

O/0659/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3964031

BY LUNA CORPORATE SPÓŁKA Z OGRANICZONĄ ODPOWIEDZIALNOŚCIĄ

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 34

AND

THE OPPOSITION THERETO UNDER NUMBER 445030

BY SUPREME IMPORTS LIMITED

Background and pleadings

1. On 5 October 2023, Luna Corporate Spółka Z Ograniczoną Odpowiedzialnością (“the applicant”) applied to register the trade mark no. 3964031 for the mark shown on the cover page in the UK. It was accepted and published in the Trade Marks Journal on 3 November 2023 in respect of the following goods:

Class 34: Tobacco-free nicotine pouches; Tobacco pouches; Tobacco and tobacco substitutes; Cigarettes and Cigars; Electronic cigarettes; Articles for use with tobacco; Smokeless tobacco; Tobacco products; Tobacco and tobacco products (including substitutes); Articles for use with tobacco; Herbs for smoking; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Devices for heating tobacco for the purpose of inhalation; Devices for heating tobacco substitutes for the purpose of inhalation; Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco; Snus with tobacco; Snus; Tobacco substitutes not for medical purposes; Tobacco substitutes; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Oral vaporizers for smokers; Cigarette tips; Cigarette tips; Books of cigarette papers; Cigars; Cigar holders; Cigarettes containing tobacco substitutes, not for medical purposes; Cigarettes; Pocket-size cigarette rolling machines; Cigarillos; Flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; Tobacco jars; Humidors; Electronic cigarettes; Tobacco; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin.

2. On 3 January 2024, Supreme Imports Limited (“the opponent”) opposed the trade mark based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK trade marks:

1.

The logo consists of the text "88vape." in a bold, sans-serif font. The "88" is in a lighter grey, and "vape." is in a darker grey.The logo consists of the text "88vape." in a bold, sans-serif font. The "88" is in red, and "vape." is in grey.

(series of two)

UK registration number: UK00003592459

Filing date: 8 February 2021

Registration date: 25 June 2021

(“the opponent’s earlier ‘459 registration”)

The following goods are relied on for this opposition:

Class 9: Chargers and batteries for electronic smokers' articles.

Class 34: Personal vaporisers and electronic cigarettes, flavourings and solutions therefor, smokeless cigarette vaporizer pipes, oral vaporizers for smokers, tobacco products for the purpose of being heated, electronic devices for the purpose of heating cigarettes or tobacco, cases and boxes for cigarettes and electronic cigarettes, flavourings for electronic cigarettes and vaporisers, liquids for electronic cigarettes, flavoured nicotine fluids for vaporisers, herbs (smoking), other than for medical purposes, refills and cartridges for electronic cigarettes, atomisers for smoking and inhalation, substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes, holders for electronic cigarettes, holders for electronic devices used for heating tobacco, lighters for smokers, matches, smokers articles; parts and fittings for all the aforesaid goods.

Class 35: Shop retail services, mail order retail services and electronic shopping retail services connected with the sale of personal vaporisers and electronic cigarettes, flavourings and solutions therefor, smokeless cigarette vaporizer pipes, oral vaporizers for smokers, tobacco products for the purpose of being heated, electronic devices for the purpose of heating cigarettes or

tobacco, cases and boxes for cigarettes and electronic cigarettes, flavourings for electronic cigarettes and vaporisers, liquids for electronic cigarettes, flavoured nicotine fluids for vaporisers, herbs (smoking), other than for medical purposes, refills and cartridges for electronic cigarettes, atomisers for smoking and inhalation, substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes, holders for electronic cigarettes, holders for electronic devices used for heating tobacco, lighters for smokers, matches, smokers articles, chargers and batteries for electronic smokers articles, electronic order processing services, advisory, consultancy and information services relating to all the aforesaid.

2. 88vape

UK comparable¹ registration number: UK0000917579632

Filing date: 11 December 2017

Registration date: 20 April 2018

(“the opponent’s earlier ‘632 registration”)

The following goods are relied on for this opposition:

Class 34: Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; electronic cigarettes; parts, fittings and accessories for electronic cigarettes; smokeless cigarette vaporizer pipes; parts, fittings and accessories for smokeless cigarette vaporizer pipes; oral vaporizers for smokers; parts, fittings and accessories for oral vaporizers for smokers; cases for cigarettes and electronic cigarettes; flavourings for electronic cigarettes and vaporisers; flavoured nicotine fluids for vaporisers; herbs (smoking -), other than for medical purposes; refills and cartridges for electronic cigarettes; atomisers for smoking and inhalation; substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes.

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 right holders with an existing EUTM. As a result of the opponent’s EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

3. 88vape

UK registration number: UK00003071511

Filing date: 8 September 2014

Registration date: 5 December 2014

(“the opponent’s earlier ‘511 registration”)

The following goods are relied on for this opposition:

Class 34: Electronic cigarettes; smokeless cigarette vaporizer pipes; parts, fittings and accessories for electronic cigarettes; cases for cigarettes and electronic cigarettes; flavourings for electronic cigarettes and vaporisers; flavoured nicotine fluids for vaporisers; herbs (smoking -), other than for medical purposes; refills and cartridges for electronic cigarettes; atomisers for smoking and inhalation; substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes.

3. By virtue of their earlier filing dates, the above registrations constitute earlier marks in accordance with section 6 of the Act. Although the opponent’s third mark had been registered for more than five years at the filing date of the applicant’s mark, the applicant has not requested for the opponent to provide proof of use. As such, the opponent may rely upon all of the goods and services set out above.

4. Under section 5(2)(b), the opponent claims that the respective goods and services are identical or highly similar and that the marks are similar. As such, the opponent submits there will be a likelihood of confusion between the marks, including a likelihood of association.

5. The applicant filed a counterstatement in which they concede that the goods and services are similar (but not identical), but that the differences in the marks result in no confusion between the marks.

6. The opponent is represented by HGF Limited. The applicant is represented by Ewelina Jasion.²

² When filing their Form TM8, the applicant was represented by Pravna. This representation was changed to Ewelina Jasion by filing a Form TM33 on 11 December 2024.

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

8. The opponent's evidence was filed in the form of a witness statement, dated 8 July 2024. This was filed by Sandeep Singh Chadha, a Director at Supreme Imports Ltd. The witness statement includes nineteen exhibits labelled EXH 1-19. The purpose of the evidence is to support the opponent's claims that the distinctiveness of its earlier marks have been enhanced through the use made of them.

9. The applicant did not file evidence.

10. I do not intend to summarise the evidence filed by the opponent in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Decision

Section 5(2)(b)

11. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Section 5A

12. 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.”

The principles

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the Page 5 of 17 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 comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

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

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

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP

TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. Further, in *Kurt Hesse v OHIM*,³ 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*,⁴ the GC stated that "complementary" means:

"...there is 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."

19. With this in mind, the goods and services for comparison are as follows:

Opponent's goods and services:	Applicant's contested goods and services:
<p>The opponent's earlier '511 registration:</p> <p><i>Class 34: Electronic cigarettes; smokeless cigarette vaporizer pipes; parts, fittings and accessories for electronic cigarettes; cases for cigarettes and electronic cigarettes; flavourings for electronic cigarettes and vaporisers; flavoured nicotine fluids for vaporisers;</i></p>	<p><i>Class 34: Tobacco-free nicotine pouches; Tobacco pouches; Tobacco and tobacco substitutes; Cigarettes and Cigars; Electronic cigarettes; Articles for use with tobacco; Smokeless tobacco; Tobacco products; Tobacco and tobacco products (including substitutes); Articles for use with tobacco; Herbs for smoking;</i></p>

³ Case C-50/15 P

⁴ Case T-325/06

<p><i>herbs (smoking -), other than for medical purposes; refills and cartridges for electronic cigarettes; atomisers for smoking and inhalation; substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes.</i></p>	<p><i>Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Devices for heating tobacco for the purpose of inhalation; Devices for heating tobacco substitutes for the purpose of inhalation; Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco; Snus with tobacco; Snus; Tobacco substitutes not for medical purposes; Tobacco substitutes; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Oral vaporizers for smokers; Cigarette tips; Cigarette tips; Books of cigarette papers; Cigars; Cigar holders; Cigarettes containing tobacco substitutes, not for medical purposes; Cigarettes; Pocket-size cigarette rolling machines; Cigarillos; Flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; Tobacco jars; Humidors; Electronic cigarettes; Tobacco; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin.</i></p>
<p>The opponent's earlier '632 registration:</p> <p><i>Class 34: Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; electronic cigarettes; parts, fittings and accessories for electronic cigarettes; smokeless cigarette vaporizer pipes; parts, fittings and accessories for smokeless cigarette vaporizer pipes; oral vaporizers for smokers; parts, fittings and accessories for oral vaporizers for smokers; cases for cigarettes and electronic cigarettes; flavourings for electronic cigarettes and vaporisers; flavoured nicotine fluids for vaporisers; herbs (smoking -), other than for medical purposes; refills and cartridges for electronic cigarettes; atomisers for smoking and inhalation; substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes.</i></p>	<p><i>Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Devices for heating tobacco for the purpose of inhalation; Devices for heating tobacco substitutes for the purpose of inhalation; Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco; Snus with tobacco; Snus; Tobacco substitutes not for medical purposes; Tobacco substitutes; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Oral vaporizers for smokers; Cigarette tips; Cigarette tips; Books of cigarette papers; Cigars; Cigar holders; Cigarettes containing tobacco substitutes, not for medical purposes; Cigarettes; Pocket-size cigarette rolling machines; Cigarillos; Flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; Tobacco jars; Humidors; Electronic cigarettes; Tobacco; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin.</i></p>
<p>The opponent's earlier '459 registration:</p>	<p><i>Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Devices for heating tobacco for the purpose of inhalation; Devices for heating tobacco substitutes for the purpose of inhalation; Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco; Snus with tobacco; Snus; Tobacco substitutes not for medical purposes; Tobacco substitutes; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Oral vaporizers for smokers; Cigarette tips; Cigarette tips; Books of cigarette papers; Cigars; Cigar holders; Cigarettes containing tobacco substitutes, not for medical purposes; Cigarettes; Pocket-size cigarette rolling machines; Cigarillos; Flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; Tobacco jars; Humidors; Electronic cigarettes; Tobacco; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin.</i></p>

Class 9: Chargers and batteries for electronic smokers' articles.

Class 34: Personal vaporisers and electronic cigarettes, flavourings and solutions therefor, smokeless cigarette vaporizer pipes, oral vaporizers for smokers, tobacco products for the purpose of being heated, electronic devices for the purpose of heating cigarettes or tobacco, cases and boxes for cigarettes and electronic cigarettes, flavourings for electronic cigarettes and vaporisers, liquids for electronic cigarettes, flavoured nicotine fluids for vaporisers, herbs (smoking), other than for medical purposes, refills and cartridges for electronic cigarettes, atomisers for smoking and inhalation, substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes, holders for electronic cigarettes, holders for electronic devices used for heating tobacco, lighters for smokers, matches, smokers articles; parts and fittings for all the aforesaid goods.

Class 35: Shop retail services, mail order retail services and electronic shopping retail services connected with the sale of personal vaporisers and electronic cigarettes, flavourings and solutions therefor, smokeless cigarette vaporizer

pipes, oral vaporizers for smokers, tobacco products for the purpose of being heated, electronic devices for the purpose of heating cigarettes or tobacco, cases and boxes for cigarettes and electronic cigarettes, flavourings for electronic cigarettes and vaporisers, liquids for electronic cigarettes, flavoured nicotine fluids for vaporisers, herbs (smoking), other than for medical purposes, refills and cartridges for electronic cigarettes, atomisers for smoking and inhalation, substances for smoking sold separately or blended with tobacco or nicotine, none being for medicinal or curative purposes, holders for electronic cigarettes, holders for electronic devices used for heating tobacco, lighters for smokers, matches, smokers articles, chargers and batteries for electronic smokers articles, electronic order processing services, advisory, consultancy and information services relating to all the aforesaid.

20. At this stage, I will not compare all of the contested goods with goods and services under each earlier mark, and I will instead consider only those which are most similar to the contested goods from the three earlier marks relied upon. However, I will return to this point to determine the exact level of similarity in respect of each earlier mark if it becomes necessary to do so.

21. In their submissions in lieu, the opponent argues that the contested goods are identical to the earlier goods and highly similar to the earlier services.

22. The applicant's counterstatement concedes that the goods and services are similar, though not identical. I will therefore conduct my own assessment as to the level of similarity or identity between the goods below.

Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Electronic cigarettes; Oral vaporizers for smokers; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin. Flavourings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils, for tobacco

23. The above goods are either self-evidently identical to or considered to fall within the scope of the 'personal vaporisers and electronic cigarettes, flavourings and solutions therefor' under the opponent's earlier '459 and '632 registrations, and 'electronic cigarettes; flavourings for electronic cigarettes and vaporisers' under the opponent's earlier '459 registration. These goods are therefore considered identical either self-evidently, or according to the principles set out in *Meric*.⁵

Devices for heating tobacco for the purpose of inhalation

24. The above goods are considered to fall within the scope of the 'electronic devices for the purpose of heating cigarettes or tobacco' under the opponent's '459 earlier registration. These goods are therefore considered identical according to the principles set out in *Meric*.⁶

Tobacco products

25. 'Tobacco products for the purpose of being heated' under the opponent's '459 earlier registration fall into the scope of the above goods. These goods are therefore considered identical according to the principles set out in *Meric*.⁷

⁵ Case T-133/05

⁶ Case T-133/05

⁷ Case T-133/05

Cigarettes and Cigars; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Cigars; Cigarettes; Cigarillos

26. The above goods are all articles for smoking, which can include tobacco or tobacco-substitute products. I do not consider that the scope of these includes 'tobacco products for the purpose of being heated' because heated tobacco devices heat the tobacco rather than burning it, as is typically the case with the above goods.

27. These goods are most similar to the opponent's 'tobacco products for the purpose of being heated' under the opponent's earlier '459 registration. The purpose of the goods overlaps as all the goods are intended to allow the consumer to inhale tobacco, and differs where the above goods are burnt, while the opponent's goods are heated to enable the user to inhale the tobacco. The users overlap as all of the goods will be purchased by members of the general public wanting to consume tobacco. The nature of the goods overlaps to a degree as the above goods are typically tobacco leaves and filters encased in paper and the opponent's goods are sticks containing tobacco encased in a wrapper or casing. The nature differs where the opponent's goods further comprise a heating element. The goods may be sold in the same retail outlets to the same consumer. There is a potential for competition between them to the extent that persons who have developed a nicotine addiction may buy either cigarettes, cigars, or other ready-for-use smoking articles, or tobacco products for the purpose of being heated to allow them to consume tobacco or tobacco-substitutes. The goods are not complementary in the sense described by the case law. Therefore, I find these goods to be similar to a high degree.

28. I will also compare the above goods to 'electronic cigarettes' under all the opponent's earlier registrations. Although the nature of the goods differs, there is a clear overlap in purpose with the opponent's 'electronic cigarettes' as all the goods are intended to allow a user to consume tobacco or an alternative. Both goods are inhaled, although the electronic cigarette liquids are vaporised, while the above goods are typically burnt. The users overlap as all of the goods will be purchased by members of the general public wanting to consume tobacco. The goods may be sold in the same retail outlets to the same consumer. There is a potential for competition between them to the extent that persons who have developed a nicotine addiction may buy either cigarettes, cigars, or other ready-for-use smoking articles, or electronic cigarettes to

allow them to consume tobacco or tobacco-substitutes. The goods are not complementary in the sense described by the case law. Therefore, I find these goods to be similar to a medium degree.

Tobacco and tobacco products (including substitutes); Tobacco substitutes not for medical purposes; Tobacco substitutes; [...] tobacco substitutes; Tobacco; Tobacco [...]

29. The above products fall into four categories: tobacco; tobacco products; tobacco substitutes; and tobacco substitute products.

30. 'Tobacco products for the purpose of being heated' under the opponent's '459 earlier registration is considered to fall within the scope of the above 'tobacco products'. These goods are therefore considered identical according to the principles set out in *Meric*.⁸

31. The above 'tobacco' is most similar to 'tobacco products for the purpose of being heated' under the opponent's '459 earlier registration. These goods are tobacco products that are heated rather than burnt. They include tobacco, as well as a means of heating the tobacco. The nature overlaps as the tobacco products include tobacco but differ where the tobacco products also comprise a heating means. Methods of use and purposes overlap as both can be heated to consume tobacco. The users overlap as both will be used by members of the public wanting to consume tobacco. The goods are likely to be sold in the same retail outlets to the same consumer. There is a potential relationship of competition between them to the extent that persons wishing to consume tobacco may purchase the tobacco itself for use in cigarettes or other products, or they may buy a tobacco product for the purpose of being heated. The production of tobacco products for the purpose of being heated requires tobacco and it is likely that a consumer would conclude that both goods would originate from the same entity. The goods are therefore complementary. Overall, I consider that the above 'tobacco' is highly similar to the opponent's 'tobacco products for the purpose of being heated'.

⁸ Case T-133/05

32. 'Herbs (smoking -), other than for medical purposes' under all three of the opponent's earlier registrations is considered to fall within the scope of the above 'tobacco substitutes'. These goods are therefore considered identical according to the principles set out in *Meric*.⁹

33. 'Flavoured nicotine fluids for vaporisers' under all three of the opponent's earlier registrations is considered to fall within the scope of the above 'tobacco substitute products'. These goods are therefore considered identical according to the principles set out in *Meric*.¹⁰

Devices for heating tobacco substitutes for the purpose of inhalation

34. The above goods fall under the scope of 'electronic cigarettes' under all three of the opponent's earlier registrations. These goods are therefore considered identical according to the principles set out in *Meric*.¹¹

Cigarettes containing tobacco substitutes, not for medical purposes;

35. The above goods are considered most similar to 'herbs (smoking -), other than for medical purposes' under all three of the opponent's earlier registrations. The above goods would include cigarettes containing herbs for smoking, other than for medical purposes. The nature overlaps where the cigarettes contain herbs, but differ where the cigarettes also comprise other articles, such as filters and cigarette paper. The purpose overlaps as both are used to smoke herbs. Methods of use differ as the above goods are lit and inhaled, while the opponent's goods have the extra step of being rolled into a cigarette. The users overlap as both will be used by members of the public wanting to smoke herbs. There is a potential relationship of competition between them to the extent that persons wishing to smoke herbs may purchase the herbs themselves for use in cigarettes or other products, or they may purchase cigarettes containing herbs. The production of cigarettes containing herbs requires herbs for smoking, and it is likely that a consumer would conclude that both goods would originate from the same entity. The goods are therefore complementary. Overall, I consider that the

⁹ Case T-133/05

¹⁰ Case T-133/05

¹¹ Case T-133/05

above goods are highly similar to the opponent's 'herbs (smoking -), other than for medical purposes'.

Articles for use with tobacco; Cigarette tips; Books of cigarette papers; Cigar holders; Pocket-size cigarette rolling machines; Tobacco jars; Humidors

36. The above goods are identical to or considered to fall within the scope of the opponent's 'smokers articles' under the opponent's earlier '459 registration. These goods are therefore considered identical according to the principles set out in *Meric*.¹²

Herbs for smoking

37. The above goods are identical to or considered to fall within the scope of 'herbs (smoking), other than for medical purposes' under all three of the opponent's earlier registrations. These goods are therefore considered identical according to the principles set out in *Meric*.¹³

Snus with tobacco; Snus; Smokeless tobacco

38. The above goods are all tobacco products for use other than by smoking. These goods are closest to 'tobacco products for the purpose of being heated' under the opponent's earlier '459 registration. These goods include vaporisers and electronic cigarettes which contain tobacco. The purpose of the goods overlaps as both goods are designed to allow a consumer to consume tobacco. The nature of the goods differs as the above goods are pouches of tobacco for placement in a consumer's gums, while the opponent's goods are electronic systems comprising metal or plastic formed to create a vaporiser or electronic cigarette, although there is some overlap as both goods include tobacco. The users overlap as both will be used by members of the general public who wish to consume tobacco. Trade channels will overlap as it is likely that retailers who sell tobacco products will sell a range of products for consuming tobacco, including smokeless and heating tobacco products. There is no complementary. There may be an element of competition, as a consumer wishing to consume tobacco may buy the snus, tobacco pouches or smokeless tobacco, or

¹² Case T-133/05

¹³ Case T-133/05

alternatively they may buy a tobacco product for the purpose of being heated. Consequently, I consider these goods to be similar to a medium degree.

Tobacco-free nicotine pouches; Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco

39. I have interpreted 'tobacco-free nicotine pouches' as oral nicotine pouches, which are teabag-like pouches filled with a powder infused with nicotine, which is placed in the top lip.

40. The above goods are all tobacco-free pouches for consuming nicotine. These goods are closest to 'flavoured nicotine fluids for vaporisers' under all three of the opponent's earlier registrations. The purpose of the goods overlaps as both allow a consumer to consume nicotine without tobacco. The nature of the goods overlaps where both contain nicotine without tobacco, but differ where the above goods are pouches containing nicotine, while the opponent's goods are fluids containing nicotine. Users overlap as both will be used by members of the general public who wish to consume nicotine without tobacco. Trade channels will overlap as it is likely that retailers who sell tobacco-free nicotine products will sell a range of products for consuming nicotine, including pouches and fluids for vaporisers. There is no complementary. There may be an element of competition, as a consumer wishing to consume nicotine may buy the pouches, or alternatively they may buy the flavoured nicotine fluid for use in a vaporiser. Consequently, I consider these goods to be similar to a medium degree.

Tobacco pouches

41. I have interpreted the above goods as containers for storing tobacco and related articles. These goods are considered to fall under the scope of the opponent's 'smokers' articles' under the opponent's earlier '459 registration. These goods are therefore considered identical according to the principles set out in *Meric*.¹⁴

42. If I am wrong in this interpretation, the above goods could also be interpreted as relating to nicotine pouches which deliver nicotine through the user's gums. In this

¹⁴ Case T-133/05

case, the above goods are most similar to 'substances for smoking sold separately or blended with tobacco or nicotine' under all of the opponent's earlier registrations. The purpose of the goods overlaps as both goods allow a user to consume nicotine and/or tobacco but differs where the above goods are placed into the user's gums, and the opponent's goods are smoked to allow the nicotine and/or tobacco to be consumed. The nature of the goods overlaps where both contain nicotine and/or tobacco but differ where the above goods are pouches containing nicotine, while the opponent's goods are substances for smoking. Users overlap as both will be used by members of the general public who wish to consume nicotine and/or tobacco. Trade channels will likely overlap. There is no complementary. There may be an element of competition, as a consumer wishing to consume nicotine may buy tobacco pouches or substances for smoking containing tobacco or nicotine. Consequently, I consider these goods to be similar to a medium degree.




Comparison of marks

43. 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.”

44. It would be wrong, therefore, to dissect the trade marks artificially, 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.

45. The respective trade marks are shown below:

The opponent's earlier marks	The applicant's contested mark
<p>1.  </p> <p><i>"The opponent's earlier '511 registration"</i></p> <p>2. 88vape</p> <p><i>"The opponent's earlier '632 registration"</i></p> <p>3. 88vape</p> <p><i>"The opponent's earlier '459 registration"</i></p>	

46. In its submissions in lieu, the opponent submits that the marks are highly visually, phonetically and conceptually similar.

47. In its counterstatement, the applicant submits that the letter 'L' in the contested mark provides a strong impression on the consumer, resulting in a difference between the marks.

Overall impression

48. The opponent's earlier '459 registration is a series of two figurative marks comprising the number "88" followed by the word "vape" and a circle element, which appears as a full stop. The first mark of the series has the "88" and circle element in a light grey colour and the "vape" element in a dark grey colour, while the second mark of the series has the "88" and circle element in a red colour and the "vape" element in a dark grey colour. The elements "88" and "vape" are similar in size. The number "88" is the most distinctive element and is at the beginning of the mark, so it plays a larger

role in the overall impression of the mark than “vape”, despite the size similarities. The full stop plays only a small role in the overall impression, as does the contrast in colour/shade.

49. The opponent’s earlier ‘632 and ‘511 registrations comprise the same marks. Both marks comprise the number “88” followed by the word “vape”. As above, the number “88” is more distinctive and is positioned at the beginning of the marks, and therefore plays a larger role in the same.

50. The contested mark comprises the letter “L” followed by the number “8”, with the word “VAPE” underneath. The mark is presented entirely in a black colour. The “L8” element of the mark is much larger than the word “VAPE”. The righthand edge of the “L” is curved where it meets the 8, creating a space between the letter and number. Additionally, as above, “L8” is more distinctive in the context of the goods. The “L8” element therefore plays a larger role in the overall impression of the mark.

Visual comparison

The earlier ‘459 registration

51. The opponent’s earlier ‘459 marks and the applicant’s contested mark use similar fonts and both feature the word “vape”, although the opponent’s marks include “vape” in lowercase letters, while the applicant’s mark uses uppercase letters, and the words are in different positions in each of the marks. The use of the circle element in the opponent’s earlier ‘459 registration creates a very small point of visual difference between this series of marks and the applicant’s contested mark, as does the use of contrasting shades/colours.

52. The first element of the marks overlaps visually where the second character is the number 8 but differs where the opponent’s marks start with an 8 and the applicant’s mark starts with an L. Overall, I find there to be a medium level of visual similarity between the opponent’s earlier ‘459 registration and the contested mark.

The earlier '632 and '511 registrations

53. The opponent's earlier '632 and '511 registrations are both word-only marks. The font used in the contested mark is conventional and such a similar font could be used with the earlier '632 and '511 registrations through normal and fair use. Additionally, it would be open to the opponent to use the mark in a stacked formation. In this case, the most significant difference between the contested mark and the earlier '632 and '511 registrations is the first element of the mark being the number 8 in the earlier registrations and being the letter L in the contested registration. Overall, I find there to be a slightly above medium level of visual similarity between the opponent's earlier '632 and '511 registrations and the contested mark.

Aural comparison

54. All of the marks include the word "vape" at the end, which will be pronounced in the same way in each mark.

55. The opponent's three marks have the numbers "88" at the beginning of the mark, which will be pronounced as "ate-ee-ate". The applicant's contested mark has "L8" at the beginning, which will be pronounced as "ell-ate" by the majority of consumers or may be pronounced as one word, "late", by a small number of consumers. Regardless of which way the applicant's mark is pronounced, there is an overlap in the aural nature of the marks in the "8vape".

56. The difference in pronunciation between the marks amounts to "ate-ee" in the opponent's marks and "ell" or "lay" (i.e. the first sound of 'late'). Given that the beginnings of marks tend to have more visual and aural impact than the ends, this difference makes a greater impact than it would later on in the mark.¹⁵

57. For consumers who pronounce the contested mark as "ell-ate", there is a difference between this mark and the earlier marks in the first syllable of the contested mark and the first two syllables of the earlier marks, with the remaining two syllables being identical. In this situation, I consider the marks to a slightly above medium level of aural similarity.

¹⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

58. For consumers who pronounce the contested mark as “late”, there is a difference between this mark and the earlier marks in the first syllable of the contested mark and the first three syllables of the earlier marks (although “late” sounds similar to both the first and third syllable “ate”), with the remaining one syllable being identical. In this situation, I consider the marks to have a medium level of aural similarity.

Conceptual comparison

59. All three marks include the word “vape”. The average consumer will understand this word to mean an electronic cigarette or the act of smoking an electronic cigarette.

60. The opponent’s marks comprise the words “88vape”. In my view, these words do not hang together and will not form a unit with a meaning that is more than the sum of its parts. Instead, each word plays an independent role within the mark itself. The word “vape” will convey the above meaning, and the numbers “88” will convey no graspable concept outside of the fact it is a number. The stylisation of the opponent’s first series of marks also does not add any additional conceptual meaning.

61. The applicant’s mark comprises the elements “L8” and “VAPE”. In my view, these words do not hang together and will not form a unit with a meaning that is more than the sum of its parts. Instead, each word plays an independent role within the mark itself. The word “vape” will convey the above meaning.

62. In its counterstatement, the applicant submits that the contested mark is stylised as follows:

“The stylistic writing is significant in that it makes the writing into a graphic element, due to the particular style in which the L meets the 8, giving the Applicant’s trade mark a striking visual aspect. The impression created by this is of someone smoking or vaping and smoke/vape rings coming out of it (the two circles created by the character 8). The average consumer may put more importance on this impression than the fact that the letters/numbers used to create this impression are L and 8.”

63. Although I accept that a small number of consumers may note the impression of a person smoking or vaping and smoke rings coming out of it from the applicant’s mark,

I consider that most consumers will not see this. Most consumers will view the applicant's mark as "L8" with "VAPE" underneath. I consider that the majority of consumers would view the "L8" element as having no concept, although a small number of consumers may view this element as a play on the word "late".

64. In all of the marks, the concept of "vape" is shared, and I note that where consumers consider the "L8" element of the earlier mark to have no concept, this will be the only concept conveyed by both marks.

65. However, where consumers view the "L8" element of the contested mark as being a play on the word "late", the consumer will note the overlap in the concept of the word "vape" to each mark, and the difference conveyed by "L8" (late), and in this scenario I consider the marks to have a medium level of conceptual similarity.

Average consumer and the purchasing act

66. As the case law above indicates, it is necessary to determine who the average consumer is for the respective 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. 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."

67. The average consumer of the applicant's goods is likely to be a member of the general public aged over 18 years old. The goods will likely be a relatively frequent purchase and priced at a relatively low cost. During the purchasing process, consideration will be taken of factors such as price, flavour and nicotine content, for

many of these goods. Consequently, I consider that a medium degree of attention will be paid during the purchasing act.

68. The goods at issue will be purchased in general retail shops, specialist vape stores, tobacconists or via online retailers. In the case of retail shops, disposable electronic cigarettes containing nicotine will be stored behind a counter and, in order to make a purchase, the consumer will need to request them from a shop assistant. In addition, advice may be sought from a shop assistant in relation to all of the goods, either in person or over the phone, and there is the possibility of word-of-mouth recommendations. Aural considerations will therefore play an important role in the purchasing act. However, I also consider that visual considerations will play at least an equal role, as the consumer will have sight of the packaging at the point of sale. Disposable electronic cigarettes that do not contain tobacco may be available for self-selection on shelves of the shops, while all the products are available for purchase online. I therefore consider that both aural and visual considerations will play a role during the purchasing process.

Distinctive character of the earlier trade mark

69. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

70. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

71. As noted above, the earlier marks do not hang together or form a unit. The word “vape” is descriptive of the goods for which the opponent’s marks are registered, which are primarily electronic cigarettes and associated articles. Further, it is my view that even where it is not directly descriptive of the goods themselves, it will be simply seen as a reference to the type of related goods also offered by that company. The preceding “88” is not descriptive or allusive of the goods, however it is a very short, 2 digit number. In all of the earlier marks, this element holds a medium level of distinctive character.

72. Overall, the opponent’s earlier ‘632 and ‘511 registrations are considered to have a medium level of inherent distinctive character for the registered goods.

73. The opponent’s earlier ‘459 registration is stylised, with the letters being presented in a sans-serif typeface; a circle being placed after the words, which imitates a full stop; and the “88” and circle being presented in either red or light grey, and the word “vape” being presented in a dark grey. I consider that the typeface used is not particularly stylistic, and as such does not add to the distinctiveness of the mark. Earlier I found the circle element to play a small role in the mark. I consider that this element does not add to the distinctiveness of the mark. The “88” and circle aspects of the mark are coloured in a different colour to the word “vape”, resulting in contrast between the elements. I consider that this contrast does add a small amount of distinctiveness to the mark.

74. Due to the stylisation, the opponent’s earlier ‘459 registration is considered to have a slightly higher than medium level of inherent distinctive character for the registered goods.

75. The opponent submits that the earlier marks have acquired an enhanced distinctive character through the use that has been made of it and has filed evidence in support of this. I will now consider whether this evidence demonstrates that the distinctiveness of the earlier marks have been enhanced through use. I remind myself that the relevant date is 5 October 2023. When considering whether or not the distinctiveness of a mark has been enhanced, it is the perception of the UK consumer at the relevant date that is key.

76. In his witness statement, Sandeep Chadha states that the 88Vape brand was established in 2013, commencing with e-liquids and then expanding into disposables, vape pens and pod-style e-cigarettes the following year.¹⁶ Yearly UK sales figures have been included dating back to 2019. These are set out below:

Year	Turnover (£)
2023	57,301,528
2022	46,673,384
2021	37,388,081
2020	27,102,271
2019	15,769,579

77. Exhibit 3 shows an article dated 28 November 2023 from the website ‘Shares News’, a UK-based magazine, titled “Supreme shares surge as vapes-to-vitamins supplier delivers yet another profit upgrade”. The article names Supreme plc as “a leading e-cigarette and vaping market name known for its 88vape brand”. Whilst this article is dated after, it was published less than two months after the relevant date. Considering that the impression given by this article is unlikely to be a result solely of those two months, I consider that this article sheds a light on the likely position at the relevant date.

¹⁶ See paragraph 5 of the witness statement of Mr Chadha.

78. Exhibit 10 shows an article dated 16 February 2021 from the website www.planetofthevapes.co.uk titled “88vape Listed on the Stock Exchange”. The article focuses on Supreme plc’s growth over the previous few years and states that the opponent had an estimated 36% of the market share of the UK budget vape sector. Exhibit 9 states that Supreme plc’s vaping division delivered a revenue of £76.1 million in the financial year ending 31 March 2023. The Chair Statement in this exhibit states that this revenue is “largely through robust sales and complementary new product development in our market-leading 88vape brand”, and it therefore appears reasonable to assume at least a large portion of the sales relate to products sold under the “88vape” brand. Exhibit 8 shows an article dated 21 May 2024 from the website grocerytrader.co.uk titled “Expanding category – The vape market is expected to reach £1.4bn in the next three years”. This article states that the UK vape market was worth £1.2 billion at the time and is expected to reach £1.4 billion by 2027. I note that this figure is from seven months after the relevant date, so it may not be reflective of the worth of the market in October 2024. However, it is clear from the evidence that the vape market has been increasing in value in the past number of years, and therefore it is likely that the market was worth slightly less than £1.2 billion at the relevant date. In any case, it is clear that Supreme plc seem likely to have owned a significant share of the market at the relevant date. As noted above, it is not clear exactly what proportion of this percentage relates to the “88vape” brand. However, the exhibit states that the revenue is largely due to this brand.

79. Exhibit 17 shows invoices from the company’s main third party retailers, listing products ordered and their prices. In the witness statement, Sandeep Chadha provides a list of the main third party stores where 88Vape products are sold and the date they first started selling the goods.¹⁷ Many of the listed stores have sold the goods since 2016. In paragraph 26 of the witness statement, Sandeep Chadha states that 88Vape is represented in approximately 8000 retail stores. It is not clear whether these are all in the UK, however the “main third party stores” listed in this paragraph are all UK stores, so it is reasonable to conclude that the mark is geographically widespread throughout the UK.

¹⁷ See paragraph 26 of the witness statement of Mr Chadha.

80. Exhibits 4 to 6 provide clear images of the opponent's earlier '459 registration relied upon being used on e-liquids, disposable vapes and vape kits. The products are listed for sale in GBP, suggesting that these are reflective of products available to the UK market. However, the printouts in Exhibit 4 are from 20 June 2024, and Exhibits 5 and 6 are not dated. In paragraph 8 of the witness statement, Sandeep Chadha states that there was use on these websites in the relevant period. I have considered the sum of the evidence, and I find that this is reflective of the sign used during the relevant period in the UK.

81. Sandeep Chadha provides in the witness statement annual advertising expenditure for the 5 years prior to the relevant date. In their submissions in lieu, the opponent states that regulations have been put in place to restrict the advertising of the products due to their nature, but that advertising has still been heavily invested in by the opponent. However, this has not been filed in evidence, and so I cannot consider this as evidence of fact. The breakdown of turnover figures from the witness statement are set out below:¹⁸

Year	Expenditure (£)
FY23	185,366
FY22	123,990
FY21	267,324
FY20	1,812,553
FY19	931,720

82. Although the annual advertising expenditure for financial years 2021 to 2023 has been relatively low compared to the turnover of the company, the figures for financial years 2019 and 2020 are significantly higher. Sandeep Chadha also states that the brand has a significant online presence, with over 6.7 million visits to the 88Vape website between the years 2017 and 2024.¹⁹ Exhibits 4 to 6 show printouts of this website with products for sale in GBP, indicating that this website is directed towards the UK market.

¹⁸ See paragraph 21 of the witness statement of Mr Chadha.

¹⁹ See paragraph 29 of the witness statement of Mr Chadha.

83. Whilst I have not listed all of the evidence at this stage, it has nonetheless been considered in its entirety. It is clear that the 88vape mark holds a significant market share and had been used extensively across the UK on the relevant goods for approximately 10 years at the relevant date. A notable proportion of the company's turnover was spent on promoting the mark and third party evidence shows that 88vape was a well known brand in the industry at the relevant date. The evidence shows that the marks have been used on reusable e-cigarettes, disposable e-cigarettes and liquids. It is my view that, with consideration to the evidence as a whole, the distinctiveness of all of the earlier marks relied upon has been enhanced to a high degree at the relevant date, with regard to the following goods:

Class 34: Personal vaporisers and electronic cigarettes, flavourings and solutions therefor, electronic cigarettes, oral vaporizers for smokers, tobacco products for the purpose of being heated, electronic devices for the purpose of heating cigarettes or tobacco, flavourings for electronic cigarettes and vaporisers, liquids for electronic cigarettes, flavoured nicotine fluids for vaporisers, refills and cartridges for electronic cigarettes, and atomisers for smoking and inhalation.

84. The earlier '632 and '511 registrations possess a medium level of inherent distinctiveness with regard to the remaining relied on goods and services. The earlier '459 registration possesses a slightly higher than medium level of inherent distinctiveness with regard to the remaining relied on goods and services.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

85. 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 trade marks may be offset by a greater degree of similarity between the respective goods (or services) and vice versa (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the

imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

86. 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.

87. Earlier in this decision, I found the goods and services to range from medium similarity to identical. I found all three earlier marks to have an either medium or slightly above medium level of visual and aural similarity, and a medium level of conceptual similarity where the consumer understands “L8” to be a play on the word “late”. I found the opponent’s earlier ‘632 and ‘511 registrations to possess a medium level of inherent distinctive character for the relevant goods, and the opponent’s earlier ‘459 registration to possess a slightly higher than medium level of inherent distinctive character for the relevant goods. I found this distinctiveness to be enhanced to a high degree by the use of the mark, for the goods listed in paragraph 76 above. I identified the average consumer to be members of the general public aged over 18 years old, paying a medium degree of attention. I found that the goods would be selected by both visual and aural means.

88. Firstly, considering direct confusion, I note that the differences between the marks, particularly the “L” in the applicant’s mark which is prominent and is at the start of the mark, create a significant difference between the marks both visually and aurally. Whilst I note the use of “vape” in all of the marks creates a point of conceptual similarity, this has little impact considering it is not distinctive in the context of the goods. It is my view that the aural and visual difference created by the use of the ‘L’ in place of the ‘8’ is not one that would go unnoticed or be misremembered by consumers paying an average degree of attention, even considering the identity of the goods and the high distinctiveness of the earlier mark, and I therefore do not consider it likely that a consumer would mistake one mark for the other. I therefore do not find a likelihood of direct confusion between the applicant’s mark and any of the opponent’s earlier marks.

89. I will therefore proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, 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”.

90. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., 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)."

91. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances in which indirect confusion occurs.

92. Earlier I found that "vape" is descriptive of the goods and that the elements "88" and "L8" played a larger role in all of the marks. Neither "L8" or "88" is allusive of the goods. Considering the descriptive nature of the word "vape", the average consumer would not see this common element as being so strikingly distinctive that no other entity would be using it. As noted above, I consider that a consumer who is aware of any of the opponent's earlier marks would note the change of the first letter in the applicant's contested mark. Whilst I note the opponent has submitted that there is a clear risk of indirect confusion due to similarities between the marks and the goods, it has not provided me with the proposed basis on which the consumer might reach this conclusion. I do not see any logical reason for the consumer to conclude that the "L8 vape" mark is another brand of the owner of any of the earlier "88vape" marks. Whilst it is possible that due to the similarities between the marks, which all comprise two digits/letters before the word "vape", the second of which is an 8, the earlier mark may be brought to mind by the use of the later mark, this is mere association and does not equate to a likelihood of indirect confusion.

93. Taking all of this into account, I do not consider there to be a likelihood of indirect confusion between the applicant's contested mark and any of the opponent's earlier marks.

94. I have considered the possibility of confusion based on identical goods under each mark and have found none. As a result, I will not return to compare the goods under the contested mark against the goods and services of each earlier mark individually, as it would not alter my finding of no likelihood of confusion.

Final Remarks

95. The opposition under Section 5(2)(b) fails in its entirety. Subject to any successful appeal, the application will proceed to registration in respect of all of the goods applied for.

COSTS

96. The applicant has achieved success in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of £450 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the TM7 and statement of grounds and preparing and filing the TM8 and counterstatement:	£250
Considering the opponent's evidence:	£200 ²⁰
Total:	£450

97. I therefore order Supreme Imports Limited to pay Luna Corporate Spółka Z Ograniczoną Odpowiedzialnością the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 17th day of July 2025

K HARBACH

For the Registrar

²⁰ I have awarded under the scale costs as, although the opponent's evidence needed to be considered, the applicant neither filed their own evidence nor made any comments based on the opponent's evidence.