O-0046-25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO. UK00003821866
IN THE NAME OF YANG JIANG
FOR THE FOLLOWING TRADE MARK:

IN CLASSES 9, 34, 35 AND 45
AND
IN THE MATTER OF INVALIDATION APPLICATION
BY TROMPENBURG HOLDINGS B.V.
UNDER NO. 506264

AND

IN THE MATTER OF REGISTRATION NO. UK00003594839
IN THE NAME OF TROMPENBURG HOLDINGS B.V.
FOR THE FOLLOWING TRADE MARK:

VIBES

IN CLASSES 9 AND 34
AND
IN THE MATTER OF INVALIDATION APPLICATION
BY YANG JIANG UNDER NO. 506504

BACKGROUND AND PLEADINGS

1. This decision is in respect of consolidated proceedings between Trompenburg Holdings B.V. ("THBV") and Yang Jiang ("Mr Jiang") wherein each party has brought proceedings against the other.

2. I will begin by summarising the nature of those proceedings in turn.

THBV's application for invalidity

3. On 05 July 2023, THBV applied to have a trade mark registered in the name of Mr Jiang declared invalid.

4. The relevant details of Mr Jiang's trade mark are shown below:

UK00003821866

Filing date: 19 August 2022

Registration date: 18 November 2022

Class 9: *Batteries for electronic cigarettes, cables for charging electronic cigarettes; USB cables for connecting electronic cigarettes to electronic devices; cables for connecting electronic cigarettes to mains electricity; adapters for charging electronic cigarettes; portable charging cases for electronic cigarettes and vaporisers; parts and fittings for the aforesaid goods.*

Class 34: *Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; smokers' articles; liquids for use in personal vaporisers and*

electronic cigarettes; cigarette cases and holders; parts and fittings for all the aforesaid goods.

Class 35: *Advertising, marketing and sales promotions; online ordering services; retail services and wholesale services connected with the sale of personal vaporisers and electronic cigarettes, and flavourings and solutions therefor, smokers' articles, liquid solutions for use in personal vaporisers and electronic cigarettes, cigarette cases and holders, batteries for electronic cigarettes, cables for charging electronic cigarettes, USB cables for connecting electronic cigarettes to electronic devices, cables for connecting electronic cigarettes to mains electricity, adapters for charging electronic cigarettes, portable charging cases for electronic cigarettes and vaporisers, parts and fittings for all the aforesaid goods; business consultancy; business management; business assistance; business risk management services; business introductory services; business and commercial information; business management, assistance and advice relating to franchising; consultancy, information and advisory services relating to all the aforesaid services.*

Class 45: *Licensing of franchise concepts; licensing; legal services; consultancy, information and advisory services relating to all the aforesaid services.*

5. In its applications for invalidation, THBV relies upon grounds based upon Section 47(2)(a) and Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") with the application being directed at some of the registered goods and services, namely those underlined in the table above. THBV relies upon one single earlier mark and all the goods and services covered by it, the details of which are:

UK00003594839

VIBES

Although the mark was filed in the UK on 12 February 2021, the application was made pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU, and the EU filing date was 29 October 2020

Registration date: 08 October 2021

Class 9: *Batteries; batteries for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; battery chargers; battery chargers for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; docking stations; docking stations for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; power cables; power cables for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers.*

Class 34: *Tobacco products; cigarettes; cigars; rolling tobacco; pipe tobacco; electronic smoking devices, personal vaporisers, tobacco heating devices and electronic cigarettes, and flavourings and solutions therefor; ampoules, cartridges and refill cartridges for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; liquid solutions for use in electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; holders for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; and parts and fittings of all the aforesaid goods, included in the class.*

6. By virtue of having a filing date that is earlier than the filing date of Mr Jiang's contested mark, THBV's mark is an "earlier trade mark" as defined in Section 6 of the Act.

7. THBV asserts that the respective marks are similar, with the dominant element 'VIBES' in its earlier mark being wholly contained within Mr Jiang's mark. It also asserts that the respective goods and services are identical or similar. On this basis, it asserts that there is a likelihood of confusion and that the contested mark should be declared invalid under Sections 47(2)(a) and 5(2)(b) of the Act.

8. Mr Jiang filed a counterstatement acknowledging that some of the goods at issue might be regarded as similar, but otherwise denying THBV's claims. Further, he submitted that the Registry did not cite THBV's mark as a potential relative ground during the examination process and argued that this would suggest that the Registry did not consider the marks to be similar. In addition, in response to THBV's application

against his trade mark registration, Mr Jiang attacked THBV's earlier mark by filing an application for a declaration of invalidity, to which I now turn.

Mr Jiang's application for invalidity

9. On 11 September 2023, Mr Jiang applied to have THBV's earlier mark declared invalid under Section 47 of the Act. The application is reliant on Sections 3(1)(b), 3(1)(c), 3(3)(a) and 3(3)(b) of the Act and is targeted at the entirety of the goods in THBV's earlier mark's specification.

10. In respect of Mr Jiang's reliance upon Sections 3(1)(b) and (c), he claims that the word 'VIBES' lacks distinctiveness for the registered goods in classes 9 and 34, that the definition of 'VIBES' is *"the mood of a place, situation, person, etc. and the way that they make you feel"* and that the relevant public would simply perceive the sign 'VIBES' as providing the purely laudatory message that the goods will provide a mood, or atmosphere, or feeling of an uplifting experience. In support of the claim that the mark is devoid of distinctiveness, Mr Jiang also relies on the existence on the Registry of other trade marks covering the same or similar classes which incorporate the word 'VIBE' or 'VIBES', including Good Vibes (UK00003405862), Fatty Vibes (WO0000001722764), Cool Vibes (WO0000001641980), Fresh Vibes (UK00801028700) and Island Vibes (UK00003323977).

11. In respect of Mr Jiang's reliance upon Section 3(3)(a), he states that the word 'VIBES' for tobacco products is contrary to public policy and, in particular to the Tobacco and Related Products Regulations, because it has positive connotations and is likely to increase the appeal of tobacco products to young people and encourage the consumption of tobacco. He states:

> *"The word VIBES for tobacco products should not have been allowed registration because is contrary to public policy. The word VIBES is heavily used and liked by the younger generation to denote an excellent experience. When the word is used with tobacco and related products, it is likely that the brand per se will increase the appeal of tobacco products amongst young people, which is effectively against the Tobacco and Related Products*

Regulations ("TRPR") main objective which is reducing youth uptake of smoking and encouraging and supporting quitting amongst smokers.

According to for example The Newest Teen Slang Trends of 2023 - Family Education or Cracking the Code on Gen Z Slang: Slaps, Vibes, Bet, and Other Terms Your Kids Are Saying (ourcommunitynow.com) (the relevant evidence will be submitted during the evidential stage of these proceedings) the word VIBES is part of the current teenager slang and is defined:

Vibe/Vibes

The vibe describes the overall mood of the situation; the "aura."

Vibe Check
The vibe is the general mood, atmosphere or aesthetic of a person or situation. A "vibe check" is generally used as a way to survey the overall aura of a person or group. The phrase "passing the vibe check" is a compliment to someone who seems like a good or chill person.

For example, the provisions of TRPR to ban characterising flavourings for cigarettes and roll your own tobacco or to forbid indications that the products have vitalising, energising, healing or rejuvenating, natural or organic properties was expected to reduce their palatability to minors. A trademark such as VIBES for tobacco and related products defeats the main objections of the TRPR and therefore, should not have been allowed registration.

The word VIBES is clearly an encouragement to use tobacco products because it is a positive statement for the smoking experience and therefore, glorifies smoking amongst the younger generation. Such trademark is contrary to public policy on tobacco use and the reduction of smoking on the younger generation in particular.

The Invalidity Applicant argues that there will be a large section of the public for which the word VIBES will convey a clear message relating to the

encouragement of smoking. The registration of the Registrant's mark, therefore, undermines principles of accepted social values and in particular the discouragement of smoking. Further, the use of the word VIBES in the Registrant's mark goes beyond the suggestion of recreational use but to a social use of tobacco products as a positive and uplifting experience to give you a VIBE. Therefore, the Registrant's mark is contrary to public policy."

12. In respect of Mr Jiang's reliance upon Section 3(3)(b), he states that the word 'VIBES' for tobacco products is deceptive because it gives a misleading statement about the benefits of tobacco products conveying the false message that they have energising or vitalising elements which according to the TRPR is forbidden. He states:

"The sign VIBES would clearly be deceptive when used in connection with tobacco products or related products in classes 9 and 34 as covered by the Registration, as it conveys clear information indicating that the goods in classes 9 and 34 are of such a nature that have energising or vitalising elements, whereas those goods cannot in reality have these characteristics. Therefore, there is a sufficiently serious risk that the relevant public, in particular the youth consumers for which the word VIBES is a constant in their vocabulary, would be deceived as regards the kind of the goods covered by the Registration. Hence, the sign is deceptive within the meaning of Section 3(3)(b).

The word VIBES for tobacco products gives a misleading statement about the benefits of tobacco products which according to the TRPR is forbidden as per the Tobacco Regulations (the supporting Regulation will be provided during the evidential stage of these proceedings)."

13. THBV filed a counterstatement wherein it denied the claims against it.

14. Upon the filing of THBV's counterstatement in response to Mr Jiang's invalidity application, the proceedings were consolidated in accordance with Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties by way of correspondence from the Tribunal dated 29 November 2023.

15. Mr Jiang is represented by Trademark Eagle Limited. THBV is represented by Sellars Legal Limited. Only Mr Jiang filed evidence. No hearing was requested and neither party filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

THE EVIDENCE

17. Mr Jiang's evidence consists of two witness statements, one from Rosario Valdez-Knight and another from Mr Jiang's himself, both dated 1 March 2024.

18. Mr Valdez-Knight is a solicitor employed by Mr Jiang's representatives in these proceedings. His evidence contains no narrative, and it is merely a vehicle for introducing a range of materials, including documents aimed at showing state of the register evidence, use of the word 'VIBE' by third parties, dictionary definitions of the word 'VIBE' and extracts from The Standard Packaging of Tobacco Products Regulation 2015, The Tobacco and Related Products Regulation 2016 and The Children and Families Act 2014 (RVK01-11).

19. Mr Jiang's evidence goes to the use of his mark.

MY APPROACH

20. The invalidation action brought by Mr Jiang against THBV's earlier mark impacts upon the invalidity action brough by THBV against Mr Jiang's mark. This is because the mark for which invalidation is sought by Mr Jiang is relied upon by THBV in its invalidity action against Mr Jiang's registration. Since the success of Mr Jiang's

invalidation application will result in THBV's invalidity application falling away, I will begin my decision with Mr Jiang's invalidity application.

DECISION

MR JIANG'S APPLICATION FOR INVALIDITY

21. Section 3 of the Act has application in invalidation proceedings pursuant to Section 47 of the Act, which reads as follows:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
>
> […]
>
> (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.
>
> […]
>
> (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.
>
> Provided that this shall not affect transactions past and closed."

Section 3(1) case-law and legislation

22. Section 3(1) states:

> "3. Absolute grounds for refusal of registration.
>
> (1) The following shall not be registered—
>
> (a) […]
>
> (b) trade marks which are devoid of any distinctive character,
>
> (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
>
> (d) […]
>
> Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

23. The relevant date for determining whether THBV's registration is objectionable under Sections 3(1)(b) and 3(1)(c) is its filing date, being 29 October 2020.

24. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of Section 3(1)(c) but still be objectionable under Section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM,* Case C-329/02 P at [25]. Mr Jiang claims that the mark is devoid of distinctive character because *"the relevant public would simply perceive the sign VIBES as providing the purely laudatory information that the goods will provide a mood or*

atmosphere or feeling of an uplifting experience". For the same reasons, Mr Jiang also alleges that the mark is descriptive. He states:

> *"The relevant public will not tend to see in the sign any indication of commercial origin, but merely laudatory information that serves to highlight positive aspects of the goods and the way it will make consumers feel. Therefore, the sign in question is devoid of any distinctive character within the meaning of Section 3(1)(b) and descriptive within the meaning of Section 3(1)(c) and it should not have been allowed registration."*

25. The claims that the mark is devoid of distinctive character under Section 3(1)(b) and descriptive under Section 3(1)(c) are based on the same allegation, namely that the sign 'VIBES' will be understood as providing the *"purely laudatory information*" that the goods will provide a mood or atmosphere or feeling of an uplifting experience. The word *"laudatory"* is normally used in the context of trade mark objections to denote trade marks that praise or acclaim the quality, characteristics, or superiority of the goods or services. Whilst Mr Jiang uses the word "*laudatory"* rather than "*descriptive*", I take "*laudatory*" to mean "*descriptive*", at least in the context of the Section 3(1)(c) ground of invalidity, otherwise that ground would have no substance.

26. Nevertheless, I bear in mind that a trade mark can be devoid of distinctive character without being directly descriptive of the goods and services or their characteristics, when due to its "*laudatory connotation*", the public perceives the mark as a purely promotional formula rather than as an indication of the commercial origin of the goods or services concerned. Consequently, I will also consider whether THBV's mark is devoid of distinctive character without being wholly descriptive under Section 3(1)(b).

27. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.[1]

[1] *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04

28. The goods subject to the invalidation application are class 9 and 34 goods all relating to tobacco products, personal vaporisers and electronic cigarettes and include flavourings and solutions for vaping, and parts and fittings for electronic smoking devices. The average consumer for such goods are members of the general public at large, but given that the goods at issue are subject to an age limit, the average consumer will be limited to members of the general public over the age of 18. The goods at issue will generally be sold through a range of retail shops and their online equivalents. In shops, the goods will normally be stored behind a counter and to purchase the goods, the average consumer is likely to request them from a shop assistant. For these purchases, the aural component will, of course play a role. However, once the request has been made, the average consumer will still have sight of the packaging at the point of purchase, and so visual considerations cannot be discounted. A similar process will apply to online retailers, where the consumer will select the goods having viewed an image displayed on a webpage. For the most part, I consider that the purchasing process will be primarily visual with the aural component playing a part. The goods are not particularly expensive and will be selected at a reasonably frequent rate. The consumer is likely to consider, *inter alia,* factors such compatibility (for batteries and electronic goods that are meant to be used in conjunction with electronic smoking devices), nicotine content and flavour. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods at issue.

Section 3(1)(c)

29. Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign

could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland,* paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods

or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

30. Mr Jiang claims that the relevant public will not attribute any trade mark significance to the word 'VIBES' and will not see it as an indication of commercial origin. Rather, they will perceive it as having the meaning of *"mood"* or *"atmosphere"* or *"feeling"* and as a laudatory reminiscence of the smoking experience conveying *"merely laudatory information that serves to highlight positive aspects of the goods and the way it will make consumers feel".* In his statement of grounds, Mr Jiang refers to the dictionary definition of the word 'VIBES' as *"the mood of a place, situation, person, etc. and the way that they make you feel".* He also states that according to government websites *"Nicotine creates an immediate sense of relaxation"* and *"vaping nicotine may feel good by stimulating production of the "feel good" chemical".*

31. What the word 'VIBES' allegedly describes is, in Mr Jiang's claim, "*the positive aspects of the goods and the way [they] make consumers feel".* In other words, the effects of smoking or vaping.

32. In addition to the above, Mr Valdez-Knight introduces the following six exhibits which, he states, are in support of the invalidity action filed against THVB's registration:

- **Exhibit RVK06:** this exhibit consists of a printout (undated) from Cambridge online dictionary showing the definition of 'VIBES' as: *"informal for vibraphone: a musical instrument consisting of a frame with a set of metal bars in it that you hit. The bars have electrical devices attached to them that make them vibrate (= shake) so that they produce musical notes that seem to shake slightly".* The webpage also contains another definition of 'VIBES' as *"the feeling you get from being in a particular place or situation or from being with a particular person";* however, the definition also indicates that it is a slang word from an American Dictionary.

  It is apparent that there has been some confusion when this evidence was filed, as Mr Valdez-Knight states that the print-out at Exhibit RVK06 downloaded from

the Cambridge English Dictionary defines 'VIBES' as: *"the mood of a place, situation, person, etc. and the way that they make you feel"*, a definition which is not contained within the exhibit. I have checked the Cambridge online dictionary and the definition referred by Mr Valdez-Knight relates to the singular word 'VIBE' which appears to be a word used as a synonymous for "mood" in the UK.

- **Exhibit RVK07-08:** these exhibits consist of printouts (undated) from the websites www.mentalhealth.org.UK and www.truthinitiative.org stating as follows: "*Nicotine creates an immediate sense of relaxation, so people smoke in the belief it reduces stress and anxiety. This feeling is temporary and soon gives way to withdrawal symptoms and increased cravings. Smoking reduces withdrawal symptoms but doesn't reduce anxiety or deal with the reasons someone may feel that way"* and "*in the short-term, vaping nicotine may feel good by stimulating production of the "feel good" chemical in the brain called dopamine which can create feelings of pleasure and relaxation. Vaping nicotine also creates social opportunities to connect with other people and provides a distraction from stressful situations".*

- **Exhibit RVK09**: this exhibit consists of a printout (undated) from www.familyeducation.com which is said to be a guide to "*New Teen Slang and Gen Z Slang"* showing the following definition: *"Vibe Check - The vibe is the general mood, atmosphere, or aesthetic of a person or situation. A "vibe check" is generally used as a way to survey the overall aura of a person or group. The phrase "passing the vibe check" is a compliment to someone who seems like a good or chill person. Example: "The new kid let me use their charger this morning when I left mine on the bus and complimented my hair. They definitely pass the vibe check."* Mr Valdez-Knight states that this shows the use of the word 'VIBE' as part of young people's common vocabulary to denote their general mood and aura.

- **Exhibit RVK10-11:** these exhibits consist of what Mr Valdez-Knight describes as the relevant pages of (1) The Standard Packaging of Tobacco Products

Regulation 2015, (2) The Tobacco and Related Products Regulation 2016 and (3) The Children and Families Act 2014. As this evidence appears to relate to the claims that the mark is contrary to public policy and deceptive under Sections 3(3)(a) and (b), I will consider it later in this decision.

33. In its counterstatement, THBV states the word 'VIBES' does not describe any potential characteristic of the goods in question, namely batteries, chargers and cables for e-cigarettes (in class 9) and smoking and vaping products including cigarettes, e-cigarettes, and refill/accessory products (in class 34). It also argues that Mr Jiang made no specific submissions in relation to Section 3(1)(c) and that the only conclusion that can be made from such omission is that there is no basis for a descriptiveness claim, suggesting that Mr Jiang has taken a "kitchen sink" approach to pleading invalidity.

34. For a sign to be caught by the prohibition set out in Section 3(1)(c), there must be a sufficiently direct and specific relationship between the sign and the goods for which it is registered (or seeks registration) to enable the public concerned to immediately perceive, without further thought, a description of the goods in question or of one of their characteristics.[2] The descriptiveness of a sign can only be assessed, first, in relation to how the relevant public understands the sign and, second, in relation to the goods concerned.

35. The are various problems with Mr Jiang's claim that the mark 'VIBES' is descriptive. First, the evidence is all undated. Second, even if I were to accept that the position would not have been materially different at the relevant date (which is nearly four years before Mr Valdez-Knight's witness statement was signed), there are more serious issues. I have already noted that the dictionary definition of 'VIBES' as *"the feeling you get from being in a particular place or situation or from being with a particular person"* relates to an American slang word*,* however, the assessment must be conducted from the point of view of the UK relevant public. In this connection, Collins online dictionary describes 'VIBES' (plural) as follows:

[2] T-19/04, Paperlab, paragraph 25

"**vibes**

in **British English**

plural noun

1. informal (esp in jazz) short for vibraphone
2. slang short for vibrations vibes

Vibes

in **American English**

US

plural noun

1. vibraphone
2. Slang

qualities in a person or thing that are thought of as being like vibrations which produce an emotional reaction in others."

36. In addition, Cambridge online dictionary contains the following definition of 'VIBE' (singular):

"**vibe**

Noun

uk /vaɪb/ us /vaɪb/

vibe noun (MOOD)

informal

the mood of a place, situation, person, etc. and the way that they make you feel:

laid-back vibe *The city is famous for its laid-back vibe.*

vibe of *I loved the overall vibe of the place but the food wasn't that great.*

The music has a ***soothing vibe****.*

I didn't like the place—it had ***bad vibes****.*

I was getting some ***weird vibes*** *from him—I don't think he liked me."*

37. The above definitions indicates that the word 'VIBES' (plural) taken on its own is primarily used in the UK as an informal abbreviation for "vibrations" or as having the same meaning of "vibrations". Admittedly, whilst the word 'VIBE' (singular) appears to

be used to mean “mood” in the UK, the same dictionary definitions give examples showing that ‘VIBES’ (plural) can also be used in the same manner in the UK, i.e. bad vibes, weird vibes. Nevertheless, both “vibe” (singular) and “vibes” (plural) need a qualifier (an adjective or a noun) to describe a mood, which can be either good or bad. For example, a place, a city, or a person can give “a good vibe” or “good vibes”, but it can also give “a bad vibe” or “bad vibes”. Likewise, the phrase *“passing (or failing) a vibe check”* referred to at RVK09 has its own meaning, namely that of assessing the “vibe” of a situation, which can be either good or bad.[3]

38. Taking into account all of the above, the UK average consumer is likely to perceive the word ‘VIBES’ (plural) on its own as meaning either “vibrations” or “mood”. The word “vibration” is defined as *“continuous quick, slight shaking movement”* (Cambridge online dictionary) and has no direct reference to the registered goods (and Mr Jiang did not argue that the word ‘VIBES’ understood as an informal word for vibrations describes the goods or a characteristic of the goods). The same goes if consumers perceive ‘VIBES’ as meaning “mood”. First, it does not describe the goods. Second, without a qualifier, it cannot even allude to the effects of some of the goods (i.e. tobacco and vaping products) on consumers.

39. The invalidity based on Section 3(1)(c) fails.

Section 3(1)(b)

40. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

> “29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or

[3] Collins online dictionary states that the phrase “vibe-check” is being monitored for evidence of usage.

service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM* v *Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel* v *OHIM*, paragraphs 36 and 38; and *Audi* v *OHIM*, paragraph 37)."

41. Mr Jiang's claim under Section 3(1)(b) is that "*the relevant public would simply perceive the sign VIBES as providing the purely laudatory information that the goods will provide a mood or atmosphere or feeling of an uplifting experience."*

41. As it will be recalled, Mr Jiang has made the same claim that 'VIBES' conveys "*purely laudatory information"* under Sections 3(1)(b) and (c). Whilst I have rejected the claim that 'VIBES' is descriptive for the registered goods in classes 9 and 34, as I have anticipated at paragraph 26, for the sake of completeness, I will consider whether the mark is devoid of distinctive character without being wholly descriptive.

42. In its counterstatement, THBV states that whilst it acknowledges that the word 'VIBES' has a dictionary meaning equivalent to "mood", "atmosphere", or "feeling", the word does not have any laudatory meaning in relation to the smoking experience because the trade mark 'VIBES' "*is not telling the consumer that use [of the registered goods] will make them feel a particular way"* and *"It is left up to the consumer".*

43. The contested mark is the single word 'VIBES' and, as THBV entirely correctly points out, there is nothing in the mark which suggests that the goods will make the user experience an uplifting experience. The word 'VIBES' alone does not convey that message. As I have already stated, even if consumers understood 'VIBES' as meaning "*something which is given off by a person, place or situation"*, the word, without a qualifier, cannot have any promotional or laudatory meaning.

44. Mr Jiang did not put forward any other reason why the mark 'VIBES' is devoid of distinctive character and is incapable of fulfilling the essential function of a trade mark.

45. The claim under Section 3(1)(b) also fails.

SECTION 3(3)

46. Section 3(3) states as follows:

> "3.— Absolute grounds for refusal of registration

[…]

(2) A trade mark shall not be registered if it is—

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)."

Section 3(3)(a)

47. In *Constantin Film Produktion GmbH v EUIPO,* Case C-240/18P, the CJEU upheld an appeal against the decision of the General Court ("GC"), which had upheld EUIPO's refusal to register the words 'Fack Ju Göhte' ('Fuck you Göhte') in relation to a range of goods/services in 13 classes. There was evidence that the mark corresponded with the title of a German cinematic comedy produced by the appellant, which had been one of the greatest film successes of 2013 in Germany. The film had been seen by several million people when it was released in cinemas, without attracting great controversy. The court stated that:

"38. As the General Court found in paragraph 24 of the judgment under appeal, without being contradicted by the appellant, EUIPO refused, on the basis of Article 7(1)(f) of Regulation No 207/2009, to register the word sign 'Fack Ju Göhte', not on the ground that that sign might be contrary to public policy, but on the sole ground that it would be contrary to accepted principles of morality. It is therefore only in the light of the latter absolute ground of refusal that the first ground of appeal should be examined.

39. As regards that ground for refusal, it should be noted that, since the concept of 'accepted principles of morality' is not defined by Regulation No 207/2009, it must be interpreted in the light of its usual meaning and the context in which it is generally used. However, as the Advocate General observes in essence in point 77 of his Opinion, that concept refers, in its usual sense, to the fundamental moral values and standards to which a society adheres at a given

time. Those values and norms, which are likely to change over time and vary in space, should be determined according to the social consensus prevailing in that society at the time of the assessment. In making that determination, due account is to be taken of the social context, including, where appropriate, the cultural, religious or philosophical diversities that characterise it, in order to assess objectively what that society considers to be morally acceptable at that time.

40. Moreover, in the context of the application of Article 7(1)(f) of Regulation No 207/2009, the examination as to whether a sign, in respect of which registration as an EU trade mark is sought, is contrary to accepted principles of morality requires an examination of all the elements specific to the case in order to determine how the relevant public would perceive such a sign if it were used as a trade mark for the goods or services claimed.

41. In that connection, in order to come within the scope of Article 7(1)(f) of Regulation No 207/2009, it is not sufficient for the sign concerned to be regarded as being in bad taste. It must, at the time of the examination, be perceived by the relevant public as contrary to the fundamental moral values and standards of society as they exist at that time.

42. In order to establish whether that is the case, the examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered and, where appropriate, the particular circumstances of the part of the Union concerned. To that end, elements such as legislation and administrative practices, public opinion and, where appropriate, the way in which the relevant public has reacted in the past to that sign or similar signs, as well as any other factor which may make it possible to assess the perception of that public, are relevant.

43. The examination to be carried out cannot be confined to an abstract assessment of the mark applied for, or even of certain components of it, but it must be established, in particular where an applicant has relied on factors that

are liable to cast doubt on the fact that that mark is perceived by the relevant public as contrary to accepted principles of morality, that the use of that mark in the concrete and current social context would indeed be perceived by that public as being contrary to the fundamental moral values and standards of society."

48. In *Santa Conte v EUIPO*, Case T-683/18, the GC upheld a decision of the EUIPO to refuse to register the trade mark shown below on the grounds that it was contrary to public policy.

49. The Court held that:

"72. As regards, more specifically, the interpretation of that concept in the context of Article 7(1)(f) of Regulation 2017/1001, Advocate General Bobek, in point 76 of his Opinion in the case Constantin Film Produktion v EUIPO (C-240/18 P, EU:C:2019:553), stressed that public policy is a normative vision of values and goals, defined by the relevant public authority, to be pursued now and in the future, that is, prospectively. Public policy, he continued, thus expresses the public regulator's wishes as to the norms to be respected in society.

73. In view of the foregoing, the applicant is justified in submitting that, in essence, something being against the law is not always necessarily the equivalent of its being contrary to public policy for the purposes of Article 7(1)(f) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation. It is also necessary that the fact of that thing being against the law affects an

interest which the Member State or States concerned consider to be fundamental in accordance with their own systems of values.

74. In the present case, it must be noted that, in the Member States where the consumption and use of the narcotic substance derived from cannabis remain prohibited, tackling the spread of cannabis is particularly sensitive, which meets a public health objective aimed at combating the harmful effects of that substance. That prohibition thus seeks to protect an interest which those Member States consider to be fundamental in accordance with their own systems of values, with the result that the rules applicable to the consumption and use of that substance are a matter of 'public policy' for the purposes of Article 7(1)(f) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation.

75. Furthermore, the importance of the protection of that fundamental interest is further emphasised by Article 83 TFEU, according to which illicit drug trafficking is one of the areas of particularly serious crime with a cross-border dimension, in which the EU legislature may intervene, and by the third subparagraph of Article 168(1) TFEU, according to which the Union is to complement the Member States' action in reducing drugs-related health damage, including information and prevention.

76. Therefore, the Board of Appeal rightly considered, when examining whether the sign at issue is contrary to public policy in relation to all the consumers in the European Union who can understand its meaning, and given that their perception necessarily forms part of the context referred to in paragraphs 74 and 75 above, that the sign at issue, which would be perceived by the relevant public as an indication that the food and drink items referred to by the applicant in the trade mark application, and the related services, contain narcotic substances which are illegal in many Member States, is contrary to public policy for the purposes of Article 7(1)(f) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation."

50. Mr Jiang's pleadings under this ground is that the word 'VIBES' is heavily used and liked by the younger generation to denote an excellent experience and that when used with tobacco and related products, it is likely that the brand will increase the appeal of tobacco products amongst young people, contravening the Tobacco and Related Products Regulations whose main objective is reducing youth uptake of smoking and encouraging and supporting quitting amongst smokers.

51. In support of this claim, Mr Valdez-Knight provided copies of the following pieces of legislation: (A) The Standard Packaging of Tobacco Products Regulation 2015 - Part 4 (10).3.(a) and (c) (iii) and Part 5 13.(1).(b) and (2)(a), (B) The Tobacco and Related Products Regulation 2016 - Part 2 - Labelling of Tobacco Products and (C) the Children and Families Act 2014, Part 5- Welfare of Children – Section 94 - Regulation of retail packaging etc of tobacco products.

52. These provisions establish that:

- the labelling of tobacco products cannot contain any elements or features (including trade marks) that promotes a tobacco product or encourages its consumption by creating an erroneous impression about its characteristics, health effects, risks or emissions, or suggests that a particular tobacco product has vitalising, energizing, healing, rejuvenating, natural or organic properties.[4]

- Tobacco product for smoking must carry a combined health warning.[5]

- The Secretary of State may by regulations make provisions about the retail packaging of tobacco products with a view of contributing to reducing the risk of harm to, or promoting, the health or welfare of people under the age of 18.[6]

52. As it will be recalled, I have found that the word 'VIBES' on its own (without a qualifier) is likely to be perceived by the relevant public as an informal word meaning

[4] The Standard Packaging of Tobacco Products Regulation 2015 - Part 4 (10).3.(a) and (c) (iii)
[5] The Tobacco and Related Products Regulation 2016 - Part 2 - Labelling of Tobacco Products
[6] Children and Families Act 2014, Part 5- Welfare of Children – Section 94 - Regulation of retail packaging etc of tobacco products.

"vibrations", a meaning which is not relevant for the goods in question. Alternatively, it will be perceived as a word meaning *"something which is given off by a person, place or situation",* however, without a qualifier, it cannot convey any laudatory or promotional message. In this connection, there is no evidence that the word 'VIBES' on its own is related to, or invocative of, smoking or vaping; no evidence of 'VIBES' having these kinds of connotations has been provided. Whilst the dictionary definitions and the evidence from www.familyeducation.com indicate that the word 'Vibe' and 'Vibes' can convey positive meanings, that is only when they are combined with a noun or used within a phrase (i.e. pass the vibe check) or an adjective (i.e. good vibes), not when they are use on their own.

53. Since the word 'VIBES' neither encourages nor invokes smoking or vaping, nor conveys any promotional message about the goods, it cannot be contrary to any law aimed at reducing smoking amongst the younger generation.

54. The claim under Section 3(3)(a) fails.

Section 3(3)(b)

55. Section 3(3)(b) prevents the registration of trade marks which deceive the public as to the nature, quality or geographical origin of the goods or services. Mr Jiang claims that the trade mark 'VIBES' is deceptive because it conveys "clear" information indicating that the goods in classes 9 and 34 are of such a nature that have energising or vitalising elements, whereas those goods cannot in reality have these characteristics. Unless I am missing something, I am not sure how the word 'VIBES' on its own might be understood as referring to tobacco and vaping products being energising or vitalising. As THBV entirely correctly submits, the single word 'VIBES' does not convey any message about the nature, quality or geographical origin of the goods, let alone that of the goods being energising or vitalising. The mark consists of the single word 'VIBES' and does not include any additional verbal elements (such as for example, the word "good") or any figurative element which might be understood as encouraging smoking (or vaping) or targeting a younger audience or saying that the goods are energising or vitalising. The alleged meaning attributed to THBV's mark is wholly strained and far-fetched.

56. The claim under Section 3(3)(b) also fails.

57. Since the invalidity application against THBV's earlier mark no. UK00003594839 has failed, THBV can continue to rely on its earlier mark in the invalidity against Mr Jiang's registration no. UK00003821866, to which I will now turn.

THBV'S APPLICATION FOR INVALIDITY

58. Section 5(2)(b) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
> >
> > unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> (2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –
>
> > (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

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

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

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

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

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

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

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

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

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

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

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

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

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

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(2)(b): legislation and case law

59. Section 5(2)(b) of the Act is 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".

60. Section 5A of the Act states as follows:

"Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

61. As THBV's earlier mark had not completed its registration process more than five years before the filing date of Mr Jiang's contested mark or the date of the application

for the declaration of invalidity, it is not subject to proof of use pursuant to Section 47(2B) of the Act. Consequently, THBV may rely on all of the goods for which its mark is registered.

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

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

63. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

65. In *Gérard Meric v OHIM* Case T- 133/05, the GC stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysterne 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."

66. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM***,** Case T-325/06, the GC stated that "complementary" means:

> "[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

67. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

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

68. Whilst on the other hand:

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

69. The competing goods and services of the parties are as follows:

Mr Jiang's contested goods and services	**THBV's earlier goods**
Class 9: *Batteries for electronic cigarettes, cables for charging electronic cigarettes; USB cables for connecting electronic cigarettes to electronic devices; cables for connecting electronic*	**Class 9:** *Batteries; batteries for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; battery chargers; battery chargers for electronic smoking*

cigarettes to mains electricity; adapters for charging electronic cigarettes; portable charging cases for electronic cigarettes and vaporisers; parts and fittings for the aforesaid goods.	*devices, electronic cigarettes, tobacco heating devices and personal vaporisers; docking stations; docking stations for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; power cables; power cables for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers.*
Class 34: *Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; smokers' articles; liquids for use in personal vaporisers and electronic cigarettes; cigarette cases and holders; parts and fittings for all the aforesaid goods.* **Class 35:** *online ordering services; retail services and wholesale services connected with the sale of personal vaporisers and electronic cigarettes, and flavourings and solutions therefor, smokers' articles, liquid solutions for use in personal vaporisers and electronic cigarettes, cigarette cases and holders, batteries for electronic cigarettes, cables for charging electronic cigarettes, USB cables for connecting electronic cigarettes to electronic devices, cables for connecting electronic cigarettes to mains electricity, adapters for charging*	**Class 34:** *Tobacco products; cigarettes; cigars; rolling tobacco; pipe tobacco; electronic smoking devices, personal vaporisers, tobacco heating devices and electronic cigarettes, and flavourings and solutions therefor; ampoules, cartridges and refill cartridges for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; liquid solutions for use in electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; holders for electronic smoking devices, electronic cigarettes, tobacco heating devices and personal vaporisers; and parts and fittings of all the aforesaid goods, included in the class.*

electronic cigarettes, portable charging cases for electronic cigarettes and vaporisers, parts and fittings for all the aforesaid goods.	

Class 9: *Batteries for electronic cigarettes, cables for charging electronic cigarettes; USB cables for connecting electronic cigarettes to electronic devices; cables for connecting electronic cigarettes to mains electricity; adapters for charging electronic cigarettes; portable charging cases for electronic cigarettes and vaporisers; parts and fittings for the aforesaid goods.*

70. Mr Jiang's contested goods in class 9 are batteries for electronic cigarettes, cables, adapters, portable charging cases and parts and fittings for electronic cigarettes. The earlier goods include batteries, cables and docking stations for electronic cigarettes.

71. Mr Jiang's batteries and cables for electronic cigarettes are self-evidently identical to the earlier goods, whilst his portable charging cases, adapters, and parts and fittings for electronic cigarettes are, if not identical, highly similar to the earlier batteries, cables and docking stations for electronic cigarettes, as the goods have a similar nature and the same purpose, target the same users, are complementary or interchangeable, and are distributed through the same trade channels. **These goods are either identical or highly similar.**

Class 34: *Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; smokers' articles; liquids for use in personal vaporisers and electronic cigarettes; cigarette cases and holders; parts and fittings for all the aforesaid goods.*

72. Mr Jiang's *smokers' articles* are encompassed by the earlier *tobacco products* and are **identical (*Meric*).** Alternatively, if the earlier *tobacco products* are only taken to cover products consisting of tobacco, the opposed *smokers' articles* must include the tobacco heating devices[7] which are covered by THBV's earlier registration and are

[7] See the EUIPO TMClass tool which list *Batteries for electronic smokers' articles* in class 9 from which it can be deducted that smokers' articles include electronic devices for smoking hence the earlier tobacco heating devices.

highly complementary, likely to be distributed through the same trade channels and similar to, at least, a medium degree. Mr Jiang's *Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; liquids for use in personal vaporisers and electronic cigarettes; parts and fittings for all the aforesaid goods,* are **self-evidently identical** to the earlier terms *electronic smoking devices, personal vaporisers, tobacco heating devices and electronic cigarettes, and flavourings and solutions therefor; and parts and fittings of all the aforesaid goods, included in the class.* Mr Jiang's *cigarette cases and holders* are **either identical** to the earlier *tobacco products* (if the term *tobacco products* is understood as covering tobacco-related products and smokers articles) or **at least similar to a medium degree** (if the term *tobacco products* is understood as covering only products consisting of tobacco such as cigarettes and cigars) because although the goods have a different nature and purpose, they are complementary, target the same users and are distributed through the same trade channels.

Class 35: *online ordering services; retail services and wholesale services connected with the sale of personal vaporisers and electronic cigarettes, and flavourings and solutions therefor, smokers' articles, liquid solutions for use in personal vaporisers and electronic cigarettes, cigarette cases and holders, batteries for electronic cigarettes, cables for charging electronic cigarettes, USB cables for connecting electronic cigarettes to electronic devices, cables for connecting electronic cigarettes to mains electricity, adapters for charging electronic cigarettes, portable charging cases for electronic cigarettes and vaporisers, parts and fittings for all the aforesaid goods.*

73. Mr Jiang's services in class 35 are online ordering services and retail and wholesale services which cover (or are notionally apt to cover) goods identical or similar to the earlier goods in classes 9 and 34. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.[8] Accordingly I find that Mr Jiang's services in class 35 are **similar to a medium degree** to the earlier goods in classes 9 and 34.

[8] Tony Van Gulck v Wasabi Frog Ltd, Case BL O/391/14

Average consumer

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

75. My comments about the average consumer for the goods covered by the earlier mark (see paragraph 28) apply to the goods covered by Mr Jiang's contested mark, as the goods are mostly identical. Here I only need to add a few comments in relation to the class 35 services which have no counterpart in the earlier mark.

76. The average consumer of these services, which relate to the retail and wholesale of electronic cigarettes (and related goods), are members of the general public over the age of 18 or retailers. The services will be selected mainly visually from websites, marketing material and signage outside shops, with the aural component playing a part through, for example, word of mouth recommendations. The relevant public is likely to consider various factors including location and range of goods on offer and is likely to pay a medium degree of attention. I do not consider that the level of attention would be materially higher for retailers who are consumers of the wholesale services.

Comparison of marks

77. 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."

78. 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.

79. The respective marks are shown below:

Mr Jiang's contested mark	**THBV's earlier mark**
	VIBES

80. The earlier mark consists of the single word 'VIBES' presented in capital letters. That is the overall impression it will convey and where its distinctiveness lies.

81. Mr Jiang's contested mark consists of the words 'HAPPY' and 'VIBES' presented within a circular device. The word 'HAPPY' is written in standard letters and is placed above the word Vibes which is written in lager letters in a handwritten typeface with the first letter 'V' capitalised and stylised in such a way as to appear as a wavy line. THBV argues that the word 'VIBES' is the dominant element of the mark because it is larger in size and because the word 'HAPPY' will be seen as nothing more than a modifier and is non-distinctive.

82. The fact that the word 'Vibes' is visually prominent and stands out, that 'HAPPY' is an extremely common word (which is something the average consumer will be alive to), that although 'HAPPY' qualifies 'Vibes' it does not alter its meaning, and that the position of 'HAPPY' above 'Vibes' and the use of different typefaces, sizes and stylisation creates the impression of the two words retaining their independence within the mark, inevitably results, in my view, in the element 'Vibes' carrying the mark both visually and conceptually (due to its size, position, stylisation and inherent distinctiveness), and in the relevant public focusing on that element. The word 'HAPPY', whilst still contributing, plays the lesser role of the two. The circular device will be perceived as ornamental and will have less weight in the overall impression.

Visual similarity

83. In terms of visual similarity, the marks share the identical word 'VIBES/Vibes' and the earlier mark could also be presented in title case. Whilst the word 'HAPPY', the circular device and the stylisation create some visual differences, they do not outweigh the similarity created by the word 'VIBES/Vibes', which I regard to be of a medium level.

Aural similarity

84. In terms of aural similarity, there is a degree of aural similarity as both marks share the word 'VIBES/Vibes' but there is a difference in that the beginning of the contested mark is 'HAPPY'. This results in the respective pronunciations being 'HAEPI VAIBZ' and 'VAIBZ'. I regard there to be a medium to high level of aural similarity.

Conceptual similarity

85. Mr Jiang argued that the word ‘VIBES’ is in common use in all sorts of fields and lacks distinctive character because is a laudatory term, suggestive of the smoking experience relying on the decision of the EUIPO in a dispute between THBV and Philip Morris Products S.A. in Case R 814/2010-4 where the Board of Appeal stated:

> "English-speaking consumers will no doubt recognise the meaningful word vibe/vibes in the two signs, as the meaning of such relatively common word is relevant in relation to the smoking experience. Vibe, as "mood" or "atmosphere", intends to be a laudatory reminiscence of the smoking experience."

86. What was said in the above decision was repeated in Mr Jiang’s invalidity claim which alleged that ‘VIBES’ was descriptive and non-distinctive. I have already rejected that claim. Further, I note that whilst the Board of Appeal decision states that ‘VIBES’ is a relatively common word whose meaning is relevant in relation to the smoking experience, because it is “a laudatory reminiscence of the smoking experience”, first, I do not agree with that conclusion and I am not bound by it and, second, in the same decision the Board of Appeal also stated that ‘VIBES’ is neither descriptive nor generic for tobacco, articles for smokers and matches (which were the goods at issue in that decision) as it can be seen from the following paragraph:

> “The opponent did not claim that its VIBES mark has acquired an enhanced distinctiveness due to intensive use or reputation. Since the word “VIBES” is neither generic nor descriptive in relation to the goods, its distinctiveness must be regarded as normal. “VIBES” is not for the same reasons a weak sign in relation to tobacco products.”

87. Whilst ‘HAPPY’ qualifies ‘VIBES’, it does not alter its meaning. Consequently, to the extent that ‘HAPPY’ introduces the additional adjectival concept, it does not alter the meaning of ‘VIBES’ as vibrations or mood/atmosphere. There is a medium degree of conceptual similarity insofar as both marks contain a reference to ‘VIBES’.

Distinctive character of the earlier mark

88. 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 *WindsurfingChiemsee* 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)."

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

90. As THBV has not filed any evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider.

91. Since the word ‘VIBES’ is neither allusive nor descriptive in relation to the goods, it is distinctive to a medium degree.

Likelihood of confusion

92. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

93. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the 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)."

94. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

95. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

96. Earlier in this decision I found that:

- The competing goods and services range from being identical to being similar to a medium degree.

- The average consumer of the goods and services is a member of the general public over the age of 18 or a retailer who will select the goods and services with a medium degree of attention. The selection process is mainly a visual one, although I do not discount aural considerations completely.

- The competing marks are visually similar to a medium degree, aurally similar to a medium to high degree and conceptually similar to a medium degree.

- The earlier mark is distinctive to a medium degree.

97. In support of his defence, Mr Jiang has filed state of the register evidence showing the registration of other trade marks incorporating the word 'VIBE' or 'VIBES' for goods in class 34, including VIBE DRIP (UK00003161893), ULTRA VIBE (UK00003693945), URBAN VIBE (UK00918196152), SISHA VIBE (UK00003918104), VAPE TO VIBE (UK00003918104), VAPE2VIBE (UK00003918408), VIBE BEYOND (UK00914283329), VIBE JUICE (UK00003242712), VAPE AND VIBE (UK00003634915), VIBES (UK00917231747, UK00003594839, UK00917950627, WO0000000839255), GOOD VIBES (UK00003405862) and VIBES FATTY (WO0000001722764). Further, whilst Mr Jiang also provided evidence of some of these marks being present on the market, it is all undated and it is impossible to know to what extent these marks had penetrated the market for tobacco and vaping products at the relevant date of 19 August 2022, no specific figures about the level of trade of the users of these marks having been provided. It is accepted that state of the register evidence is hardly relevant in opposition proceedings;[9] likewise, the evidence of other trade marks being in use after the relevant date cannot establish that the distinctiveness of the earlier mark had been weakened by the use of the word 'VIBES' by other traders after that date.

[9] *Zero Industry Srl v OHIM,* Case T-400/06

98. Lastly, the evidence about Mr Jiang's use of his mark does not assist him as it does not establish peaceful co-existence on the market or honest concurrent use, since THBV's earlier mark has not been used. In this connection, I have not overlooked Mr Jiang's evidence consisting of three letters (JJ7) from what are described as importers and distributors of his goods saying that they have never *"encountered, received or communicated"* any form of trade mark confusion between 'HAPPY VIBES' and any other products sold including those with a trade mark that include the word 'VIBES' or 'VIBE'.

99. That evidence is not very helpful. First, it is hearsay. Section 4 of the Civil Evidence Act 1995 permits hearsay evidence in civil proceedings but provides the following guidance as to the weight to be accorded to such evidence:

> "Considerations relevant to weighing of hearsay evidence.
>
> (1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.
>
> (2) Regard may be had, in particular, to the following -
>
> (a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
>
> (b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
>
> (c) whether the evidence involves multiple hearsay;
>
> (d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

100. No reason has been provided as to why it would not have been reasonable and practicable for Mr Jiang to have produced the makers of the original statements as witnesses. As such, I am inclined to give this evidence very little weight.

101. Second, these statements provide no context or information about the volume of goods sold, the circumstances in which the goods were sold, or the trade marks under which the goods were sold (aside from saying that the trade marks include the word Vibe or Vibes). In *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220, Kitchen L.J. stated that:

"80. .....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

102. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

103. Accordingly, absence of confusion is neither relevant nor determinative, especially in circumstances where the argument relates to use by third parties of similar marks (and it is not clear what these marks are).

104. I now turn to the likelihood of confusion.

105. THBV's pleaded case is that Mr Jiang's mark will be seen as a brand extension or a stylised version of its earlier mark.

106. I agree that THBV's best case is indirect confusion. The differences between the marks are such that there is not, in my view, a risk of direct confusion between them, the identity of the goods not being capable of outweighing these differences.

107. Turning to indirect confusion, I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.

108. In the present case, the later mark contains the verbal element 'Vibes' which is identical to the verbal element of the earlier mark 'VIBES'. As it will be recalled, while the public will perceive the later mark as a whole, the word 'Vibes' is visually prominent and stands out, and carries the mark both visually and conceptually due to its size, position, stylisation and inherent distinctiveness, whilst the position of 'HAPPY' above 'Vibes' and the use of different typefaces and sizes creates the impression of the two words retaining their independence within the mark.

109. Taking all of the above into account, including the average degree of distinctiveness of the earlier mark 'VIBES', the identity or similarity of the goods and services at issue, and the laudatory nature of the word 'HAPPY' (which is something the average consumer will be alive to), I consider that a significant proportion of the

relevant pubic who is familiar with the use of the trade mark 'VIBES' in relation to smoking products, electronic cigarettes and vaping products (and related electrical goods) in classes 9 and 34 and subsequently sees Mr Jiang's 'HAPPY Vibes' mark used on identical or similar goods and retail services connected with the sale of these goods, would consider the latter as being a play on words indicating an extension or sub-brand of the 'VIBES' line of goods together with the laudatory message that the use of the goods and services gives the consumer a happy/positive experience. There is a likelihood of indirect confusion.

110. The partial invalidity application under Section 5(2)(b) is successful.

OUTCOME

111. The application for a declaration of invalidity against THBV's trade mark no. UK00003594839 has failed and the mark remains registered.

1112. The partial application for a declaration of invalidity against Mr Jiang's trade mark no. UK00003821866 is successful and the mark is invalidated in respect of the following goods and services:

> **Class 9:** *Batteries for electronic cigarettes, cables for charging electronic cigarettes; USB cables for connecting electronic cigarettes to electronic devices; cables for connecting electronic cigarettes to mains electricity; adapters for charging electronic cigarettes; portable charging cases for electronic cigarettes and vaporisers; parts and fittings for the aforesaid goods.*
>
> **Class 34:** *Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; smokers' articles; liquids for use in personal vaporisers and electronic cigarettes; cigarette cases and holders; parts and fittings for all the aforesaid goods.*
>
> **Class 35:** *online ordering services; retail services and wholesale services connected with the sale of personal vaporisers and electronic cigarettes, and flavourings and solutions therefor, smokers' articles, liquid solutions for use in*

personal vaporisers and electronic cigarettes, cigarette cases and holders, batteries for electronic cigarettes, cables for charging electronic cigarettes, USB cables for connecting electronic cigarettes to electronic devices, cables for connecting electronic cigarettes to mains electricity, adapters for charging electronic cigarettes, portable charging cases for electronic cigarettes and vaporisers, parts and fittings for all the aforesaid goods.

113. As the following services were not subject to the application for invalidation, UK00003821866 remains registered in respect of them:

Class 35: *Advertising, marketing and sales promotions; business consultancy; business management; business assistance; business risk management services; business introductory services; business and commercial information; business management, assistance and advice relating to franchising; consultancy, information and advisory services relating to all the aforesaid services.*

Class 45: *Licensing of franchise concepts; licensing; legal services; consultancy, information and advisory services relating to all the aforesaid services.*

COSTS

114. THBV has been successful in defending its registration and in its application to partially invalidate Mr Jiang's trade mark. As the winning party in both consolidated proceedings, THBV is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award THBV the sum of £1,400, calculated as follows:

Preparing a statement and considering the other side's statement: £600 (£300x2)
Considering the other party's evidence: £600
Official fees: £200
Total: £1,400

115. I therefore order Yang Jiang to pay Trompenburg Holdings B.V. the sum of £1,400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 17th day of January 2025

TERESA PERKS
For the Registrar