

**BL O/818/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3258084**

**BY**

**BLUESPUR LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 34:**

**MV MENTHOL MIST**

**AND**

**OPPOSITION THERETO (NO. 411270)**

**BY**

**STARBUZZ TOBACCO INC**

## **Background and pleadings**

1. Bluespur Limited (the applicant) applied to register the trade mark:

### **MV MENTHOL MIST**

in the UK on 20 September 2017. It was accepted and published in the Trade Marks Journal on 06 October 2017, in respect of the following goods:

**Class 34:** Cartomizers for electronic cigarettes; cartridges containing nicotine; cartridges for electronic cigarettes; cases and holders for electronic cigarettes; cases and pouches adapted for carrying electric and electronic cigarettes and accessories for electric and electronic cigarettes; cases for pipes, not of precious metal; chemical flavourings in liquid form used to refill electric and electronic cigarette cartridges; cigarette cases; cigarette cases made of precious metal; cigarettes containing tobacco substitutes; cigarettes; cigars, vaporizers, and inhalers containing nicotine for use as an alternative to traditional tobacco cigarettes; cigars; clearomizers for electronic cigarettes; coils for electronic cigarettes; components for electric and electronic cigarettes, namely, atomisers for tobacco substitutes, cartomisers for tobacco substitutes, clearomisers for tobacco substitutes; disposable or rechargeable electronic cigarettes; drip tips for use in relation to electronic cigarettes and vaporising devices for tobacco substitutes; electric and electronic cigarette refill cartridges sold empty; electric and electronic cigarettes containing tobacco substitutes; electric and electronic cigarettes; electric coils for electric and electronic cigarettes and electronic smoking devices; electronic cigarette atomizers; electronic cigarette boxes; electronic cigarette cartomizers; electronic cigarette cartridges; electronic cigarette cases; electronic cigarette lighters; electronic cigarette liquids; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic cigars, electronic pipes; electronic hookahs; electronic nicotine inhalation devices; electronic smoking pipes; flavourings for electronic smoking devices and electronic cigarettes; flavour essences for electronic smoking devices and electronic cigarettes; flavourings for electronic cigarettes; flavourings, other than essential oils, for use in

electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; liquids for electric and electronic cigarettes; liquids for electronic cigarettes; matches and smokers' articles; mouth pieces for electric and electronic cigarettes; mouth pieces for vaporizers; oral vaporizers for smokers; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; pouches for carrying electric and electronic cigarettes; refill cartridges and solutions for electronic cigarettes; smokeless cigarette vaporizer pipes; smokers' articles; smokers articles for electric and electronic cigarettes; smokers' articles of precious metal; smokers' articles, not of precious metal; substitutes for tobacco and cigarettes; tanks for electronic cigarettes; tobacco free cigarettes, other than for medical purposes; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; tobacco, whether manufactured or unmanufactured; vaporising devices for tobacco substitutes; vaporising devices for tobacco, tobacco products and tobacco substitutes; vaporizers and inhalers (smoker's articles); parts and fittings for all the aforesaid goods.

2. Starbuzz Tobacco Inc (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is raised against all of the goods applied for. The opposition is based on an earlier European Trade Mark (EUTM), namely:

EUTM 12280418, filed on 05 November 2013 and registered on 19 March 2014, for the following mark:

**MIST**

3. The earlier mark is registered in class 34 for the following goods:

**Class 34:** Tobacco; Smokers' articles; Matches; Ashtrays for smokers; Cigar cases; Cigars; Cigarette cases; Cigarette filters; Cigarette tips; Cigarette paper; Books of cigarette papers; Cigarette holders; Cigarettes; Cigarettes containing tobacco substitutes, not for medical purposes; Pocket machines for rolling cigarettes; Cigarillos; Cigar cutters; Cigar holders; Electronic cigarettes; Gas

containers for cigar lighters; Humidors; Firestones; Lighters for smokers; Tips of yellow amber for cigar and cigarette holders; Mouthpieces for cigarette holders; Absorbent paper for tobacco pipes; Tobacco pipes; Pipe cleaners for tobacco pipes; Pipe racks for tobacco pipes; Chewing tobacco; Snuff; Snuff boxes; Spittoons for tobacco users; Match boxes; Match holders; Matches; Tobacco; Tobacco jars; Tobacco pouches; Herbs for smoking.

4. In its statement of grounds, the opponent claims:

- that the applied for mark contains the earlier mark MIST in its entirety.
- that the other elements in the later mark are devoid of any distinctive character and therefore the average consumer's attention will be drawn to the common word MIST.
- that the goods concerned are identical or highly similar, and that as a result of all of these facts, there is a likelihood of confusion between the marks.

5. In its counterstatement, the applicant claims:

- that whilst some of the goods at issue are identical or similar, many of the opponent's earlier goods are traditional smoking products and are therefore less similar to the applicant's goods.
- that the word MIST is highly descriptive of the vapour or mist inhaled or exhaled using the relevant goods, and is therefore low in distinctive character.
- that due to the nature of the goods at issue, the level of attention of the average consumer will be higher than average.
- that the application contains three words as opposed to the earlier mark which is comprised of the single word MIST.
- that the elements MV and MENTHOL are the dominant and distinctive elements in the later mark.
- that the goods at issue occupy very different and distinct markets and that there are very few 'crossover' brands between the vaping/e-cigarette market and the traditional tobacco smoking market.
- that the average consumer will perceive the words 'MENTHOL MIST' in combination as a description of menthol flavoured mist.

- that the word MIST has no independent distinctive role in the later mark applied for.
6. Both parties have provided written submissions and evidence which will not be summarised here, but will be referred to later in this decision if and where necessary.
  7. No hearing was requested and so this decision is taken following a careful perusal of the papers.
  8. Throughout the proceedings the opponent has been professionally represented by Bailey Walsh & Co LLP whilst the applicant has been professionally represented by Spearing Waite LLP.

## **Decision**

### **Section 5(2)(b) of the Act**

9. 5(2)(b) of the Act states:

“(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.”

10. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

11. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, Case T- 133/05, the General Court 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”.

14. The parties' respective specifications are:

Earlier mark	Application
<b>Class 34:</b> Tobacco; Smokers' articles; Matches; Ashtrays for smokers; Cigar cases; Cigars; Cigarette cases; Cigarette filters; Cigarette tips; Cigarette paper; Books of cigarette papers; Cigarette holders; Cigarettes; Cigarettes containing tobacco	<b>Class 34:</b> Cartomizers for electronic cigarettes; cartridges containing nicotine; cartridges for electronic cigarettes; cases and holders for electronic cigarettes; cases and pouches adapted for carrying electric and electronic cigarettes and accessories for electric and electronic cigarettes; cases for pipes, not of

<p>substitutes, not for medical purposes; Pocket machines for rolling cigarettes; Cigarillos; Cigar cutters; Cigar holders; Electronic cigarettes; Gas containers for cigar lighters; Humidors; Firestones; Lighters for smokers; Tips of yellow amber for cigar and cigarette holders; Mouthpieces for cigarette holders; Absorbent paper for tobacco pipes; Tobacco pipes; Pipe cleaners for tobacco pipes; Pipe racks for tobacco pipes; Chewing tobacco; Snuff; Snuff boxes; Spittoons for tobacco users; Match boxes; Match holders; Matches; Tobacco; Tobacco jars; Tobacco pouches; Herbs for smoking.</p> <p>.</p>	<p>precious metal; chemical flavourings in liquid form used to refill electric and electronic cigarette cartridges; cigarette cases; cigarette cases made of precious metal; cigarettes containing tobacco substitutes; cigarettes; cigars, vaporizers, and inhalers containing nicotine for use as an alternative to traditional tobacco cigarettes; cigars; clearomizers for electronic cigarettes; coils for electronic cigarettes; components for electric and electronic cigarettes, namely, atomisers for tobacco substitutes, cartomisers for tobacco substitutes, clearomisers for tobacco substitutes; disposable or rechargeable electronic cigarettes; drip tips for use in relation to electronic cigarettes and vaporising devices for tobacco substitutes; electric and electronic cigarette refill cartridges sold empty; electric and electronic cigarettes containing tobacco substitutes; electric and electronic cigarettes; electric coils for electric and electronic cigarettes and electronic smoking devices; electronic cigarette atomizers; electronic cigarette boxes; electronic cigarette cartomizers; electronic cigarette cartridges; electronic cigarette cases; electronic cigarette lighters; electronic cigarette liquids; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic cigars, electronic</p>
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	<p>pipes; electronic hookahs; electronic nicotine inhalation devices; electronic smoking pipes; flavourings for electronic smoking devices and electronic cigarettes; flavour essences for electronic smoking devices and electronic cigarettes; flavourings for electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; liquids for electric and electronic cigarettes; liquids for electronic cigarettes; matches and smokers' articles; mouth pieces for electric and electronic cigarettes; mouth pieces for vaporizers; oral vaporizers for smokers; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; pouches for carrying electric and electronic cigarettes; refill cartridges and solutions for electronic cigarettes; smokeless cigarette vaporizer pipes; smokers' articles; smokers articles for electric and electronic cigarettes; smokers' articles of precious metal; smokers' articles, not of precious metal; substitutes for tobacco and cigarettes; tanks for electronic cigarettes; tobacco free cigarettes, other than for medical purposes; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; tobacco, whether manufactured or unmanufactured;</p>
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	vaporising devices for tobacco substitutes; vaporising devices for tobacco, tobacco products and tobacco substitutes; vaporizers and inhalers (smoker's articles); parts and fittings for all the aforesaid goods.
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15. The applied for goods ‘*Cigarettes containing tobacco substitutes; cigarettes; cigars (listed twice); substitutes for tobacco and cigarettes; tobacco free cigarettes, other than for medical purposes; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; tobacco, whether manufactured or unmanufactured; parts and fittings for all the aforesaid goods*’ are all wholly contained within the earlier goods ‘*Tobacco (listed twice); Cigarettes; Cigarettes containing tobacco substitutes, not for medical purposes; Cigars; Cigarillos; Chewing tobacco; Snuff, Herbs for smoking*’ and are therefore identical.

16. The applied for goods ‘*Cases for pipes, not of precious metal; cigarette cases; cigarette cases made of precious metal; smokers' articles; smokers' articles of precious metal; smokers' articles, not of precious metal; vaporising devices for tobacco substitutes; vaporising devices for tobacco, tobacco products and tobacco substitutes; vaporizers and inhalers (smoker's articles); matches and smokers' articles; parts and fittings for all the aforesaid goods*’ are all wholly contained within the earlier goods ‘*Smokers' articles; Matches; Cigarette cases*’ and are therefore identical.

17. The Oxford English Dictionary<sup>1</sup> defines ‘*electronic cigarette*’ as:

“A cigarette-shaped device containing a nicotine-based liquid that is vaporized and inhaled, used to simulate the experience of smoking tobacco.”

18. The applied for goods ‘*Disposable or rechargeable electronic cigarettes; electric and electronic cigarettes containing tobacco substitutes; electric and electronic cigarettes;*

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<sup>1</sup> [https://en.oxforddictionaries.com/definition/electronic\\_cigarette](https://en.oxforddictionaries.com/definition/electronic_cigarette)

*electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic cigars*' are identical to the earlier goods '*Electronic cigarettes*'.

19. The applied for goods '*Electronic pipes; electronic hookahs; electronic nicotine inhalation devices; electronic smoking pipes*' are used to deliver nicotine to the user, by electronic means rather than via the traditional methods of smoking a cigarette or cigar. These goods share purpose, end-user, channels of trade and manufacturer with the earlier goods '*Electronic cigarettes*'. As such they are considered to be similar to a medium degree.

20. The applied for goods '*Cartomizers for electronic cigarettes; cartridges containing nicotine; cartridges for electronic cigarettes; cases and holders for electronic cigarettes; cases and pouches adapted for carrying electric and electronic cigarettes and accessories for electric and electronic cigarettes; chemical flavourings in liquid form used to refill electric and electronic cigarette cartridges; clearomizers for electronic cigarettes; coils for electronic cigarettes; components for electric and electronic cigarettes, namely, atomisers for tobacco substitutes, cartomisers for tobacco substitutes, clearomisers for tobacco substitutes; drip tips for use in relation to electronic cigarettes and vaporising devices for tobacco substitutes; electric and electronic cigarette refill cartridges sold empty; electric coils for electric and electronic cigarettes and electronic smoking devices; electronic cigarette atomizers; electronic cigarette boxes; electronic cigarette cartomizers; electronic cigarette cartridges; electronic cigarette cases; electronic cigarette lighters; electronic cigarette liquids; flavourings for electronic smoking devices and electronic cigarettes; flavour essences for electronic smoking devices and electronic cigarettes; flavourings for electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; liquids for electric and electronic cigarettes; liquids for electronic cigarettes; mouth pieces for electric and electronic cigarettes; mouth pieces for vaporizers; oral vaporizers for smokers; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; pouches for carrying electric and electronic cigarettes; refill cartridges and solutions for electronic cigarettes; smokeless cigarette vaporizer pipes; smokers articles for electric and electronic cigarettes; tanks for electronic cigarettes; Vaporizers, and inhalers containing nicotine for use as an alternative to traditional tobacco cigarettes; parts and*

*fittings for all the aforesaid goods'* are all goods used together or in combination with electronic cigarettes. As such they share end-user, manufacturer, channels of trade and distribution and are also complementary to the electronic cigarettes themselves. These goods are considered similar to a medium degree.

21. In conclusion, all of the applied for goods have been found to be either identical, or similar to a medium degree, with the earlier goods of the opponent.

### **Average consumer and the purchasing act**

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

23. 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.”

24. The relevant public of the goods at issue is the nicotine consuming section of the general public. The applicant has claimed that brand loyalty will play a part in the purchasing process of the goods, which would result in a careful approach being taken.

25. The issue of brand loyalty has been considered by Mr Iain Purvis QC, sitting as the appointed person, in *BONJORNO CAFÉ (AND DEVICE)*, BL O-382-10, where he found:

“15. I do not accept that a generalized concept of “brand loyalty” is of any real assistance in assessing likelihood of confusion. First of all it is very hard, in my view, to identify particular categories of product or service as inspiring more brand loyalty than others. Secondly, even if were established that there was a high degree of brand loyalty in a particular field, I do not see how this would advance matters. We are concerned with the likelihood of confusion, not the degree of disappointment which would be caused by an incident of confusion. Questions of likelihood of confusion are always to be approached from the point of view of the “reasonably observant and circumspect” consumer. I do not understand how brand loyalty can be said to affect the consumer’s observation skills or his circumspection. Thirdly, it is rather odd to assume that the concept of “brand loyalty” associated with a general class of products or service tends to reduce the likelihood of confusion, when we are also told by the European Court [*Sabel v Puma* [1998] RPC 199 at 22-24] to assume that a high reputation associated with a specific brand of products or services tends to increase the likelihood of confusion.”

26. I come to the view that Mr Purvis’ decision reflects my own understanding that whilst brand loyalty exists in many fields, including that of cigarettes, this does not automatically equate to a high level of care and consideration being adopted. Cigarettes, whilst heavily taxed, are not particularly expensive. They are purchased by smokers frequently. Whilst I do not hold that the purchasing process is a casual one, there is no reason for me to assume that the average consumer is anything other than reasonably observant and circumspect and will adopt an average level of care and consideration. However, in respect of the electronic cigarettes and related ‘e’ products at issue, I believe that the level of attention paid by that consumer will be higher than normal, due to the relatively expensive cost of those products. Consumers of such goods will be careful in selecting a product that fits their specific requirements.

27. In this respect I refer to *Nico ventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) (para 11) where Birss J found:

“the decision deals with the average consumer, concluding that the average consumer will be a member of the public over 18 years of age and, having regard to the prices for the relevant goods (ranging from about £40 to about £200), the average consumer will pay a reasonably high degree of attention to the selection of the goods and a reasonable level of attention relating to services. Rightly, neither party criticises that finding.”

28. I am aware that in the UK there are controls on the way in which traditional tobacco products such as cigarettes may be displayed and purchased. They are generally hidden from view behind a counter, normally in a cupboard or other unit, with some form of sliding door, shutter or curtain. The consequence of this is that the consumer must request cigarettes from the sales assistant. I therefore accept that the aural impact of the marks is of importance here, more so than would be the case with other general consumer items, where self-selection is normally the key. However, the visual impact of the marks should not be ignored completely. This is because once the consumer has requested a particular product, he/she is likely to have sight of the packaging at the point of sale, when they have been retrieved by the sales assistant.

29. The selection of the goods at issue will largely be via high street outlets and other traditional retail establishments. As referred to above, the selection process will generally be a visual one, however, in respect at least of tobacco cigarettes and cigars, with the move to plain packaging, these goods will be largely be selected aurally. In respect, however, of the electronic products and general smoking articles such as pipes, matches and cigar cases, the selection process remains primarily visual in nature.

### **Comparison of marks**

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual

similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

31. 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.

32. The respective trade marks are shown below:

<b>Earlier mark</b>	<b>Contested trade mark</b>
<b>MIST</b>	<b>MV MENTHOL MIST</b>

33. The opponent's mark is comprised of the single plain word 'MIST' with no stylisation or embellishment. The overall impression of the mark lies in the word alone.

34. The applicant's mark is also a plain word mark, consisting of the elements 'MV 'MENTHOL MIST'. Whilst it may be the shortest element in the mark, the letters 'MV' are presented at the beginning of it and will therefore be perceived first. The longest element in the mark 'MENTHOL' will likely be considered as a descriptive term within the whole and therefore carries less weight than the other elements, however in combination with the final element 'MIST' may be perceived as a unitary phrase. As

such, the overall impression in the later mark is of the letters 'MV' combined with the unitary phrase 'MENTHOL MIST'.

### **Visual similarity**

35. Visually, the respective marks are similar inasmuch as they share the word 'MIST'. They differ visually in the letters 'MV' and the word 'MENTHOL' of the later mark which have no counterparts in the earlier mark. The marks are considered to be visually similar to a low degree.

### **Aural similarity**

36. Aurally, the earlier mark is comprised of the single verbal element /MYST/. The later mark also contains the element /MYST/. The marks differ in the elements /EM/VEE/ and /MEN/THOL/ that are present in the later mark. As the common verbal element is the final element of the later mark and is preceded by the sounds /EM/VEE/ and /MEN/THOL/, the marks are considered to be aurally similar to a low degree.

### **Conceptual similarity**

37. The earlier mark is comprised solely of the word 'MIST', which is defined as '*a condensed vapour settling in fine droplets on a surface*'<sup>2</sup>. The later mark also contains the word 'MIST' and therefore both marks share the concept of condensed vapour.

38. The marks differ conceptually in respect of the letters 'MV' which have no obvious meaning, and the word 'MENTHOL' which is '*a crystalline compound with a cooling minty taste and odour, found in peppermint and other natural oils. It is used as a flavouring and in decongestants and analgesics*'<sup>3</sup>. Where the relevant consumer

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<sup>2</sup> <https://en.oxforddictionaries.com/definition/mist>

<sup>3</sup> <https://en.oxforddictionaries.com/definition/menthol>

perceives the words 'MENTHOL MIST' in combination as a descriptor of the flavour of the product, the concept of 'MIST' within the later mark will be that of a menthol flavoured mist.

39. The marks are found to be conceptually similar to a medium degree.

40. In conclusion, the marks are found to be visually and aurally similar to a low degree, and conceptually similar to a medium degree.

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

41. 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-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. The opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character. I must therefore assess the mark purely on its inherent distinctive character. I note that in its final written submissions, dated 07 November 2018, the opponent states that “*the marks in suit both benefit from an average or medium degree of distinctiveness*”.

43. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

44. In this instance, the common element ‘MIST’ will be understood to refer to a condensed vapour settling in fine droplets. As such it is inherently distinctive to a normal degree when considered in respect of cigarettes, cigars, cigarillos and other traditional methods of inhaling nicotine.

45. When considered in the context of electronic media such as e-cigarettes, designed to allow the user to inhale nicotine, ultimately resulting, through exhalation, in the creation of mist or vapour, the term ‘MIST’ will be perceived as allusive and is inherently distinctive to a lower than normal degree.

## **Likelihood of Confusion**

46. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
47. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).
48. The marks have been found to be visually and aurally similar to a low degree, and conceptually similar to a medium degree.
49. As was found earlier in this decision, the level of awareness and attention paid during the selection process will be higher than normal in respect of the electronic cigarettes and related 'e' products, due to the relatively high cost of those goods. In respect of the traditional tobacco products such as cigars and cigarettes, and in respect of smokers' articles such as cigarette papers, matches and ashtrays however, the level of attention paid during the selection process will be average.
50. During the selection process of the electronic goods and some of the more traditional smoking items, the visual impact of the marks will carry the most weight in the mind of the average consumer, however the aural impact cannot be dismissed, particularly in respect of traditional tobacco cigarettes, which by law now have to be packaged plainly, without any branding or logo on display.
51. Taking all of the aforesaid into account, I find that the visual and aural differences between the marks are such that the average consumer will distinguish between them

readily. Consequently, I am satisfied that direct confusion will not occur i.e. the relevant public will not mistake the earlier mark for the later one, or vice-versa.

52. Having found that direct confusion will not occur when the average consumer is faced with one of the marks to hand, having previously encountered the other, I now go on to consider whether the average consumer, would consider the common elements in the marks and determine, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking, thereby indirectly confusing the marks.

53. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

54. These examples are not exhaustive, but provide helpful focus.

55. Both parties submitted evidence and written submissions. I find it useful at this point, to refer to some of the more pertinent aspects that I have taken from both sides.

56. The applicant pointed out in its evidence, that it has already registered the plain word mark ‘MV’ for the same goods as those at issue in this matter, at the UK IPO (UK 3246194) and stated that this mark was accepted prima facie, with no objections or opposition raised against it. As such, the applicant states that the element ‘MV’ in the mark to hand, must be considered as a distinctive element within the applied for mark here.

57. The applicant also showed in the evidence, that the combination ‘MENTHOL MIST’ is used in the relevant trade by several undertakings other than the applicant, to describe menthol flavoured electronic cigarette liquid, and that this trade is based in the UK, with prices of goods displayed in pounds sterling<sup>4</sup>.

58. The applicant referred to *L’Oreal S.a. v OHIM, C-235/05*) where it was found that consumers pay most attention to the beginning of marks. As such, the applicant claims that the element ‘MV’ in the later mark must be considered the most dominant and distinctive part of that mark.

59. The applicant provided evidence showing that their ‘MV’ range of e-cigarette and vaping goods was the 6<sup>th</sup> highest selling UK brand in 2015, with £11 million in sales from 1.4 million units sold<sup>5</sup>.

60. The opponent claimed that the goods concerned, both the traditional and electronic versions, are closely linked, share end-user and can be found through the same

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<sup>4</sup> Witness statement of Christian Mulcahy, pages 44-66 of Exhibit CM1

<sup>5</sup> Witness statement of Christian Mulcahy, page 39 of Exhibit CM1 – The Grocer Magazine

channels of trade. The applicant disputes this and claims the opposite, stating that in fact a user of e.g. electronic cigarettes, will not be a consumer of traditional smoking products. The applicant suggests that the consumer of e.g. electronic cigarettes, will be a person who may have previously been a consumer of traditional tobacco products, but who is now trying to give up that habit, or will be a consumer who has never used traditional tobacco products but is attracted to the electronic versions for a variety of reasons. The applicant also claims that the channels of trade of the goods will be quite different.

61. The opponent has provided evidence of decisions taken by the European Union Intellectual Property Office (EUIPO), in which the opponent, relying on their 'MIST' EUTM, challenged the marks 'MOST', 'LONDON MIST' and 'ORIENTAL MIST'. In each decision the earlier mark 'MIST' was found to be distinctive to at least a normal degree.

62. I have taken careful note of all of the written submissions and evidence provided by both parties.

63. The word 'MIST' has been found to have a normal degree of inherent distinctiveness for some of the goods at issue and a lower than average degree when considered in the context of electronic goods that produce a mist when used.

64. The words 'MENTHOL MIST' have been shown to be used as a unitary phrase by several UK undertakings, and as such, it seems likely that the relevant public will consider that these words have a meaning as a unit, forming a single descriptive message regarding the flavour of the mist produced when using the goods at issue.

65. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an

earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

66. In my view, the average consumer will likely perceive the applied for mark as an ‘MV’ mark, under which the consumer can expect menthol flavoured mist or vapour to be produced when using those goods. The channels of trade will generally be different between the traditional tobacco products and the electronic products, however, as has been established previously, both parties provide both kinds of goods under their

respective marks. It has also been found that the average consumer will pay a higher than average level of attention during the purchase of the electronic goods at issue.

67. The same cannot be said to be the case when considering the word 'MIST' in the context of traditional cigarettes, cigars and other tobacco products. For those goods, the consumer, generally referred to as a 'smoker', will exhale smoke from the lungs during the consumption of those goods. For those goods the word 'MIST' is distinctive.

68. Taking all of this into consideration, I conclude that the marks at issue will be indirectly confused by the average consumer when considering the traditional smoking products and associated or ancillary goods at issue, where the word 'MIST' will be found to be distinctive. I find, however that the marks will not be indirectly confused by the average consumer when considered in the context of the electronic goods at issue, which are known for producing a mist or vapour, and for which the average consumer would give no trade origin significance to the word 'MIST'.

69. In that regard the word 'MIST' cannot be said to be so strikingly distinctive that the average consumer would assume that no other undertaking would wish to use it, even with additional distinctive matter. The letters 'MV' in the later mark are clearly an independently distinctive element in that mark and are therefore unlikely to be perceived by the average consumer, having regard for the electronic goods, as part of a logical brand extension of the 'MIST' range. Finally, it is unlikely that the relevant public will, when faced with the later mark applied to the electronic products, assume that that mark is a logical evolution of the earlier mark 'MIST'.

### **Conclusion**

70. The opposition partially succeeds. The application is refused for the following goods:

*Class 34: Cigarettes containing tobacco substitutes; cigarettes; substitutes for tobacco and cigarettes; tobacco free cigarettes, other than for medical purposes; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; tobacco, whether manufactured or unmanufactured; Cases for pipes, not of precious metal; cigarette cases; cigarette cases made of*

*precious metal; smokers' articles; smokers' articles of precious metal; smokers' articles, not of precious metal; vaporising devices for tobacco substitutes; vaporising devices for tobacco, tobacco products and tobacco substitutes; vaporizers and inhalers (smoker's articles); matches and smokers' articles; parts and fittings for all the aforesaid goods.*

71. Subject to appeal, the application may proceed to registration for the following goods:

*Class 34: Disposable or rechargeable electronic cigarettes; electric and electronic cigarettes containing tobacco substitutes; electric and electronic cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic cigars; Electronic pipes; electronic hookahs; electronic nicotine inhalation devices; electronic smoking pipes; Cartomizers for electronic cigarettes; cartridges containing nicotine; cartridges for electronic cigarettes; cases and holders for electronic cigarettes; cases and pouches adapted for carrying electric and electronic cigarettes and accessories for electric and electronic cigarettes; chemical flavourings in liquid form used to refill electric and electronic cigarette cartridges; clearomizers for electronic cigarettes; coils for electronic cigarettes; components for electric and electronic cigarettes, namely, atomisers for tobacco substitutes, cartomisers for tobacco substitutes, clearomisers for tobacco substitutes; drip tips for use in relation to electronic cigarettes and vaporising devices for tobacco substitutes; electric and electronic cigarette refill cartridges sold empty; electric coils for electric and electronic cigarettes and electronic smoking devices; electronic cigarette atomizers; electronic cigarette boxes; electronic cigarette cartomizers; electronic cigarette cartridges; electronic cigarette cases; electronic cigarette lighters; electronic cigarette liquids; flavourings for electronic smoking devices and electronic cigarettes; flavour essences for electronic smoking devices and electronic cigarettes; flavourings for electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; liquids for electric and electronic cigarettes; liquids for electronic cigarettes; mouth pieces for electric and electronic cigarettes; mouth pieces for vaporizers; oral vaporizers for smokers; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; pouches for*

*carrying electric and electronic cigarettes; refill cartridges and solutions for electronic cigarettes; smokeless cigarette vaporizer pipes; smokers articles for electric and electronic cigarettes; tanks for electronic cigarettes; Vaporizers, and inhalers containing nicotine for use as an alternative to traditional tobacco cigarettes; parts and fittings for all the aforesaid goods*

### **Costs**

72. The applicant has been, proportionately, slightly more successful than the opponent and is therefore entitled to a contribution towards its costs, reduced to reflect the partial nature of its success.

73. I bear in mind that the relevant scale is contained in Tribunal Practice Notice ("TPN") 2/2016. I award costs to the applicant as follows:

Considering the statement of case and preparing the counterstatement	£50
Preparing evidence and considering the evidence of the applicant	£100
Preparing submissions	£50
<u>Total</u>	<u>£200</u>

74. I therefore order Starbuzz Tobacco Inc to pay Bluespur Limited the sum of £200. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 20<sup>th</sup> day of December 2018**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**