

O/0659/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003571604
BY SHENZHEN WOODY VAPES TECHNOLOGY CO., LTD.
FOR THE FOLLOWING TRADE MARK:



IN CLASS 34

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 504779
BY REPUBLIC TECHNOLOGIES (NA) LLC

BACKGROUND AND PLEADINGS

1. ShenZhen Woody Vapes Technology Co., Ltd. (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the Contested Mark”) in the UK on 23 December 2020. It was registered on 30 April 2021 for the following goods:

Class 34 Electronic cigarettes; Cartridges for electronic cigarettes; Electronic cigarette atomizers; Electronic cigarette cartomizers; Liquid for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Cigarettes containing tobacco substitutes; Devices for heating tobacco substitutes for the purpose of inhalation; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic nicotine inhalation devices; Inhalers for use as an alternative to tobacco cigarettes; Smokeless Tobacco; Snuff; Chewing Tobacco; Tobacco.

2. On 12 April 2022, REPUBLIC TECHNOLOGIES (NA) LLC (“the applicant”) applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act, and the applicant relies upon the following trade marks:



Comparable UK trade mark (EU) registration no. UK00902037000

Filing date 17 January 2001; registration date 20 March 2002.

(“The First Earlier Mark”)



Comparable UK trade mark (EU) registration no. UK00904458733

Filing date 27 May 2005; registration date 8 May 2006.

(“The Second Earlier Mark”)

3. The applicant relies upon all of its goods in class 34, as set out in the Annex to this decision.

4. As shown above, the invalidation is based upon both of the applicant's earlier comparable UK trade marks (EU),¹ claiming that there is a likelihood of confusion because of the high degree of similarity between the marks, and the identity/high degree of similarity between the goods.

5. The proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use.

7. The applicant is represented by Venner Shipley LLP and the proprietor is represented by Novagraaf UK. Neither party filed evidence nor requested a hearing, but the applicant filed evidence in chief, and both parties filed submissions in lieu of a hearing. I have taken all of the evidence and submissions into account in reaching this decision, referring to them as necessary.

EVIDENCE

8. The applicant's evidence consists of the witness statement of Mr Oliver Partouche dated 2 November 2022. Mr Partouche is the Vice-President Senior Trademark officer at the applicant, a position which he has held since July 2017. Mr Partouche's statement was accompanied by 5 exhibits (OP1-OP5).

PRELIMINARY VIEW

9. On 30 November 2022, the Registry wrote to the parties, noting that **exhibits OP4** and **OP5**, contained "foreign language information. Some aspects of the evidence e.g. regarding the products on offer is in French and may be difficult to assess. As a result

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

you are requested to provide translations of the foreign content of exhibit OP4 and OP5”.

10. The applicant was given 14 days, until 14 December 2022, to file the witness statement and translated exhibits.

11. In an official letter dated 5 January 2023, the Registry stated the following:

“I refer to our letter dated 30 November 2022, as no translation has been filed, please note, the filing of foreign-language information only is at the applicant’s own risk and the Hearing Officer will consider the weight to be given to this evidence when making their final decision.”

12. On inspection of the evidence, **exhibit OP4** contains invoices, with the “TOP” and “TOP-O-MATIC” marks clearly used on the product name, however, as highlighted above, the products are written in French, and are simply listed as “SLIM TOP” or “SLIM PREMIUM”. I note that in his witness statement, Mr Partouche states that TOP products “come with different flavours and different characteristics. Therefore, the “TOP” products listed on the invoices are sometimes referred to as “TOP DOUBLE PREMIUM”, “TOP SLIM”, “TOP SLIM PREMIUM” (referred as “TOP SL PREM”), or “TOP4” on the invoices.

13. Albeit is clear that these are all “TOP” products, the issue is determining what “SLIM TOP” or “SLIM PREMIUM” are, for example. I am unable to determine whether the above products are cigarette papers, cigarette filters, lighters, matches, rolling machines or metal cases for cigarettes, all of which are listed as goods the applicant sells under the TOP mark in Mr Partouche’s witness statement. Therefore, as I am unable to determine what products are being sold within the invoices, this evidence has little, to no weight.

14. However, it is clear that **exhibit OP5** contains some evidence provided in French and some provided in English. I note that the evidence written in French encounters the same issue with the above evidence, being clear the TOP mark is used, but unable to determine what the goods are. However, the evidence written in English allows me

to determine what the goods are, and therefore has some weight. Consequently, I will be able to explore this evidence below.

RELEVANCE OF EU LAW

15. 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 Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

16. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 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) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(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.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the

form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive

to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds 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.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(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.”

17. As the applicant’s earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

Section 5(2)(b)

18. Section 5(2)(b) 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.”

19. The trade marks upon which the applicant relies qualifies as earlier trade marks because they were applied for at an earlier date than the proprietor’s mark pursuant to section 6(1)(aa) of the Act. As the earlier trade marks had completed their

registration process more than five years before the date the applicant applied to invalidate the contested mark, they are subject to proof of use pursuant to section 6A(1) and (1A) of the Act.

Proof of use

20. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant provisions about proof of use in invalidity proceedings are contained in Section 47 of the Act, which I have set out above. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

21. Pursuant to section 47(2B) of the Act, if the earlier marks have been registered for five years or more at the date the challenged mark was filed then there are two relevant periods for assessing whether there has been genuine use of the applicant’s marks; the five-year period ending with the date of the contested mark being filed, i.e. 24 December 2015 to 23 December 2020 and the five-year period ending with the date of the application for invalidity, i.e. 13 April 2017 to 12 April 2022.

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*

Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

23. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

24. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends

who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

25. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

26. I note the following from the applicant’s evidence:

- a) Mr Partouche states that the applicant is a “specialist in the “roll your own” segment of the smoking market”, and that its earlier marks “are used in relation to a variety of smoking products (including cigarette paper, filters for cigarettes, machines for rolling cigarettes and metal cases for cigarettes)”.
- b) Mr Partouche also states that the invoices exhibited at **OP4** (which as highlighted above bear little to no weight in these proceedings) shows that the applicant has “sold more than €5,038,00 of “TOP” products with the sale of “TOP-O-MATIC” exceeded €267,670” [sic]. He does not clarify within his witness statement whether the invoices were sent globally or around the EU, and even if this information is contained within the invoices themselves, as highlighted above, I am unable to obtain this information from the exhibit which

is written in French. However, a date is clearly included at the top right hand corner of the invoices, with 5 invoices provided per year, for the years 2010 and 2012 to 2022, and 4 invoices provided for the year 2011.

- c) **Exhibit OP2** firstly contains an undated printout from Wikipedia. I note that this platform allows entries to be updated by the public and, therefore, I consider that the information from Wikipedia should be approached with a certain degree of caution.

- d) **Exhibit OP2** also contains an undated printout from its website which states that “TOP complements its offer with an award-winning range of rolling papers”. Furthermore, it contains screenshots from Amazon (delivering to the UK). Albeit the screenshots are undated, the majority of the listings pertain to “TOP” rolling papers. However, the rolling papers are priced in dollars, a currency which is used outside of the EU. I also note that the remaining undated screenshots taken from other websites within this exhibit (including Green Caviar Club and The Smoking Store) only shows the sale of “TOP” rolling papers in dollars.

- e) The last undated pictures contained within **exhibit OP2** are in relation to a box labelled the “TOP-O-MATIC”. However, the writing on the box is written in another language and therefore I am unable to determine what the product is.

- f) **Exhibit OP3** contains undated screenshots of google searches for “top-o-matic”. The top 2 websites are from Amazon, which state that it is a “cigarette making machine”. The 3 YouTube videos below show how to use the cigarette rolling machine, and are dated 20 October 2012, 5 February 2014 and 11 June 2019.

- g) **Exhibit OP3** also contains undated screenshots from eBay which shows the sale of the “Top-o-Matic Cigarette Making Machine”. However, I note that the product listing has reviews from 2017 to 2020. The second undated listing from Amazon in regard to the Top-o-Matic Cigarette Making Machine has reviews from the United Kingdom dated from 2014 and 2019. The third undated listing

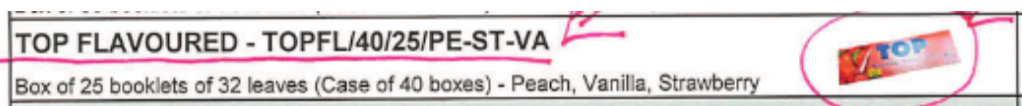
from Amazon for the Top-o-Matic Cigarette Making Machine has reviews from Germany dated 2013, 2018 and 2021.

h) **Exhibit OP3** furthermore contains undated screenshots from Amazon searching for “Top Cigarette Rolling Papers”, to be delivered to the UK, which lists 18 of these items, all titled as “top cigarette rolling papers”, including the following:

<p>Top Cigarette Paper 100 Count (Pack of 24) ★★★★★ - 616 \$33⁵² (\$0.01/Count) Delivery Wed, Nov 9 Or fastest delivery Wed, Nov 2 More Buying Choices \$29.75 (13 new offers)</p>	<p>TOP Rolling Papers, 6 Pack Bundle, 600 Cigarette Paper Leaves Total 100 Count (Pack of 6) ★★★★★ - 1,301 \$9⁴³ (\$1.57/Count) \$9.99 Delivery Thu, Nov 3</p>	<p>Top Cigarette Rolling Papers, 3 Packs 100 Count (Pack of 3) ★★★★★ - 941 \$5⁹⁹ (\$2.00/Count) \$6.99 \$7.40 delivery</p>	<p>(10 Pack) Top Rolling Papers - 70mm Single Wide Cigarette Papers - Package of 10 10 Count (Pack of 1) ★★★★★ - 301 \$19⁶⁵ (\$1.97/Count) Delivery Wed, Nov 2 Only 14 left in stock - order soon. More Buying Choices \$17.87 (13 new offers)</p>

i) I note that the prices of the above goods are again all in dollars.

j) **Exhibit OP5** contains “true copies of price lists sent to retailers”. Mr Partouche states that “as with the invoices, the products listed are sometimes referred as “TOP ROLLS”, “TOP KING SIZE”, “TOP PREMIUM”, “TOP DORG”, “TOP SL PREM”, “TOP XPSLFI”, “TOPSLUNBTIP”, “MR TOPOMATICV2”, “BF TOP S8” or “TOP4” to name a few”. Again, it has not been clarified what these products specifically are. However, based on the following images from this exhibit, from the 2010 to 2015 Estonia price list, and its product description as “box of 25 booklets of 32 leaves”, it is reasonable to infer that the goods are cigarette papers in books:



Conclusions from the evidence on genuine use

27. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

28. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*,

EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

29. Where the applicant’s mark has been used as registered this will, clearly, be use upon which the applicant can rely. However, as highlighted above, I note that the First Earlier Mark has been used in the following variant:



30. The word TOP is presented in the same stylised font, as registered, but presented in the colour blue. I note that below the word TOP is a depiction of a spinning top. As noted in the case law above, (*Lactalis*, paragraph 15), where a mark contains both words and a figurative element, the word element will usually be more distinctive. Furthermore, I consider that as the device is a spinning top, it reinforces the meaning of the word element TOP. Consequently, the addition of the device element will not

change or alter the distinctive character of the word. Therefore, as far as the form of the mark is concerned, I am satisfied that the mark has been used as registered.

31. The case law summarised in the passage from *Walton* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

32. Where proof of use is required, it is typical to see evidence such as invoices showing the sale of goods to customers, whether retail or wholesale. Albeit the applicant has provided this, alongside the total sales made from the invoices noted at paragraph (b), as highlighted above, the evidence has little to no weight. It is all presented in a foreign language without being officially translated and I am unable to determine what products were sold under the applicant's marks within the invoices. The applicant also has not provided me with turnover figures and numbers of units sold during the relevant period, which is plainly information which should have been available and relatively easy to provide.

33. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the applicant is sufficient to show that there has been a real attempt to exploit the marks in the sector. However, there is very little evidence of other activity in this case, and the evidence that has been provided suffers with multiple problems. For example, a proportion of the evidence is presented in

French and therefore I am unable to read it. I have not been provided with any evidence of advertising or promotional activity, whether in terms of traditional print advertising, web advertising or via social media. I also have not been provided with any advertising figures. All of the screenshot evidence is undated and therefore cannot be determined as falling within the relevant periods. The goods are also shown to be sold in dollars, which is a currency used outside of the EU.

34. The only evidence which falls within the relevant period is the 2015 Estonian price list which depicts the applicant's cigarette papers in books, however, no evidence of actual sales from this list has been provided. The only evidence of sales that can be concluded from the Amazon pages are from the reviews of the opponent's cigarette papers and cigarette making machines made by German and British consumers. Therefore, taking the evidence as a whole, my view is that it does not establish that there has been genuine use of the opponent's marks for any goods.

35. In the event I am wrong in my finding of proof of use, I will proceed with the rest of the decision as if the applicant had established genuine use for its cigarette papers in books under the First Earlier Mark and automatic boxes for rolling cigarettes under its Second Earlier Mark (which are the only goods shown within the applicant's limited evidence). Therefore, based on my conclusion above, I consider a fair specification of the earlier marks to be:

The First Earlier Mark

Class 34 Cigarette papers in books.

The Second Earlier Mark

Class 34 Automatic boxes for rolling cigarettes.

Section 5(2)(b) - case law

36. In making this decision, I bear in mind the following principles 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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

37. I consider that the opponent’s best case is its First Earlier Mark (based on the mark itself and its specification). I will therefore continue my assessment based on that registration alone. If the invalidation fails on this mark, it follows that the invalidation will also fail where the marks, and the goods, are even less similar.

38. Consequently, the competing goods are as follows:

Applicant’s goods	Proprietor’s goods
<p>The First Earlier Mark <u>Class 34</u> Cigarette papers in books.</p>	<p><u>Class 34</u> Electronic cigarettes; Cartridges for electronic cigarettes; Electronic cigarette atomizers; Electronic cigarette cartomizers; Liquid for electronic cigarettes; Liquid nicotine solutions for</p>

	<p>use in electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Cigarettes containing tobacco substitutes; Devices for heating tobacco substitutes for the purpose of inhalation; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic nicotine inhalation devices; Inhalers for use as an alternative to tobacco cigarettes; Smokeless Tobacco; Snuff; Chewing Tobacco; Tobacco.</p>
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39. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, 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.”

40. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

41. 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 for 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.”

42. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category

of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

43. In *Kurt Hesse v 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 the responsibility for those goods lies with the same undertaking.”

Tobacco.

44. Smokers who roll their own cigarettes will buy both the tobacco and rolling papers together. Consequently, I consider that the proprietor’s above goods and the applicant’s “cigarette papers in books” are complementary. There will also be overlap in trade channels as businesses that sell tobacco would most likely sell the rolling papers to go with it. They will also be distributed together, being sold in the same retail establishments such as supermarkets and newsagents, located in the same area behind the counter. There will also be an overlap in user, and to some extent purpose, as they both allow the user to smoke. Consequently, I consider that the goods are similar to at least a medium degree.

Cigarettes containing tobacco substitutes

45. Smokers may buy ready-made cigarettes or, alternatively, may buy tobacco, cigarette papers and cigarette filters individually to enable them to prepare their own cigarettes. Consequently, I consider that there will be a degree of competition between “cigarettes containing tobacco substitutes” in the proprietor’s specification and “cigarette papers in books” in the applicant’s specification. There will also be overlap in trade channels as businesses that sell cigarettes may also sell cigarette papers and

tobacco. There will also be overlap in user. Therefore, I consider the goods to be similar to at least a medium degree.

Electronic cigarettes; Devices for heating tobacco substitutes for the purpose of inhalation; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic nicotine inhalation devices; Inhalers for use as an alternative to tobacco cigarettes.

46. I consider that the proprietor's above goods are the actual articles/oral vaporisers used for smoking tobacco substitutes. I consider that these goods will overlap with the applicant's "cigarette papers in books". The goods will overlap in user, being adult members of the general public. I also consider that they will overlap in distribution channels, being sold in the same retail establishments such as supermarkets and newsagents, located in the same area behind the counter. The goods all allow the user to smoke, which would in turn give them a nicotine boost, and therefore they overlap in purpose. However, I appreciate that the applicant's goods are specifically used to hold and roll up tobacco. The goods do not overlap in nature and method of use, however, they may be to some extent in competition, with the user either choosing to make its own roll-up cigarettes, or an electronic cigarette, to smoke. Taking all of the above into account, I consider that the goods are similar to at least a medium degree.

Cartridges for electronic cigarettes; Electronic cigarette atomizers; Electronic cigarette cartomizers; Liquid for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges.

47. The above terms in the proprietor's specification are the cartridges for electronic cigarettes which contain a (flavoured) liquid, which contains nicotine. This is heated up and converted into a vapor for the user to inhale. I consider that these goods will overlap with the applicant's "cigarette papers in books". The goods overlap in users and in distribution channels, being sold behind the counter of supermarkets or newsagents. The goods are all used to facilitate smoking, and therefore to some extent, overlaps in purpose. The goods may also be in competition, with the user either

choosing to make its own roll-up cigarettes, or an electronic cigarette and its cartridges, to smoke. However, the goods do not overlap in nature and method of use. Consequently, the goods are similar to at least a medium degree.

Smokeless Tobacco; Snuff; Chewing Tobacco.

48. The proprietor's above goods are used as substitutes to traditional smoking products such as cigarettes (including roll-ups) and electronic cigarettes. The goods will therefore overlap in user with the applicant's "cigarette papers in books". All of the goods will be sold behind the counter of supermarkets or newsagents. The goods may also be in competition, with the user either choosing to make its own roll-up cigarettes, or consuming its tobacco in an alternative way (non-smoking). However, they clearly do not overlap in nature or method of use. I also consider that, to some extent, albeit they all will give the user a nicotine boost, that as they are used in such different ways, that they do not overlap in purpose, as the proprietor's goods are not smoked (in that they are not set on fire, or inhaled). Taking the above into account, I consider that the goods are similar to between a low and medium degree.

The average consumer and the nature of the purchasing act

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

50. The average consumer for the goods will be adult members of the general public who smoke. The cost of the purchase is likely to be fairly low, and the goods are likely to be purchased reasonably frequently. However, these are all products that are intended to be inhaled into the body (with the proprietors goods in paragraph 48 consumed in an alternative way, such as being chewed). The average consumer will therefore take various factors into consideration such as nicotine content and flavour. Taking all of the above into account, I consider that at least a medium degree of attention will be paid during the purchasing process for the goods.

51. It is illegal in the UK for tobacco products to be displayed in retail premises. They are therefore stored behind a counter, and, in order to purchase them, the consumer will need to request them aurally. Therefore, for these purchases, the purchasing process will be predominantly aural. However, once the request has been made, the average consumer will have sight of the packaging at the point of purchase and so visual considerations cannot be discounted. I also recognise that the goods can be purchased by self-selection online. In these circumstances, visual considerations will dominate the selection process.

Comparison of the trade marks


52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. 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.”

53. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

54. The respective trade marks are shown below:

Applicant's trade mark	Proprietor's trade mark
<p data-bbox="352 981 644 1093" style="text-align: center;">TOP</p> <p data-bbox="301 1149 687 1187" style="text-align: center;">("The First Earlier Mark")</p>	

55. The First Earlier Mark consists of the word “TOP” presented in a highly stylised black capitalised font. I consider that the word TOP plays a greater role in the overall impression, with the stylisation playing a lesser role.

56. The proprietor’s mark consists of the highly stylised letters TPP. I note that these are presented in an elongated oblong outline. I consider that the letters TPP play a greater role in the overall impression, with the stylisation playing a lesser role.

57. Visually, the marks overlap in the letter T at the beginning of the marks, and the letter P at the end of the marks. This acts as a point of visual similarity. However, the First Earlier Mark contains the letter O in the middle of the mark, and the proprietor’s mark contains the letter P in the middle of the mark. The marks are also presented in

heavily stylised fonts, with the proprietor's letters TPP outlined by the elongated oblong. These act as visual points of difference. I also bear in mind that there is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way.² However, it is clear that the change of one letter to a mark which is only three letters long is clearly more significant than a change of one letter to a longer mark. Therefore, taking all of the above into account, I consider that the marks are visually similar to between a low and medium degree.

58. Aurally, the First Earlier Mark will be given its ordinary dictionary pronunciation (TOP). I consider that the proprietor's mark will be pronounced by its individual letters TEE-PEE-PEE. Therefore, as the marks only overlap in the "T" element at the beginning of the marks, I consider that they are aurally similar to a low degree.

59. Conceptually, I consider that the word TOP in the First Earlier Mark will be given its ordinary dictionary definition, which as highlighted by the proprietor, is "something to be perceived to be of the highest quality or amount", or is the highest point or part of something.³ I consider that the letters TPP in the proprietor's mark will be recognised as initialism, which is an acronym in which each letter is pronounced separately, rather than the acronym being pronounced as a word,⁴ with no immediate conceptual meaning. The stylisation of the marks, and the outline of the proprietor's mark does not add to the meaning of the marks. Consequently, I consider that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

60. 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

² *Bosco Brands UK Limited v Robert Bosch GmbH*, Case BL- O/301/20, paragraph 44

³ <https://www.collinsdictionary.com/dictionary/english/top> accessed 29 June 2023

⁴ <https://www.collinsdictionary.com/dictionary/english/initialism> accessed 29 June 2023

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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

61. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

62. For the purposes of assessing enhanced distinctiveness, the relevant market is the United Kingdom. I note that the applicant did not provide any evidence to establish use of its mark in the UK. Consequently, I have only the inherent position to consider.

63. The First Earlier Mark consists of the word TOP presented in a heavily stylised font. This is an ordinary dictionary word, which would be recognised by the average consumer. I consider that the word TOP is a laudatory word, which may be understood as alluding to the quality of the goods (aka. their goods are on top, they are the best etc.). This would therefore put the mark at a low level of distinctiveness. However, in combination with the stylisation of the word, I consider that this elevates the inherent distinctiveness to between a low and medium degree.

Likelihood of confusion

64. 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

65. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to a low degree.
- I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer for the goods to be adult members of general public (smokers), who will select the goods primarily by aural means, although I do not discount a visual component.
- I also recognise that the goods can be purchased by self-selection online. In these circumstances, visual considerations will dominate the selection process.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process.

- I have found the parties' goods to be similar to at least a medium degree, or between a low and medium degree.

66. Taking all of the factors listed in paragraph 65 into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. It is well established that where the meaning of at least one of the two supposedly conflicting marks at issue is so clear and specific that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them.⁵ In this instance, the proprietor's mark has a clear and specific meaning; TOP, which is an ordinary dictionary word which evokes the concept of the highest quality, amount or point/part of something. Furthermore, and as highlighted above, the marks are aurally similar to a low degree (with the purchasing process most likely being predominantly aural), and they are visually similar to between a low and medium degree (with self-selection purchasing processes being predominantly visual). Lastly, the length of the parties' marks are short and therefore the differences are more likely to be noticed. Consequently, I do not consider that the average consumer would overlook the second letter P in the proprietor's mark, and the second letter O in the applicant's mark, especially as the effect is to change the concept of the marks from initialism with no meaning, to the concept of "TOP". Taking all of the above factors into account, I do not consider there to be a likelihood of direct confusion.

67. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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

⁵ *The Picasso Estate v OHIM*, Case C-361/04P, CJEU

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.”

68. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

69. Mr Purvis KC in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion ‘tends’ to fall in one of them (paragraphs 16 & 17). I note that the applicant hasn’t provided any submissions as to what category this case would fall within. I also bear in mind that the examples set out by Mr Purvis are not exhaustive. However, having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the proprietor’s trade mark was connected with the applicant or vice versa. Although both marks use the letters T and P at the beginning and end of the marks, given the clear and distinct conceptual difference separating the marks, they are not natural variants or brand extensions of each other. Taking all of the above into account, I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

70. The application for a declaration of invalidity has failed in its entirety and the proprietor’s trade mark will remain registered.

COSTS

71. The proprietor has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the proprietor the sum of **£900** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the application of invalidity and preparing a Counterstatement	£200
Considering the applicant's evidence	£350
Preparing and filling written submissions in lieu	£350
Total	£900

72. I therefore order REPUBLIC TECHNOLOGIES (NA) LLC to pay ShenZhen Woody Vapes Technology Co., Ltd. the sum of £900. This sum is to 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 11 day of July 2023

L FAYTER

For the Registrar

ANNEX

The First Earlier Mark

Class 34

Tobacco; smokers' articles not of precious metal including cigarette papers in books or tubes, machines for rolling cigarettes, machines for filling tubes, filter tips.

The Second Earlier Mark

Class 34

Tobacco, namely smoking tobacco, cigarettes, smokers' articles including cigarette papers in books or tubes, automatic boxes for rolling cigarettes, rollers, machines for filling tubes, filter tips, metal cases.