinctive character, this does not preclude a finding of a likelihood of confusion.[6] When used on identical goods, I consider that there to be a likelihood of direct confusion.

41. Even if the differences are recalled by the average consumer, given the common use of the words/letters MY which is the only element of the earlier mark and the first more dominant element of the applied for mark, I consider that it likely that the average consumer will conclude that these are alternative marks being used by the same or economically linked undertaking. This is particularly likely given the nature of the goods. The difference created by the words E-Liquid Supplies is insufficient to distinguish between them, leading to the marks being indirectly confused.

Conclusion

42. The opposition under section 5(2)(b) of the Act succeeds in full. Subject to any successful appeal, the application shall be refused registration.

Costs

43. Mr Mussa has succeeded and therefore ordinarily is entitled to a contribution towards his costs. As he was not professionally represented he was invited by the Tribunal under cover letter dated 23 February 2023 to complete and return a costs pro forma indicating an accurate estimate of the time spent on a range of given activities relating to bringing the opposition. It was made clear in this letter that if the pro-forma was not completed, no costs would be awarded. No further communication was received from Mr Mussa and therefore other than the reimbursement of the official fee for having successfully brought the action, I make no further award of costs.

[6] *L'Oréal SA v OHIM*, Case C-235/05 P, CJEU

44. I order Unbranded Vape Supplies Ltd to pay Fayaz Mussa the sum of £100 representing the official fee in these proceedings. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2023

Leisa Davies

For the Registrar