O/0672/25

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATIONS NO. 3872373 & NO. 3867124
IN THE NAME OF BRITISH AMERICAN TOBACCO (BRANDS) LIMITED
TO REGISTER AS TRADE MARKS

POUCHERS

AND

POUCHING

IN CLASS 34

AND

IN THE MATTER OF OPPOSITIONS THERETO
UNDER NUMBERS 441773 & 441896
BY
SWEDISH MATCH NORTH EUROPE AB

BACKGROUND AND PLEADINGS

1. On 30 January 2023 and 12 January 2023 respectively, British American Tobacco (Brands) Limited ("the applicant") applied to register two trade marks, being UK3872373 ("the '373 mark") for the word mark "POUCHERS" and UK3867124 ("the '124 mark") for the word mark "POUCHING", in the United Kingdom.

2. Both applications were made in respect of goods in class 34. The applications were accepted[1] and were published for opposition purposes on 14 April 2023 and 21 April 2023 respectively, for the following goods:

The '373 mark:

Class 34: *Cigarettes; tobacco, raw or manufactured; tobacco products; tobacco substitutes (not for medical purposes); cigars; cigarillos; cigar lighters; lighter flints; cigarette lighters; matches; smokers articles; cigarette paper; cigarette tubes; cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; tobacco products for the purpose of being heated; devices for heating tobacco substitutes for the purpose of inhalation; cigarettes containing tobacco substitutes; cigarette cases; cigarette boxes; snus with tobacco; snuff with tobacco; snus without tobacco; snuff without tobacco; tobacco free oral nicotine pouches (not for medical use).*

The '124 mark:

Class 34: *Cigarettes; cigars; cigarillos; Cigar lighters; Lighter flints; Cigarette lighters; matches; smokers articles; cigarette paper; cigarette tubes;*

[1] I note that a *prima facie* objection to the '124 mark in relation to some of the class 34 goods applied for was made during the examination of the application. The applicant subsequently requested the deletion of the objectionable terms, resulting in the (accepted) specification shown under paragraph 2 of this decision.

cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes containing tobacco substitutes; cigarette cases; cigarette boxes.

3. The applications are opposed by Swedish Match North Europe AB ("the opponent"). The opposition against the '373 mark was filed on 5 July 2023; the opposition against the '124 mark was filed on 11 July 2023. Both oppositions are based upon sections 3(1)(a), 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 ("the Act"). The oppositions are both directed against all of the goods in the applications. On 30 October 2023, the Tribunal wrote to the parties to confirm that having considered the nature of the claims in the individual cases, it considered it appropriate to consolidate the proceedings.

4. The opponent claims that each of the marks have been afforded, by the relevant public, a meaning that is immediately perceived as providing information about the goods covered by each of the applications in class 34. As such, it submits that the marks offend against the provisions of sections 3(1)(a),(b) and (c) of the Act. In addition, it submits that the marks are likely to be used within the nicotine and tobacco industry and cannot confer distinctiveness for goods covered by the applications, and therefore the marks offend against the provisions of section 3(1)(d) of the Act.

5. The applicant filed counterstatements for each opposition, denying each of the claims made by the opponent, and it puts the opponent to proof of each of its allegations. While it admits that the definition of "POUCH" provided by the opponent is an acceptable definition, it denies that this means that the applied-for marks contravene sections 3(1)(a) or 3(1)(b), as claimed by the opponent.[2]

6. Both parties filed evidence. Neither party requested a hearing; both parties filed written submissions in lieu of a hearing, which will be referred to as and where

[2] At paragraph 6 of its Statement of Grounds.

appropriate in my decision. This decision is taken following careful consideration of the papers on file.

7. In these proceedings, the opponent is represented by Shoosmiths LLP[3] and the applicant is represented by Baker & McKenzie LLP.

EVIDENCE

The opponent's evidence

8. The opponent filed evidence in the form of a witness statement dated 22 December 2023, and adduces 27 exhibits, labelled SM1 to SM27, in support of the oppositions. The witness statement is in the name of Anna-Lena C. Orrenius, being Legal Counsel in the legal department of the opponent.

9. I will not provide a full summary of the exhibits at this point, but I will instead give a brief outline of them, grouped collectively, as appropriate:

- Exhibits SM1 and SM2 are screenshots from various online dictionaries providing definitions of, or setting out the etymology of the words pouch" and "poucher".

- Exhibits SM3 to SM19 comprise a variety of articles which make reference to "nicotine pouches". While the majority of these articles are written in English, I note that some are written in other languages, in particular, in Swedish, and that a translation of such articles has not been provided. As such, any evidence without a translation into English provides no value in support of the opposition and will therefore be disregarded.

[3] Form TM33P notifying the change of representative from Locke Lord (UK) LLP to Shoosmiths LLP as representatives to the opponent was filed on 10 February 2025, the details of which have been recorded accordingly in these proceedings.

- Exhibit SM20 is a copy of a study conducted by the National Library of Medicine of the USA, entitled “Nicotine Pouch: Awareness, Beliefs, Use, and Susceptibility among Current Tobacco Users in the United States, 2021”.

- Exhibit SM21 is an extract from a decision by the Norwegian Trademark Office, translated into English, whereby the applicant in these proceedings was denied registration of the application of the trade mark “POUCHERS” for a variety of tobacco products. The reason for the refusal of the mark was because it was said that it was descriptive and lacked distinctive character. While I acknowledge the findings of the Norwegian Office, I am not bound by the decisions of other jurisdictions, and they do not preclude a finding for the applicant under the section 3 grounds within the present opposition proceedings. Rather, I must make my decision based on the evidence before me in relation to the relevant territory of the UK at the relevant date

- Exhibit SM22 is a copy of a refused application by the UK Intellectual Property Office for the mark “MOVE ON TO POUCHING” for goods in class 34. Exhibit SM26 is a screenshot derived from a Google Patents webpage showing a worldwide patent application pertinent to Canada, the US and the EU for “Pouch material for smokeless tobacco and tobacco substitute products”. While I acknowledge the content of these exhibits, neither seems to be on all fours with the proceedings before me.

- Exhibit SM23 comprises articles from various websites which refer to “pouchers” as users of nicotine pouches.

- Exhibit SM24 is a schedule of UK registrations and pending applications (at the time the evidence was produced) for trade marks filed in class 34 which include the terms “pouch”, “pouches”, pouchers” or “pouching” within the mark; Exhibit SM25 shows the inclusion of the term tobacco pouches in class 34 of the 11th edition of the Nice Classification system

- Exhibit SM27 is a screenshot showing the “IM Series Horizontal Form-Fill-Seal Poucher”, being a model of a machine used to produce pouches of varying sizes.

The applicant’s evidence

10. The applicant filed evidence in support of the applications in the form of a witness statement dated 29 February 2024. The witness statement is in the name of Elena Valuiskich, Trade Mark Counsel of BATMark Limited, a member of the British American Tobacco plc Group of companies (“the BAT Group”). Ms Valuiskich confirms that the applicant is a wholly owned member of the BAT Group. Alongside the witness statement, Ms Valuiskich adduces 5 exhibits, labelled EV1 to EV5, respectively, the contents of which are summarised in the witness statement from which the following is directly reproduced:

4. Enclosed at **Exhibit EV1** are screenshots from the Google.co.uk search engine showing that when one searches for the terms "*pouching tobacco*", "*pouching snus*", and "*pouching nicotine*", the search engine questions whether the user intended to search for the terms "*pouching tobacco*", "*pouching snus*", and "*pouching nicotine*" (taken on 29 February 2024).

5. Enclosed at **Exhibit EV2** are screenshots from Google.co.uk when searching for the word "POUCHING" by itself (taken on 29 February 2024).

6. Enclosed at **Exhibit EV3** are screenshots from Google.co.uk when searching for the word "POUCHERS" by itself (taken on 29 February 2024).

7. Enclosed at **Exhibit EV4** are screenshots from a number of online dictionary searches for the word "POUCHING" (taken on 29 February 2024).

8. Enclosed at **Exhibit EV5** are screenshots from a number of online dictionary searches for the word "POUCHERS" (taken on 29 February 2024).

11. I will refer to the evidence of both parties in more detail, to the extent I consider necessary, within the decision.

DECISION

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

Section 3(1) –

13. Section 3(1) of the Act provides as follows:

> "3(1) The following shall not be registered –
>
> (a) signs which do not satisfy the requirements of section 1(1),
>
> (b) trade marks which are devoid of any distinctive character,
>
> (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
>
> (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

14. Section 1(1) states:

" 1(1) In this Act "trade mark" means any sign which is capable —

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging."

15. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b): SAT.1 *SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-329/02 P at [25].

16. The relevant date for determining whether the applicant's marks are objectionable under section (3)(1) is the date on which the applications were made, being 30 January 2023 (the '373 mark) and 12 January 2023 (the '124 mark).

Section 3(1)(a)

17. I note that in each of its statement of grounds, the opponent has made a catch-all claim as to why it considers the opposed marks offend under sections 3(1)(a), (b) and

(c) of the Act, i.e. that the signs are descriptive and lack distinctiveness.[4] I find nothing further in the opponent's written submissions in lieu of a hearing which address the specific claim under section 3(1)(a).

18. Mr Geoffrey Hobbs QC, (as he then was), sitting as the Appointed Person in *AD2000 Trade Mark*, said that section 3(1)(a) permits registration provided that the mark is 'capable' to the limited extent of "not being incapable" of distinguishing.[5] Consequently, if I am satisfied that the mark complies with sections 3(1)(b), (c) and (d) of the Act, the 'incapable of distinguishing' objection under section 3(1)(a) is bound to fail. Alternatively, if any of the grounds under sections 3(1)(b), (c) or (d) succeed, the outcome under section 3(1)(a) becomes moot. In any event, this ground of opposition fails for the reasons given by Arnold J (as he then was) in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch):

> "44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4, the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.
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> 45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:
>
> > "80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the

[4] Points 1 to 3 and point 6.
[5] [1997] RPC 168.

goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing **any** goods or services."
(My emphasis).

19. The marks are not incapable of distinguishing any goods or services.

20. **The section 3(1)(a) ground fails.**

Section 3(1)(d)

21. I will begin by considering the oppositions under Section 3(1)(d) of the Act.

22. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM,* Case T-322/03, the General Court ("GC") summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

> "49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).
>
> 50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).
>
> 51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive,

but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS,* paragraph 40)."

23. In light of the above case law, the pertinent question is whether, on the relevant dates (30 January 2023 for the '373 mark and 12 January 2023 for the '124 mark), the marks "POUCHERS" and "POUCHING" had, based on the perception of the average consumer of the goods in the UK, "become customary in the current language or in the *bona fide* and established practices of the trade" to designate the goods covered by the marks.

24. In its written submissions in lieu of a hearing, the opponent reminds me that it is necessary to define the relevant consumer in respect of the challenged goods. In my view, the average consumer of the goods, being various forms of cigarettes and tobacco-related products, will be the general UK smoking public.[6] I acknowledge that the average UK consumer of the goods may also be a specialist in trade, such as a third party supplier of the goods to retail or wholesale outlets, who is likely to have a broader knowledge of the goods at hand than a member of the general public.[7]

25. I note that at point 4 of the statement of grounds, the opponent claims that the marks are "**likely** to be used within the nicotine and tobacco industry" (**my emphasis**). In support of the claims under section 3(1)(d), in its written submissions in lieu of a hearing, the opponent directs me to exhibit SM23, and in particular to paragraphs 39

[6] The legal age to purchase tobacco and nicotine-containing products, including cigarettes, in the UK is 18.
[7] See *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04, paragraph 24.

- 40 of that exhibit.[8] The exhibit consists of 19 pages, numbered accordingly by the opponent, although as the exhibit provides extracts from several different sources, the pages are also numbered independently according to the source. In any event, I am unable to locate the specifically referenced paragraphs 39 – 40. The opponent submits that it is clear from the exhibit that the words POUCHING and POUCHERS are already being used extensively.[9] I note that the first article within the exhibit, numbered from page 1 to 9, is a blog relating to the best-selling nicotine pouches in 2022, derived from the website www.nicopouches.fr, which was published on 30 May 2022. While the extract is predominantly in English, and I note the references to a "poucher" as being a user of nicotine pouches, given that this blog comes from a French website, it cannot be said to accurately reflect the perception of the average consumer of the mark in relation to the goods in the UK. The next article, entitled "Considerate Pouchers Launches Global Nicotine Pouch Survey 2023", refers to the rights and needs of nicotine pouch users worldwide. "Considerate Pouchers" are described in the article as "a leading consumer advocacy organization". The article is derived from a .com domain and does not specifically mention the UK market, although it does contain a quote from the organisation's UK Director, Richard Crosby, in which he encourages "nicotine pouchers" to participate in the survey. I also note the Youtube and twitter/X accounts of the organisation. Again, these are not specific to UK followers, although in the "About Us" screenshot at page 19 of the exhibit I note that it mentions that Considerate Pouchers have spokespersons in both Sweden and the UK. A further article, entitled "Nicotine Pouches: Can You Smoke At Festivals?/Übbs Pouches", makes two references to "pouching" in the context of using nicotine pouches. However, the article, dated 17 March 2023, is a blog from a .com domain with nothing to show it was directed towards the UK market. Further, it was published after the relevant application dates and as such must be discounted in relation to section 3(1)(d).

26. I do not contest the generic nature of the term "nicotine pouches". Further, the applicant has said in its counterstatement and in its written submissions in lieu of a hearing that it does not dispute that "POUCH" is commonly used in connection with

[8] At [56], footnote 60.
[9] At point 56 of the written submissions in lieu of a hearing.

nicotine pouches. The marks at issue are for the terms "POUCHERS" and "POUCHING". By way of analogy, the opponent refers to electronic cigarettes, which are commonly referred to as "vapes", which are used by "vapers" who enjoy "vaping".[10] While there are limited references within the evidence of users of nicotine pouches being referred to as POUCHERS, I cannot agree with the opponent that the evidence shows that either of the signs are already being used "extensively" in relation to such goods, in the UK, although it is possible that the terms at issue may be widely referred to in this way in the future. I acknowledge the submissions that the applicant's "attempt to monopolise the words POUCHING and POUCHERS recognises the trend amongst consumers within the industry of creating slang terminology around their chosen nicotine product", which the opponent submits "is only likely to increase as the prevalence of nicotine pouch use increases". However, in order to be contrary to the provisions of section 3(1)(d), the mark must be considered customary in the course of trade at the time of application.

27. The evidence as a whole focusses on the marks in the context of "nicotine pouches" which are portrayed throughout the opponent's evidence as being tobacco-free alternative products. In exhibit SM5, nicotine pouches are described as "modern oral products" placed under the lip so nicotine can be effectively absorbed, while exhibit SM7 describes them as an alternative to tobacco. I find nothing within the evidence which supports that the '124 mark, the specification of goods of which are predominantly cigarettes or tobacco based products and accessories and which does not include nicotine pouches, had become customary in trade at the relevant date.[11] Although *tobacco free oral nicotine pouches (not for medical use)* and *tobacco substitutes (not for medical purposes)* are included, inter alia, in the specification of goods under the '373 mark, the evidence provided does not persuade me that, at the time the application was filed, the mark had already become generic/customary in trade in the UK, in relation to *any* of the goods applied for.

28. **The opposition based on Section 3(1)(d) fails.**

[10] Ibid.
[11] See goods as listed under paragraph 2 of this decision.

Section 3(1)(c)

29. I will now move to consider the opposition under Section 3(1)(c) of the Act.

30. At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] E.T.M.R. 57, Case C-363/99, the Court of Justice of the European Union ("CJEU") described section 3(1)(c) as requiring "that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods."

31. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R.

9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

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

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

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland*

[2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

And

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

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the

goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

32. With consideration to the above principles, in assessing the mark under Section 3(1)(c), I keep in mind that the objective of this section is to ensure that signs which consist exclusively of elements which designate a characteristic of the goods remain free for use by other traders of those goods.

33. Earlier in this decision, I found that as one of the articles contained within exhibit SM23 was published after the relevant dates, it was of no help to the opponent in

relation to the claim under Section 3(1)(d).[12] I note, however, that a trade mark does not need to be in use in a descriptive manner at the time of application for it to fall foul of Section 3(1)(c): the possibility that a sign may be used descriptively in the future should also be considered.[13]

34. I acknowledge that the word "pouch" is descriptive of a flexible container, such as a bag, used to contain small items. I also note that in its written submissions in lieu of a hearing, the applicant does not dispute that nicotine pouches are commonly used terms.[14] However, it is the words "POUCHER" and "POUCHING", and not "POUCH", which I must consider.

35. As mentioned previously, the evidence focusses on nicotine pouches, rather than the wider specifications of goods applied for. As noted under the section 3(1)(d) claim, the '124 mark for the word "POUCHING" was accepted *prima facie* in relation to various smokers' articles, including cigarette/cigar/electronic cigarettes, as well as accessories such as lighters, matches and cases. I note that the mark was refused during the examination stage in relation to *tobacco free oral nicotine pouches (not for medical use)* under section 3(1)(b), but not under section 3(1)(c). These goods were subsequently removed from the specification following correspondence between the examiner and the applicant. In my view, the opponent has not provided evidence to support that the sign "POUCHING" would be seen by the relevant public as a descriptive term for the spectrum of the accepted goods under the '124 mark.

36. In relation to the goods accepted under the '373 mark, I consider that for goods such as cigarettes, the apt description of the "container" in which they are presented for sale would be a packet, not a pouch. I accept that it would not be uncommon for loose tobacco (such as that used to "roll your own" cigarettes or for use in pipes or snuff boxes) to be sold in what could be aptly described as a pouch. However, the opponent has provided no evidence to demonstrate descriptive use of the word "POUCHER" in relation to these goods. Further, I see no reason why the sign could reasonably be expected to become the apt descriptors of goods such as cigarettes,

[12] See paragraph 25 of this decision.
[13] See *Exalation v OHIM*, Case T-85/08, paragraphs 42 – 43.
[14] Point 8.b).

tobacco or smokers' articles, for example, cigarette lighters or boxes, in the future. Given the substance of the opponent's evidence, I will now consider whether the sign "POUCHER" is descriptive of a characteristic of the applicant's "*tobacco free oral nicotine pouches (not for medical use)*" as well as its "*tobacco substitutes (not for medical purposes)*" as applied for under the '373 mark.

37. I consider that a proportion of the UK public will relate the term "POUCHER" as being derived from the root POUCH. I note the applicant's evidence includes the lack of results for the term "pouchers" in a search of the Cambridge Dictionary online (Exhibit EV5). However, an absence of results within the exhibits is insufficient to illustrate that something does not exist. I also note the opponent's evidence, and particularly exhibit SM1 which provides, inter alia, British dictionary definitions for the word "pouch" as both a noun and a verb; and exhibit SM2 which shows an entry in Wiktionary for the word "poucher" as a surname originating as an occupation (for a maker of bags and purses):

Exhibit SM1

BRITISH DICTIONARY DEFINITIONS FOR POUCH

pouch

/ (paʊtʃ) /

noun

1. a small flexible baglike container: *a tobacco pouch*
2. a saclike structure in any of various animals, such as the abdominal receptacle marsupium in marsupials or the cheek fold in rodents

SEE MORE

verb

6. *(tr)* to place in or as if in a pouch
7. to arrange or become arranged in a pouchlike form

SEE MORE

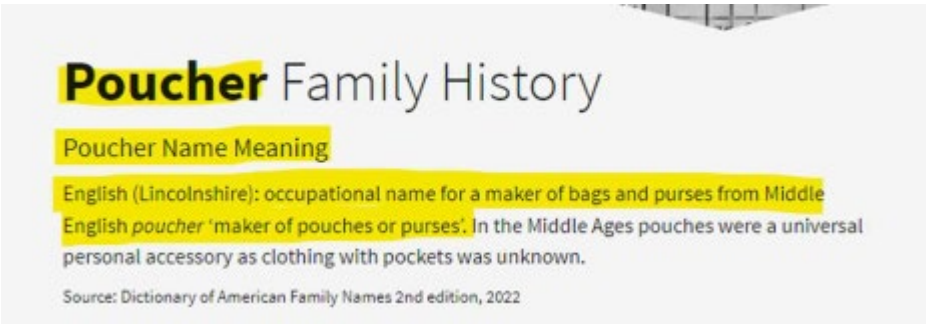
ORIGIN OF POUCH[1]

C14: from Old Norman French *pouche*, from Old French *poche* bag; see POKE [2]

DERIVED FORMS OF POUCH

pouchy, adjective

Exhibit SM2

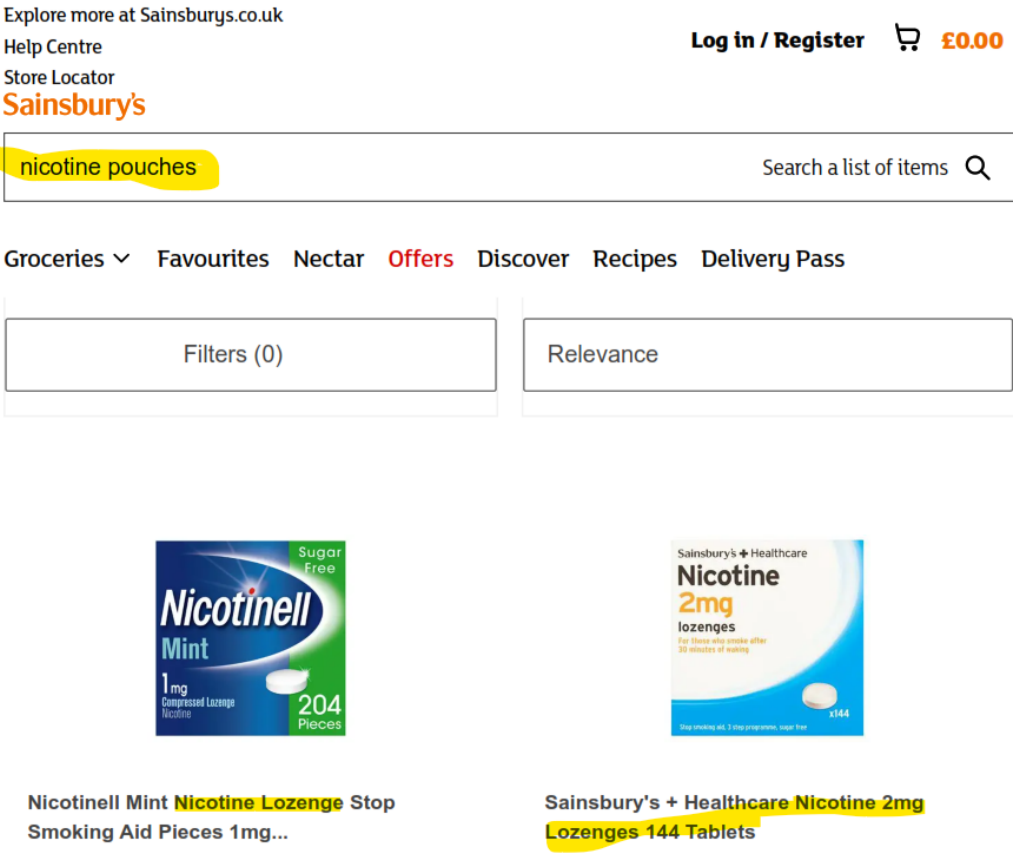


38. I disagree with the opponent that the evidence demonstrates that the relevant public view "POUCHER" as a descriptor of the goods. While a proportion of the average consumer may recognise the term "poucher" as deriving from an occupational surname, I do not consider it to be an apt term to describe nicotine pouches or that the consumer would perceive the term as a characteristic of the goods themselves. In my view, it is more likely that they will see the term as allusive rather than describing goods such as nicotine pouches, being tobacco-free sources of nicotine which are placed between the gums and upper lip, as explained in the opponent's exhibit SM7:

3 **Place one pouch between your gums and upper lip for up to 1 hour.**
The nicotine will slowly release from the pouch and be absorbed by your body. Once the pouch loses its flavor, you'll know that you've absorbed the nicotine and can spit out the pouch.[4]

- Most ZYN users consume 8-12 pouches per day, but the amount is totally up to you.[5]

39. I consider that there would be a proportion of consumers who would view "POUCHER" as an invented word with no conceptual identity, and therefore completely distinctive in relation to all of the goods at issue. While nicotine pouches have been attributed such a title, they are not what I would consider to be a pouch in the traditional sense of a bag in which to place small items. Rather, the evidence suggests that they are more like a lozenge, as demonstrated in the opponent's exhibit SM10:



40. It is my view that to those members of the relevant public who recognise "POUCHER" as deriving from a surname relating to the maker of pouches, this is not the same as finding the mark to be descriptive of a characteristic of the goods applied for. The applicant reminds me that to be considered descriptive, the relationship between the term and the goods must be sufficiently direct and specific: *Limo* case judgement T-311/02, at [30]; and *Nurseryroom* case T-173/03, at [28].[15] The opponent submits that the applicant's attempts to monopolise the words POUCHING and POUCHERS recognises the trend amongst consumers within the industry of creating slang terminology around their chosen nicotine product, which is only likely to increase as the prevalence of nicotine pouch use increases.[16]

41. Neither party has provided details of when nicotine pouches were first introduced to the UK market, but to the best of my knowledge, they have been available in the UK for a number of years. While I have no information on the overall size of the UK market for nicotine pouches, the opponent has stated that it sold 6.6 million nicotine pouches in the UK in the 2022 financial year.[17] As such, compelling evidence of descriptive use of the marks should be readily available. However, while I acknowledge the references to "pouchers" in the opponent's exhibit SM23 (as outlined under paragraph 25 of this decision), and to a poucher machine in exhibit SM27, I find that insufficient evidence has been provided to demonstrate that the sign "POUCHERS" would be recognised in the UK as designating an essential characteristic of tobacco substitutes such as nicotine pouches.

42. Taking all of the above into account, I have no basis on which to find that either mark should remain free for use by other traders on any of the goods.

43. **The opposition under Section 3(1)(c) fails.**

[15] Applicant's written submissions in lieu of a hearing, paragraph 10.
[16] Opponent's written submissions in lieu of a hearing, paragraph 56.
[17] At point 5 of the witness statement of Anna-Lena C. Orrenius.

Section 3(1)(b)

44. Section 3(1)(b) of the Act prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

> "29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).
>
> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
>
> 31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).
>
> 32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively,

Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

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

45. Earlier in this decision, I found both marks to be acceptable under sections 3(1)(a), 3(1)(c) and 3(1)(d) and that neither mark is directly descriptive of the goods to which the marks are applied. I remind myself that section 3(1)(c) and section 3(1)(b) are independent grounds and have differing general interests. However, the opponent has not provided any further evidence in relation to its claims under 3(1)(b) per se, although I note its written submissions in lieu of a hearing under these grounds, where it submits that the signs will be seen by the relevant consumer "as common terms associated with purchase and consumption of the Challenged Goods and goods related closely thereto".[18] I again refer to the content of the opponent's evidence at large which is directed towards nicotine pouches. As such, I will first consider whether the word "POUCHING" under the '124 mark is devoid of distinctive character for the goods applied for, being various cigarette/cigar/electronic cigarettes, as well as accessories such as lighters, matches and cases.

46. I have already found that "POUCHING" is not descriptive of the class 34 goods as accepted during examination. I see nothing within the opponent's evidence to demonstrate that the mark is devoid in respect of the goods at issue, and I do not find there to be any logical reason why the mark "POUCHING" would be unable to indicate trade origin to the relevant public.

[18] At points 44 to 46, and in particular, point 45.

47. **The opposition under section 3(1)(b) fails in its entirety in relation to the '124 mark.**

48. For the '373 mark, the application under class 34 also includes tobacco at large, as well as snus (with and without tobacco), which may be presented for sale in pouches. In spite of how these goods may be packaged, I consider the term "POUCHERS" to be fanciful, and, in my view, the relevant public of these goods would readily see the sign as originating from a single given undertaking. For the remaining goods, I apply the same finding as for the '124 mark, with the exception of "*tobacco free oral nicotine pouches (not for medical use)*" and "*tobacco substitutes (not for medical purposes)*", which I will consider now separately.

49. The opponent submits that there is nothing fanciful or unusual in attaching the suffix "ERS" to the term "POUCH". The applicant submits that a trade mark does not require any specific level of artistic creativity or imaginativeness or any excess of originality in order to qualify for registration, and that a minimum degree of distinctive character is sufficient to preclude the application of the absolute ground for refusal set out in Section 3 of the Act.[19] In my view, the mark is allusive of nicotine pouches, which are also a tobacco substitute, but that does not make it devoid of distinctiveness. I take into account the opponent's argument that users of nicotine pouches could be referred to as "pouchers" in the same way that an e-cigarette (or vape) would be used by vapers, but this does not necessarily carry across all activities. Users of snuff are not referred to as "snuffers", nor are pipe smokers known as "pipers". Likewise, consumers of gin would not be known as "ginners". Therefore, just by adding the suffix "ERS" to the descriptive term "pouch" and presenting an analogy with expressions such as "vaper" is not enough, in my view, to show that the sign "POUCHERS" does not possess sufficient distinctive character to allow the relevant consumer to distinguish between one undertaking and another supplying the same goods, i.e. nicotine pouches (being a tobacco substitute). To my mind, the term "POUCHERS" possesses a sufficient degree of distinctive character under section

[19] Points 24 - 25 of the applicant's written submissions in lieu of a hearing.

3(1)(b) of the Act to fulfil the essential function of a trade mark to designate trade origin of the goods at hand.

50. **The opposition under section 3(1)(b) fails in its entirety in relation to the '373 mark.**

CONCLUSION

OP441773 and OP441896

51. The oppositions to applications No. UK00003872373 and No. UK00003867124 have failed on all grounds. Subject to any successful appeal, both applications by British American Tobacco (Brands) Limited may proceed to registration.

COSTS

52. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. While separate counterstatements were made for each individual case, the substance of each counterstatement was the same, which I take into account accordingly. I also take into account that one set of evidence and written submissions was filed in support of both applications in these consolidated proceedings. Applying the guidance in the TPN, I consider the following to be fair:

Considering the notices of opposition and preparing counterstatements: (x2)	£300
Preparing evidence and considering and commenting on the opponent's evidence:	£600
Preparing written submissions in lieu of a hearing:	£500
Total:	**£1400**

53. I therefore order Swedish Match North Europe AB to pay British American Tobacco (Brands) Limited the sum of £1400. 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 22nd day of July 2025

Suzanne Hitchings
For the Registrar,
the Comptroller-General