O/0747/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK REGISTRATION NO. 3841865
IN THE NAME OF SHENZHEN SENDAO TECHNOLOGY CO., LTD
IN RESPECT OF THE TRADE MARK

Love Mary

IN CLASS 34

AND

THE APPLICATION FOR THE INVALIDATION THEREOF UNDER NO. 506036
BY IMIRACLE (HK) LIMITED

Background and pleadings

1. On 24 October 2022, Shenzhen Sendao Technology Co., Ltd ("the proprietor") applied to register the trade mark no. 3841865 for the mark Love Mary in the UK. It was accepted and published in the Trade Marks Journal on 3 November 2022, and was registered on 13 January 2023 in respect of the following goods:

> Class 34: *Electronic cigarettes; Electronic cigars; Electronic nicotine inhalation devices; Liquid solutions for use in electronic cigarettes; Filter-tipped cigarettes; Cigarette lighters; Cigarette cases; Cigarette paper; Tobacco filters; Flavourings, other than essential oils, for use in electronic cigarettes.*

2. On 26 April 2023, Imiracle (HK) Limited ("the cancellation applicant") applied to invalidate the trade mark on the basis of section 47(2)(a) and 5(2)(b), and section 47(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. The application for invalidation based on section 5(2)(b) of the Act relies upon the cancellation applicant's earlier UK designation of International Trade Mark no. 1616521, for the mark set out below:

> **LOST MARY**
>
> Designation date: 4 August 2021
> IR registration date: 4 August 2021
> Date of protection in the UK: 20 January 2022
> Relying on all goods as registered, those being:
> Class 34: *Cigarettes; cigarette tips; oral vaporizers for smokers; matches; lighters for smokers; cigarette filters; flavourings, other than essential oils, for tobacco; liquid solutions for use in electronic cigarettes; electronic cigarettes; cigarette cases.*

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance section 6 of the Act.

5. The cancellation applicant argues that the respective goods are identical or highly similar and that the marks are similar, and that as such, there is a likelihood of confusion including a likelihood of association between the marks. It therefore submits the proprietor’s mark should be declared invalid under section 5(2)(b) of the Act.

6. The cancellation applicant also argues that it has used its sign (that being the mark set out in relation to the 5(2)(b) ground) throughout the UK since at least January 2022 in respect of the following goods:

> *Cigarettes; oral vaporizers for smokers; flavourings, other than essential oils, for tobacco; liquid solutions for use in electronic cigarettes; electronic cigarettes; cigarette cases; disposable vapes.*

7. The cancellation applicant argues that by virtue of this use, it has acquired goodwill in its business under the sign in the UK, and that use of the proprietor’s mark in relation to the goods as registered would amount to a misrepresentation, leading to damage. As such, it argues that the mark should be declared invalid under section 5(4)(a) of the Act.

8. The proprietor filed a counterstatement denying the similarity between the marks under section 5(2)(b), and denying there would be a misrepresentation under section 5(4)(a).

9. Only the cancellation applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

10. A Hearing took place on 12 June 2025 via video conference. The cancellation applicant is represented in these proceedings by Maucher Jenkins and was represented at the hearing with by Katie Cameron of the same. The proprietor is represented in these proceedings by Eric Mo, but opted not to attend or be represented at the hearing, nor to file written submissions in lieu of the same.

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

Evidence

12. The cancellation applicant filed its evidence in the form of a witness statement in the name of Zeyuan Tang, Internal Legal Counsel for the cancellation applicant. The statement introduces 11 exhibits, namely Exhibit ZT1 – ZT11. Exhibit ZT8 is subject to a confidentiality order, withholding the document from public inspection. The statement is dated 29 March 2024 and goes to the use of the cancellation applicant's mark, as well as to the use of the proprietor's mark and to the existence of what are described as "imitation products"[1] from third parties.

Decision

Section 5(2)(b)

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

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

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

[1] See paragraph 14 of the witness statement of Zeyuan Tang

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

15. The relevant part of section 47 of the Act states as follows:

"47. –

(1) […]

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, […]

[…]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

…

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met

16. As the earlier mark not been granted protection for a period of five years or more at the date on which the invalidation was filed, it is not subject to the use provisions set out at section 47(2A) of the Act.

The Principles

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

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

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

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are

apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court ("GC") stated that there is complementarity where:

> *"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".*

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

> *"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".*

23. In this instance, the cancellation applicant has pleaded that the proprietor's following goods are identical to its own goods protected under the earlier mark:

> Class 34: *Electronic cigarettes; Electronic nicotine inhalation devices; Liquid solutions for use in electronic cigarettes; Cigarette lighters; Cigarette cases; Tobacco filters; Flavourings, other than essential oils, for use in electronic cigarettes.*

24. It pleaded that the remaining goods, as outlined below, are highly similar:

Class 34: *Electronic cigars; Filter-tipped cigarettes; Cigarette paper.*

25. In its TM8, the proprietor states:

> *"1. Response to 5(2)(b): It is similar to an earlier mark and for identical or similar goods or services as the earlier mark. The mark UK00003841865 is not similar to the earlier mark WO000001616521, I disagree with this for the following reasons.*
>
> > *[…]*
> >
> > *(3) The mark UK00003841865 is similar to the goods or services as the earlier mark WO000001616521, I agreed it."*

26. I note at the hearing, Ms Cameron tweaked the cancellation applicant's position slightly, submitting that all of the goods were identical or highly similar as pleaded, with the exception of *electronic cigars*, which were instead similar.

27. I take the proprietor's statement in its TM8 as an agreement with the cancellation applicant's pleadings as to the high similarity and identity of the contested goods. However, I also accept that Ms Cameron altered this slightly, to submit that *electronic cigars* are only similar to the earlier goods. I therefore find the goods identical or highly similar, in the manner that has been set out by the cancellation applicant in its pleadings, with the exception of electronic cigars, which I will come onto below.

28. However, in case I am wrong to take the proprietor's statement as a blanket acceptance of the cancellation applicant's pleadings, it is in any case my view that the goods identified by the cancellation applicant as identical are indeed identical to its earlier goods, either self-evidently, or in accordance with the principles set out in *Meric*. Further, I note I would in fact also find *filter-tipped cigarettes* identical to the earlier *cigarettes* in accordance with the principles set out in *Meric*, if I were not limited to the cancellation applicant's pleading of high similarity. I would also find *cigarette paper* highly similar to *cigarette tips* in that they may be used together for a shared purpose,

they are likely to share users and trade channels, and they will be complementary in the sense that they are likely important to one another, and the consumer will believe they derive from the same entity.

29. In respect of *electronic cigars,* I consider these are of a similar nature to the earlier *electronic cigarettes*, both being small electronic items filled with a liquid which likely includes nicotine. They share a similar purpose, that being for smoking and/or the absorption of nicotine, and they share a method of use. The goods may also share users by way of the general public wishing to consume nicotine-based products, and will likely share trade channels. Due to the overlap in purpose, there may also be an element of competition between these goods. Overall, I find these to be similar to the earlier *electronic cigarettes* to a at least a medium degree.

Comparison of marks

30. 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."*

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

32. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
LOST MARY	LOVE MARY

33. The earlier mark comprises the two words LOST MARY. These play the most dominant role in the overall impression of the mark. Whilst I note that the beginnings of marks tend to have more impact on consumers, in this instance I consider that the word LOST serves to describe the state MARY is in, and as such MARY plays a slightly more dominant role in the mark overall. The stylisation of the mark plays a much smaller role in the overall impression than the wording itself.

34. The contested mark comprises the two words LOVE MARY. Again, it is my view that the word MARY plays a slightly more dominant role in the mark, on the basis LOVE describes either a feeling for MARY, or that something is from MARY, with LOVE.

Visual comparison

35. Visually, the marks coincide through the use of the initial two letters and the second four letter word. They differ by way of the last two letters in the first word in each mark, those being “ST” in the earlier mark, and “VE” in the contested mark. I also note the addition of the stylisation of the earlier mark. However, I consider the contested mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39, meaning the stylisation of the earlier mark makes less impact visually. Overall, considering particularly that 6 out of 8 letters of the marks are shared, I find the marks to be visually similar to a fairly high degree.

Aural comparison

36. Aurally, the marks coincide through the use of the same 'LH' sound at the beginning of the marks, and the same two syllable word at the end of the marks. They differ by way of the remaining part of the first syllable and first words, those being LOVE and LOST, pronounced in the normal way.

37. Overall, I find the marks aurally similar to between a medium and high degree.

Conceptual comparison

38. Conceptually, the marks coincide through the use of the same name Mary. They differ on the basis that the earlier mark refers to Mary being lost, i.e. not able to find her way, either geographically or existentially. On the other hand, the contested mark conveys the concept of feeling love towards Mary, or of a sign off, indicating that the goods themselves stem from Mary with love. Overall, considering both marks refer to a person called "Mary", they are conceptually similar to a medium degree.

Average consumer and the purchasing act

39. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case* C-342/97.

40. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> *"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively*

by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

41. Within her skeleton arguments, Ms Cameron submitted that the consumer would pay an average level of attention to the goods, as they will be regular purchases, but factors such as safety, nicotine content and flavour will be considered.

42. It is my view that the average consumer of the applicant's goods will be a member of the general public aged over 18 years old. The goods will likely be a relatively frequent purchase and priced at a relatively low cost. In respect of the goods such as electronic cigarettes and cigars and liquids and flavours for these, the consumer will likely consider factors such as price, flavour and nicotine content. I agree with the cancellation applicant that an average (or medium) level of attention will be paid towards these goods. Goods such as cigarette papers and filters are likely to be at a lower price point and there are likely to be fewer considerations made during the purchasing process, although it is possible the quality and effectiveness of the goods may be considered. However, I accept the cancellation applicant's position that an average (or medium) level of attention will be paid in respect of these goods.

43. The goods at issue will be purchased in online or in person retail stores, as well as in specialist vape stores or tobacconists. In the case of retail stores, electronic cigarettes containing nicotine will likely be stored behind a counter and the consumer may be required to seek verbal assistance from retail staff in order to make a purchase. In addition, advice may be sought from a shop assistant in relation to all of the goods, either in person or over the phone, and there is the possibility of word-of-mouth recommendations. Aural considerations will therefore play an important role in the purchasing act. However, I also consider that visual considerations will play at least an equal role, as the consumer will have sight of the packaging at the point of sale, and particularly online, the consumer will make primarily visual purchases. I therefore consider that both aural and visual considerations will play a role during the purchasing process.

Distinctive character of the earlier trade mark

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

> *"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 WindsurfingChiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).*
>
> *23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."*

45. The earlier mark comprises the two words LOST MARY, presented in a stylised font. It is my view that it conveys to the consumer the concept of a woman called Mary who is or feels lost. I do not consider this to be descriptive or allusive of the goods, and it appears to be slightly unusual, despite it being formed of a known name and a dictionary word. It is my view it holds slightly above a medium degree of distinctive character inherently.

46. The cancellation applicant has also filed evidence relating to the use of its mark in the UK. I will therefore consider whether the distinctive character of the mark has been

enhanced through the use of the same. When considering whether the distinctive character of a trade mark has been enhanced, it is the perception of the UK consumer at the relevant date, that being the filing date of the contested mark of 24 October 2022, that is key.

47. In the witness statement, Zeyuan Tang confirms that the cancellation applicant has sold electronic cigarettes and vaping products under the mark since March 2022,[2] and provides its monthly UK unit sales to its principal importer dating back to April 2022.[3] These are set out below:

Period	**LOST MARY Unit Sales (UK)**
April 2022	1,269,662
May 2022	4,077,450
June 2022	3,977,700
July 2022	3,848,100
August 2022	5,637,204
September 2022	6,377,933
October 2022	9,235,818
Total	**34,423,867**

48. Zeyuan Tang also confirms that a further 18 million units were sold prior to its other UK distributors in advance of the filing date of the contested mark.[4] Further, Exhibit ZT7 comprises a market insight report from German statistic and data analytics company Statista, which states that the LOST MARY e-cigarette was the second most used e-cigarette product in the UK in 2022. In addition, Exhibit ZT6 provides an extract of a report showing that goods sold under the earlier mark held an 11% market share as of 23 October 2022, a day prior to the relevant date.

49. In the witness statement, Zeyuan Tang explains that no advertising has taken place under the mark due to UK regulatory laws.[5] However, printouts of the mark in

[2] See paragraph 3 of the witness statement of Zeyuan Tang.
[3] See paragraph 6 of the witness statement of Zeyuan Tang.
[4] See paragraph 8 of the witness statement of Zeyuan Tang.
[5] See paragraph 12 of the witness statement of Zeyuan Tang.

use on products on providers websites are provided at Exhibit ZT3. Whilst the pages are dated shortly after the filing date, Zeyuan Tang confirms in the witness statement that these are "…reflective of the position at the filing date".[6] These provide clear images of the mark relied upon being used (albeit in white[7]) on disposable vapes. I have considered the sum of the evidence, and I note have no reason to doubt that this is reflective of the sign used during the relevant period in the UK.

50. Whilst I have not listed all of the evidence at this stage, this has nonetheless been considered in its entirety. Whilst I note that the mark had only been in use for a relatively short space of time prior to the filing date, I also note the high level of quickly increasing unit sales during this period, as well as the significant market share held by the cancellation applicant for goods under the mark on the day prior to the relevant date. It is my view that, with consideration to the evidence as a whole, the distinctiveness of the earlier mark had been enhanced to a high degree at the relevant date, in respect of *oral vaporizers for smokers* and *electronic cigarettes*.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

51. Prior to reaching a decision under Section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 17 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[8] I must keep

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[6] See paragraph 5 of the witness statement of Zeyuan Tang.
[7] As the mark is filed in black it is my view it may be used in any colour, including white.
[8] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the

in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods are obtained will have a bearing on how likely the consumer is to be confused.

52. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[9]

53. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

54. I firstly consider the position in respect of direct confusion. I found the marks visually similar to a fairly high degree, and aurally similar to between a medium and high degree. I found the marks to be conceptually similar to a medium degree, but that LOST and LOVE convey different concepts in each. I found the goods to range from identical to similar to at least a medium degree. I found the mark to be inherently distinctive to slightly above a medium degree, but that its distinctiveness had been enhanced to a high degree by virtue of the use made of the same in respect of *oral vaporizers for smokers* and *electronic cigarettes*. I found the consumer would pay a medium degree of attention to the goods, and that both aural and visual factors will be important in the purchasing process.

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likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

[9] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

55. I consider that conceptual distinctions between marks can, in some instances, counteract aural and visual factors.[10] However, I note this is not always the case. For example, in *Nokia Oyj v OHIM,* Case T-460/07, the GC stated that:

> *"Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P Éditions Albert René [2008] ECR I-0000, paragraph 98)."*

56. Further I consider in particular the enhanced degree of distinctiveness of the earlier mark in respect of *oral vaporizers for smokers* and *electronic cigarettes*, and the impact this may have on consumers. In *Aveda Corporation v. Dabur India Ltd* [2013] EMTR 33 at [48] Arnold J as he then was said:

> *"The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear. Thus it is likely that some consumers would misread or mishear UVEDA as AVEDA".*

57. Whilst not all of the contested goods have been compared to those goods for which the high level of distinctiveness has been evidenced, I note where the similarity between the goods is at its lowest, those goods were nonetheless found to be similar to at least a medium degree with *electronic cigarettes*, goods for which the earlier mark holds a high degree of enhanced distinctiveness.

58. Considering all of the factors of this particular case, and keeping in mind the consumers imperfect recollection, it is my view that upon viewing the contested mark, a significant portion of consumers who have previously come into contact with the earlier mark are likely to fail to notice the differences between the same, despite the conceptual distinction created by the use of LOVE over LOST. I therefore find a likelihood of direct confusion between the marks.

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[10] *The Picasso Estate v OHIM*, Case C-361/04 P

59. In case I am wrong in my finding of direct confusion, I will now consider the likelihood of indirect confusion in this instance. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

> *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)."*

60. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

61. I note this is not a case that quite falls within one of the categories set out in *L.A. Sugar*. However, I remind myself that these are not intended to be exhaustive. I note

in this case, both marks are variations of “Mary” marks, for the most part registered in respect of highly similar or identical goods. “Mary” is the dominant element in each mark, and both make use of a similarly formed word proceeding this element. The earlier mark is considered to have at least an above medium level of distinctive character, or higher where this has been enhanced through use. Considering all the circumstances of this case, it is my view that should the consumer notice the difference between the words LOVE and LOST on the contested goods, there would be a significant portion of those consumers that would nonetheless believe that the two similar variations of the “MARY” marks, were representative of an alternative range of products deriving from the same economic entity.

62. For completeness, I note here that the consumer will not be generally consider the marks side by side. However, I do note the evidence provided by the cancellation applicant of goods under the two marks being sold in this way. In this instance, the evidence of the goods side by side on the marketplace only serves to reinforce the conclusion I have already reached. If the consumer were to notice the differences between the marks in this case, I find there would be a likelihood of indirect confusion in respect of all of the goods registered by the proprietor.

63. The application for invalidation based on section 47(2)(a) and 5(2)(b) of the Act succeeds in its entirety.

Section 5(4)(a)

64. Section 5(4)(a) states:

> “(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> > (aa) […]
> > (b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

65. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

66. The relevant parts of section 47 state:

"47. (1) […]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) […]
(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

67. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> *"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.*
>
> *56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21)."*

68. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

> *"43. In SWORDERS TM O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:*
>
> *'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position*

would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

69. In this case, the registration subject to invalidation was filed on 24 October 2022. The proprietor has filed no evidence of use in these proceedings. Whilst I note the cancellation applicant has filed evidence showing the use of the proprietor's mark, this post dates the relevant date. I therefore only have the position at the relevant date of 24 October 2022 to consider in this instance.

Goodwill

70. *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) defines goodwill as follows:

> *"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."*

71. In respect of the opposition based on section 5(4)(a) of the Act, the proprietor has stated in its TM8 as follows:

> *"2. Response to Invalidation is based on Section 5(4)(a): Where the use of the registered owner's trade mark would be contrary to law, in particular, the law of passing off.*
>
> *Since those trademark can be distinguished by people easily, it should not contrary to law."*

72. It is my view that the proprietor has not denied that the cancellation applicant held goodwill in its business distinguished by the earlier mark, in respect of the goods

pleaded. I therefore accept the cancellation applicant has goodwill in its business distinguished by the sign as pleaded.

73. I note however, the cancellation applicant has not pleaded any particular level of goodwill is held in its business as distinguished by its sign. It is therefore necessary to determine this at this stage. I again consider the sum of the evidence which I have set out at paragraphs 47 to 49 of this decision. Whilst I consider the evidence only covers a short period of time, I note the significant monthly turn over rising quickly from over a million GBP to over nine million GBP a month in the space of seven months, up to October 2022, the month in which the contested mark was filed. Further, I also consider the fact that the cancellation applicant was said to have an 11% market share as of 23 October 2022, a day prior to the relevant date, in respect of e-cigarettes under its mark. It is my view that there is no doubt that the cancellation applicant held a fairly high level of goodwill for its business in (at least) *oral vaporizers for smokers*, *electronic cigarettes* and *disposable vapes* and as distinguished by the sign relied upon in the UK at the relevant date. I therefore move on to consider if there exists a misrepresentation between the marks.

Misrepresentation

74. At the hearing, I note Ms Cameron for the cancellation applicant requested that I take into account that that the proprietor clearly has an intention to deceive. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL), Lord Simonds stated that:

> *“Confusion innocently caused will yet be restrained. But, if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade.”*

75. I note the cancellation applicant did not plead that the proprietor had an intention to deceive at the outset of these proceedings. However, the proprietor’s goods are clearly referred to as a “knock-off” product by Zeyuan Tang in the witness statement provided. Further, third party UK articles referring to goods under the proprietor’s mark as “knock-off” or “duplicate” products are provided at Exhibit ZT11. These display

products that seemingly derive from the proprietor using a very similar packaging and type face to that used by the cancellation applicant. This, in my view, and on the balance of the evidence provided, is highly unlikely to have been chosen incidentally. I have set out an example of this from the evidence in the images set out below:

76. Further, I note there was no response to these claims from the proprietor, who had an opportunity to reply to the same both in the evidence rounds and at the close of the proceedings. I am therefore minded to agree with the cancellation applicant that on balance, it appears there was an intention to deceive in this instance. Considering all of the factors of this case, including the distinctiveness of the earlier mark, the similarity of the marks and the significant overlap in field of activity, alongside this apparent intention to deceive, it is my view that misrepresentation may be readily inferred.

77. However, in case I am wrong to find an intention to deceive on the basis that it was not explicitly pleaded, it is my view that in any case and without this factor, that my findings on misrepresentation in this instance will follow my findings under section 5(2)(b) above. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

> *"… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."*

78. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

79. Although I note I have found goodwill to extend to a smaller list of goods than that relied upon under section 5(2)(b), I note the full specification concerns goods in the same field of activity, that being smoking and vaping. Further the mark relied upon under section 5(2)(b) and the sign relied upon under this ground are identical. Finally, I note that the high level of goodwill held in the business of *oral vaporizers for smokers*, *electronic cigarettes* and *disposable vapes* under this ground, and considering all of the factors, it is my view that the assessment of misrepresentation under this ground cannot produce a less favourable outcome for the cancellation applicant than my assessment of likelihood of confusion under section 5(2)(b). I find there to be a clear likelihood of misrepresentation present in relation to all of the contested goods.

Damage

80. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

> *"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant*

in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the Lego case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

81. In this case, it is my view that there exists a real likelihood of damage by way of substitution, as well as an obvious risk of damage should the cancellation applicant's customers be dissatisfied with goods purchased from the proprietor, under the mistaken belief that they derive from the cancellation applicant.

82. The cancellation applicant has been successful under section 5(4)(a) of the Act, and the registration will be invalidated in respect of all of the goods filed on this basis.

Final Remarks

83. The application for invalidation has been successful in its entirety. Subject to any successful appeal, registration no. 3841865 will be treated as though it was never registered.

COSTS

84. The cancellation applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the cancellation applicant the sum of £2100 in accordance with Tribunal Practice Notice 1/2023 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£200

Preparing and filing the TM26(I) and considering the TM8:	£400
Preparing the evidence:	£700
Preparing for and attending a hearing	£800
Total	**£2100**

85. I therefore order Shenzhen Sendao Technology Co.,Ltd to pay Imiracle (HK) Limited the sum of £2100. 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 11th day of August 2025

R. Le Breton
For the Registrar