BL O/0948/24

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NUMBER 3856935

BY AKAD GENERAL TRADING LLC

TO REGISTER THE TRADE MARK:

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NUMBER 440996

BY ELECTRONIC CIGARETTES HOLDINGS LIMITED

BACKGROUND AND PLEADINGS

1. On 17 December 2022, AKAD GENERAL TRADING LLC ("the applicant") applied to register the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The application was published in the Trade Marks Journal for opposition purposes on 24 February 2023 in respect of the following goods:

Class 34 Tobacco; cigarettes; Herbal molasses [tobacco substitutes]; matches; electronic cigarettes

2. On 24 May 2023, Electronic Cigarettes Holdings Limited ("the opponent") filed a notice of opposition, opposing the application in full, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon its United Kingdom Trade Mark ("UKTM") number 3547614, "ICON VAPE" ("the earlier mark"). The earlier mark was filed on 23 October 2020 and became registered on 5 March 2021. For the purpose of these proceedings the opponent relies upon all the goods for which the mark is registered, namely:

Class 34 Electronic cigarettes; cigarettes containing tobacco substitutes; cigarettes containing tobacco substitutes, not for medical purposes; refill cartridges and solutions for electronic cigarettes; electronic cigarette liquids; flavourings for electronic cigarettes; chemical flavourings in liquid form used to refill electronic cigarette cartridges; cigarettes; cigarette boxes; cigarette cases; cigarette packets; cigarette lighters; cigars; vaporizers and inhalers containing nicotine for use as an alternative to traditional tobacco cigarettes; electronic cigarette refill cartridges sold empty; vaporizer and inhalers (smoker's articles); tobacco; pipes; smokers' articles; matches; lighters for smokers; substitutes for tobacco and cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic nicotine inhalation devices; electronic cigarette cartridges; electronic cigarette atomizers; electronic cigarette cartomizers; electronic cigarette lighters; cases and holders for electronic cigarettes; cigarette cases of paper and card; cigarette papers; parts and fittings for all the aforesaid goods.

3. The opponent claims that the marks at issue are highly similar or near identical and that the respective goods are either identical or similar, resulting in a likelihood of confusion including the likelihood of association between the marks.

4. The applicant filed a counterstatement admitting that the parties' goods are identical or similar but denied the claims of a likelihood of confusion between the marks.

5. The opponent's mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act.

6. The opponent is represented by Maguire Boss and the applicant is represented by Abion UK Limited. Only the opponent filed evidence and, in doing so, also filed written submissions. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, nor did they choose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me.

RELEVANCE OF EU LAW

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

EVIDENCE

8. The opponent's evidence consists of the witness statement of Sylvie Tate dated 11 December 2023, and is accompanied by one exhibit (ST1). Ms Tate is a Chartered

Trade Mark Attorney employed by Maguire Boss. The exhibit is an extract from the Cambridge English Dictionary and provides various definitions of the word 'ICON'.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) and 5A of the Act states that:

> "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.
>
> […]
>
> 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."

10. I am guided by the following principles which 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 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

11. Section 60A of the Act provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

12. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*., where the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, […] 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".

13. 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 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."

14. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 34: Electronic cigarettes; cigarettes containing tobacco substitutes; cigarettes containing tobacco substitutes, not for medical purposes; refill cartridges and solutions for electronic cigarettes; electronic cigarette liquids; flavourings for electronic cigarettes; chemical flavourings in liquid form used to refill electronic cigarette cartridges; cigarettes; cigarette boxes; cigarette cases; cigarette packets; cigarette lighters; cigars; vaporizers and inhalers containing nicotine for use as an alternative to	Class 34: Tobacco; cigarettes; Herbal Molasses [tobacco substitutes]; matches; electronic cigarettes.

traditional tobacco cigarettes; electronic cigarette refill cartridges sold empty; vaporizer and inhalers (smoker's articles); tobacco; pipes; smokers' articles; matches; lighters for smokers; substitutes for tobacco and cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic nicotine inhalation devices; electronic cigarette cartridges; electronic cigarette atomizers; electronic cigarette cartomizers; electronic cigarette lighters; cases and holders for electronic cigarettes; cigarette cases of paper and card; cigarette papers; parts and fittings for all the aforesaid goods.	

15. The opponent states in its notice of opposition that the goods covered by the contested mark are either identical or similar to the goods contained in the earlier mark. In its counterstatement, the applicant accepts that the goods are identical or similar.

Tobacco; cigarettes; matches; electronic cigarettes

16. The above contested goods appear in both specifications, therefore these goods are identical.

Herbal Molasses [tobacco substitutes]

17. The opponent's goods include the term '*substitutes for tobacco and cigarettes''*, which as a broad term encompasses the above goods. Therefore, these goods are identical in line with the principle set out in *Meric*.

The average consumer and the nature of the purchasing act

18. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97.

19. 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."

20. The average consumer for the goods at issue is likely to include members of the general public (over the age of 18) as well as retail business users. The goods are generally sold through retail premises and their online equivalents, such as general retail stores, newsagents, tobacconists, and specialist vape or e-cigarette stores. Although purchase of these goods will be a visual process, due to the nature of some of the goods, such as cigarettes, they will generally be a behind the counter or shutter purchase, which will give rise to aural considerations. Various factors will be considered such as price, taste, nicotine content, quality, functionality and also suitability to satisfy specific requirements. The goods are likely to be purchased frequently. Consequently, I consider that a medium degree of attention is likely to be paid during the purchase of these goods.

Comparison of the Marks

21. 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."

22. 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.

23. The marks to be compared are:

Opponent's mark	**Applicant's mark**
ICON VAPE	

24. With regards to the similarity of the marks, in its opposition, the opponent states the following:

> "The Opponent's Mark is the word mark ICON VAPE, without restriction as to font, stylisation or colour, and may be presented as above or similar. The dominant and distinctive element of the Applicant's Mark is the identical word

'ICON'. The logo elements, such as they are, having negligible impact on the mark as a whole.

We contend that the marks are visually highly similar/near identical.

Aurally, the respective marks share the identical element ICON, which is also the first element of the Opponent's Mark, and as such the element that consumers are likely to pay the greatest attention to, having regard to the fact that consumers tend to focus on the beginnings of marks rather than their endings. We contend that the respective marks are aurally highly similar/near identical."

25. With regards to the similarity of the marks, in its counterstatement the applicant states the following:

"…. It is denied that the dominant and the distinctive element of the Applicant's Mark is the word ICON, and it is denied that the logo elements have a negligible impact on the marks as whole.

It is denied that the marks are visually highly similar/near identical.

Noting some degree of stylisation within the Applicant's Mark, it is denied that the element ICON is identical to both, and it is denied that consumers will pay the greatest attention thereto. It is denied that the marks are orally highly similar/near identical.

It is denied that the marks are highly similar/near identical conceptually. The Opponent's Mark is composed of an additional element, namely the word VAPE, which imparts a different meaning as against the mark in suit."

Overall Impression

26. The opponent's mark is in word only format and consists of the words 'ICON VAPE', presented in black standard uppercase letters without any stylisation. There

are no other elements to contribute to the overall impression of the mark. In terms of some of the opponent's goods, the word 'VAPE' is descriptive in nature and therefore, I find that it plays a lesser role in the overall impression of the mark, with the word 'ICON' playing the greater role.

27. With regards to word marks, Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation,* case BL O/281/14 found that:

> "It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark."

28. The applicant's figurative mark consists of the singular word 'ICON', presented in white, slightly stylised, bold capital letters. The word sits upon a black rectangular background. I find that the word 'ICON' dominates the overall impression of the mark, with the black rectangular background element playing a lesser role and will likely have little impact on the consumer.

Visual similarity

29. Both marks identically share the same word 'ICON'. This similarity appears at the beginning of the respective marks being where consumers tend to focus[1] as this position is generally considered to have more impact due to consumers in the UK reading from left to right. Accordingly, this is the element that will be read first in the opponent's mark and is the only word element in the applicant's mark. In making my visual comparison of the marks, I bear in mind that notional and fair use of the marks means that the font and colour used is irrelevant.[2] The marks differ in the black background present in the applicant's mark and in the word 'VAPE', present in the

[1] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[2] *Bentley Motors Limited v Bentley 1962 Limited,* BL O/158/17

opponent's mark. However, I am of the view that the word 'ICON', present in both marks, will play the greater role in the overall impression of the marks. Accordingly, I find the marks to be visually similar to at least a medium degree.

Aural Comparison

30. Aurally, the opponent's mark consists of three syllables, namely 'I-CON-VAPE', whereas the applicant's mark consists of two syllables, namely 'I-CON'. However, with regards to the opponent's mark, given the descriptive nature of the word 'VAPE' and its position within the mark, I consider it unlikely that this word will be articulated. Consequently, I find the marks are aurally identical. However, if I am wrong, and the word 'VAPE' is pronounced, the marks will be aurally similar to at least a medium degree.

Conceptual Comparison

31. The opponent, submitted evidence, asserting that the word 'ICON' has various definitions, which are contained within Exhibit ST1.

32. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

33. Conceptually, the ordinary dictionary word 'ICON', identically present in both marks, will likely be perceived by the average consumer as someone or something that is very successful and admired. The word 'VAPE' in the opponent's mark is likely to be perceived as reference to a device used for inhaling vapour containing nicotine and flavouring, and therefore creates a point of conceptual difference between the marks, although in my view not a distinctive one, bearing in mind some of the goods at issue. Accordingly, I find that the respective marks are conceptually similar to at least a medium degree.

Distinctive character of the earlier mark

34. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

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

36. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

37. The earlier mark comprises of the words ‘ICON VAPE’, and whilst the word ‘ICON’ has no obvious connection with the goods for which the opponent’s mark is registered, I bear in mind that for some of the goods at issue, the words, considered as a whole, are likely to be perceived as alluding to a vape that is iconic. Accordingly, on this basis, I find that the opponent’s mark is inherently distinctive to between a low to medium degree.

Likelihood of confusion

38. In determining whether there is likelihood of confusion, I must take all of the above factors into account and consider if there is a likelihood of confusion for the average consumer.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. While indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the marks and vice versa. I must bear in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. To do so, I must recognise that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. Earlier in the decision, I concluded that the respective marks are visually and conceptually similar to at least a medium degree, and either aurally identical or aurally similar to at least a medium degree. I have found the earlier mark to be inherently distinctive to between a low to medium degree. I have found the average consumer of the parties’ goods to be adult members of the general public over the age of 18, as well as members of the business community, who will pay a medium degree of attention when selecting the goods. I have found that the purchasing process will be

largely visual, although I have not discounted aural considerations. Furthermore, I have found the parties' goods to be identical.

41. I bear in mind that the opponent's word mark contains the entirety of the verbal element of the applicant's mark, namely 'ICON / ICON', and that I have found this element to play the greater role in the opponent's mark. Accordingly, although the average consumer views marks as a whole, case law also directs me to bear in mind the dominant and distinctive elements of the marks. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. With regard to the additional elements present in the marks, namely the non-distinctive black background in the applicant's mark, and the word 'VAPE' in the opponent's mark which I have found to have a descriptive nature in relation to some of the goods at issue, I am of the view that these elements are likely to go unnoticed, be overlooked, or be forgotten. Accordingly, with all things considered, given the similarity of the marks and the identity between the goods, I find that the average consumer is unlikely to recall the differences between the marks resulting in the consumer confusing the marks for one another and therefore, there is a likelihood of direct confusion.

42. However, if the average consumer does identify the differences between the marks, given the common presence of the word 'ICON' and the identity of the goods, I consider that they will put the differences between the marks down to brand extension or the same company presenting its mark in two slightly different ways, rather than concluding that the marks originate from different undertakings. Accordingly, I consider there to be a likelihood of indirect confusion.

Conclusion

43.The opposition under section 5(2)(b) of the Act is successful. Subject to any successful appeal, the application will be refused.

Costs

44. The opponent has been successful and is entitled to an award of costs based upon the scale published in Tribunal Practice Notice 1/2023. Using that guidance, I award the opponent costs on the following basis:

Official fee	£100
Preparing the Notice of Opposition and considering the counter statement	£300
Preparing written submissions	£200
TOTAL	**£600**

45. I therefore order AKAD GENERAL TRADING LLC to pay Electronic Cigarettes Holdings Ltd the sum of £600. The above sum should 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 3rd day of October 2024

Mrs Joanne Roberts
For the Registrar