O/0704/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3823317 BY SAMI ASGHAR & RAFI ASGHAR TO REGISTER THE TRADE MARK:

Biccy Baccy

IN CLASS 34

AND

OPPOSITION THERETO UNDER NO. 437664 BY BHOPINDER SINGH & AJIT SINGH CHAWLA

BACKGROUND & PLEADINGS

1. Sami Asghar and Rafi Asghar ("**the applicants**"), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 24 August 2022. It was accepted and published in the Trade Marks Journal on 9 September 2022 for the following goods:

> **Class 34:** Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid]; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Liquid solutions for use in electronic cigarettes.

2. On 22 November 2022, Bhopinder Singh and Ajit Singh Chawla ("**the opponents**") opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**") [1]. The opponents are the proprietors of the following mark:

Trade Mark no.	UK00003014893
Trade Mark (Series of two)	IBACCY ibaccy
Goods & Services for which the mark is registered	Classes 14, 34 & 35
Filing date	23 July 2013
Date of entry in register	18 October 2013

[1] 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.

3. For the purpose of this opposition, the opponents rely on Class 34 goods of the earlier mark, as follows:

> **Class 34:** Smokers' articles, tobacco, electronic smokers' articles.

4. For ease of reference, from this point onwards in this decision, I will refer to the parties in the singular as the "applicant" and the "opponent". In addition, I will refer to the series of the earlier mark as the opponent's 'earlier mark', unless it becomes necessary to differentiate between the marks which comprise the series.

5. The opponent argues that there is a likelihood of confusion between the competing marks due to the aural similarities. The opponent also claims that the goods are identical and similar. Therefore, registration of the contested mark should be refused under Section 5(2)(b) of the Act, and an award of costs be made to the opponent.

6. The applicant filed a notice of defence and counterstatement[2] asserting the following:

> "[…] The earlier mark relied upon by the opponent is 'Ibaccy' for 'Smokers' articles, tobacco, electronic smokers' articles.' As a form of resolution we have filed amendments to the application such that the terms and goods of coverage by our trademark is not the same nor to that of the opponents specially as we have been manufacturing flavours with a biscuit flavour (biccy baccy). These are electronic flavours and not smokers articles, tobacco nor electronic smokers articles." [sic]

The applicant requested that the opponent provides proof of use of its earlier mark relied upon.

[2] I note that the applicant filed a late TM8 which the Registry admitted into the proceedings with its official letter dated 7 July 2023.

7. Only the opponent filed evidence in these proceedings, which will not be summarised but will be referred to as and where appropriate during this decision.

8. No hearing was requested. Only the opponent filed written submissions in lieu of a hearing, and so this decision is taken following a careful perusal of the papers.

9. In these proceedings, the opponent is represented by National Business Register Group Ltd and the applicant is a litigant in person.

EVIDENCE

Opponent's Witness Statement

10. Only the opponent filed evidence in these proceedings. It consists of a witness statement dated 31 August 2023 of Mitchell Willmott of the National Business Register Group Limited, the representative of the opponent in these proceedings. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used for the relevant period.

11. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

DECISION

Relevant Date/Period

12. An "earlier trade mark" is defined in Section 6(1) of the Act:

> "(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that

of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

[…]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. […]"

13. As the earlier mark relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

"(1) This Section applies where–

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

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

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

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

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

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

14. In accordance with Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier mark. The relevant period for proof of use of the opponent's mark is **25 August 2017 to 24 August 2022**.

15. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **24 August 2022**.

Proof of Use

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

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
>
> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark:

Ansul at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor

is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

17. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

Form of the Mark

18. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use',

within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark."

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (Emphasis added)

19. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I,

HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

20. There are examples of use of the earlier mark as registered in the evidence, such as invoices. There is also use in the following forms:

i. 

ii. 

iii. 

iv. I-baccy/i-baccy

21. Although the earlier mark "IBACCY/ibaccy" is registered as a word mark, the evidence shows that the mark is used as a composite mark with the initial letter 'i' being a cigarette device in various colours (as shown in i. - iii. above). Also, the mark is used with a hyphen separating the initial letter 'I/i' and the word "baccy" (see 'iv' above). In my view, the mark as registered, while fully incorporated in the composite mark, retains its

independent use as an indicator of origin, pertaining to the *Colloseum* principles. The same applies in the case where the letter 'I/i' and "baccy" are connected with a hyphen. Consequently, I find that the forms of use set out above may also be taken into account. If I am wrong, I do not consider that the use in these forms alters the distinctiveness of the registered mark, and these are variants upon which the opponent can rely, as per *Lactalis*.

Genuine Use

22. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

23. The witness statement of Mitchell Willmott states that:

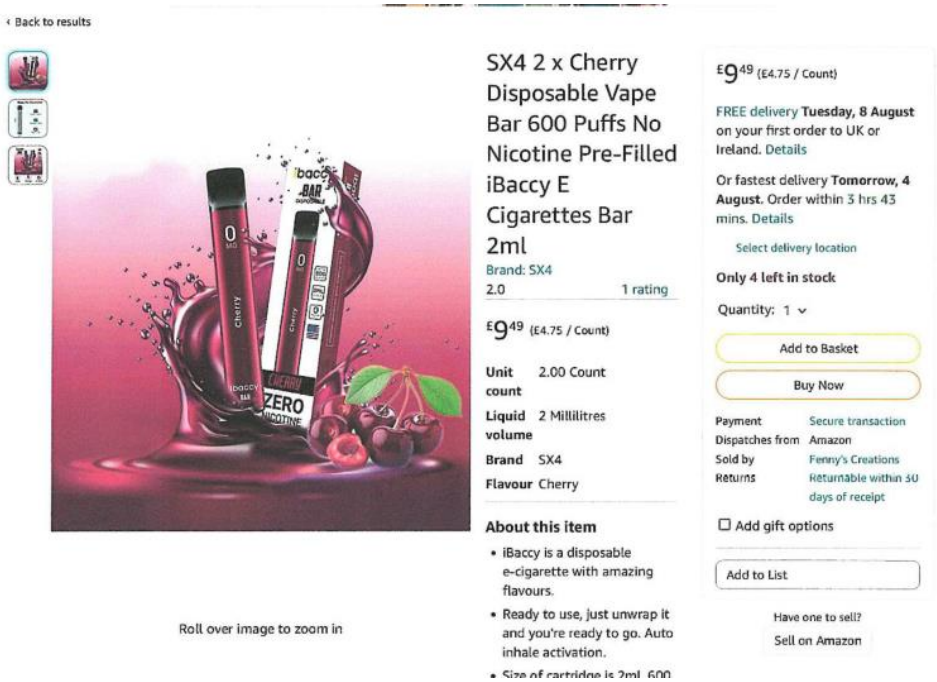
> "The evidence, in particular, the invoices exhibited within this Witness Statement are raised in the names of Prince Cash & Carry Limited and Prince Electronics Limited. It should be noted that the Opponent is a director of Prince Cash & Carry Limited and a director and secretary of Prince Electronics Limited. **Exhibit MW1** contains information from Companies House to confirm that the opponent is an officer of both Prince Electronics Limited and Prince Cash & Carry Limited."

24. Mr Willmott also explains that the opponent initially used its earlier mark in 2013 by selling electronic smokers articles within its website *ibaccy.co.uk* (**Exhibit MW2**).

25. According to the witness, the opponent's goods are now sold through third party websites such as ebay, Amazon, ShishaVibe, and Juicedoutvapes.

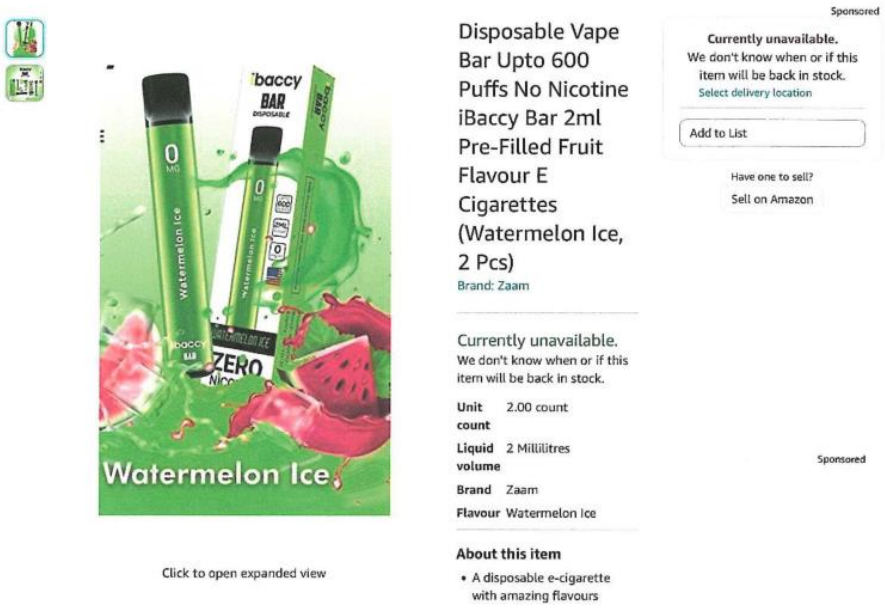
Exhibit MW3 consists of screenshots taken from the above websites. However, I note that the majority of the screenshosts are undated, apart from the following:

a.

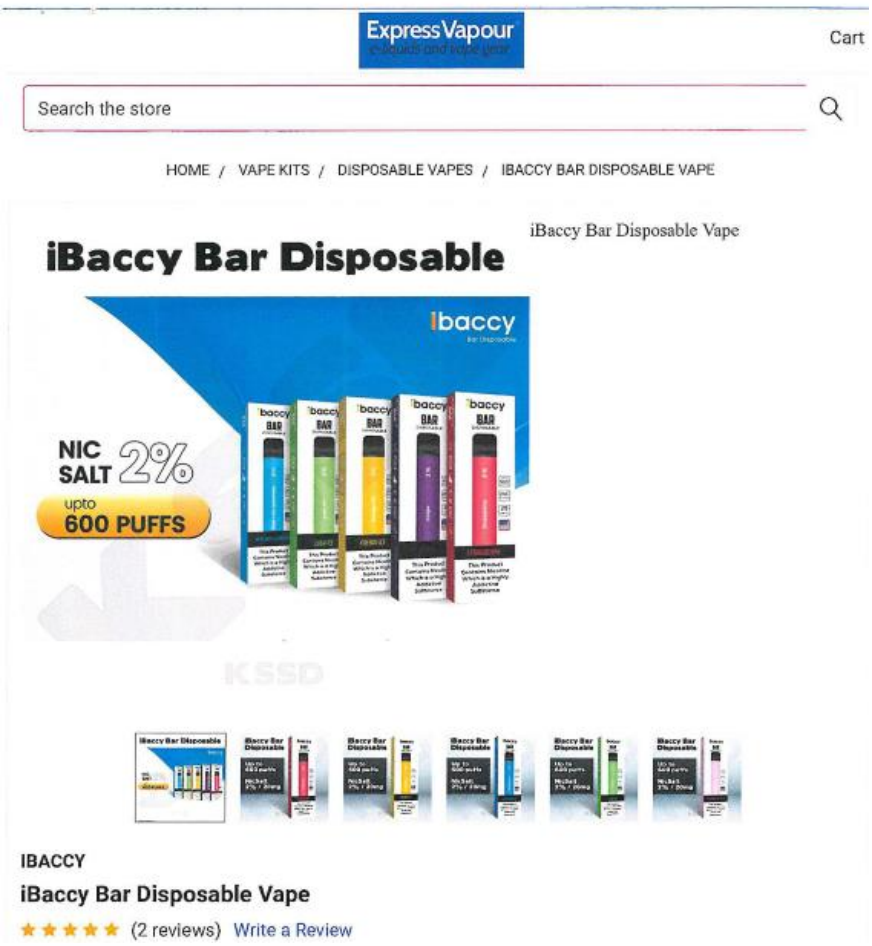


According to the screenshots, the goods were initially available on 18 November 2021. Therefore, it falls within the relevant period.

b.



According to the screenshots, the goods were initially available on 3 March 2022. Therefore, it falls within the relevant period.

c. 

Although the above screenshot is undated, there are two user reviews dated 18 October 2021 and 29 November 2021 from which it can be inferred that the exhibited goods were made available sometime before that date and within the relevant period.

26. In addition to the above screenshots, **Exhibit MW4** contains a selection of UK invoices dated between 2017 and 2022 illustrating sales of goods under the earlier mark in the UK. According to Mr Willmott and Exhibit MW1, the opponent is the director of 'PRINCE ELECTRONICS LTD', the company that issued the said invoices. I have considered all the invoices filed and note that they contain the sale of a range of goods under the earlier mark, such as e-liquid iBaccy; i-baccy plug; i-baccy USB cable; i-baccy spartan clearomizer; i-baccy twist (1300-2600 MAH); ibaccy Neutronstar Tank; i-baccy irontrick tank; i-baccy Ce4 Automisor; i-baccy CE4 kit; Ibaccy bar. The total amount from these sales exceeded £54,000 within the relevant period. The invoices contain the description, quantity in

units, unit price and the total amount. All the invoices are UK sales and are addressed to various customers in the UK, including Edinburgh, Sutton, Portsmouth, Bromsgrove, Glasgow, London, Hockley, Southall, and Argyll and Bute.

27. In addition, undated screenshots containing product packaging of the opponent's goods are provided with **Exhibit MW5** demonstrating goods under the registered mark and its forms. However, their evidential value is limited due to the lack of a date on these materials.

28. Although the evidence could have been better and more comprehensive in parts, such as how the goods were marketed, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.[3] Even though the opponent did not provide any evidence as to turnover figures or the market share it possesses, and the marketing expenditure, I am satisfied that the evidence supports that the opponent has operated in a way aimed at real commercial exploitation and has done so for a number of years. Bearing in mind the evidential picture as a whole, I am satisfied that the evidence supports genuine use of the mark in the UK during the relevant period. As such, the opponent can rely upon the registered mark for the purposes of these proceedings.

Fair specification

29. I must now consider what a fair specification would be for the use shown.

30. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

[3] See *New Yorker SHK Jeans GmbH & Co KG v OHIM,* T-415/09.

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

31. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to Section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a

mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc [2015] EWCA Civ 220 ("Asos")* at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

32. The goods at issue are in Class 34 for which the opponent made a statement of use. The opponent has submitted that the earlier mark has been used in relation to all the goods relied upon in this opposition.

33. One of the areas in which the opponent's evidence could have been more helpful is to illustrate the link between what they have used the mark on and how that relates to the specification they have registered. The earlier specification reads as follows:

Class 34: Smokers' articles, tobacco, electronic smokers' articles.

34. Some of the terms in Class 34 are far too broad to properly reflect the use shown and would not represent a fair description. From my perspective, the evidence only really shows use of the mark on goods that directly concern e-cigarette goods. This is also evident from the witness statement where reference is made only to the sales of electronic smokers' articles. Consequently, I consider a fair specification to be:

Class 34: Electronic smokers' articles.

Section 5(2)(b)

35. Section 5(2)(b) of the Act states:

> "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."

36. The principles, considered in this opposition, stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):

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

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

attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of Goods

37. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

> "23. 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 complementary."

38. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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."

39. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "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 für 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."

40. Taking into account the fair specification as set out earlier in this decision, the competing goods to be compared are shown in the following table:

Opponent's Goods	Applicant's Goods
Class 34: electronic smokers' articles.	**Class 34:** Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid]; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Liquid solutions for use in electronic cigarettes.

41. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are

sufficiently comparable to be assessed in essentially the same way for the same reasons.[4]

42. The contested goods are electronic cigarette liquid goods for use in electronic cigarettes. The earlier term "*electronic smokers' articles*" is a broad term that would readily cover the contested goods. Therefore, I find them to be identical as per *Meric*. If I am wrong on this finding, they are similar to a high degree as they may share the same nature, purpose, users, method of use, trade channels and they are complementary and in competition.

Average Consumer and the Purchasing Act

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

> "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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

[4] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

44. The goods in question are items of relatively low value, directed at the part of the general public (over the age of 18) who use e-cigarettes, which will be the same as those consumers who use e-liquid/e-cigarette flavourings. The goods are sold through a range of channels, including newsagents, general retail premises or in specialised vape or e-cigarette stores, and online. The goods are likely to be self-selected via visual means. However, since they are generally behind the counter goods, a request for the goods and then a supply by a member of staff is likely, which gives rise to aural considerations. Even where this occurs, the consumer will still review the product visually. For online sales, the consumer will select the goods having viewed an image displayed on a webpage. Both visual and aural considerations will, therefore, play a part in the selection process. During the selection process, consumers will primarily consider factors such as price, ease of use, taste and nicotine content. Taking these matters into account, I consider that an average degree of attention will be paid when selecting the goods.

Comparison of Trade Marks

45. 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."

46. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

47. The marks to be compared are:

Earlier Mark (Series of Two)	**Contested Mark**
IBACCY ibaccy	Biccy Baccy

Overall Impression

48. The earlier mark is a word mark in upper/lower case and standard type face. Registration of a word mark protects the word itself.[5] The overall impression of the mark lies in the word itself.

49. The contested mark consists of two words “Biccy Baccy” capitalised and in standard typeface. The overall impression of the mark lies in the words themselves with neither word dominating the other.

Visual Comparison

50. The earlier mark consists of a single word, “IBACCY/ibaccy”, which is six letters long, whereas the contested mark consists of two words “Biccy Baccy” which are ten letters long. I bear in mind that the beginnings of words tend to have more impact than the ends.[6] In particular, I note that

[5] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[6] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

both marks share the same word element “Baccy”. However, the marks differ in more than one element. In particular, there is no counterpart of the word “Biccy” in the earlier mark, which is also the first word element in the contested mark. In addition, the marks differ in the presence/absence of the initial letter “I/i” appearing in the earlier mark. Thus, weighing the various points of similarity and difference, I consider that the marks are visually similar to between a low to medium degree.

Aural Comparison

51. The earlier mark will be verbalised either as “IE-BAK-EE” or “EYE-BAK-EE” and the applicant’s as “BIK-EE-BAK-EE”. The earlier mark is three syllables long, and the contested mark is four, from which they share the last two syllables. However, there is no phonetic counterpart for the word element “BIK-EE” in the earlier mark, nor a phonetic counterpart of the “IE/EYE” syllable in the contested mark. I find that the degree of aural similarity falls somewhere between low and medium.

Conceptual Comparison

52. The opponent submitted that:

> “Conceptually, the earlier trade mark and the opposed trade mark are also conceptually similar. Both trade marks are based around the term BACCY which is another term for tobacco. However, electronic smokers' articles including e-cigarettes and e-liquids used in e-cigarettes do not contain tobacco. Subsequently, the use and reference to the term BACCY in respect to electronic smokers' articles is memorable which is likely to result in a likelihood of confusion and a likelihood of association.”

53. The competing marks share the common word “Baccy”, which the UK average consumer will understand as the slang term for tobacco. This will also be perceived as suggestive of the goods, such as tobacco-flavoured e-liquids or an alternative for tobacco. Despite the suggestive quality of this word in the competing marks, it still contributes towards the overall impression of the marks and cannot be disregarded completely. In addition, the letter “I/i” in the contested mark will be understood as such with no further concept attributed to it. Further, the contested mark contains the word “Biccy”, which the applicant in their counterstatement suggests means “biscuit flavour”. I agree and consider that a significant proportion of the consumers will understand “Biccy” colloquially as meaning ‘biscuit’. When the contested mark is viewed as a whole, I consider that the combination of the words will give rise to a unified meaning, namely biscuit-flavoured tobacco, that will hang together. Taking all the above factors into account and the overall impression of the marks, I find that the marks are conceptually similar to between a low and medium degree.

Distinctive Character of the Earlier Trade Mark

54. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> “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).
>
> 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)."

55. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

56. As outlined in the previous section, the opponent's (series of two) word mark "IBACCY/ibaccy" contains the slang term "-baccy", which is the only common element with the contested mark.[7] When considered against the goods relied upon, I find that it will be viewed as a suggestive term relating to the taste of the goods or an alternative for tobacco. That being said, the structure of the mark with the letter 'i' conjoined with a well-known word ("IBACCY/ibaccy") will award some degree of distinctiveness to the mark. Bearing in mind when making my assessment that a registered trade mark must be considered to have at least a minimum degree of distinctive character,[8] and weighing all the factors, I find the earlier mark is inherently distinctive to a low degree.

[7] *Kurt Geiger v A-List Corporate Limited*, BL O/075/13.

[8] *Formula One Licensing BV v OHIM,* Case C-196/11P.

Enhanced Distinctiveness

57. I find the evidence insufficient to demonstrate that the mark has acquired an enhanced degree of distinctive character through use in the UK for the given goods for which the opponent has genuinely used the mark. The sales, which have been evidenced, do not strike me as particularly significant in what must be a significant market in the UK. Although invoices are provided, there is no indication of turnover figures or the market share held by the mark. Also, no evidence of promotional material or activities were provided to support any extensive media coverage or intensive advertising or promotional activities in the UK. I do not consider that the use shown establishes enhanced distinctiveness for the average consumer as a whole or even for a significant enough subset of average consumers. Overall, the evidence is insufficient to demonstrate enhanced distinctiveness.

Likelihood of Confusion

58. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.[9] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[10]

[9] See *Canon Kabushiki Kaisha*, paragraph 17.

[10] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

59. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

60. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

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

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[11]

61. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

[11] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

62. Earlier in this decision I have concluded that:

- the competing goods at issue are identical;
- the average consumer of the Class 34 goods will be an adult member of the general public. The selection process is predominantly visual without discounting aural considerations. Depending on the cost, ease of use, taste and nicotine content of the item, the degree of attention will be average;
- the competing marks are visually, aurally, and conceptually similar to between a low and medium degree;
- the earlier mark has a low degree of inherent distinctive character, and the use is not sufficient to establish enhanced distinctiveness of the mark.

63. Taking into account the above factors and even considering the identical goods in play, there is no likelihood of direct confusion. Notwithstanding the principle of imperfect recollection, the consumers will not confuse one mark for the other. Despite the shared common word element/component “baccy” in the competing marks, which is considered to be too weak, the average consumer will not misremember/misrecall the marks as each other, especially in light of the additional and divergent word component “Biccy” present in the beginning of the contested mark, a position which is generally considered more impactful. In this respect, and according to the rationale in *Kurt Geiger* as quoted above*,* the likelihood of confusion in this case is reduced. Thus, the various differences between the competing trade marks previously identified are, in my view, sufficient, and, as a result, the marks will not be directly confused.

64. Even if the average consumer recalls the points of similarity between the marks, such as that both contain the common word component “baccy”, I still consider the marks would not be indirectly confused. Sitting

as the Appointed Person in *Eden Chocolat,*[12] James Mellor QC (as he then was) stated:

> "81.4 […] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining[13] in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.'" (Emphasis added)

65. Following the rationale above, the words of the contested mark "Biccy Baccy" form a cohesive whole. The overall impression lies within the words with none dominating the other. In this regard, the average consumer will not consider the respective marks as variants or sub-brands of each other nor that the goods in question are from the same or economically linked undertakings merely on the use of the weak word component "-baccy". I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse the two. Thus, I consider that there is no likelihood of indirect confusion.

OUTCOME

66. There is no likelihood of confusion. **The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to appeal, the application can proceed to registration.

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[12] Case BL O/547/17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017).

[13] In *L.A. Sugar*.

COSTS

67. This opposition has failed in its entirety and the applicants are entitled to a contribution towards their costs of defending their application. The applicants were not professionally represented and submitted a completed cost proforma to the Tribunal, outlining the number of hours spent on these proceedings. I set out below my assessment on the claim made. However, the award is subject to an assessment of the reasonableness of the claim, and it should be noted that a costs award is intended to be a contribution towards costs rather than full compensation.

68. I will make the award of costs on the basis of £19.00 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended). The sum is calculated as follows:

    a. The applicants claimed 2 hours for filing the Notice of Defence and 2 hours for considering the forms filed by the other party. I consider this to be a reasonable claim.

    b. The applicants claimed a total of 21 hours for:

        i. preparing and filing a witness statement (including "reasoning of delayed response") together with evidence X 13 hours;

        ii. submissions 21-12-2023 X 7 hours, and "phone call to the IPO X 1 hour".

    First, I note that the tasks regarding point 'i.' relate to the late filing of the Form TM8. Whilst I accept that the applicants have claimed costs for the work done in relation to the admission of their late TM8, which included the preparation of (minimal) evidence, I do not consider it appropriate to make a costs award to the applicants for

work which arose from their own error/failure to meet the deadlines. Second, in relation to point 'ii.' above, the activities involving communication with the Registry and the applicant's response dated 21 December 2023 to the preliminary view of the Registry are not costs that would be recoverable on the usual scale. Therefore, I make no award for the above claims.

The total award is £76 (4 hours at £19 per hour).

69. I, therefore, order, Bhopinder Singh and Ajit Singh Chawla, being jointly and severally liable, to pay Sami Asghar and Rafi Asghar the sum of £76. 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 26th day of July 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General