O/0637/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3752701
IN THE NAME OF BURCHGROVE GROUP PTY LTD
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 3, 4 & 21

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 435238
BY STARBUZZ TOBACCO, INC.

Background and pleadings

1. On 9 February 2022, Burchgrove Group Pty Ltd ("the applicant") applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3752701 ("the applicant's mark"). Details of the application were published for opposition purposes on 29 April 2022. Registration is sought for the following goods:

> Class 3: Hair shampoo; non-medicated shampoos; shampoos (non-medicated); bath salts, not for medical purposes; cosmetic soaps; non-medicated soaps; perfumed soaps; body moisturisers; cosmetic moisturisers; moisturisers (cosmetics); non-medicated moisturisers; aromatic perfumery products; perfumery products; cosmetic skin care products; skin care preparations (cosmetic); reed diffusers; reed diffusers comprised of scented oils in a container and including reeds; aromatics (essential oils).
>
> Class 4: Candles; Christmas tree candles; fragranced candles; perfumed candles; scented candles; wicks for candles.
>
> Class 21: Reed diffusers being devices for diffusing perfume, sold empty; glass tableware; tableware (other than knives, forks and spoons); fragrance bottles; diffuser reed stick holders; candle holders; candle jars (holders).

2. On 27 July 2022, Starbuzz Tobacco, Inc. ("the opponent") partially opposed the applicant's mark under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at the goods underlined above. The opponent relies upon its UK trade mark number 918286890, **MIST** ("the opponent's mark").[1] The opponent's mark was filed on 10 August 2020 and became registered on 16 December 2020. It stands registered for goods in classes 4 and 34. Only some of those are relied upon for the purposes of the opposition, namely:

[1] The opponent's mark is a comparable trade mark based upon pre-existing EU trade mark number 18286890. On 1 January 2021, in accordance with article 54 of the Withdrawal Agreement between the UK and EU, a comparable UK trade mark was automatically created. It is now recorded on the UK register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Class 4: Candles; perfumed candles; scented candles; fruit candles; candles secreting the scent of shisha smoke; candles in tins; musk scented candles.

3. The opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the applicant's mark, it is not subject to the use requirements in section 6A of the Act.

4. In its statement of grounds, the opponent contends that the parties' goods are identical or similar and that the competing marks are similar, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement, denying the grounds of opposition. The applicant denies that all the parties' goods are identical or similar and that the competing marks are similar. Even for goods which are identical or similar, the applicant disputes that there is a likelihood of confusion.

6. Both parties are professionally represented; the opponent by Keltie LLP and the applicant by Mewburn Ellis LLP. Both parties filed evidence. No hearing was requested but both parties filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

7. 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.

Evidence and submissions

8. The applicant's evidence is given in the witness statement of Joe McAlary, dated 1 November 2023, and two exhibits (JM1-JM2). Mr McAlary is a Trade Mark Attorney

with the applicant's representatives. He gives evidence regarding the meaning of the letters 'ST', resulting from internet research conducted on 20 October 2023.

9. The opponent filed evidence in reply in the form of a witness statement from Rosemary Cardas, dated 18 December 2023, and five exhibits (RC1-RC5). Ms Cardas is a Trade Mark Attorney with the opponent's representatives. She gives evidence about word marks being used without their vowels, obtained via internet research conducted on 15 December 2023.

10. Both parties filed written submissions on 30 January 2024.

11. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

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

12. Sections 5(2)(b) and 5A of the Act read 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."
>
> "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."

13. 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

14. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, […] 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."

15. Furthermore, the relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods also include an assessment as to the respective users and trade channels.

16. 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 General Court ("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."

17. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods 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/services is to assess whether the relevant public are liable to believe that responsibility for the goods/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."

18. In addition, the law requires that goods be considered identical where one party's description of its goods encompasses the specific goods covered by the other party's description (and vice versa).[2]

19. The goods to be compared are as follows:

The opponent's goods	**The applicant's goods**
Class 4: Candles; perfumed candles; scented candles; fruit candles; candles	Class 3: Aromatic perfumery products; perfumery products; reed diffusers; reed

[2] *Gérard Meric v OHIM,* Case T-33/05

secreting the scent of shisha smoke; candles in tins; musk scented candles.	diffusers comprised of scented oils in a container and including reeds. Class 4: Candles; Christmas tree candles; fragranced candles; perfumed candles; scented candles; wicks for candles. Class 21: Reed diffusers being devices for diffusing perfume, sold empty; diffuser reed stick holders; candle holders; candle jars (holders).

Class 3

20. The applicant's *aromatic perfumery products; perfumery products* may overlap in nature with the opponent's *candles* to the extent that they may all be made from wax (the former could include goods such as scented wax melts). The method of use of the respective goods is different, though I consider there to be an overlap in intended purpose. This is because both parties' goods could be used for providing a pleasant scent. They are likely to reach the market through overlapping trade channels and may be in close proximity in retail outlets. The respective goods are not important or indispensable to one another. As such, they are not complementary. Nevertheless, a consumer may select the applicant's products over a scented candle, and vice versa. Therefore, there is a degree of competition between them. They will also have the same users. Overall, I find that there is between a medium and high degree of similarity between the respective goods.

21. The applicant's *reed diffusers; reed diffusers comprised of scented oils in a container and including reeds* differ in nature and method of use when compared with the opponent's *candles*. The former are typically containers filled with essential oils, into which strips of material are placed to absorb and diffuse the scent, whereas the latter are wax candles with wicks which are lit. However, as the respective goods may be used for their pleasant scent, they overlap in intended purpose. They are likely to

share trade channels and will be located in the same sections of retail outlets. The respective goods are not complementary, since they are neither important nor indispensable to one another. However, given the overlap in purpose, a consumer could select one over the other. Accordingly, there is a degree of competition between them. The respective goods also share users. In light of all this, I find that there is a medium degree of similarity between the respective goods.

Class 4

22. *'Candles'* appears in both parties' specifications. As conceded by the applicant, these goods are plainly identical.

23. The applicant accepts that its *Christmas tree candles; fragranced candles; perfumed candles; scented candles* fall within the opponent's broader term *candles.* These goods are to be regarded as identical.

24. Whilst the applicant's *wicks for candles* are not the same as the opponent's *candles*, there is an overlap in nature since candles typically incorporate wicks. There is also a general overlap in intended purpose and method of use. This is because the respective goods will be lit to produce light or a pleasant scent. The respective goods are likely to reach the market through the same trade channels and producers. There is no material competition between them because a consumer is unlikely to purchase a wick instead of a finished candle. I do, however, consider there to be a complementary relationship. This is because wicks are important to candles, and the relationship between them is such that consumers are likely to believe that responsibility for them lies with the same undertaking. Users are also likely to overlap. Taking all of this into account, I find that there is between a medium and high degree of similarity between the respective goods.

Class 21

25. The applicant's *candle holders; candle jars (holders)* differ in nature, method of use and purpose when compared with the opponent's *candles*. However, they are likely to share trade channels and be located in close proximity in retail outlets. The

respective goods also share users. They are not in competition as a consumer is extremely unlikely to purchase a candle holder instead of a candle, and vice versa. Nevertheless, I consider there to be a degree of complementarity between them. This is because candles are important to the use of candle holders and consumers may believe that responsibility for them lies with the same undertaking. This is particularly the case considering that it is not uncommon for producers of candles to also produce holders for their candles. They may also be sold together in sets. In light of all this, I find that there is between a medium degree of similarity between the respective goods.

26. As for *reed diffusers being devices for diffusing perfume, sold empty; diffuser reed stick holders*, these differ in nature, method of use and intended purpose when compared with the opponent's *candles*. These goods are not important or indispensable to one another and are not, therefore, complementary. Moreover, there is no direct competition between them. This is because the applicant's goods are sold empty, and in order to provide a pleasant scent, additional items must be purchased. However, the respective goods are likely to share trade channels and may be located in the same sections of retail outlets. They also share users. On this basis, I find that there is a low degree of similarity between the respective goods.

Average consumer and the nature of the purchasing act

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

28. The goods at issue in these proceedings are available to the general public. The goods may be purchased relatively frequently and, overall, are not overly expensive. However, the average consumer may consider factors such as cost, scent, ingredients, longevity and aesthetics when selecting the goods. Overall, I find that the average consumer will demonstrate a medium level of attention. The goods are typically purchased from retail establishments and their online equivalents, after being viewed on shelves or on websites. As such, it is my view that the purchasing process is predominantly visual in nature. However, I do not exclude aural considerations entirely as the average consumer may receive word-of-mouth recommendations or discuss the products with sales assistants.

Distinctive character of the earlier mark

29. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee*, paragraph 51)."

30. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

31. Although the distinctive character of a mark may be enhanced as a result of it having been used in the market, the opponent has not filed any evidence of use. As a consequence, I have only the inherent position to consider.

32. The opponent's mark is in word-only format and consists of the word 'MIST'. This is the only element which contributes to the distinctiveness of the mark. The word 'MIST' is an ordinary dictionary word which will be understood as referring to a thin fog which is produced by small drops of water collecting in the air. The applicant argues that it is highly allusive of the opponent's goods and, therefore, low in distinctive character. This is on the basis that:

"[…] a scent or fragrance could be said to be pleasant mist in the air, and the word MIST will create an image in the consumers mind of air which is refreshing. The word MIST also brings to mind images of scented mists which may be associated with room fragrancing."

33. I disagree. The potential messages described by the applicant are, in my view, far too indirect and ambiguous. This is particularly the case, given that there is no obvious connection between mist or refreshing air and the goods relied upon, i.e. candles. The average consumer is not likely to extract such messages from the mark upon immediate perception, that is, without further thought or analysis. I consider it far more likely that the average consumer would simply perceive the opponent's mark in

accordance with its dictionary meaning. To my mind, the word has no allusive or descriptive qualities. Overall, I find that the opponent's mark possesses a medium level of inherent distinctive character.

Comparison of trade marks

34. It is clear from *Sabel* 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 *Bimbo* 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."

35. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

36. Before proceeding with the comparison, it is convenient to first deal with the parties' evidence on how the average consumer may perceive the applicant's mark.

37. Mr McAlary produces the results of Google searches for the terms "St meaning UK" and "Street signs UK".[3] It consists of printouts from the Cambridge Dictionary and Wikipedia, which state that "St." is a written abbreviation for the word "street"; printouts from chaptertwoantiques.co.uk and room8interiors.co.uk, which show street signs for

[3] Exhibit JM1

"LOMBARD ST." and "CHARLESS II ST." for sale; and articles and images about various streets/street signs in the UK, such as "PRINCESS ST", "MANCHESTER ST.", "BANK ST.", "GARNET ST.", "KEMBLE ST.", "Liverpool St.", and "MERMAID ST.". He also evidences printouts from Google Maps of locations in the UK,[4] including Manchester, London, Birmingham, Edinburgh and Belfast. Many street names include the abbreviation "St" for the word "street".

38. This evidence is from after the relevant date, and is, therefore, of limited probative value. Further, it does not establish that the average consumer will readily see the letters as an abbreviation for street in all circumstances, such as, in this case, where the letters 'ST' follow a single letter (as opposed to a word). In addition, there is no evidence of this practice being used in connection with the goods at issue in these proceedings. Whilst the evidence supports my own understanding that the letters 'ST' are widely used as an abbreviation for the word 'street' in the context of geographic locations in the UK, it does not, in my view, establish that the average consumer will perceive the letters in the applicant's mark in this manner. Although it is possible that some individuals might, I do not consider those individuals to be sufficiently numerous to constitute a significant proportion of consumers.

39. Ms Cardas' evidence in reply seeks to show that there is a trend for omitting vowels in brand names. It consists of the following:

i) Google search results for the term "brand names without vowels".[5]

ii) An article from *Food Quality and Preference* from April 2022 entitled 'Evaluating brand names without vowels'.[6] The author states that a new trend has emerged where undertakings have begun using brand names without the vowels. Their study sought to understand how consumers in the food market would perceive brands with vowels vs those without. The author says that the use of brands without vowels is common in social media, the food/beverage market and the technology market.

[4] Exhibit JM2
[5] Exhibit RC1
[6] Exhibit RC2

iii) An article from *Financial Times* dated 30 April 2021 entitled 'Msg to brnd xprts: ditch vowels at your peril'.[7] It discusses Standard Life Aberdeen's rebranding to Abrdn. It characterises it as a nod to the texting and chat app habit and a pastiche to the web trend (referencing undertakings such as Flickr, Grindr and Tickr).

iv) An article from *The Guardian* dated 2 May 2021 entitled 'Why Abrdn's loss of vowels is not such a 'rdcls' rebrand'.[8] The author says that the rebrand fits into a long tradition of reduced-vowel spelling, citing Irn-Bru (1946). They also say that "[…] we learned to recognise tmrw as tomorrow and rlly as really".

v) Printouts from a selection of undertakings using brands without vowels, including, *inter alia*, LNDR, flickr, tumblr and Nike SNKRS.[9] They are used in connection with clothing, social media, financial services and software. The websites all have '.com' domains.

40. The opponent argues that this evidence establishes the applicant's mark will be perceived as a short version or misspelling of the word mist. I disagree. Firstly, much of the evidence is from after the relevant date, meaning that it is limited in terms of probative value. In respect of the Google search results, it is my understanding that internet searches use algorithms which become tailored to a user based upon their search history; search results will also vary over time and are dependent upon who is doing the search. These, too, are of limited probative value. Although the evidence does support my own impression that some undertakings' trade marks contain no vowels, there is no evidence that this is the case in the relevant market or that consumers of candles, for example, have become accustomed to it. As an aside, one of the articles from before the relevant date indicates that recognising the abbreviated form as the full word is something that is learned; to my mind, this points away from the average consumer seeing the applicant's mark and immediately perceiving it as the word mist. Crucially, there is a distinct lack of evidence of 'MIST' being abbreviated

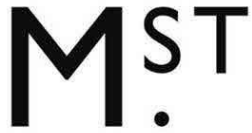
[7] Exhibit RC3
[8] Exhibit RC4
[9] Exhibit RC5

in any way. Whilst it is, of course, possible that some individuals do see the applicant's mark in the way suggested by the opponent, I do not consider them to constitute a significant proportion of relevant consumers.

41. I should add that I am not persuaded otherwise by the excerpt from the Intellectual Property Enterprise Court's judgement contained in the opponent's written submissions.[10] Arnold J (as he then was) readily accepted that consumers in the UK (particularly younger consumers) are in the habit of writing and reading abbreviations in digital forms of communication such as texts, messages, tweets and Instagram posts, and in particular abbreviations in which vowels are omitted from words. Nevertheless, he also stated that such abbreviations can be used and understood because the context makes the intended meaning clear. To my mind, there is nothing in the applicant's mark which indicates that the letters 'MST' are intended to be the word mist, even less so when accounting for its configuration. The opponent claims that the circle/dot device gives the impression of a letter 'I' on first glance. I do not agree. Firstly, as I will come on to below, the circle/dot device plays a much lesser role in the applicant's mark and might be overlooked. Perhaps more pertinently, whilst I accept that the lower-case letter 'i' includes a dot, I can see no reason why the average consumer would assume that the device is, or representative of, a letter 'I'. This is because a) there is no vertical line, only the dot, b) it is below another letter, c) it is at the bottom of the mark, not where one would expect the dot of an 'i' to be, and d) the letters in the mark are presented in upper case. The applied-for goods also do not provide the requisite context, and no evidence of the applicant's use is before me. Without any context, if seen as an abbreviation with no vowels at all, the applicant's mark could just as reasonably be seen as the words 'most', 'must' or 'mast'. However, I do not believe that the applicant's mark will be perceived as any such abbreviations.

42. The marks to be compared are as follows:

[10] *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC 1893 (Ch), paragraphs 29-30

The opponent's mark	The applicant's mark
MIST	

Overall impressions

43. The opponent's mark is in word-only format and consists of the word 'MIST'. As it is the only element of the mark, the overall impression lies in the word itself.

44. The applicant's mark is figurative and comprises the letters 'MST'. The 'M' is largest, whilst the 'S' and 'T' are presented in a smaller font. A circle/dot device appears below the 'S'. The overall impression is dominated by the combination of the letters 'MST', whereas the device plays a much lesser role.

Visual comparison

45. The applicant argues that its mark is visually dissimilar to the opponent's mark. I disagree. The competing marks share three letters in the same order, i.e. 'M' and 'ST'. The respective beginnings and endings of the marks are identical. The competing marks are visually different insofar as the opponent's mark contains the letter 'I', whilst the applicant's mark includes a circle/dot device. The letters 'ST' in the applicant's mark are also presented in a smaller font. Bearing in mind my assessment of the overall impressions, I find that there is a relatively high degree of visual similarity between the competing marks.

Aural comparison

46. The opponent's mark consists of the word 'MIST', which will be given its ordinary English pronunciation. As I consider it unlikely that consumers will perceive the applicant's mark as a misspelling or shortening of the word 'MIST', it follows that they

will not pronounce it as such. Rather, the letters in the applicant's mark are likely to be articulated individually. The applicant has argued that, irrespective of the pronunciation of its mark, the competing marks are aurally dissimilar. Again, I disagree. The competing marks contain similar sounds resulting from the letters 'M', 'S' and 'T'. Although these are separated in the applicant's mark and will be pronounced phonetically, as opposed to forming a word, overall, I find that there is a medium degree of aural similarity between the competing marks.

Conceptual comparison

47. The opponent's mark is a dictionary word which will be understood as referring to a thin fog which is produced by small drops of water collecting in the air. The letters 'MST' in the applicant's mark do not have any obvious meaning other than their existence as letters in the English alphabet. The opponent's mark conveys a concept which is not replicated by the applicant's mark. Therefore, insofar as the competing marks convey any meanings, they are conceptually dissimilar.

Likelihood of confusion

48. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods down to the responsible undertakings being the same or related.

50. Earlier in this decision, I concluded that:

- The parties' goods are identical or similar to at least a low degree;
- The average consumer is a member of the general public, who will demonstrate a medium level of attention;
- The purchasing process is predominantly visual in nature, though aural considerations have not been excluded;
- The opponent's mark has a medium level of inherent distinctive character;
- The overall impression of the opponent's mark is dominated by the word 'MIST';
- The overall impression of the applicant's mark is dominated by the combination of the letters 'MST', whereas the device plays a much lesser role;
- There is a relatively high degree of visual similarity and a medium degree of aural similarity between the competing marks;
- The competing marks are conceptually dissimilar.

51. I acknowledge that the three letters which comprise the applicant's mark are present in the opponent's mark and that they appear in the same order. Nevertheless, there are differences between the marks which are not negligible. The opponent's mark contains the letter 'I', which has no counterpart in the applicant's mark. Whilst the circle/dot device in the applicant's mark plays a much lesser role, and may be overlooked by the average consumer, I do not believe that the letter 'I' would be overlooked. Although the competing marks both begin with the letter 'M', and the

beginnings of marks tend to have more impact,[11] this is not necessarily decisive.[12] It is my view that the letter 'I' in the opponent's mark will enable the average consumer to differentiate between them. This is particularly the case, given that the competing marks as wholes are conceptually dissimilar; the opponent's mark will be perceived as the dictionary word 'MIST', and will convey its well-known meaning. Conversely, the letters 'MST' in the applicant's mark convey no discernible meaning. Where the meaning of at least one of the two marks at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those marks may counteract the visual and phonetic similarities between them.[13] Although I accept that conceptual differences do not always overcome visual and aural similarities, I certainly consider that to be the case here. Finally, despite there being no special test for 'short' marks,[14] the opponent's mark and the applicant's mark consist of only four and three letters, respectively. Due to the brevity of the marks, the average consumer is more likely to notice the differences between them.[15] Taking all the above factors into account, it is my view that the aforementioned differences between the competing marks are likely to be sufficient for the average consumer, paying a medium level of attention during the purchasing process, to distinguish between them and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to identical goods.

52. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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

[11] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[12] *CureVac GmbH v OHIM*, T-80/08
[13] *The Picasso Estate v OHIM*, Case C-361/04 P, paragraph 20
[14] *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraphs 38 and 43
[15] Case T-274/09 *Deutsche Bahn v OHIM*, paragraph 78, and Case T-304/10 *dm-drogerie markt v OHIM*, paragraph 42

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).”

53. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.[16] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element.

[16] As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

In this connection, it is not sufficient that a mark merely calls to mind another mark.[17] It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.[18]

54. Applying these principles, I do not believe that the average consumer, having noticed the differences between the competing marks, will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing marks; I am unconvinced that consumers would assume a commercial association or licencing agreement between the parties, or sponsorship on the part of the opponent, due to the shared letters 'M', 'S' and 'T'. The word 'MIST' is not so strikingly distinctive that the average consumer would assume that only the opponent would be using it in a trade mark. Neither are the letters 'M', 'S' and 'T', and the average consumer would not dissect the opponent's mark and separate these letters from the mark as a whole in any event. This would involve a level of analysis not typically conducted by the average consumer upon immediate perception of trade marks. Further, the differences between the competing marks are not simply adding or removing non-distinctive elements. Although the inclusion of a circle/dot device could be perceived as use of a variant mark with an additional decorative element, I can see no reason why an undertaking would dissect the word 'MIST', which forms a singular word with a clear meaning, and remove one of the letters, resulting in a conceptually neutral combination of letters. Whilst indirect confusion is not limited to the three categories outlined in *L.A. Sugar*, to my mind, there is no other basis for concluding that the average consumer would assume an economic connection between the parties. For the avoidance of doubt, this includes the removal of the vowels from the opponent's mark. I have already discussed this point above, but for the purposes of the global comparison I will simply record that there is nothing before me which suggests that there is any real risk that the average consumer of the goods at issue in these proceedings would perceive the marks in this manner. In light of all this, I do not consider there to be a likelihood of indirect confusion between the competing marks, even in relation to goods that are identical.

[17] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[18] See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

Conclusion

55. The opposition under section 5(2)(b) has been unsuccessful. Subject to any appeal against this decision, the applicant's mark will proceed to registration in the UK.

Costs

56. As the applicant has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.[19] In the circumstances, I award the applicant the sum of **£1,100** which is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£250
Considering the opponent's evidence and preparing evidence	£500
Preparing written submissions	£350
Total	**£1,100**

57. I order Starbuzz Tobacco, Inc. to pay Burchgrove Group Pty Ltd the sum of **£1,100**. This is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 5th day of July 2024

James Hopkins
For the Registrar

[19] These proceedings having commenced after 1 July 2016 but before 1 February 2023.