O/0613/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003814448
BY IMPERIAL TOBACCO LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 34

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 439101
BY STARBUZZ TOBACCO, INC.

BACKGROUND AND PLEADINGS

1. On 28 July 2022, Imperial Tobacco Limited ("the applicant") applied for the trade mark shown on the cover page of this decision, in the UK ("the contested mark"). The application was published for opposition purposes on 11 November 2022 in respect of the following goods:

> **Class 34:** *Tobacco free oral nicotine pouches (not for medical use); snus without tobacco.*

2. On 9 February 2023, the application was opposed by Starbuzz Tobacco, Inc. ("the opponent") based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following trade marks[1] and some of the goods covered by the same, as shown below:[2]

UK00003699684 ("earlier mark no. 1") FREEZE Filing date: 23 September 2021 Registration date: 17 March 2023 Priority date: 09 October 2020 **Class 34:** *Hookahs; electronic hookahs; tobacco products* ***not including snus or nicotine pouches;*** *tobacco* ***not including snus or nicotine pouches;*** *tobacco substitutes* ***not including snus or nicotine pouches;*** *cigarette tobacco; chewing tobacco; pipe tobacco; shisha tobacco; smokers' articles; matches; shisha pipes; electronic shisha pipes; cigars; small cigars; electronic cigars; personal vaporisers*

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM or International Registration designating the EU ("IR(EU)"). Some of the opponent's earlier marks were originally protected as EUTMs and IR(EU)s and are now comparable marks which are recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing and priority dates.

[2] The opponent initially relied on an additional mark, namely trade mark no. UK00914973457 for ALASKAN FREEZE, however in its submissions in lieu the opponent withdrew reliance on that mark as it recognised that no proof of use of that mark had been filed.

and electronic cigarettes, and flavourings and solutions therefor; liquids for electronic cigarettes; smoking pipes; steam stones for water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; Tea for smoking as a tobacco substitute.
UK00913367461(“earlier mark no. 2”) Mighty Freeze Filing date: 15 October 2014 Registration date: 25 February 2015 **Class 34:** *Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.*
UK00913367511 (“earlier mark no. 3”) Grape Freeze Filing date: 15 October 2014 Registration date: 25 February 2015 **Class 34:** *Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.*
UK00913367537 (“earlier mark no. 4”) Watermelon Freeze Filing date: 15 October 2014 Registration date: 25 February 2015

Class 34: *Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.*

3. In relation to the earlier mark no. 1, it is important to note that when the opponent identified the goods it relies upon on the Form TM7, it omitted the limitation **not including snus or nicotine pouches** highlighted in bold above. However, since omitting a limitation which excludes certain goods would result in expanding the scope of the registration to include the goods which are expressly excluded by the registered specification, I will disregard the omission and I will refer to the goods as they are registered.

4. The opponent claims that the respective goods are either identical or similar and that the respective marks are similar such that there exists a likelihood of confusion under Section 5(2)(b). The opponent states that all the competing marks share the dominant and distinctive element FREEZE, that the element ROYAL in the contested mark and the element MIGHTY in the earlier mark no. 2 are laudatory, and that the terms GRAPES and WATERMELON in the earlier marks nos. 3 and 4 will be perceived as flavours. The opponent also states that it owns registrations for, and uses, a family of marks consisting of two words, the second being FREEZE.

5. The trade marks relied upon by the opponent are all earlier marks in accordance with Section 6 of the Act. As the earlier marks nos. 2, 3 and 4 had been registered for five years or more at the application date of the contested mark, they are subject to proof of use.

6. The applicant filed a counterstatement, denying the claims made and putting the opponent to proof of use of the earlier marks nos. 2, 3 and 4.

7. The opponent is represented by Keltie LLP. The applicant is represented by Stevens Hewlett & Perkins. Both parties filed evidence during the evidence rounds, with the applicant also filing written submissions dated 25 September 2023.

8. Neither party requested a hearing, and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

THE EVIDENCE

9. The opponent's evidence came in the form of the witness statement of Majda Haddoudi date 25 July 2023. Ms Haddoudi is the C.F.O of the opponent, a position she has held for 9 years. Ms Haddoudi's statement is accompanied by 9 exhibits, being those labelled Exhibits MH1 - MH9.

10. The opponent's evidence came in the form of the witness statement of Jonathon Sutton dated 22 September 2023. Mr Sutton is a Charted Trade Mark attorney employed by Stevens Hewlett & Perkins, the firm representing the applicant is these proceedings. Mr Sutton's statement is accompanied by 6 exhibits, being those labelled Exhibits JS1- JS06.

11. I do not intend to summarise the parties' evidence at this stage but confirm that I have given due consideration to all of the documents filed by both parties.

RELEVANCE OF EU LAW

12. 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.

DECISION

Proof of use

13. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5)-(5A) [Repealed]

(6) 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."

14. Section 100 is also relevant, which reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

15. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the contested mark: 29 July 2017 to 28 July 2022. As the earlier marks subject to proof of use are comparable marks, use within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (i.e. 31 December 2020).[3] Only use in the UK will be relevant after that date.

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and*

[3] See paragraph 7 of Part 1, Schedule 2A of the Act.

Designs) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising

campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

17. With regards to assessing use within the EU (which is relevant due to the earlier mark being a 'comparable mark'), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11, the CJEU found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, "all facts and circumstances" should be considered including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.[4]

The evidence

18. Ms Haddoudi states that the relevant goods have been available in the UK during the relevant 5-year period under the earlier trade marks subject to proof of use from the opponent's website www.starbuzzlondon.com, its physical store in London as well as from various third party on-line and physical stores in the UK and Spain. Ms Haddoudi also provides the names of the opponent's Spanish distributors, Marcelino Gonzalez, S.A. and Tabaco y Complementos Barcelona S.L.

19. Examples (undated) of product packaging are provided. They show use of the trade marks Mighty Freeze, Grape Freeze and Watermelon Freeze preceded by the adjective "Exotic". The use appears to be descriptive denoting the flavour of the product and the marks are used in conjunction with the trade mark STARBUZZ TOBACCO and STARBUZZ E-JUICE as shown below:

[4] See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, TVR Automotive Ltd v OHIM (paragraph 57)

20. Copies of pages from the opponent's catalogues for the years 2018, 2019, 2020, 2021 and 2022 also show use of the trade mark STARBUZZ as the primary indicator of origin as confirmed by the image shown below and the text: *"With over 150 unique flavors to choose from across 7 different flavor lines,* ***Starbuzz Tobacco*** *is sure to leave even the most discriminating smoker satisfied":*

21. The catalogues show over 100 different types of flavours but only 7 contain the word FREEZE, namely Mighty Freeze, Grape Freeze, Watermelon Freeze, Margarita Freeze, Pineapple Freeze, Alaskan Freeze and Moscow Freeze. Although the marks display the symbol ® meaning that they are registered trade marks, they are clearly used as the names of flavours belonging to a line called FREEZE that is described as a flavour that *"packs a serious minty punch".* In this connection, it is notable that all the product packaging display the image of mint leaves together with the names Mighty Freeze, Grape Freeze and Watermelon Freeze. Further, the descriptiveness of Mighty Freeze, Grape Freeze and Watermelon Freeze is apparent from the description of the product, with Grape Freeze being described as the flavour of "frozen succulent grape", Watermelon Freeze as "refreshing, ice cold- watermelon smoke" and Mighty Freeze as the perfect blend of "lemon and frozen mint":

Grape Freeze®

Another addition from the Freeze line means that this flavor packs a serious minty punch. The only thing better than a succulent grape is a frozen succulent grape.

Watermelon Freeze®

We took this popular mix and added our special spin to it, making for one of the most refreshing, ice-cold, watermelon smokes you've ever experienced.

Mighty Freeze®

This perfected blend of lemon and frozen mint is mighty enough to start the next Ice Age. Experience a twist on a classic mix like never before.

22. Ms Haddoudi says that the catalogues were sent to customers via a link in the email signature of the opponent's emails, although there is no evidence about the identity or number of individuals/businesses to whom the emails were sent.

23. Turnover figures for the UK and Spain are provided as follows:

Year	Trade Mark	Turnover for Spain by SMB Mundial and Oriental Shisha only	Turnover for UK
2018	MIGHTY FREEZE	6,690.25 €	£3,378.97
	WATERMELON FREEZE	3,492.00 €	£5,330.00
2019	GRAPE FREEZE	5,689.00 €	£3,070.30
	MIGHTY FREEZE	216.00€	£795.00
	WATERMELON FREEZE	1,947.00 €	£5,915.72
2020	GRAPE FREEZE	289.60€	£4,564.76
	MIGHTY FREEZE	–	£4,539.50
	WATERMELON FREEZE	209.60€	£2,526.06
2021	GRAPE FREEZE	12.80 €	£1,385.20
	MIGHTY FREEZE	377.80 €	£4,539.50
	WATERMELON FREEZE	450.00€	£2,526.06
2022	GRAPE FREEZE	1,935.00€	£1,989.82
	MIGHTY FREEZE	630.00€	£851.01
	WATERMELON FREEZE	1,890.00€	£2,320.00

24. The turnover generated in Spain in 2021 and 2022 does not count towards genuine use because it is post-Brexit. Further, the relevant period ends on 28 July 2022, however, it is not clear what proportion of the sales achieved in 2022 falls prior to the end of the relevant period, i.e. 28 July 2022. This leaves the following:

- The total value of goods sold under the mark Mighty Freeze during the relevant period is £13,251 in the UK and €6,906 in the EU;

- The total value of goods sold under the mark Watermelon Freeze during the relevant period is £16,297 in the UK and €5,648 in the EU;

- The total value of goods sold under the mark Grape Freeze during the relevant period is £9,019 in the UK and €5,978 in the EU;

25. Sample invoices are provided. They are dated on various dates in 2018, 2019, 2020, 2021 and 2022 and show sales of various products in the UK by a company called Starbuzz London Limited to customers in London, Birmingham, Harrogate, Peterborough, Luton and Hove. The goods are sold mostly under the brand STARBUZZ.[5] The earlier marks Mighty Freeze, Grape Freeze and Watermelon Freeze appear in the description of a tiny number of goods sometimes preceded by the adjective 'exotic'. Most of the invoices contain one reference to the earlier marks along with the names of other flavours as shown below:

QTY	Brand	Description	Net Price	Pckg	Unit Price	VAT	Total
1	STARBUZZ	APPLE DOPPIO/STONES-125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	BLUE MIST/STONES-125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	CITRUS MIST/STONES125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	GOLDEN GRAPE/STONES-125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	IRISH PEACH/STONES125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	MELON BLUE/STONES125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	MIGHTY FREEZE/STONES125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	PINK/STONES125G	7.50	1	9.00	1.50	9.00
1	STARBUZZ	PIRATES CAVE/STONES125G	7.50	1	9.00	1.50	9.00

QTY	Brand	Description	Net Price	Pckg	Unit Price	VAT	Total
1	SAVACCO	PURPLE RAIN 1KG	145.83	1	175.00	29.17	175.00
2	STARBUZZ	EXOTC BLUE MIST/KILO	166.67	1	200.00	66.67	400.00
1	STARBUZZ	EXOTC SEX ON THE BEACH/KILO	166.67	1	200.00	33.33	200.00
1	STARBUZZ	EXOTIC CODE 69/KILO	166.67	1	200.00	33.33	200.00
1	STARBUZZ	EXOTIC PINK /KILO	166.67	1	200.00	33.33	200.00
1	STARBUZZ	EXOTIC PIRATES CAVE/KILO	166.67	1	200.00	33.33	200.00
1	STARBUZZ	EXOTIC WATERMELON FREEZE /KILO	166.67	1	200.00	33.33	200.00
2	STARBUZZ	FRENCH ORANGE/500G	83.33	1	100.00	33.33	200.00
5	STARBUZZ	FRESH LIME 200G	37.50	1	45.00	37.50	225.00
10	STARBUZZ	GEISHA/100G	16.67	1	20.00	33.33	200.00
2	STARBUZZ	GRAPEFRUIT MINT/CITRUM/500G	83.33	1	100.00	33.33	200.00
2	STARBUZZ	PEACH MIST/500G	83.33	1	100.00	33.33	200.00
2	STARBUZZ	RASPBERRY/500G	83.33	1	100.00	33.33	200.00
5	STARBUZZ	SPICE ME RED 200G	37.50	1	45.00	37.50	225.00

[5] Other brands are also named on the invoices, including Savacco and Overdozz

26. The conclusion I draw from the evidence is that the opponent has used the earlier marks Mighty Freeze, Grape Freeze and Watermelon Freeze as the names of three flavours of tobacco and e-liquids sold under the brand STARBUZZ. This is an important point in my view when it comes to considering whether the use made by the opponent amounts to genuine use and helped the opponent to create or maintain a share of the market for goods bearing the earlier marks.

27. For it to be genuine, use must be consistent with the essential function of a trade mark which is to denote the origin of the goods or services. Furthermore, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark. In *Henkell & Co Sektkellerei KG v EUIPO,* case T-20/15, the General Court ("GC") upheld the decision of the First Board of Appeal at the EUIPO that Henkell's use of Piccolo was descriptive and therefore not in accordance with the essential function of a trade mark. Consequently, the court upheld the Board of Appeal's ruling that such use could not be accepted as genuine use of the EU trade mark PICCOLO.

28. In this case, despite the catalogues showing the earlier marks being used with a registered trade mark symbol, an examination of the documents submitted by the opponent shows that the signs Exotic Mighty Freeze, Exotic Grape Freeze and Exotic Watermelon Freeze on product packaging, and Mighty Freeze, Grape Freeze and Watermelon Freeze on catalogues and invoices, do not indicate the commercial origin of the goods, but rather their flavour. For the average consumer, the signs in question, affixed to the product help to distinguish those flavours from other flavours of the goods originating from STARBUZZ. The commercial origin of the goods is therefore the company producing the goods under the brand STARBUZZ.

29. Alternatively, if I am wrong, and FREEZE is seen as a secondary mark indicating a line of flavours distinctive of the opponent, I find as follows:

30. The turnover figures are very low in volume, amounting to £13,251 in the UK and €6,906 in the EU for goods sold under the earlier mark Mighty Freeze; £16,297 in the UK and €5,648 in the EU for goods sold under the earlier mark Watermelon Freeze, and £9,019 in the UK and €5,978 in the EU for goods sold under the earlier mark Grape Freeze. These are the total sales achieved under each earlier mark during the relevant five-years period. A further issue is that the turnover is not broken down by product. This is problematic since (a) as the applicant argued in its written submissions, the earlier marks that are subject to proof of use do not cover e-liquids products and are registered only for tobacco products and (b) the catalogues indicates that the earlier marks that are subject to proof of use have been used in relation to both e-liquids and tobacco products and (c) Ms Haddoudi did not say that the turnover relates exclusively to tobacco products. It follows from that that if the turnover includes revenue generated by the sale of e-liquids (as I think it does)[6], the proportion of turnover relating to the registered goods must be even lower. In addition, there is no indication of market share. In this connection, Mr Stutton filed evidence showing that the UK vaping market was estimated to be worth £1.32 billion in the UK in 2021; whilst, as the opponent noted in its written submissions, the vaping market is not the same as the market for tobacco, they are closely related, and I would think that the market for tobacco is very large indeed. In any event, there is very tiny proven use in the context of the relevant market as a whole. Finally, there is no indication of marketing spend for the goods sold under the earlier marks and no examples of marketing other than the catalogue evidence.

31. Taking all of the above into account, my conclusion is that the level of use shown is insufficient to create or maintain a market share under the earlier marks.

32. Since I found that the earlier marks nos. 2, 3 and 4 had not been put to genuine use, the opponent cannot longer rely on those marks. Nevertheless, the opponent is still able to pursue its opposition relying on the earlier mark no.1, which is a valid

[6] See the catalogues and invoices exhibited at MH6 and MH8 which show that the opponent's E-Juice is available in bottles the content of which is measured in ML. Whilst most of the invoices refers to KG which suggests the sale of tobacco, one of the invoices refers to the sale of GRAPE FREEZE STARBUZZ 50ML which suggests the sale of e-juices. However, Ms Haddoudi says that the invoice exhibited represents only a small example of the invoices relating to sales of the goods under the earlier marks during the relevant period.

registration that is not subject to proof of use. I will therefore consider the opposition based solely on the earlier mark no. 1.

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

35. 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

36. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

37. 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.

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

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

39. 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."

40. 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."

41. 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."

42. The applied-for goods are *tobacco free oral nicotine pouches (not for medical use)* and *snus without tobacco.* The applicant filed evidence about the use of nicotine pouches indicating that they are placed under the user's upper lip. The opponent stated that snus and nicotine pouches are products which are used as an alternative to cigarettes and that snus are a substitute tobacco product. Although neither party explained the difference between snus and nicotine pouches, I understand that they are very similar goods insofar as they are smokeless tobacco alternatives that deliver nicotine and/or other ingredients to the user, but are free from tobacco leaves and are for oral use and not for consumption.

43. The earlier mark covers *hookahs; electronic hookahs; tobacco products not including snus or nicotine pouches; tobacco not including snus or nicotine pouches; tobacco substitutes not including snus or nicotine pouches; cigarette tobacco; chewing tobacco; pipe tobacco; shisha tobacco; smokers' articles; matches; shisha pipes; electronic shisha pipes; cigars; small cigars; electronic cigars; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; liquids for electronic cigarettes; smoking pipes; steam stones for water pipes; inhalable aerosols and carrier*

substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; Tea for smoking as a tobacco substitute.

44. The applicant argued that the opponent's tobacco products are hidden from view behind a counter, normally in a cupboard or other unit, whereas the applicant's goods are on display to the public, are not subject to tobacco display legislation and may be purchased like any other consumer good with no restrictions. The applicant further argued that the respective goods are not classified as the same category of goods by the UK government because the nature of the selling process of the opponent's goods is heavily regulated, whilst the applicant's goods have no such controls placed on them.

45. The first thing to note is that although the opponent's specification covers tobacco products and excludes snus or nicotine pouches, it also covers tobacco substitutes other than snus or nicotine pouches such as, for example, non-tobacco plants suitable for smoking or used as a replacer for cigarettes, e.g. cigarettes containing tobacco substitutes. The opponent has not indicated that its specification covers other smokeless tobacco substitutes, but it might be possible that there are herbal-based replacements for chewing tobacco. The opponent's specification also covers tobacco products, including chewing tobacco, as well as electronic cigarettes and e-liquids.

46. Hence, whilst the applicant's *tobacco free oral nicotine pouches (not for medical use) and snus without tobacco* and the opponent's goods might seek the same ultimate purpose, as they are all intended to satisfy the same needs, i.e. addiction to tobacco, they have a different nature, and different methods of use. The goods are not complementary, however, insofar as the applicant's goods and some of the goods in the opponent's specification offer alternative to cigarettes and tobacco products, and target smokers of tobacco products who try to quit or look for alternatives to help quit, they target the same users and are in competition. Further, the goods are sold through the same trade channels such as shops specialised in items for smokers. Overall, I find the goods to be similar to a medium degree.

Average consumer

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

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

48. The goods at issue are tobacco substitutes. The relevant consumer is a member of the general public over the age of 18. Tobacco free nicotine pouches and snus are not regulated under rules that cover tobacco or vaping products and are available to be bought online and in shops. Visual consideration will therefore dominate the selection process for those goods. E-cigarettes and the associated liquids and flavourings can be purchased in general retail premises or in specialised vape stores. The goods are likely to be self-selected via visual means, however, since they are generally kept behind the counter, a request for the goods and then a supply by a member of staff is likely which gives rise to aural considerations. Even where this occurs, the consumer will still review the product visually. Both visual and aural considerations will, therefore, play a part in the selection process.

49. The goods are relatively low in price and there is nothing to suggest these goods are impulse purchases made without much attention. Considerations such as price, taste and nicotine content will be at the forefront of consumers' minds when selecting the goods. In my view, the degree of attention paid by the average consumer will be medium.

Comparison of marks

50. 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."

51. 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.

52. The respective marks are shown below:

The applicant's mark	**The opponent's mark**
	**FREEZE**

53. The parties have made submissions on the similarities and differences of the marks. I have considered them all in reaching my decision and will refer below to some of the arguments raised (although I do not propose to reproduce the submissions in full).

54. The earlier mark consists solely of the word FREEZE, with no stylisation or figurative elements. The overall impression of the mark rests in the word itself.

55. The applicant's mark consists of a diagonal bold line with very neat borders over which another diagonal line running in the opposite direction is superimposed, so that this element appears either as a letter X or a cross depending on how it is perceived. The superimposed diagonal line has a painted effect and is presented in shades of grey. Within the angle created on the right-hand side by the crossing lines, there are the words ROYAL FREEZE, which appear in a much smaller size on two levels, with the word ROYAL above the word FREEZE. Although the eye is naturally drawn to the element that can be read, that is only a rule of thumb and given the comparatively large size of the stylised device, I consider that the eye is drawn to the stylised device rather than the words, and that the stylised device is the more important element of the mark. In this connection, I disagree with the opponent's submission that the X device is not distinctive, striking or memorable. First, the CJEU has rejected the assumption that single letters are, a priori, devoid of distinctive character[7] confirming the approach that the distinctive character of a mark must always be assessed by reference to the goods or services in respect of which registration of the mark is sought. In this case, whichever way the device is perceived, i.e. as the letter X or a cross, it is neither descriptive nor allusive of the goods in question, which are tobacco substitutes for oral use. Second, the device is not simply the single letter X or a cross with no graphic modifications, but it is distinctively stylised. Therefore, taking all of the above into account, the X plays a greater role in the overall impression with the words ROYAL FREEZE playing a lesser role.

Visual similarity

[7] *OHMI/ Borco-Marken-Import Matthiesen* C-265/09

56. The only visual similarity between the respective marks is the word FREEZE. Further, the marks differ in the presence in the application of the dominant and distinctive X device and word ROYAL, neither of which has a counterpart in the earlier mark. Overall, I consider the marks to be visually similar to a very low degree.

Aural similarity

57. Aurally, the opponent's mark will be articulated as the word "freeze". A significant proportion of the average consumers will pronounce the device in the applicant's mark as the letter X; those consumers will refer to the mark as "X royal freeze". Of those consumers who will perceive the X device as a cross, I think a significant proportion will still try to verbalise it as the letter X, whilst some consumers (which do not represent a significant proportion of the relevant public) might only articulate the words "royal freeze". The word FREEZE will be the last word articulated in both scenarios. Overall, I find that the marks are aurally similar to a low degree (in the former scenario) or to a medium degree (in the latter scenario).

Conceptual similarity

58. The opponent states that the marks are highly similar because they share the concept conveyed by the word 'freeze', that is, something that solidifies as a result of extremely cold temperatures, whereas the word 'royal' is laudatory and would merely be perceived as an indication of superior quality without changing the conceptual perception of the applied-for mark.

59. The applicant states that whilst the reference to FREEZE will bring to mind a menthol or cooling effect, the inclusion of the dominant X device and the word 'royal' will bring to mind the concept of a superior product and the marks are conceptually dissimilar.

60. I agree with the opponent that insofar as the marks share the concept of conveyed by the word 'freeze', there is a degree of conceptual similarity. However, the word ROYAL and the X device, which I found to be dominant, cannot be regarded as negligible. Further, the words Royal and Freeze will be perceived as a unit, rather than

as independent elements, with the adjective Royal qualifying the noun Freeze, and being evocative of the monarchy and, more generally, of luxury and magnificence.

61. The applicant provided evidence that it intends to use the word FREEZE along with other words such as BREEZE, FROST, CHILL and BLAST to denote the strength of the nicotine pouches to the consumer; however, those are marketing considerations that are extraneous to the assessment I am required to make, which is based on the mark as it is applied for. Further, whilst the applicant filed evidence that other traders use the word FREEZE in relation to nicotine pouches, that does not establish that FREEZE is a word used in trade to denote the strength of the nicotine content (or was used as such at the relevant date). Overall, the marks are similar to a medium degree.

Distinctive character of earlier mark

62. 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)."

63. 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.

64. Although I found that the word FREEZE has been used descriptively by the opponent in the context of flavoured tobacco and e-liquid products sold under the marks Mighty Freeze, Grape Freeze and Watermelon Freeze, the relevant goods here are tobacco products, tobacco substitutes not including snus or nicotine pouches, and e-cigarettes and e-liquids. The earlier mark FREEZE is neither descriptive nor allusive of these goods. Consequently, I find that the earlier mark is distinctive to a medium degree.

65. There is no evidence of use of the earlier mark FREEZE alone that could have enhanced the distinctiveness of the mark through use.

Likelihood of confusion

66. 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing 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.

67. 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)."

68. 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."

69. Earlier in this decision I found that:

- the competing goods are similar to a medium degree;

- the competing marks are visually similar to a very low degree, aurally similar to a low degree (for the majority of the relevant public) or medium degree (for a non-significant proportion of the relevant public) and conceptually similar to a medium degree;

- the applied-for goods will be selected visually whereas the opponent's goods will be selected either visually, or visually and aurally, with a medium degree of attention;

- the earlier mark is distinctive to a medium degree.

70. The opponent states that when taking into account the similarity of the marks and the similarity goods, there is a high risk that consumers faced with the contested mark

containing the words ROYAL FREEZE will make an association with the opponent's FREEZE trade mark and will be confused into believing the goods emanate from the same source of origin. It states:

> "Since the Opponent's mark consists of the single plain word FREEZE, which is contained in the Contested Mark, the device element and the word ROYAL are not sufficient to create a sufficiently distinguishing difference between the marks. The Contested Mark will be perceived as a sub-brand of the Opponent's FREEZE product or as a reference to a particularly high-quality version of the goods under the FREEZE brand.
> […]
> Even if it was held that there is no likelihood of direct confusion, there is a high risk of confusion as a result of imperfect recollection because of the shared element FREEZE and non-distinctive nature of the word ROYAL, combined with the fact that consumers tend to recall the similarities between a mark rather than the differences."

71. Further, the opponent relies on the family of marks argument and states:

> "The Earlier Marks consist of the word FREEZE per se as a single word and the words MIGHTY FREEZE, GRAPE FREEZE and WATERMELON FREEZE. The Contested Mark is formed of the word FREEZE preceded by a non-distinctive laudatory word or a word which describes a character of the goods. As a result, it is likely that the relevant public will make a link between the mark ROYAL FREEZE and the Opponent's marks and will assume that ROYAL FREEZE is another mark belonging to that family. In the General Court's judgement in *II Ponte Finanziaria SpA v OHIM* it was confirmed that a mark's membership of a "family" of registered marks (i.e. which all contain a common element) might enhance its distinctiveness, provided that a sufficient number of marks has been used. In this case, the Opponent has demonstrated use of MIGHTY FREEZE, GRAPE FREEZE and WATERMELON FREEZE. The Contested Mark is similar to all of these marks. Further, the structure of the Contested Mark is the same as the Earlier Marks and features characters which associate the mark with the Earlier Marks. In other words, as a result of the

similar marks and goods and the shared features and structures of the marks, the relevant public will assume that ROYAL FREEZE is also part of the Opponent's family of 'FREEZE' marks."

72. The opponent's primary case is therefore that there is a likelihood of indirect confusion. I agree that if the opponent has any chance of success, that must be on the likelihood of indirect confusion, as the differences between the marks are too great for the average consumer to directly confuse them.

73. As it can be seen, there are multiple references in the opponent's submissions to the average consumer associating the marks or making a link. However, 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.

74. In my view, given the visual, aural and conceptual differences between the marks, the fact that the goods are not identical, but only similar to a medium degree, the dominant role played by the X device in the overall impression of the contested mark, the unitary character of the phrase ROYAL FREEZE, and its secondary role within the contested mark, there is no real risk of indirect confusion. Whilst the parties' trade marks may have the word FREEZE in common, they produce different overall impressions. As I have said, the contested mark is dominated by the X device which will be perceived as the main indicator of origin. Further, although the words Royal will be perceived as evocative of the monarchy and, more generally, of luxury and magnificence, it will still be perceived as part of the unit Royal Freeze, which is likely to be seen as a secondary indicator of origin, possibly a luxurious sub-brand used for a specific line of products by the undertaking using the X device.

75. In this connection, the evidence about the use of the earlier marks Mighty Freeze, Grape Freeze and Watermelon Freeze, does not assist the opponent as these marks have been used to indicate the flavour of the goods, rather than their origin. Consequently, even if the average consumer who has been exposed to the use of the earlier marks Mighty Freeze, Grape Freeze and Watermelon Freeze on the opponent's goods, might perceive these signs as belonging to a line of flavour distinctive of, and originating from, the opponent, it will also have been educated to identify Starbuzz as

the primary badge of origin. Given the evidence that Starbuzz has been used as a primary brand and the high inherent distinctiveness of Starbuzz as an invented word, I conclude that even considering the family of marks argument, the reality of the use made by the opponent of its family of marks and the descriptive element of such use, means that the average consumer will consider that Starbuzz is so distinctive that its absence in the contested mark signifies that the marks belong to different unconnected undertakings.

76. Hence, even if the average consumer will notice the use of the common word FREEZE as part of a sub-brand Royal Freeze within the contested mark, he/she will rely on the X device as the main indicator of origin and will consider the presence in both marks of a common word Freeze as a coincidence rather than an indicator that the goods originate from the same or economically connected undertakings.

OUTCOME

77. The opposition fail in its entirety and the mark may proceed to registration.

COSTS

78. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,000, calculated as follows:

Preparing counterstatement:	£300
Filing evidence and reviewing the other party's evidence:	£600
Written submissions:	£400
Total	£1,300

79. I therefore order Starbuzz Tobacco, Inc. to pay Imperial Tobacco Limited the sum of £1,300. 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 28th day of June 2024

TERESA PERKS

For the Registrar