

O-510-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3048065 BY
E-VAP LIMITED**

TO REGISTER:



**AS A TRADE MARK
IN CLASS 34**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000122 BY
AHMED EL-ZALABANY**

BACKGROUND

1. On 21 March 2014, E-VAP Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 18 April 2014, for the following goods in class 34:

Electronic Cigarettes and accessories for the aforesaid.

2. The application is opposed by Ahmed El-Zalabany (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon all of the goods in the following UK trade mark registration:

UK no. 3007304 for the trade mark:



which was applied for on 24 May 2013 and for which the registration process was completed on 30 August 2013:

Class 34 - Smokers articles, electronic smokers articles.

3. The applicant filed a counterstatement in which the basis of the opposition was denied. It stated:

“The current opponent and applicant were recently involved in another opposition in relation to the opponent’s mark (same as the mark in the current case), but against a different mark of the applicant (i.e. the applicant’s was a word mark in standard English letters).”

4. In the Notice of Opposition and in the counterstatement, the parties refer extensively to a previous decision of this Tribunal in BL-O-106-14 (dated 6 March 2014) in which the opponent, on the basis of the earlier registration mentioned above, successfully opposed the registration of a series of two trade marks i.e. e-Vap/eVap in the name of Mr Syed Naseer for a specification of goods in class 34 very similar to that shown above. Although the applicant in these proceedings is E-VAP Limited (and not Mr Naseer), I infer from the applicant’s comments that Mr Naseer plays a significant role in the applicant’s affairs. Given the importance both parties place on the earlier decision, a copy is attached as an Annex to this decision. I will refer to it as necessary below, although I am not, of course, bound by it.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions, which I will refer to, as necessary, below.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

(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.”

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the opponent’s earlier trade mark had not been registered for more than five years when the application for registration was published, it is not subject to proof of use, as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods for which its earlier trade mark is registered.

Section 5(2)(b) – case law

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

The principles:

- (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 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

11. The competing goods are as follows:

The opponent's specification	The applicant's specification
Smokers articles, electronic smokers articles.	Electronic Cigarettes and accessories for the aforesaid.

12. In the earlier decision, the Hearing Officer (“HO”) stated:

“26. The terms ‘electronic cigarettes’ and ‘vapour cigarettes’ were added to the NICE classification guide on 1 January 2014. Prior to this date such products would have been classified as electronic smokers’ articles. The opponent’s specification for electronic smokers’ articles is a broad term which includes electronic and vapour cigarettes.”

13. In the above paragraph, the HO comments upon a purely factual matter and draws a conclusion based upon it. As neither party in these proceedings appears to take any issue with it, I am happy to adopt it. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

14. It is, in my view, self evident, that the opponent’s “electronic smoker’s articles” would encompass the applicant’s “electronic cigarettes and accessories for the aforesaid”. The competing goods are, as a consequence, identical on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing process

15. 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 these goods are likely to be selected by the average consumer in the course of trade. 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.”

16. In the earlier decision (paragraph 22), the HO found that “electronic cigarettes are currently unregulated so they may be purchased by a person of any age.” As a consequence, she found that the average consumer was a member of the general public. As there is no evidence or submissions to indicate that is not still the position, I reach the same conclusion. As to the nature of the purchasing process, I have no meaningful experience of my own upon which to draw. In those circumstances, I am guided by the decision of the HO in the earlier proceedings (in which she refers to her “experience”) and the submissions of the parties. In the earlier proceedings, the HO concluded:

“22...The nature of the purchase is likely to be both visual and aural. In my experience electronic cigarettes are usually sold from locked cabinets or shelves behind a counter and are not accessible to the consumer without assistance. However, in contrast with tobacco cigarettes, electronic cigarettes may be promoted through advertising, therefore, the potential for visual confusion still exists...Given the nature of these products which are sold in a range of styles, strengths and flavours, the level of attention paid will be at least normal.”

In his Notice of Opposition, the opponent states:

“9...In this case, the goods at issue are goods in class 34 which are often recommended by word of mouth and referred to orally. Subsequently, the phonetic aspects of the signs in question will generally have greater significance for the relevant public than the visual aspects.”

In its counterstatement, the applicant states:

“Contrary to the opponent’s assertion, the trade mark for the goods in question is not often referred to orally. Purchases of electronic cigarettes are rarely conducted by telephone. Rather, they are commonly bought online and in shops where the goods are distinguished visually.

Unlike traditional cigarettes, electronic cigarettes can be promoted and advertised in all the usual channels, and are not hidden behind closed cabinets. Even if the product is behind a counter and a shop assistant is

required to retrieve the product, the actual electronic cigarette (or the packaging containing the cigarette) is openly and fully on display for the consumers to see so that they can make their choice.

Even if a telephone call is made for the purchasing of an electronic cigarette, the caller would have seen and read about the electronic cigarette in question and would have seen the trade mark before the call...”

And:

“...The visual element of the mark is therefore far more important than the aural element in this case.”

And:

“Electronic cigarettes vary in style, flavours, strengths, re-chargeability, reservoir size, disposability, voltage, variability, costs etc. It is therefore not a product that a consumer will buy impulsively...the level of attention of the relevant average consumer would be reasonably high...”

17. In his submissions, the opponent states that the “average consumer will pay at least an average level of attention” to the selection of the goods at issue. Whilst both parties agree (as did the HO in the earlier proceedings) that the selection process will consist of a mixture of visual and aural considerations, they differ as to their relative importance, with the opponent suggesting that aural considerations will dominate, whereas the applicant considers visual considerations to be more important. I am not, absent evidence directed to this point, able to resolve this difference of opinion. However, as the goods may, it appears, be selected from the pages of a website or catalogue as well as from traditional retail outlets on the high street, this strongly suggests that visual considerations are likely to form a significant part of the selection process. That said, as the goods may also, it appears, be the subject of, for example, word of mouth recommendations and requests to sales assistants in, for example, retail outlets on the high street, it appears that aural considerations will have a not insignificant part to play.

18. As to the degree of care that will be taken when selecting the goods at issue, in the earlier proceedings the HO concluded that the level of attention would be “at least normal” whereas the parties in these proceedings submit it will be “reasonably high” (the applicant) and “at least an average level of attention” (the opponent). In reality, I think there is little between the parties. Whilst I have concluded, bearing in mind the various factors it appears the average consumer is likely to consider when selecting the goods at issue, that the average consumer will (as the applicant suggests) pay a reasonably high degree of attention to the selection of the goods at issue, I do not (given the wording it has adopted), detect any significant tension between this conclusion and that of the opponent.

Comparison of trade marks

19. 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 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.”

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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

20. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	

21. The comparison of the competing trade marks and the degree of distinctive character present in the opponent's earlier trade mark (see below) were, not surprisingly in my view, the issues upon which the majority of the parties' competing submissions were focused. Whilst I do not intend to rehearse all of the competing submissions here, I will, of course, keep them in mind, and, given the importance of these issues to the decision I am required to make, refer in some detail to those submissions which, in my view, capture the parties' respective positions. In his Notice of Opposition, the opponent states:

“6. The opposed application consists of the term E-VAP in a stylised form together with a vapour/smoke like device to the right hand side of the term E-VAP. The single dominant and distinctive component of the opposed mark is the term E-VAP as the device of a vapour/smoke like device in relation to electronic cigarettes and smokers articles possesses little or no distinctive character.

7. The opponent's earlier trade mark consists of the term EVape together with 3 puffs of smoke/vapour placed to the right of the word EVape. The single dominant and distinctive component in the opponent's earlier mark is the term EVape as the device of three puffs of smoke/vapour in respect to smoker's articles again has little or no distinctiveness on its own. The marks are therefore phonetically very similar.

8. The visual elements of the opponent's earlier mark do not visually dominate the image that the relevant public keeps in mind. Although they are visible, it is very unlikely that the public would easily recognise and ascribe an origin to the figurative elements of the opponent's earlier mark. The relevant public would refer to the signs at issue orally and would remember them as much by their name as their figurative elements especially as the visual elements merely refer to the purpose of the goods."

In its counterstatement, the applicant states:

"Visually – even if the marks are not compared side by side and taking into account imperfect memory, the two marks are not similar, let alone confusingly similar. The marks share no common features visually. They are clearly different in their stylisation, colours and theme...

In this case, the marks do not possess multiple components where one is dominant. In this case, even if the details are analysed, they would be:

- EV in a highly curvy font in grey vs E with hyphen in a square font in magenta
- small letters "ape" in italics in black vs capital letters VAP in square font in grey
- three grey puffs or clouds vs s curve in grey next to a larger s curve in magenta

The opponent's assertion that the vapour/smoke element should be ignored in the assessment of similarity due its lack of distinctiveness is inappropriate, because the lack of distinctiveness is just as true for the word EVape...

Aurally – the opponent's earlier mark is a highly stylised device mark, which can be pronounced as "ee-vape" (to rhyme with Tape) if the sound break is considered to be after the letter E. However, given the styling and colouring of the letters E and V, it is just as likely that the mark will be pronounced by the public as "ee-vi-ape". This contrasts with the applicant's mark which would be pronounced as "ee-vap" (to rhyme with Tap).

Conceptually – given that the opponent's mark has a low distinctive character any conceptual similarity found on such a basis cannot be used to establish a likelihood of confusion to any real degree. The idea of comparing conceptual similarity makes sense and should be given weight only when applied to marks where the earlier mark does not describe the goods in question. It

would be absurd and inappropriate for a non-distinctive and descriptive mark to benefit from the fact that it is non-distinctive. Any distinctive features of the earlier mark can only come from the stylisation, colour, layout etc. of the mark. Such features do not convey any conceptual meaning.”

In his written submissions, the opponent states:

“3. Moreover the HO [in the previous decision] stated that the combination of “e-vape” is not a natural one and therefore one must take this to mean that the term “e-vape” does possess a level of inherent distinctive character. The applicant...has not provided any evidence to support the applicant’s claim that the term is sufficiently well established as being naturally descriptive of a characteristic of the goods...”

4. Furthermore the HO [in the previous decision] stated: “I also accept that the puffs of smoke, or clouds, in the opponent’s mark are non-distinctive for these goods...”

6. The applicant’s mark in this case at hand does not differ in anyway phonetically to the word mark filed by the applicant [in the previous proceedings]...and therefore it must be found in this case that there is still a medium degree of aural similarity between [the competing trade marks]

7...It is also true that the term VAPE alludes to vapour which is an obvious characteristic of electronic cigarettes and therefore consumers of these goods are likely to pronounce the mark EE-VAPE in association with that characteristic...

13...It is the terms EVAP and E-VAPE that are the dominant elements and the concept which will be stored away in the memory of the relevant consumer. Both marks begin with the letter “E” which alludes to “electronic” and both marks contain the terms “VAP” and “VAPE” which, bearing in mind the goods in question, are likely to be seen as indirect references to “vapour”.

15. Furthermore, the conceptual similarity between the marks does not end with the aural references to the trade marks. The opposed mark not only contains the term E-VAP (stylised) but also contains a stylised representation of two wisps of smoke/vapour to the right of the term E-VAP which copies the concept of the opponent’s earlier mark which contains three puffs of smoke/vapour to the right hand side of the term E-VAPE.”

22. As I mentioned above, I am not bound by the HO’s decision in the earlier proceedings. However, where I agree with the conclusions she reached, I intend to adopt her findings as my own. The HO described the opponent’s earlier mark in the following terms:

“30. The opponent’s mark consists of the letter ‘E’ followed by the word ‘Vape’. The first two letters are presented as capital letters, in a grey colour, while the remaining three letters, ‘ape’, are shown in lower case and in black. The mark is presented in a script font in which the capital letters E and V

feature curled terminals. To the right of the word 'Vape' are three cloud shapes shown in a triangular formation.”

23. That is, in my view, an accurate assessment. In its submissions, the applicant describes its trade mark as being made up of the letter “E with hyphen in a square font in magenta”, “capital letters VAP in square font in grey” and “s curve in grey next to a larger s curve in magenta.” The applicant’s description of its trade mark is, in my view, significant, as it clearly accepts that despite their stylisation, the first character of its trade mark will be seen as a letter E and that the three characters which follow it will be seen as the capital letters VAP. As to the figurative elements in the competing trade marks, I agree with the HO that “the puffs of smoke, or clouds, in the opponent’s mark are non-distinctive for these goods.” Insofar as the devices present in the applicant’s mark are concerned, I note that the opponent argues that they would be construed as “stylised representation of two wisps of smoke/vapour”, whereas the applicant refers to them as “s curves [in grey and magenta]”. Considered in the context of the goods for which registration is sought, I am inclined to agree with the opponent that these devices are likely to be construed in the manner he suggests and are, as a consequence, non-distinctive. However, even if they are not construed in that manner, they do not, given their size and positioning within the applicant’s trade mark do anything to change the overall impression it conveys. Insofar as to the colours present in the competing trade marks are concerned, as neither trade is limited as to colour, the opponent would be entitled to present elements of its trade mark in the same colours as those present in the applicant’s trade mark and, as a consequence, the fact that the applicant’s trade mark is presented in particular colours is not a point that assists it.

24. In my view, the overall impression created by the opponent’s trade mark is dominated by the combination of the letter E and the word Vape, whereas the overall impression created by the applicant’s trade mark is dominated by the combination of characters which would (as the applicant accepts) be perceived as the letters E and VAP separated by a hyphen. As to the distinctiveness of these competing combinations, in its counterstatement, the applicant states (by reference to the previous decision):

“In that case, evidence was submitted to show that the use of a prefix E is common in trade marks which relate to electronic cigarettes. It also showed that the verb “vape” and the derived terms “vaping” and “vaped” are widely used to describe the function of electronic cigarettes.

The Hearing Officer went on to say that “Taking all of these factors into account, for electronic cigarettes, the whole of the opponent’s mark is, in my view, greater than the sum of its parts. Its distinctiveness rests in the presentation of the mark as a whole.

The word “EVape” is clearly a sign which may serve, in trade, to designate the kind and intended purpose of the goods in question...It would therefore be incorrect for the opponent to claim monopoly over E or vape or any such obvious and natural combinations thereof.”

In his written submissions, the opponent states:

“10...The term EVAPE is the dominant element feature of the opponent’s earlier mark and it is this term which the applicant contends is the element which is weak in distinctive character...”

12. Therefore, where the shared identical or similar element, even when the identical or similar element is of a low distinctive character (which is not admitted here, it is the opponent’s contention that the earlier mark possesses at least a medium degree of inherent distinctive character) this does not allow the Hearing Officer to ignore that element...

25. In her decision in the earlier proceedings, the HO said this:

“52...In the context of the goods, the remaining letters ‘Vap’ will, in my view, evoke an impression of the vapour associated with electronic cigarettes or be seen as a shortened form of VAPE”,

and she referred to the decision of the GC in *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04*; once again, I agree with her conclusions in this regard and this is how the letters VAP in the applicant’s trade mark will be perceived by the average consumer. In relation to the opponent’s trade mark, the HO concluded:

“37. The goods are electronic cigarettes, which evidence confirms are often referred to as ‘e-cigarettes, the ‘e’ being used as a short form of the word electronic. Users of these goods may ‘vape on them **but, it does not follow that the combination ‘e-vape’ is a natural one and there is nothing in the applicant’s evidence to suggest this is the case...**”(my emphasis).

As the combination E-Vape is not, it appears, a “natural one”, nor, in my view, is the combination E-VAP, the elements which dominate the overall impression the competing trade mark will create are, although highly allusive, in my view distinctive.

26. The conceptual impression both trade marks will (and are intended) to convey to the average consumer relate to the act of using an electronic cigarette. As to the degree of visual similarity, as all of the letters in the applicant’s trade mark are wholly contained in the opponent’s trade mark, and notwithstanding the degree of stylisation present in the competing trade marks, there remains, in my view, a low to moderate degree of visual similarity between them. As to the degree of aural similarity, it is well established that where a trade mark consists of a combination of figurative and verbal elements, it is by the verbal elements that the average consumer is most likely to refer to the trade mark; that is the case in these proceedings. In the earlier proceedings, the HO concluded that the opponent’s trade mark would be pronounced as “EE-VAPE (to rhyme with TAPE)” a view with which the applicant does not appear to disagree (although it offers an alternative pronunciation); I agree with the HO’s conclusions in the earlier proceedings as to how the opponent’s trade mark will be pronounced. As to the applicant’s trade mark, the applicant argues that this would be pronounced as “ee-vap (to rhyme with Tap)” which I note was the same conclusion reached by the HO in respect of the word only

version of the applicant's trade mark in the earlier proceedings. I agree with the applicant in this regard. Although the HO in the earlier proceedings characterised the degree of aural similarity between the competing trade marks as "medium", I would describe it as fairly high.

Distinctive character of the opponent's earlier trade mark

27. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings – *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

28. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it had made of its earlier trade mark. I have, as a consequence, only the inherent characteristics of the opponent's trade mark and the parties' submissions to consider. In the earlier proceedings, the HO concluded that the opponent's trade mark had "a fairly low degree of inherent distinctive character. Although I have concluded that the combination E-Vape is distinctive, the fact remains that both the letter E and the word Vape are meaningful when considered in the context of the goods for which the opponent's trade mark is registered; in addition, the devices of puffs of smoke, or clouds are non-distinctive. Although the letter and word E-Vape have a degree of stylisation, this does not, in my view, detract from the highly allusive message they will convey to the average consumer. In short, I agree with the HO that the trade mark has a relatively low, rather than as the opponent argues, a medium degree of inherent distinctive character.

Likelihood of confusion

29. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded, that:

- the competing goods are identical;
- the average consumer is a member of the general public who will select the goods by both visual and oral means and who will pay a reasonably high degree of attention to their selection;
- the overall impressions created by both trade is dominated by the combination of the letter and word EVape and the letters E-VAP respectively;
- the competing trade marks are visually similar to a low to moderate degree, aurally similar to a fairly high degree and convey the same conceptual message;
- the opponent's earlier trade mark is possessed of a relatively low degree of inherent distinctiveness.

30. In *L'Oréal SA v OHIM*, Case C-235/05 P, the Court of Justice of the European Union found that:

“45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

31. Notwithstanding that the opponent's trade mark has a fairly low degree of inherent distinctive character, the fact remains that both parties' trade marks are dominated by elements which, in the same weakly distinctive manner, allude to (but importantly do not describe) the act of using an electronic cigarette. Given the similarities in the competing trade marks (particularly the fairly high degree of aural similarity), the likelihood of direct confusion in circumstances where the trade marks are used orally (which I have already concluded will form a not insignificant part of the selection process) is, in my view, a real one and the opposition succeeds accordingly.

Overall conclusion

32. The opposition based upon section 5(2)(b) of the Act succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

33. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£300
Opposition fee:	£100
Written submissions:	£200
Total:	£600

34. I order E-VAP Limited to pay to Ahmed El-Zalabany the sum of **£600**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of December 2014

C J BOWEN
For the Registrar
The Comptroller-General

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3010144
BY
SYED NASEER
TO REGISTER A SERIES OF TWO TRADE MARKS
IN CLASS 34**

e-Vap

eVap

AND

**THE OPPOSITION THERETO
UNDER NO 600000005
BY
AHMED EL-ZALABANY**

BACKGROUND

1. On 14 June 2013, Syed Naseer (the applicant) applied to register the above trade marks in class 34 of the Nice Classification system.¹ The specification stands as follows:

Class 34
Electronic Cigarettes or Vapour Cigarettes.

2. Following publication of the application, on 5 July 2013, Ahmed El-Zalabany (the opponent) filed notice of opposition against the application under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the UK mark 3007304, shown below:

Mark details and relevant dates	Goods relied on
<p>Mark:</p>  <p>Filing date: 24 May 2013</p> <p>Date of entry in the Register: 30 August 2013</p>	<p>Class 34</p> <p>Smokers' articles, electronic smokers' articles.</p>

4. On 21 November 2013, the applicant filed a counter statement. Attached to the counter statement were a number of additional documents in the nature of evidence. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions.

6. Tribunal Practice Notice 2/2013 states:

“6. The Registrar can usually make an assessment of the likelihood of confusion between the opposed mark and the earlier mark(s) relied on by

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

the opponent, without further evidence. Therefore applicants should not expect to have the automatic right to file evidence in a fast track opposition.

7. Where either party considers it necessary to file (further) evidence, a request for leave to file such evidence should be submitted as soon as possible and, at the latest, within 14 days of the serving of the Form TM8 (counterstatement). Each such application will be considered on its merits.”

7. On 27 November 2013 a formal request was made by the applicant to seek leave to file evidence. The request was allowed and the evidence the applicant had initially filed with its counterstatement was duly admitted on 14 January 2014.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

9. A hearing was neither requested nor considered necessary. The opponent filed written submissions, which I will refer to as necessary, below.

10. I give this decision following a review of all of the material before me.

EVIDENCE

11. The applicant’s evidence consists of a witness statement by Peter Mansfield, a Chartered Patent Attorney and a Registered Trade Mark Attorney at Coller IP. His statement is dated 20 November 2013 and is accompanied by 2 exhibits.

12. The applicant was given leave to file evidence to show that the use of a prefix E is common in trade marks which relate to electronic cigarettes. It also sought to show the verb “to vape” and the derived terms “vaping” and “vaped” are widely used to describe the functioning of electronic cigarettes.

13. To that end, exhibit 1 consists of prints showing eight marks on the UK register which are registered in class 34 for electronic cigarettes. Five of these begin with “e-“, while three begin with “e-“ followed by a word. There are also included prints of six marks registered at OHIM. Five of these begin with “e-“, while the remaining one has “e-“ followed by a word.

14. Exhibit 2 comprises five articles about electronic cigarettes found during an internet search, a print following a Google® search and a print from the opponent’s website.

Article 1. “BMA calls for stronger regulation of e-cigarettes, A briefing from the Board of Science and the Occupational Medicine Committee.” March 2012. The terms ‘vape with style’ and ‘passive vaping’ have been highlighted. It is not clear where this article was taken from.

Article 2. “French study shows significant health improvements for smokers using electronic cigarettes.” The article is taken from the Electronic Cigarette Industry Trade Association blog and is dated 9 January 2013. There are six references to ‘vape’ or ‘vaping’ throughout the article, in the context of using electronic cigarettes.

Article 3. “Vape ‘em if you got ‘em.” Taken from The Economist®, the article is dated 23 March 2013. The first paragraph of the article states:

“But these are uncertain times for Big Tobacco. Electronic cigarettes, once dismissed as a novelty, now pose a serious threat. E-cigarettes work by turning nicotine-infused liquid into vapour, which is then inhaled. A user is therefore said to be “vaping”, not smoking.”

Article 4. “E-cigarettes may damage lungs.” Taken from NHS choices website and dated 3 September 2012. The first line of the article states:

“‘Vaping’ e-cigarettes: could it damage the lungs?”

The third paragraph of the same article reads:

“The news is based on a press release of preliminary findings of a small study investigating the short-term effects of smoking an e-cigarette, commonly known as ‘vaping’.”

Article 5. “E-cigarettes to be regulated as medicines.” Taken from NHS choices website and dated 12 June 2013. On page two of the article is the heading, “DIY vaping”, under which is the following text:

“Some vapers build their own cigarettes – known as ‘rebuildables’ or ‘personal vapourisers’ (PVs). These can be from components ordered online and many vapers even make their own cigarette fluid (‘juice’). The same safety issues apply to this form of vaping, but it generally works out cheaper...”

Article 6. “Why do my gums bleed now I’ve switched to vaping?”, taken from Totally Wicked-ELiquid Blog and dated 14 June 2012. There are six references to ‘vape’ or ‘vaping’ in relation to using electronic cigarettes, one within the article and five in the following blog comments.

A print from a Google® search screen shows the term ‘vaping uk 2011’ in the search field. The exhibit is a screen shot which only identifies five ‘hits’, though the total returned hits are stated at the top of the page to be ‘About 462,000 results’. The page is not dated. The first four hits are all from www.ecigarettedirect.co.uk and are titled:

Ten top celebrities who vape...8 July 2011

Vaping, Nicotine and Pleasure – 24 October 2011

Vapefest 2011 & the dangers of excessive vaping – 20 July 2011

Sign the petition to protect vaping – 5 October 2011

The fifth page returned is from ukvapefest.com and is titled:

UK Vapefest. The only date shown is the year 2013.

The final section of exhibit 2 is a screen shot of the home page of the opponent's website. The earlier mark relied on is shown at the top of the page. To the left of the page is shown a menu of product types and to the right there are five products highlighted with photographs and descriptions. The page is not dated. In his witness statement Mr Mansfield says: "The section entitled Newsletter refers to "vaping tips"."

15. This concludes my summary of the evidence.

DECISION

16. The opposition is brought under section 5(2)(b) of the Act which 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

"6.-(1) In this Act an "earlier trade mark" means -

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

18. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been protected for five years.²

Section 5(2)(b) case law

19. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(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;

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

20. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

21. In its submissions the opponent states:

“12. This average consumer is likely to be the smoking proportion of the general public and the fact that electronic smokers’ articles are not expensive items means that the consumers level of attention when purchasing these goods will not be of the highest order. Overall, the level of attention of the average consumer will be average. Unless a vending machine is being used, the goods have to be requested aurally because they are sold behind the counter. The goods could be displayed on shelves but usually out of reach of the consumer due to the nature of the product and subsequently the purchasing act in a retail out[let] is usually performed by the aural reference to the products.

22. The average consumer for these goods will be a member of the general public.³ The nature of the purchase is likely to be both visual and aural. In my experience electronic cigarettes are usually sold from locked cabinets or shelves behind a counter and are not accessible to the consumer without assistance. However, in contrast with tobacco cigarettes, electronic cigarettes may be promoted through advertising, therefore, the potential for visual confusion still exists. Other smokers' articles such as, inter alia, lighters, ashtrays and cases will be bought, for the most part, visually, the average consumer encountering the goods and trade marks on a shelf, the internet or in a catalogue. I note that the opponent refers to sale by vending machine, but, I have nothing in evidence to indicate that any of the parties' goods would be offered in that manner. Given the nature of these products which are sold in a range of styles, strengths and flavours, the level of attention paid will be at least normal.

Comparison of goods

23. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
Smokers' articles, electronic smokers' articles.	Electronic Cigarettes or Vapour Cigarettes.

24. The opponent states:

“14. In this case the goods are identical and subsequently this is likely to offset the minimal differences that exist between the trade marks.”

25. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

26. The terms 'electronic cigarettes' and 'vapour cigarettes' were added to the NICE classification guide on 1 January 2014. Prior to this date such products would have been classified as electronic smokers' articles. The opponent's specification for electronic smokers' articles is a broad term which includes electronic and vapour cigarettes. Accordingly, these are identical goods.

³ Tobacco products cannot be sold in England and Wales to anyone under the age of 18, see *The Children and Young Persons (Sale of Tobacco) Order 2007, Article 2* which amended s.7 of the *Children and Young Persons Act 1933*. In Scotland and Northern Ireland the minimum age at which tobacco can be purchased is also 18. Electronic cigarettes are currently unregulated so they may be purchased by a person of any age.

Comparison of marks

27. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
	e-Vap eVap

28. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁴, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

29. The applicant's mark is a series of two marks, the first of which consists of a lower case 'e' followed by a hyphen and the three letters 'Vap, i.e. with the letter V capitalised. The second is the same but for the hyphen which is omitted. Neither are stylised in any way and are presented in plain black type. In both cases the distinctiveness rests in the mark as a whole.

30. The opponent's mark consists of the letter 'E' followed by the word 'Vape'. The first two letters are presented as capital letters, in a grey colour, while the remaining three letters, 'ape', are shown in lower case and in black. The mark is presented in a script font in which the capital letters E and V feature curled terminals. To the right of the word 'Vape' are three cloud shapes shown in a triangular formation.

31. In his witness statement for the applicant Mr Mansfield concludes that the prints from the UK and European Trade Mark Databases show that,

"...a prefix E is commonly used in trade marks that relate to electronic cigarettes (often referred to as 'e-cigarettes)".

32. In its submissions the opponent comments:

"2. It is not disputed that the prefix E is commonly used abbreviation for the term "electronic" which is all that can be adduced by the "State of the Register" evidence that the Applicant refers to in its evidence of registered marks at the UK IPO and the OHIM."

33. It has long been established that state of the register evidence of this type does not assist the applicant. It does not indicate whether the marks are being used, or give any indication of the goods on which there is use, or what agreements may be

⁴ *Sabel v Puma AG, para.23*

in place between those parties. It is not, therefore, an indicator of whether or not there will be confusion in the market place in relation to the respective trade marks.⁵ However, I accept that the letter 'e' may be used to substitute for the word 'electronic' in relation to the goods at issue.

34. In respect of the dominant and distinctive elements of its mark, the opponent states in its notice of opposition:

"5...The Opponent's earlier mark consists of the term EVape together with 3 puffs of smoke placed to the right of the word EVape. The single dominant and distinctive component in the Opponent's earlier mark is the term EVape as the device of three puffs of smoke in respect to smokers' articles is non-distinctive."

35. The applicant states:

"3.2 It will also be appreciated that the verb "to vape" (and the derived terms "vaping" and "vaper") is used to describe the use of an electronic cigarette."

...

5. The opponent has stated that the three small clouds or puffs of smoke are not distinctive. So the distinctive components are only the florid italic font of the letters EV and the difference in colour between the letters EV and the letters ape."

...

6. As explained above, the word component of the opponent's mark would have little distinctiveness in isolation, because it combines the standard prefix E with the word Vape, and both the prefix and the word are directly descriptive of the goods (electronic cigarettes)."

36. The evidence provided by the applicant, from a range of organisations, including the BMA and the NHS; as well as news and media articles and a trade blog, indicate that the term 'vape' or 'vaping' is used to describe the act of using an electronic cigarette and that those who use them are referred to as 'vapers'. It is reasonable to assume, from the evidence provided that to 'vape' is to 'smoke' an electronic cigarette. I have also concluded above that E or E- may be used to indicate the word 'electronic'. I also accept that the puffs of smoke, or clouds, in the opponent's mark are non-distinctive for these goods. However, the law requires me to make a finding without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

37. The goods are electronic cigarettes, which evidence confirms are often referred to as 'e-cigarettes, the 'e' being used as a short form of the word electronic. Users of these goods may 'vape on them but, it does not follow that the combination 'e-vape' is a natural one and there is nothing in the applicant's evidence to suggest this is the case. Taking all of these factors into account, for electronic cigarettes, the whole of

⁵ see Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

the opponent's mark is, in my view, greater than the sum of its parts. Its distinctiveness rests in the presentation of the mark as a whole.

Visual similarities

38. The applicant submits:

“Considering the words of the marks in isolation, the present application includes the syllable Vap which is clearly different both phonetically and visually from the syllable Vape. The present application includes the prefix e or e-, which is visually different to the florid italic capital letter E of the cited mark.”

39. The opponent submits:

“23. When comparing the marks visually, they are of [sic] clearly similar in length and both contain the same number of syllables. However, the whole of the opposed mark appears at the start of the Opponent's earlier trade mark. Clearly the presence of the opposed mark at the start of the Opponent's earlier mark in suit provides a level of similarity even if the opposed mark has the letter E added to the end.”

40. The opponent draws my attention to the fact that the beginnings of words are more important. The general rule, that the average consumer tends to place most importance on the start of a word⁶, is exactly that - a general rule, to which an exception can be made depending on the circumstances of the case.⁷ In this case the first four letters of the opponent's mark are the entirety of the applicant's mark. Only an additional letter 'e' at the end of the earlier right distinguishes them in terms of the letters used within the marks.

41. In considering the presentation of the marks at issue I am mindful of the comments in *Sadas*⁸, where the Court of First Instance (now the General Court) assessed the similarity of 'Arthur' (in script) against the application 'ARTHUR ET FÉLICIE', in plain block capital letters. It held,

“47. At the visual level, given that the figurative elements of the earlier mark are secondary relative to its word element, the comparison of the signs may be carried out on the basis of the word element alone, whilst still adhering to the principle that an assessment of the likelihood of confusion, with regard to the similarity of the signs, must be based on the overall impression given by them. Accordingly, since the earlier mark Arthur is entirely included in the trade mark sought ARTHUR ET FÉLICIE, the difference linked to the addition of the words 'et' and 'Félicie' at the end of the trade mark sought is not sufficiently large to counter the similarity created by the coincidence of the dominant element of the trade mark applied for, namely the word 'Arthur'. Moreover, since registration of the trade mark ARTHUR ET FÉLICIE was sought as a word mark, nothing

⁶ *Les Editions Albert Rene v OHIM, Case T-336/03*

⁷ *Castellani SpA v OHIM, T-149/06 ans Spa Monopole, Campagne Fermiere de Spa SA/NV v OHIM, T-438/07*

⁸ *Sadas SA v OHIM, T-346/04*

prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar.”

42. The CFI also applied *Sadas* in similar circumstances in *Peek & Cloppenburg v OHIM*⁹, where the earlier mark was the plain word mark. It stated,

“27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. ... since the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for.”

43. Accordingly, in this case, normal and fair use of the applicant’s mark would include use of the mark in normal scripts, including normal cursive scripts which would reduce the apparent visual difference between the marks when the applicant’s mark is considered in block capitals. Taking all of these factors into account, considering the presentation of the earlier mark as a whole, overall, I find the degree of visual similarity to be medium.

Aural similarities

44. The applicant submits:

“4. The Opponent has suggested that the Opponent’s mark EVAPE and the marks of the present application (e-Vap and eVap) are phonetically similar. This is not realistic. The English language clearly distinguishes between the sound of the letter ‘a’ in these two different contexts (i.e. followed by p or followed by pe), for example: bap, cap, chap, clap, flap, gap, lap, map, nap, pap, rap, sap, slap, strap, tap, trap all have the same vowel sound; and ape, cape, drape, gape, grape, jape, nape, rape, shape, tape all have the same vowel sound; and there is no difficulty in distinguishing between pairs of words such as:

<i>cap</i>	<i>cape</i>
<i>gap</i>	<i>gape</i>
<i>nap</i>	<i>nape</i>
<i>rap</i>	<i>rape</i>
<i>tap</i>	<i>tape</i>

It is therefore clear that the marks are phonetically different.”

45. The opponent submits:

“21. The Applicant is wrong in its assessment of the phonetic references to the opposed trade mark and the opponent’s earlier trade mark. The only phonetic terms to be considered are EVAPE v. EVAP/E-VAP. The Applicant’s reference to words that change meaning by the addition of the letter E to the end of the stem is unhelpful and irrelevant to the phonetic

⁹ T-386/07

assessment between the opposed mark and the Opponent's earlier trade mark."

46. Both versions of the applicant's mark will be pronounced 'EE'-'VAP' (to rhyme with TAP). In the first mark of the series the hyphen provides a natural break between the 'e' and the three letters 'Vap'. In the second mark of the series a natural break occurs in the word due to the 'e' in lower case, which starts the mark and the following letters 'Vap', which begin with a capital letter V.

47. The opponent's mark will be pronounced EE-VAPE (to rhyme with TAPE). Both marks are fairly short and begin with the same EE sound, which in both cases is followed by a V. They are both two syllables long. The aural difference between the marks rests in the longer 'APE' ending of the opponent's mark and the shorter 'AP' ending of the applicant's mark.

48. Taking these factors into account, I find that overall there is a medium degree of aural similarity between these marks.

Conceptual similarities

49. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁰ The assessment must be made from the point of view of the average consumer.

50. In respect of the conceptual comparison the opponent submits:

"16. The terms VAP and VAPE are obvious references to the term VAPOUR which is a characteristic of electronic smokers' articles, the exact goods covered by the Opposed application and the Opponent's earlier mark. The prefix E, as the Applicant has already pointed out, is an abbreviation for "electronic". Subsequently, when consumers make reference to the trade mark aurally the same idea left on the consumer's mind is the same.

...

22. The addition of the letter E to the words CAP, GAP, NAP, RAP and TAP creates an entirely different word with a completely different meaning. However, in this case, the additional letter E does not create a new word nor change the conceptual similarity between the trade marks."

51. The applicant submits:

"5...Thus not only are the syllables Vap and Vape orally and visually different, they are conceptually different: the syllable Vape is the verb used by users of electronic cigarettes to describe their use of an electronic cigarette. In the context of class 34, the term Vape is therefore a descriptive term. In contrast the syllable Vap is meaningless."

¹⁰ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

52. The evidence filed by the applicant shows that in the context of the goods, electronic cigarettes, the words 'vape' and 'vaping' are used to describe the act of using an electronic cigarette. It is also clear that these terms are a direct reference to the vapour which characterises an electronic cigarette in contrast to the smoke associated with a tobacco cigarette. Accordingly, the opponent's mark will bring to mind the act of using an electronic cigarette. The applicant's mark also includes the letter e at the beginning, which both sides agree is a shortened form of the word electronic. In the context of the goods, the remaining letters 'Vap' will, in my view, evoke an impression of the vapour associated with electronic cigarettes or be seen as a shortened form of VAPE. In making a finding on this point I have considered the comments of the General Court in *Ontex NV v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 353/04 in relation to evocative effects when it said:

91. This evocative effect is independent of whether or not the word mark EURON designates a characteristic of the goods for which registration of the earlier mark was made, since that fact does not influence the ability of the relevant public to make an association between that word mark and the words 'euro' and 'Europe' (see, by way of analogy, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the same way, the evocative force of the earlier mark cannot be altered by the fact that it is supposedly 'made up'. Even a made-up word may carry conceptual weight."

53. Taking all of these factors into account there is a medium degree of conceptual similarity between the parties' marks.

Distinctive character of the earlier mark

54. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

55. The opponent's earlier mark is the stylised mark EVape, with clouds or puffs of smoke. No element being particularly distinctive. In line with my findings above at paragraphs 36-37, as a whole, the mark has a fairly low degree of inherent distinctive character.

Likelihood of confusion

56. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹¹ I must also keep in mind the average consumer for the goods, the

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

nature of the purchasing process and have regard to 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.

57. Earlier in this decision I concluded that the goods at issue are identical, that the competing trade marks are visually, aurally and conceptually similar to a medium degree, and that that the opponent's earlier trade mark is possessed of a fairly low degree of inherent distinctive character. In reaching a conclusion on the likelihood of confusion, I also note the following comments of the CJEU in *L'Oréal SA v OHIM – Case - C-235/05 P*:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

58. Notwithstanding that the opponent's earlier mark has a fairly low distinctive character, taking all of these factors into account, particularly the concept of imperfect recollection, in my view, the similarity of the marks is such that in the

context of identical goods, I find that there will be direct confusion (where one mark is mistaken for the other).

CONCLUSION

59. The opposition succeeds under section 5(2)(b) of the Act:

Costs

60. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Considering evidence and preparing submissions:	£400
Official fee:	£200
Total	£800

61. I order Syed Naseer to pay Ahmed El-Zalabany the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this day of March 2014

**Ms Al Skilton
For the Registrar,
The Comptroller General**