

O/0887/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003692579
BY KARELIA TOBACCO COMPANY INC
TO REGISTER:**



AS A TRADE MARK IN CLASS 34

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 430635
BY STARBUZZ TOBACCO, INC.**

BACKGROUND AND PLEADINGS

1. On 09 September 2021, KARELIA TOBACCO COMPANY INC (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and is effectively a clone of EUTM application no. 017964203, claiming a priority date of 2 October 2018 from that EUTM.¹ The application was accepted and published in the Trade Marks Journal on 29 October 2021 in respect of the following goods:

Class 34: *Tobacco, cigars, cigarettes, electronic cigarettes, cigarillos, smokers articles, ashtrays, cigarette cases, cigarette lighters, cigarette papers, matches, liquid solutions for use in electronic cigarettes.*

2. On 28 January 2022, the application was opposed by Starbuzz Tobacco, Inc. (“the opponent”) based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies upon the following trade marks and some of the goods covered by the same, as shown below:²

UK00912280418

MIST

Filing date: 05 November 2013

Registration date: 19 March 2014

Class 34: *Hookah tobacco.*

UK00911809738

BLUE MIST

¹ This is the filing date of the EUTM from which priority is claimed.

² The opponent originally relied upon another trade mark (no. UK00910651008), however, it subsequently dropped reliance on that mark

Filing date: 13 May 2013

Registration date: 08 October 2013

Class 34: *Electronic cigarettes; Electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes.*

UK00913705711

Dark Mist

Filing date: 03 February 2015

Registration date: 28 May 2015

Class 34: *Electronic cigarettes; Electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smokers' articles; tobacco; flavoured tobacco; smoking pipes; hookahs; e-hookahs; parts and fittings for the aforesaid.*

UK00917884200

Green Mist

Filing date: 06 April 2018

Registration date: 15 August 2018

Priority date: 28 March 2018³

Class 34: *Hookahs and electronic hookahs and accessories thereof; tobacco products; Tobacco substitutes, in particular those made out of tea and tea plants; cut and uncut tea for smoking as tobacco substitute; cigarette tobacco; chewing tobacco; pipe tobacco; shisha tobacco; smokers' articles of all kinds, in particular matches; shishas and electronic shishas and accessories thereof; electronic cigarettes; cigars; small cigars; electronic cigars; electronic vaporizing smoking*

³ Priority country: United States of America; TM from which priority claimed: 87853519

device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smoking pipes; steam stones, in particular steam stones for water pipes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; all the aforesaid goods not for medical purposes; flavored tobacco; herbal molasses; molasses tobacco; smoking tobacco; tobacco.

4. By virtue of their earlier filing/priority dates, the trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. As the opponent’s earlier marks had not been registered for five years or more at the priority date of the applied-for mark, they are not subject to the use conditions under Section 6A of the Act. Consequently, the opponent may rely on all of the goods it has identified without demonstrating that it has used the marks.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the marks are similar, and the goods are identical or similar.

6. The applicant filed a counterstatement, denying that there is a likelihood of confusion, though it did not specifically deny the similarity of the goods and the similarity of the marks.

7. The opponent is represented by Keltie LLP. The applicant is represented by Cleveland Scott York.

8. Both parties filed evidence. Neither party requested a hearing, but they both filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

9. 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

10. The applicant's evidence came in the form of three witness statements from, respectively: Rebecca Margaret Silva, Gavin Hyde Blake and Lucy Robinson.

11. Ms Silva is a Trade Mark Attorney employed by Cleveland Scott York, the representative acting for the applicant in these proceedings. Her witness statement is dated 21 October 2024 and is accompanied by 17 exhibits being those labelled RMS1 to RMS17. The purpose of Ms Silva's evidence is: (a) to provide evidence obtained through online research with respect to how the word 'mist' is used in language and associations between this word and other words such as 'smoke', 'vaping', 'shisha/hookah' and (b) to identify whether third parties have adopted trade marks for or that include the word 'mist' in relation to tobacco, shisha and vaping products, as well as other goods in class 34 and associated services.

12. Mr Blake is the Managing Director of Eccora Ltd, a company providing IP investigation, research and acquisition services to IP owners and their professional advisors. His witness statement is dated 11 November 2024, is accompanied by one exhibit (GHB1) and goes to demonstrate that there are third parties other than the opponent that are using marks in the form of, or including, 'MIST' in relation to e-cigarettes, vaping and shisha tobacco.

13. Ms Robinson is a qualified translator. Her witness statement is dated 15 November 2024, is accompanied by two exhibits (being those labelled LR1 to LR2) and is only a vehicle for introducing an English translation of two trade mark decisions written in Greek.

14. The opponent did not file any evidence in chief; however, it filed evidence in reply in the form of a witness statement from Jason Aghatise. Mr Aghatise is a trade mark

attorney and Senior Associate at Keltie LLP, the firm representing the opponent in these proceedings. His witness statement is dated 22 January 2025, is accompanied by 17 exhibits (being those labelled JS01 to JA17) and shows the result of internet searches.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

(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.”

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

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

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:

(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 greater 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 to mind the earlier mark, 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 *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

19. The competing goods are as follows:

The applicant’s goods	The opponent’s goods
Class 34: Tobacco, cigars, cigarettes, electronic cigarettes, cigarillos, smokers articles, ashtrays, cigarette cases,	UK00912280418
	Class 34: Hookah tobacco. UK00911809738

cigarette lighters, cigarette papers, matches, liquid solutions for use in electronic cigarettes.

Class 34: *Electronic cigarettes; Electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes.*

UK00913705711

Class 34: *Electronic cigarettes; Electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smokers' articles; tobacco; flavoured tobacco; smoking pipes; hookahs; e-hookahs; parts and fittings for the aforesaid.*

UK00917884200

Class 34: *Hookahs and electronic hookahs and accessories thereof; tobacco products; Tobacco substitutes, in particular those made out of tea and tea plants; cut and uncut tea for smoking as tobacco substitute; cigarette tobacco; chewing tobacco; pipe tobacco; shisha tobacco; smokers' articles of all kinds, in particular matches; shishas and electronic shishas and accessories thereof; electronic cigarettes; cigars; small cigars; electronic cigars; electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid*

	<p><i>for electronic smoking devices and electronic cigarettes; smoking pipes; steam stones, in particular steam stones for water pipes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; all the aforesaid goods not for medical purposes; flavored tobacco; herbal molasses; molasses tobacco; smoking tobacco; tobacco.</i></p>
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20. As it will be recalled, the applicant's counterstatement does not address the identity or similarity of the goods. The applicant merely states as follows:

"The ground of opposition relied upon is Section 5(2)(b) of the Act: relying on similarity of marks, identity/similarity of goods/services and a likelihood of confusion.

The earlier goods relied upon by the Opponent are those listed in the above table in class 34.

The Applicant denies that there is a likelihood of confusion under s. 5(2)(b) of the Trade Marks Act 1994("The Act").

21. In *SKYCLUB* (BL-O-044/21), Mr Phillip Johnson, sitting as the Appointed Person, stated that the principle that where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)) is applicable in trade mark opposition proceedings. Hence, in this case, the applicant's failure to deal with the identity/similarity of the goods means that the opponent's claim as to their identity and/or similarity is admitted.

22. Furthermore, in its submissions in lieu, the opponent limits its comparison to the earlier mark no. UK00912280418 which covers *Hookah tobacco* saying that “*it is accepted that the opponent's 'hookah tobacco' is contained within the applicant's broad term 'tobacco'*”, that these goods are identical and that “*with respect to the remaining contested goods versus 'hookah tobacco', it is conceded that there is a low degree of similarity between them.*” For reason of procedural economy, I will proceed on that basis. As regards the other three earlier marks, absent any denial or submission from the applicants as to the similarity of the goods, I will proceed on the basis that the opponent’s pleadings that the goods are identical or highly similar are admitted.

Average consumer

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The 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.”

24. The goods at issue are tobacco, and smokers’ and vaping products. The average consumer of the applicant’s goods is likely to be a member of the general public aged over 18 years old.

25. In its submissions in lieu, the applicant argues that “*the average consumer of tobacco products and tobacco related products are particularly careful and selective*

about the brand of cigarettes or tobacco products they smoke and a higher degree of brand loyalty is assumed when tobacco products are involved”, though it later quotes a passage from a decision (BL-O-704/19), where the Hearing Officer found that cigars and cigarettes would be selected with a medium degree of attention, and lighters and matches with a lower degree of attention. Further, the applicant argues that “with respect to electronic cigarettes and liquid solutions for use in electronic cigarettes, the level of attention paid by the average consumer is likely to be higher than normal given the relatively expensive cost of those products”. On the other hand, the opponent argues that the regular frequency of purchasing tobacco products, e-cigarettes and vapes, and liquid vape refills, with their relatively low prices, will likely result in less attention being paid to them.

26. The goods will likely be a relatively frequent purchase and, contrary to the applicant’s submission, priced at a relatively low cost. Admittedly, during the purchasing process, consideration will be taken of factors such as price, flavour and nicotine content, for many of these goods; however, this does not mean that the level of attention would be above the norm. Consequently, I consider that a medium degree of attention will be paid during the purchasing act.

27. The goods at issue will be purchased in general retail shops, specialist vape stores, tobacconists or via online retailers. In the case of retail shops, the tobacco and vaping products will be stored behind a counter and, in order to make a purchase, the consumer will need to request them from a shop assistant. In addition, advice may be sought from a shop assistant in relation to all of the goods, 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 always have sight of the packaging at the point of sale.

28. Other smokers’ products which do not contain tobacco or nicotine may be available for self-selection on shelves of shops, or purchased online. I, therefore, consider that both aural and visual considerations will play a role during the purchasing process.

Comparison of marks

29. 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.”

30. 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. The respective marks are shown below:

The applied-for mark	The opponent's marks
	MIST BLUE MIST Dark Mist Green Mist

Overall impression

The opponent's marks

31. The only element of the opponent's first mark is the word 'MIST'. There are no other elements that contribute to the overall impression.

32. In the opponent's other marks, the word 'MIST' is preceded by the words 'BLUE', 'Dark' and 'Green', with the average consumer understanding 'BLUE MIST', 'Dark Mist' and 'Green Mist' as relating to a mist that is blue, dark or green; since the words 'BLUE', 'Dark' and 'Green' are merely adjectives describing the colour of the mist.

The application

33. The applied-for mark is a figurative mark consisting of various elements. The most prominent element is the phrase 'Oriental Mist' which is presented in title case in a brown colour in the middle of the mark. Below this element are the words 'HAND ROLLING TOBACCO', and above it are the words 'GEORGE KARELIAS AND SONS'; both presented in a smaller brown font. These verbal elements of the mark are incorporated within a rectangular background decorated with arabesque frames showing an oriental-looking misty town against a light blue sky.

34. Although the mark is applied-for in relation to tobacco as well as other smokers' and vaping products, the words 'HAND ROLLING TOBACCO' will be perceived as referring to the nature of the products sold by the user of the mark, and will have very little distinctiveness. Further, it should be recalled that, where a trade mark is composed of word and figurative elements, the former is, in principle, more distinctive than the latter, since the average consumer will more easily refer to the goods at issue by citing the name than by describing the figurative element of the mark. Bearing in mind this principle, I consider that, although the figurative elements of the mark are decorative, they nonetheless create a visually striking impression. As such, they also contribute to the overall impression but in a slightly lesser measure than the words 'ORIENTAL MIST'. This is because, first, the mark will be referred to as 'ORIENTAL MIST' and, second, the figurative elements reinforce the concept conveyed by the

words 'ORIENTAL MIST' by depicting the image of an oriental misty town and displaying a crest design which incorporates the first letters of 'ORIENTAL MIST', namely the letters 'O' and 'M'. Lastly, the words 'GEORGE KARELIAS AND SONS' will be perceived as the name of the company which uses the mark, but, given their small size, they will contribute to a lesser extent to the overall impression.

Visual similarity

35. In the first place, from a visual standpoint, the applicant maintains that the contested mark creates a very different impression visually, phonetically and conceptually to the word "MIST" alone. On the other hand, the opponent argues that the dominant and distinctive element of the marks is the word 'MIST' and that the marks are similar to a medium to high degree.

36. The applied-for mark and the opponent's 'MIST' mark coincide to the extent that they share the word 'MIST'; however, they differ in all of the other verbal and figurative elements of the applied-for mark which have no counterpart in the opponent's mark. Further, whilst the word 'MIST', being the sole element of the opponent's mark, is also the dominant and distinctive element of that mark, it does not play an independent role in the applied-for mark because the phrase 'ORIENTAL MIST' will be perceived as a unit referring to a mist that is oriental, the word 'ORIENTAL' being an adjective describing the geographical origin of the mist. I have already given a detailed description of each of the signs at issue. Overall, taking into account the visual complexity of the applied-for mark versus the simplicity of the opponent's mark, I consider the marks to be visually similar to a very low degree.

37. The position in relation to the other earlier marks 'BLUE MIST', 'Dark Mist' and 'Green Mist' is that, on one side they are further away from the applied-for mark, because the additional words 'BLUE', 'Dark' and 'Green' have no counterpart in the applied-for mark; however, on the other side, they create a similar structure in that the word 'MIST' is preceded by an adjective describing a characteristic of the mist, namely the geographical origin (in the applied-for mark) and the colour (in the opponent's marks). Overall, I consider these marks to be visually similar to a very low degree.

Aural similarity

38. Aurally, the figurative elements of the applied-for mark will not be articulated. Likewise, neither the words 'HAND ROLLING TOBACCO', being descriptive, nor the words 'GEORGE KARELIAS AND SONS', being perceived as the name of the company providing the goods, will be spoken when the applicant's mark is referred to. Consequently, the marks will be pronounced as 'ORIENTAL MIST' and 'MIST', respectively. Whilst the shared element 'MIST' is present in both marks, in the application it is preceded by the word 'ORIENTAL', which is placed at the beginning of the mark (where the attention of consumers tends to focus) and is much longer. Overall, I find the applied-for mark and the opponent's 'MIST' mark to be aurally similar to a medium degree.

39. The position in relation to the other earlier marks 'BLUE MIST', 'Dark Mist' and 'Green Mist' is that, on one side they are further away from the applied-for mark, because the additional words 'BLUE', 'Dark' and 'Green' have no counterpart in the applied-for mark; however, on the other side, they create a similar structure in that the word 'MIST' is preceded by an adjective describing a characteristic of the mist, namely the geographical origin (in the applied-for mark) and the colour (in the opponent's mark). Overall, I find these marks to be similar to a medium degree.

Conceptual similarity

40. As part of its evidence, the applicant provided some dictionary definitions of the word 'MIST' including the following:⁴

'a cloud of small particles or objects suggestive of a mist'⁵

'a cloud of dust, smoke, gas, etc.'⁶

41. In addition, the applicant provided the results of a search conducted on Wordhippo.com, an online word tool which has a synonym search function showing

⁴ RMS2

⁵ Merriam-Webster

⁶ Collins online dictionary

that a search for synonyms of 'smoke' includes: 'vapor', 'fume', 'cloud', 'mist' and 'suspension'⁷

42. The concept conveyed by the word 'MIST' is the same in both marks. However, the word 'ORIENTAL' in the application will be perceived together with the word 'MIST' to form a unit conveying the concept of a mist that comes from the East, the dictionary definition of the word 'oriental' being "*relating to the countries of East and Southeast Asia*".⁸ In addition, the applied-for mark contains figurative elements which convey the idea of a misty oriental landscape, reinforcing the oriental theme of the mark, which is striking; this means that, if anything, it is the concept of the oriental theme that is dominant. Lastly, the words 'HAND ROLLING TOBACCO' introduce a descriptive concept about the goods and the words 'GEORGE KARELIAS AND SONS' convey the concept of the name of a company. Overall, I consider the applied-for mark and the opponent's 'MIST' mark to be similar to no more than a medium degree.

43. The conceptual similarity with the other earlier marks 'BLUE MIST', 'Dark Mist' and 'Green Mist' is even less because the average consumer will understand the concepts of the marks as referring to a mist that is, respectively, 'BLUE', 'Dark' and 'Green'. Overall, I find the marks to be similar to a low to medium degree.

Distinctive character of the earlier 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-

⁷ Wordhippo.com

⁸ Cambridge online dictionary

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

46. The earlier marks consist of the words ‘MIST’, ‘BLUE MIST’, ‘DARK MIST’ and ‘GREEN MIST’. The applicant argues that the word ‘MIST’ is descriptive or allusive for the goods at issue. The descriptiveness or allusiveness is said to derive from the fact that the word ‘mist’ is associated with smoking and vaping in the sense that smoking and vaping goods produce a vapour, or smoke, mist or smoky mist and so, the applicant argues, the word ‘MIST’ describes the effect of the goods. In this connection, aside from providing the dictionary definitions mentioned above, the applicant provided the following:

1. State of the register evidence aimed at demonstrating the existence of trade mark registrations in the US, Canada, UK, Australia and the EU including the word ‘MIST’ in relation to goods in class 34.⁹

⁹ RMS3-RMS12

2. Results of Google searches for the terms 'mist vape shop' and 'mist vape'; showing the existence in the UK of shop names and products which incorporate the word 'mist', including: 'MIST', 'INFINITY MIST', 'RIDE DA MIST', 'MIST.', 'VAPES IN THE MIST', 'VAPE MYST', 'LIQUID MIST', 'MIST VAPES', 'FRESHMIST', 'MONKEY MIST' and 'MIST OR VAPE' (for shops) and 'MIST E-liquid', 'PURE MIST e-liquid', 'JUST MIST', 'DIAMOND MIST', 'MAGIC MIST', 'MIST VAPE SHOP', 'MENTHOL MIST', 'AQUA MIST', 'RED MIST', 'GORILLA MIST'.¹⁰ These searches were carried out on October 2024, which is over three years after the relevant date in these proceedings (i.e. this is the filing date of the application at issue, namely 9 September 2021).
3. Results of Google searches for the terms 'mist shisha lounge', 'mist hookah lounge', 'mist shisha bar' and 'mist hookah bar'; showing the existence in the UK and non-UK countries of e hookah/shisha bars, lounges and restaurants which include the word 'mist' in their name.¹¹ The UK-related evidence includes names such as: 'BLUE MIST', 'Mist Lounge', 'Mist Vibe Dining', 'Misty Shisha Lounge', 'Myst West' and 'MYST'. These searches were carried out on October 2024, which is over three years after the relevant date in these proceedings.
4. Results of Google searches for the terms 'mist cigarettes', showing examples of tobacco cigarette packs that feature the word 'MIST' as part of their branding including: 'DAVIDOFF EVOLVE POLAR MIST', 'DAVIDOFF EVOLVE PURPLE MIST', 'MANCHESTER BLUE MIST FUSION', 'MISTY, MOONMIST', 'OASIS with Menthol Mist', 'MARLBORO VISTA FOREST MIST', 'STORM MIST', 'ORIENTAL MIST' and 'PACIFIC MIST'.¹² These searches were carried out on October 2024, which is over three years after the relevant date in these proceedings.
5. Evidence of online articles referring to the words 'smoke' and 'mist' interchangeably (i.e. smoke or mist, smoke/mist) or together (i.e. smoky mist,

¹⁰ RMS13-15

¹¹ RMS17

¹² RMS17

mist of smoke, a smoke like mist).¹³ Some of the articles directly refer to vaping or smoking.

6. A report, dated 18 October 2024, showing the adoption by third parties of marks which consist of, or incorporate, the word 'MIST' in relation to e-cigarettes, vaping and shisha tobacco¹⁴. The report concludes as follows: *“Our searches found numerous references to MIST in connection with vaping and shisha. The searches were through numerous sources, including the internet, news sources and ECIG, the published list of notified E-cigarette products supplied in Great Britain from 1st January 2021, as published by the Medicines and Healthcare products Regulatory Agency.”*
7. Copies of two opposition decisions from the Greek and Cypriot Trade Mark Office with translation.¹⁵ The opponent did not explain the relevance of these decisions for the purpose of the opposition at issue. However, it is clear that it is to support the rejection of the present opposition since the two decisions are about the rejection of parallel oppositions brought by the opponent against trade mark applications filed by the applicant and involving marks that are the same or similar to the one at issue.

47. The above evidence is of limited assistance. First, it is well established that state of the register evidence is not very helpful because it does not show the position in the marketplace.¹⁶ Second, the evidence about the existence of third-party trade marks in relation to tobacco and vaping products is dated 3 years after the relevant date. Nonetheless, this evidence shows that the word 'MIST' is a very sought after mark in the context of tobacco and vaping products and is used in that industry in an allusive manner by many traders, being an appropriate way of referring to the smoke or vapour produced by those goods. For the sake of completeness, I should explain that I have relied upon this evidence only to the extent that it corroborates my impression that 'MIST' is allusive for tobacco and vaping products to the extent that it is an appropriate way of describing the smoke or vapour produced by the goods. Overall, I consider that

¹³ RMS1

¹⁴ GHB1

¹⁵ LR1-2

¹⁶ *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01

the earlier mark 'MIST' is distinctive to a low to medium degree. Turning to the other earlier marks 'BLUE MIST', 'DARK MIST' and 'GREEN MIST', I do not think that the addition of a word describing the colour of the mist materially increases the distinctiveness of the marks as wholes.

Likelihood of confusion

48. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. Earlier in this decision I found that:

- The applied-for mark and the earlier marks are visually similar to a very low degree, aurally similar to a medium degree and conceptually similar to a low to medium degree.
- Some of the goods are identical, whilst others are similar to a high degree or a low degree.
- The average consumer will select the goods both visually and aurally, with a medium degree of attention.
- The earlier marks are distinctive to a low to medium degree.

50. Bearing in mind all of the above, I consider it unlikely that the average consumer seeing the applied-for mark on the applied-for goods in class 34 would be confused

into thinking that it is connected with the opponent's earlier mark 'MIST', 'BLUE MIST', 'DARK MIST', 'GREEN MIST'. So far as perception of the applied-for mark to the consumer is concerned, there is no danger of the average consumer separating out the 'MIST' component of the sign from the word 'ORIENTAL', as the phrase 'ORIENTAL MIST' will be perceived as a unit and the oriental theme dominates the applied-for mark. The average consumer is unlikely therefore to see the opponent's 'MIST' mark in the application: indeed, the words 'ORIENTAL' and 'MIST' are merged into a single phrase and do not perform different functions. Added to this, the low to medium distinctiveness of the word 'MIST' in the context of the goods at issue, I am of the view that the average consumer will not be led into thinking that there is some form of association between the marks, but will put the presence of the shared word 'MIST' in the marks down to coincidence.

51. For the sake of completeness, I should say that I have not overlooked the opponent's evidence about a type of tobacco called 'oriental tobacco'.¹⁷ However, there is nothing in that evidence that can assist the opponent. If anything, if I were to attribute that knowledge to a significant proportion of the average consumer, it would make even more unlikely that the average consumer would see the word 'MIST' in the applied-for mark as denoting the opponent's earlier mark.

52. There is no likelihood of confusion.

OUTCOME

53. The opposition has failed, and the application will proceed to registration.

COSTS

54. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2016.

¹⁷ Witness statement of Jason Aghatise

In the circumstances, I award the opponent the sum of £1,400 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a counterstatement and considering the notice of opposition: £400

Filing evidence: £700

Written submissions: £300

Total: £1,400

55. I therefore order Starbuzz Tobacco, Inc. to pay KARELIA TOBACCO COMPANY INC the sum of £1,400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of September 2025

TERESA PINTO

For the Registrar