

O/299/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003370193

BY DARKSTAR INTERNATIONAL LIMITED

TO REGISTER THE TRADE MARK:

VPR

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 416200 BY

NICOVENTURES HOLDINGS LIMITED

BACKGROUND AND PLEADINGS

1. On 25 January 2019, Darkstar International Limited (“the applicant”) applied to register the trade mark **VPR** in the UK. The application was published for opposition purposes on 1 February 2019 and registration is sought for the following goods:

Class 34 Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Cartridges for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electric cigarettes [electronic cigarettes]; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarettes; Flavorings, other than essential oils, for tobacco substitutes; Flavorings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes.

2. On 1 May 2019, Nicoventures Holdings Limited (“the opponent”) opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:

Vpro

UK trade mark no. 3030578

Filing date 14 November 2013; registration date 18 April 2014

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

Class 34 Tobacco substitutes; cigarette substitutes; cigarettes containing tobacco substitutes; electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes, tobacco, tobacco products, smokers' articles, cigarette cases, cigarette boxes.

(“the First Earlier Mark”)



UK trade mark no. 3124881

Filing date 1 September 2015; registration date 27 November 2015

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

Class 34 Electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes containing tobacco substitutes; tobacco substitutes; cigarettes; tobacco; tobacco products; cigarette cases; cigarette boxes.

("the Second Earlier Mark")

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. Both parties filed evidence. The opponent filed evidence in reply. A hearing took place before me on 11 May 2020, by video conference. The opponent was represented by Mr Hiroshi Sheraton of Baker McKenzie LLP and the applicant was represented by Ms Carin Burchell of Branded!. Both parties filed Skeleton Arguments and the applicant's Skeleton Argument was accompanied by written submissions.

EVIDENCE

The Opponent's Evidence

6. The opponent filed evidence in the form of the witness statement of Ese Akpogheneta dated 10 September 2019. Ms Akpogheneta is an attorney acting on behalf of the opponent.

7. Ms Akpogheneta's witness statement served to introduce the results of an internet search for the term "VPR".¹ The search brings up a range of results including references to Vermont Public Radio, a protein called VPR, Versatile Packing Placement and Routing and Victorian Periodicals Review.

The Applicant's Evidence

8. The applicant filed evidence in the form of the witness statements of Rob Scammell and Carin Burchell, both dated 27 November 2019.

9. Mr Scammell is a Director of the applicant. Mr Scammell explains that the letters VPR was chosen because it is an abbreviation of the word Vapour/Vapor. Mr Scammell notes that this is in keeping with abbreviations used in text messaging, which will be common among the applicant's target demographic.

10. Ms Burchell is the attorney acting on behalf of the applicant. I have read Ms Burchell's evidence in its entirety and have summarised it below, only to the extent that I consider necessary.

11. Ms Burchell notes that the word 'pro' is commonly used to denote 'professional' or 'proactive' or as a prefix denoting 'favouring'. Ms Burchell has provided a print out from the Cambridge English Dictionary which lists the following definitions for the word:

"an advantage to or a reason for doing something"

"a person who plays sport as a job rather than as a hobby"

"supporting or agreeing with something"

"a person who receives money for playing a sport"²

¹ Exhibit SA1

² Exhibit CEB1

12. Ms Burchell states that ‘SMS language’ involves dropping vowels from words in order to make them easier to communicate (or easier to type) via text message. Although Ms Burchell notes that there has been a move away from the older push style keypads on mobile phones to QWERTY keyboards, Ms Burchell states that SMS language is still used.

13. By way of example, Ms Burchell notes that, in SMS language, MSG means ‘message’, PLZ means ‘please’, THNX means ‘thanks’ and RLY means ‘really’.³

The Opponent’s Evidence in Reply

14. The opponent filed evidence in reply in the form of the second witness statement of Ms Akpogheneta dated 27 January 2020.

15. Ms Akpogheneta has provided the results of a search for the term VPR on a website called acronymfinder.com which lists a number of meanings for the term VPR such as Vermont Public Radio, Vacant Property Register and Vendor Price Reduction.⁴ None of these suggest that it may be viewed as a reference to the word ‘vapour’.

16. Ms Akpogheneta has also provided a list of text abbreviations beginning with the letter V, taken from the website webopedia.com.⁵ This list does not include the term VPR.

PRELIMINARY ISSUES

17. In her evidence and submissions, Ms Burchell made a number of points that require addressing. Firstly, the applicant has filed the results of a search of the Register for trade marks in class 34 which include the word PRO. At the hearing, Ms Burchell directed me to a paragraph of Contentious Trade Mark Registry Proceedings by Michael Edenborough QC in which he stated “save for the very limited purpose of

³ Exhibit CEB5

⁴ Exhibit EA1

⁵ Exhibit EA2

showing that a certain type of mark is commonly sought, this type of evidence has no value". I refer the applicant to the decision of the General Court ("GC") in *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, when it was stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71)."

18. I accept that the state of the register evidence filed by the applicant does, of course, show that multiple parties have sought to register trade marks which contain the element PRO. However, as noted in the book referred to above, such evidence does not demonstrate any more than this. It does not demonstrate that the average consumer is used to seeing marks containing this in the market place. We have no evidence to suggest that multiple parties are actually using marks containing the word PRO in relation to vaping products. It is clear from the case law that when assessing the likelihood of confusion under section 5(2), it is necessary to consider the potential for conflict between the applied-for mark and the earlier mark (or marks) in light of all the relevant circumstances. The existence of other trade marks on the Register is not relevant to the matter before me.

19. Secondly, Ms Burchell made reference to the fact that the opponent also has a number of other marks registered which contain the letters VPRO, presented with the V and PRO separated by a hyphen or full stop. Ms Burchell suggests that this supports

the contention that the opponent's marks will always be pronounced V PRO. I accept Ms Burchell's submission regarding how she considers the opponent's marks will be pronounced, but the fact that there are other marks owned by the opponent that are more likely to be pronounced in the way suggested does not assist the applicant. The matter before me must be decided based upon a comparison of the marks as applied-for/registered. The existence of other marks are not relevant to that assessment.

20. Thirdly, Ms Burchell makes reference to the way in which the opponent's marks are used in practice (see Exhibit CEB9). Specifically, Ms Burchell notes that the marks relied upon by the opponent in these proceedings always appear to be used alongside their 'main brand VYPE' and a device mark. Further, at the hearing, Ms Burchell drew my attention to the fact that it appears the First Earlier Mark is commonly presented vPRO in practice, thus enhancing the presence of the word PRO as a separate element in the mark. This has no bearing on the assessment that I am required to undertake. Any comparison of the marks must be on the basis of how they appear on the Register. The way in which the marks are presented in practice is not relevant to that assessment.

DECISION

21. 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.”

22. The trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the applicant's mark pursuant to section 6 of the Act. The earlier marks had not completed their registration process more than 5 years before the filing date of the application in issue and are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

My approach

23. At the hearing, Mr Sheraton accepted that the focus of my assessment should be on the First Earlier Mark. He accepted that, if there is no likelihood of confusion in relation to that mark, then there will also be no likelihood of confusion in relation to the Second Earlier Mark. I will, therefore, proceed with my assessment on the basis of the First Earlier Mark, returning to the Second Earlier Mark only if it is necessary to do so.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

25. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>The First Earlier Mark</p> <p><u>Class 34</u></p> <p>Tobacco substitutes; cigarette substitutes; cigarettes containing tobacco substitutes; electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes, tobacco, tobacco products, smokers' articles, cigarette cases, cigarette boxes.</p> <p>The Second Earlier Mark</p> <p><u>Class 34</u></p> <p>Electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes containing tobacco substitutes; tobacco substitutes; cigarettes; tobacco; tobacco products; cigarette cases; cigarette boxes.</p>	<p><u>Class 34</u></p> <p>Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Cartridges for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electric cigarettes [electronic cigarettes]; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarettes; Flavorings, other than essential oils, for tobacco substitutes; Flavorings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes.</p>

26. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

(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.

27. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated that:

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

28. “Electric cigarettes [electronic cigarettes]” and “Electronic cigarettes” in the applicant’s specification are self-evidently identical to “electronic cigarettes” in the opponent’s specification.

29. “Electronic cigarette liquid [e-liquid] comprised of propylene glycol”, “Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin”, “Chemical flavorings in liquid form used to refill electronic cigarette cartridges”, “Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges”, “Liquid for electronic cigarettes”, “Liquid nicotine solutions for electronic cigarettes”, “Liquid nicotine solutions for use in electronic cigarettes” and “Liquid solutions for use in electronic cigarettes” in the applicant’s specification all fall within the broader category of “liquids for electronic cigarettes” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

30. “Cartridges for electronic cigarettes” and “Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes” in the applicant’s specification fall within the broader category of “cartridges for electronic cigarettes” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

31. That leaves “Flavorings, other than essential oils, for tobacco substitutes”, “Flavorings, other than essential oils, for use in electronic cigarettes” and “Flavourings, other than essential oils, for use in electronic cigarettes” in the applicant’s specification. At the hearing, Mr Sheraton correctly noted that these flavourings could either take liquid or solid form. Where they are liquid, they would all, in my view, fall within the broader category of “liquids for electronic cigarettes” in the opponent’s specification. This is because flavourings for electronic cigarettes are typically sold in liquid form and ‘tobacco substitutes’ could include electronic cigarettes. Consequently, I consider these goods to be identical on the principle outlined in *Meric*. However, even where the goods are not in liquid form, they will overlap in user, method of use, trade channels and nature. There may also be a degree of competition between them. Consequently, I consider the goods to be highly similar.

The average consumer and the nature of the purchasing act

32. 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.”

33. The average consumer for the goods will be a member of the general public (who is over the age of 18) who uses electronic cigarettes. 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. The average consumer will also take various factors into account such as nicotine content and flavour. Taking all of this into account, I consider that at least a medium degree of attention will be paid during the purchasing process for the goods.

34. The goods will often be stored behind a counter and, in order to purchase them, the consumer will need to request them aurally. 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. In these circumstances, visual considerations will dominate the selection process. However, as advice may still be sought from sales assistants, aural considerations cannot be discounted.

Comparison of trade marks

35. 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 the distinctive and dominant components. The Court of Justice of the European Union (“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.”

36. 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.

37. The respective marks are as follows:

Opponent's trade mark	Applicant's trade mark
Vpro (the First Earlier Mark)	VPR

38. The applicant's mark consists of the word VPR. There are no other elements to contribute to the overall impression which lies in the word itself.

39. The First Earlier Mark consists of the word Vpro. Again, there are no other elements to contribute to the overall impression, which lies in the word itself. At the hearing, Ms Burchell suggested that average consumers will be used to seeing “V” in use in relation to vaping products. However, Ms Burchell confirmed that there was no evidence before me to support this contention. Ms Burchell suggested that this could be inferred in the same way that “I” has come to mean ‘internet’ or “E” has come to mean “electronic”. However, to my knowledge, “V” has acquired no such meaning in relation to vaping products. I do not, therefore, consider there to be any reason to conclude that the ‘V’ element of the First Earlier Mark would be separated from the “PRO” element, or play any lesser role in the overall impression.

Visual Comparison

40. The First Earlier Mark consists of the letters Vpro. The applicant’s mark consists of the letters VPR. They differ in their presentation in title case/upper case, but as registration of a word only mark covers use in any standard typeface, I do not consider this to be of importance to my comparison. The only difference between the marks, therefore, is the addition of the letter O at the end of the First Earlier Mark. I bear in mind that the beginnings of marks tend to make more of an impact than the ends.⁶ Consequently, I consider the marks to be highly similar.

Aural Comparison

41. The applicant’s trade mark is likely to be pronounced VEE-PEE-ARE i.e. with each letter being pronounced individually. In my view, there will be a significant proportion of average consumers who identify the word PRO in the First Earlier Mark and pronounce it in the way suggested by Ms Burchell i.e. VEE-PRO. However, I also consider that there will be a significant proportion of average consumers who pronounce the First Earlier Mark: VEE-PEE-ARE-OHH. This is particularly the case given that the only part of the mark that may be identified as a word (PRO) is at the end of the mark and, therefore, might not be immediately identified and because notional and fair use of the First Earlier Mark will cover use in different combinations

⁶ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

of upper and lower case. Where the mark is used in all upper case (or all lower case) the differentiation between the V and PRO may not be identified. In the case of the former pronunciation, the marks will be aurally similar to a low degree. However, in the latter they will be aurally similar to a high degree.

Conceptual Comparison

42. Mr Scammell suggested in his evidence that the applied-for mark might be interpreted as a text messaging abbreviation for “vapor” or “vapour”. Evidence has, of course, been filed to illustrate the construction of abbreviations used in text messaging. However, I do not consider there to be any evidence to support the contention that a significant proportion of average consumers would view VPR as an abbreviation of the word vapour/vapor. The fact that this may be the message that the applicant intended to convey to their target public, is not relevant to my assessment. In any event, in my view, it is likely that both marks will be recognised by a significant proportion of average consumers as acronyms with no particular meaning, and the conceptual position will be neutral. Although the opponent filed evidence giving examples of the meaning that might be conveyed by the acronym VPR, I do not consider that any of these would be recognised by a significant proportion of average consumers.

43. Where the word PRO is identified in the earlier mark, this will be seen as a reference to something professional or, possibly, something with positive connotations. In these circumstances, the marks will be conceptually dissimilar.

Distinctive character of the earlier trade mark

44. 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).”

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

46. The opponent has not pleaded that its marks have acquired enhanced distinctive character through use and has filed no evidence to support such a claim. Consequently, I have only the inherent position to consider. The First Earlier Mark consists of the word Vpro. If this is viewed as an acronym with no particular meaning then it will be inherently distinctive to between a medium and high degree. If it is viewed as the letter V followed by the word PRO then, the word PRO will be given its ordinary meaning. In these circumstances, I consider the mark as a whole to be inherently distinctive to a medium degree.

Likelihood of confusion

47. 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must 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.

48. I have found the marks to be visually highly similar, aurally highly similar or similar to a low degree (depending on how the earlier mark is pronounced) and conceptually neutral or dissimilar (depending on whether the word PRO is identified in the earlier mark). I have found the earlier mark to be inherently distinctive to at least a medium degree. I have identified the average consumer to be a member of the general public (who is over the age of 18) who uses electronic cigarettes. I have found that the average consumer will purchase the goods by both visual and aural means. 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 either identical or highly similar.

49. The applicant has referred me to a decision of this Tribunal (O/128/20), in which a Hearing Officer considered the similarity of the marks YOR and YORG and concluded that there was no likelihood of confusion. Ms Burchell drew my attention to various paragraphs of that decision during the course of the hearing. Mr Sheraton sought to distinguish that case from the present case by noting that it concerned words rather than acronyms. In any event, I do not consider it useful to attempt to draw analogies between a marks comparison in relation to entirely unrelated registrations and the

comparison to be undertaken in the present case. Each case must be decided on its individual merits and by reference to the marks before me.

50. Ms Sheraton also drew my attention to a decision of the EUIPO (Opposition No. B 3060540) in which the marks compared were Vpro and a highly stylised “VPO”. Again, whilst the marks may be more similar to those in the present case than they were in the case referred to by the applicant, they are not the same. In any event, this Tribunal is not bound by decisions of the EUIPO. I do not, therefore, consider that case to be particularly informative in reaching my conclusions on whether or not there is a likelihood of confusion.

51. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin L.J. stated that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

52. This was, of course, in the context of infringement. However, the same approach is appropriate under section 5(2).⁷ It is not, therefore, necessary for me to find that the majority of consumers will be confused. The question is whether there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer.

53. For the significant proportion of average consumers who view the earlier mark as an acronym, the marks will be visually and aurally highly similar and the conceptual position will be neutral. Bearing in mind my conclusions summarised above, particularly the fact that the earlier mark has at least a medium degree of inherent distinctiveness and that the marks will be used on identical or highly similar goods, I consider that they are likely to be mistakenly recalled or misremembered as each other. In my view, taking into account the principle of imperfect recollection, the

⁷ *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch), Mann J.

average consumer is likely to overlook the additional letter at the end of the earlier mark. I consider there to be a likelihood of direct confusion.

Final Remarks

54. As I have found there to be a likelihood of confusion in relation to the First Earlier Mark, I do not consider it necessary to return to the Second Earlier Mark as it will not improve the opponent's case.

CONCLUSION

55. The opposition based upon section 5(2)(b) is successful in its entirety and the application is refused.

COSTS

56. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. At the hearing, both Mr Sheraton and Ms Burchell agreed that costs should follow the event on the normal scale. In the circumstances, I award the opponent the sum of **£1,900** as a contribution towards its costs, calculated as follows:

Preparing a Notice of Opposition and considering the applicant's counterstatement	£200
Filing evidence and evidence in reply and considering the applicant's evidence	£700
Preparing for and attendance at hearing	£900
Official fee	£100
Total	£1,900

57. I therefore order Darkstar International Limited to pay Nicoventures Holdings Limited the sum of £1,900. This sum should be paid within 2 months 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 1st day of June 2020

S WILSON

For the Registrar