

O/0684/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003686078

BY FRAX LABS TECHNOLOGY CO., LTD.

TO REGISTER THE FOLLOWING TRADE MARK:

**BUDDHA BAR**

IN CLASS 34

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431765

BY PARMEET KUKREJA

## BACKGROUND AND PLEADINGS

1. On 25 August 2021, FRAX LABS TECHNOLOGY, CO., LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 10 December 2021 and registration is sought for the following goods:

Class 34      Electronic cigarettes; Cigarettes containing tobacco substitutes, not for medical purposes; Liquid nicotine solutions for use in electronic cigarettes; Oral vaporizers for smokers; Flavourings, other than essential oils, for use in electronic cigarettes; Snuff boxes; Cigarette holders; Electronic cigarette boxes; Cigarette filters; Lighters for smokers.

2. On 10 March 2022, the application was opposed by Parmeet Kukreja (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon the following trade mark:



UKTM no. 3146171

Filing date 25 January 2016; registration date 17 June 2016

Relying upon all goods for which the earlier mark is registered, namely:

Class 34      Flavourings, other than essential oils, for use in electronic cigarettes.

---

<sup>1</sup> Although the opponent also originally relied upon sections 5(3) and 5(4)(a), it did not file any evidence and, consequently, those grounds are deemed withdrawn.

3. The opponent claims that there is a likelihood of confusion because the trade marks are similar and the goods are identical or similar.

4. The applicant filed a counterstatement denying the claims made.

5. Neither party filed evidence. A hearing took place before me on 27 April 2023, by video conference. The opponent was represented by Stephen Lowry of Barker Brettell. The applicant did not attend.

## **DECISION**

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

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

(a)...

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

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

7. Section 5A of the Act is as follows:

“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.”

8. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark

had completed its registration process more than 5 years before the application date of the mark in issue it is subject to proof of use pursuant to section 6A. However, as the applicant did not put the opponent to proof of use on its Form TM8, the opponent is entitled to rely upon the full breadth of its specification.

9. 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 197, *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 goods

10. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 34</u> Flavourings, other than essential oils, for use in electronic cigarettes.	<u>Class 34</u> Electronic cigarettes; Cigarettes containing tobacco substitutes, not for medical purposes; Liquid nicotine solutions for use in electronic cigarettes;

	<p>Oral vaporizers for smokers;          Flavourings, other than essential oils, for use in electronic cigarettes; Snuff boxes;          Cigarette holders; Electronic cigarette boxes; Cigarette filters; Lighters for smokers</p>
--	---

11. When making the comparison, all relevant factors relating to the goods 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.”

12. Guidance on this issue has also 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.

13. 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.”

14. 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 that the responsibility for those goods lies with the same undertaking.”

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

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

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

Whilst on the other hand:

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

*Electronic cigarettes; Oral vaporizers for smokers.*

16. These goods in the applicant’s specification will be sold through the same trade channels as “flavourings, other than essential oils, for use in electronic cigarettes” in the opponent’s specification. They clearly overlap in user. The nature, method of use and purpose of the goods differ. However, they are complementary in the way described in the above case law. Consequently, I consider these goods to be similar to a medium degree.

*Cigarettes containing tobacco substitutes, not for medical purposes.*

17. These goods are likely to be sold through the same trade channels as the opponent’s goods because the same businesses are likely to sell a selection of alternatives to traditional cigarettes (and associated goods). The users will clearly overlap. The nature, method of use and purpose of the goods differ. They are neither in competition, nor complementary. Consequently, I consider these goods to be similar to between a low and medium degree.

*Liquid nicotine solutions for use in electronic cigarettes.*

18. These goods are, to my understanding, the solutions that the opponent's "flavourings, other than essential oils, for use in electronic cigarettes" would be added to. Clearly, there is likely to be an overlap in user and trade channels. There will be some overlap in nature to the extent that both goods are liquids, although they differ in that one contains nicotine and the other does not. The method of use will differ, as will the purpose. However, they are complementary. Consequently, I consider the goods to be similar to between a medium and high degree.

*Flavourings, other than essential oils, for use in electronic cigarettes.*

19. This term is identical to the opponent's "flavourings, other than essential oils, for use in electronic cigarettes".

*Electronic cigarette boxes.*

20. These are likely to be sold through the same trade channels as "flavourings, other than essential oils, for use in electronic cigarettes" in the opponent's specification. They are likely to overlap in user. Clearly, the method of use, purpose and nature of the goods will differ. I do not consider them to be complementary. Consequently, I consider there to be between a low and medium degree of similarity.

*Snuff boxes; cigarette holders; cigarette filters; lighters for smokers.*

21. These are all smokers' articles. Mr Lowry submitted that these are similar to the applicant's goods to a low degree because they would overlap in trade channels and users. I accept that there may be some overlap in trade channels at a very general level, as retailers may sell electronic cigarettes and traditional cigarettes (and associated products) alongside each other. I consider it unlikely that the same businesses would produce these goods, and I have no evidence before me that they would. The users may overlap. The purpose, nature and method of use of the goods will clearly differ. There is no competition or complementarity. Consequently, I consider the goods to be dissimilar. However, if I am wrong in that finding, they will be similar to only a very low degree.

## **The average consumer and the nature of the purchasing act**

22. As the above case law 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 (as he then was) 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.”

23. The average consumer for the goods will be a member of the general public. The goods are unlikely to be particularly expensive and will mostly be reasonably frequent purchases. However, factors such as flavour and strength (for goods such as electronic cigarettes and flavourings) and aesthetics and durability (for goods such as snuff boxes and cigarette holders) will be taken into consideration. Consequently, I consider that a medium degree of attention is likely to be paid during the purchasing process.

24. In the UK, the purchasing process for some of these goods are controlled by various regulations. Many of these goods must be hidden from view and the consumer must request them from the shop assistant. Consequently, I agree with Mr Lowry that the greater emphasis would be placed on the aural aspect of the purchase. However, I do not discount that there will also be a visual consideration to the purchase, because once the consumer has requested a particular brand, they are likely to have sight of the packaging at the point of purchase. In relation to some of the goods, such as snuff boxes, visual considerations will play a greater role as they will be self-selected from

a retail outlet. However, aural considerations will still play a part as advice may be sought from shop assistants.


### **Comparison of trade marks**

25. It is clear from *Sabal 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.”

26. 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.

27. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	<p data-bbox="879 488 1374 546"><b>BUDDHA BAR</b></p>

28. The applicant's mark consists of the words BUDDHA BAR, presented in a stylised font. The overall impression of the mark lies in the words themselves, with the stylisation playing a lesser role. The opponent's mark consists of the words BUDDHA VAPES (in duplicate) in a circle device. The duplicated words are separated by two black dots and in the middle appears a buddha device. The mark is presented in black and white and on a black square background. The overall impression of the mark lies in the combination of these elements, with the words BUDDHA VAPES playing the slightly greater role due to the eye being naturally drawn to the element that can be read.

29. Visually, the marks overlap in that they contain the word BUDDHA. They differ in that the applicant's mark contains the word BAR and the opponent's mark contains the word VAPES, as well as the circle and buddha devices. The text is also duplicated in the opponent's mark, which is different to the applicant's mark. In my view, they are visually similar to no more than a medium degree.

30. Aurally, the word BUDDHA will be pronounced identically in both marks. The words BAR and VAPES will clearly act as points of aural difference. I do not consider that the duplication in the opponent's mark will be articulated, not least because the repeated wording appears upside down. Taking all of this into account, I consider the marks to be aurally similar to between a medium and high degree.

31. Conceptually, the word BUDDHA in both marks will convey the same meaning for the average consumer i.e. a reference to a spiritual teacher. The buddha device in the opponent's mark just reinforces this message. Mr Lowry submitted that the word BAR would be descriptive for the goods in question because it would be seen as a reference to the shape of the product i.e. something that is longer than it is wide, like a cigarette. Whilst this may be seen as some sort of reference to the shape of the product in some circumstances, I do not consider this to be descriptive; it is allusive at best. It may also be seen as a reference to somewhere you can go to buy goods/services (most commonly in the context of food and drink, such as an ice cream bar/drinks bar, but also in the context of businesses such as nail bars). Clearly, any meaning conveyed by the word VAPES in the opponent's mark will be non-distinctive. Taking all of this into account, I consider the marks to be conceptually similar to between a medium and high degree.

### **Distinctive character of the earlier trade mark**

32. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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 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).”

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

34. The opponent has filed no evidence of use and, consequently, I have only the inherent position to consider. The word BUDDHA has no relationship with the goods in issue and, consequently, I consider it to be distinctive to a medium degree. This, combined with the device elements in the opponent’s mark results in what I consider to be between a medium and high degree of distinctiveness.

### **Likelihood of confusion**

35. 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 goods may be offset by a greater degree of similarity between the respective marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. 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.

36. I have found as follows:

- a) The goods vary from being identical to similar to a very low degree.
- b) The average consumer is a member of the general public who will be paying a medium degree of attention.
- c) The purchasing process will be either predominantly aural or predominantly visual (depending upon the goods in question). However, neither can be discounted.
- d) The marks are visually similar to no more than a medium degree and they are aurally and conceptually similar to between a medium and high degree.
- e) The earlier mark is inherently distinctive to between a medium and high degree and the common element (the word BUDDHA) is distinctive to a medium degree.

37. Given that the opponent's mark is a composite mark including words and devices, and the applicant's mark is a stylised word mark, I consider it unlikely that they will be mistakenly recalled or misremembered as each other. However, I consider it likely that the common word BUDDHA would lead the average consumer to conclude that they originate from the same or economically linked undertakings when they are used in relation to goods which are similar to at least between a low and medium degree. The addition of the word VAPES is clearly non-distinctive and the word BAR could be seen as indicating the shape of the goods or the place from which they are purchased. Even where the marks are encountered visually, the differing presentational elements (such as the devices) are likely to be seen as different marks being used by the same undertakings. Where the goods are only similar to only a very low degree (at best), I consider the distance between them sufficient to offset the similarity of the marks and there would be no likelihood of confusion.

## CONCLUSION

38. The opposition succeeds in relation to the following goods, for which the application is refused:

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

39. The opposition is unsuccessful in relation to the following goods, for which the application may proceed to registration:

Class 34      Snuff boxes; Cigarette holders; Cigarette filters; Lighters for smokers.

## COSTS

40. As the opponent has enjoyed the greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In making the award, I have borne in mind the only partial success and I have made an appropriate reduction. Further, although the opponent paid a £200 fee when filing the opposition, it did not file evidence in support of the section 5(3) and 5(4)(a) grounds, which attracted the higher fee. Consequently, I have awarded the opponent only £100 in respect of the official fee. In the circumstances, I award the opponent the sum of **£1,100**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing for and attending the hearing	£800
Official fee	£100
<b>Total</b>	<b>£1,100</b>

41. I therefore order FRAX LABS TECHNOLOGY Co., Ltd to pay Parmeet Kukreja the sum of £1,100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 18th day of July 2023**

**S WILSON**

**For the Registrar**