O/0955/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3898795
BY DONGGUAN DELIN TECHNOLOGY CO., LTD TO REGISTER AS A TRADE MARK:

Prime Mary

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 441481
BY INDEJUICE LIMITED

BACKGROUND AND PLEADINGS

1. On 10 April 2023, Dongguan Delin Technology Co., LTD ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3898795 ("the applicant's mark"). It was accepted and published in the Trade Marks Journal on 21 April 2023 in respect of the following goods:

> Class 34: Oral vaporizers for smokers; Herbs for smoking; Cigarette lighters; Steam stones for water pipes; Cigarette filters; Cigarette holders; Smoking pipes; Ashtrays for smokers; Electronic cigarettes; Liquid for electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Pipes; Cigars; Cigarette tobacco; Cigarette cases; Snuff dispensers.

2. On 20 June 2023, the applicant's mark was opposed by IndeJuice Limited ("the opponent"). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all of the goods specified in the application.

3. The opponent relies upon the following registrations:

> UK trade mark registration no. UK00003364125 (series of 3)
>
> **PRIME**
> **prime**
> **Prime**
> Filing date 01 January 2019.
> Registration date 22 March 2019.
> Relying upon all of the goods for which its mark is registered, namely:

Class 34: Electronic cigarettes.

UK trade mark registration no. UK00003545734 (series of 3)

PRIME

prime

Prime

Filing date 19 October 2020.

Registration date 16 April 2021.

Relying upon all of the goods for which its mark is registered, namely:

Class 34: Cartridges for electronic cigarettes; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Cases for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette cases; Electronic cigarette cleaners; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigars; Electronic devices for the inhalation of nicotine containing aerosol; Electronic hookahs; Electronic nicotine inhalation devices; Electronic shisha pipes; Electronic smokers' pipes; Electronic smoking pipes; Flavorings, other than essential oils, for use in electronic cigarettes;

Holders for electronic cigarettes; Liquid for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Refill cartridges for electronic cigarettes; Smoking sets for electronic cigarettes.

4. The marks in the opponent's registrations are earlier marks, in accordance with Section 6 of the Act. However, as they had not been protected for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within Section 6A of the Act.

5. In its notice of opposition, the opponent submits that the goods contained in the applicant's mark are identical or highly similar to those contained within its earlier registrations' specifications. The opponent also submits that the marks at issue are visually, aurally, and conceptually highly similar because they share the word 'PRIME', which is either the dominant or sole element of all the marks. As such, the opponent submits that the applicant's mark should be refused in its entirety and that an award of costs be made in their favour.

6. The applicant filed a counterstatement denying that there exists a likelihood of confusion. They state that the conceptual perception of the marks would be different to consumers due to the inclusion of the word 'MARY' in the subject application. Additionally, the applicant argues that the likelihood of confusion will only be taken into account if both of the signs and the goods and services involved are deemed identical, which in their view is not the situation in the present case. They go on to submit that merely having identical or similar goods is insufficient to support an opposition.

7. The opponent is represented by Squire Patton Boggs (UK) LLP, and the applicant is represented by Pablo Albert Catala. Neither party requested a

hearing and only the opponent filed evidence and submissions. I therefore make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

8. 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

9. The opponent's evidence consists of the witness statement of Callum Burbidge dated 22 November 2023. Mr Burbidge is a Chartered Trade Mark Attorney at the opponent's representatives and his statement is accompanied by 1 exhibit (CB-1). Exhibit CB-1 consists of printouts from websites attempting to demonstrate that the terms 'Mary' and 'Mary Jane' are slang references for marijuana. I have taken all of the evidence, as well as the parties' submissions, into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b): legislation and case law

10. The opposition is based upon section 5(2)(b) of the Act which reads 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"

11. Section 5A of the Act states as follows:

"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."

12. 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 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

13. 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 1979."

14. 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."

15. 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.

16. 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. Treat was decided the way it was because the ordinary and natural, or core,

meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. 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".

17. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

18. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited,* BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

19. 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 for Lernsysterne 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."

20. The goods to be compared are:

The opponent's goods	The applicant's goods
UK00003364125 **Class 34:** Electronic cigarettes. **UK00003545734** **Class 34:** Cartridges for electronic cigarettes; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Cases for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette cases; Electronic cigarette cleaners; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional	**Class 34:** Oral vaporizers for smokers; Herbs for smoking; Cigarette lighters; Steam stones for water pipes; Cigarette filters; Cigarette holders; Smoking pipes; Ashtrays for smokers; Electronic cigarettes; Liquid for electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Pipes; Cigars; Cigarette tobacco; Cigarette cases; Snuff dispensers.

cigarettes; Electronic cigars; Electronic devices for the inhalation of nicotine containing aerosol; Electronic hookahs; Electronic nicotine inhalation devices; Electronic shisha pipes; Electronic smokers' pipes; Electronic smoking pipes; Flavorings, other than essential oils, for use in electronic cigarettes; Holders for electronic cigarettes; Liquid for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Refill cartridges for electronic cigarettes; Smoking sets for electronic cigarettes.	

Oral vaporizers for smokers.

21. It is clear that these goods are self-evidently identical to the opponent's *Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor.*

Electronic cigarettes; Liquid for electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes.

22. All of these terms are contained in both parties' specifications and are, therefore, self-evidently identical.

Herbs for smoking.

23. The above term covers dried herbs, such as cloves, mugwort or lavender, that are used as a substitute for traditional tobacco in smoking articles. In comparing this term to the opponent's 'Electronic cigarettes', there is a clear difference in nature. The method of use the contested goods is to be smoked. While the purpose of the opponent's goods is not to be smoked, the act of smoking does involve inhalation, which is how the opponent's goods are consumed. Therefore, there is some overlap in method of use. Further, the purpose of both parties' goods is as alternatives or substitutes for traditional smoking articles. Therefore, this is also an overlap in purpose. There is a competitive relationship between these goods as consumers will elect to use electronic cigarettes over vaping as an alternative method for consuming nicotine, or vice versa. Both sets of goods may share some of the same trade channels, being sold through specialist tobacconists or shops specialising in smoking or vaping, as well as online retailers. Bearing all of the above in mind, I find that the goods are similar to a medium degree.

Cigarette lighters.

24. In general, the primary purpose of the contested goods is to light traditional smoking articles. The opponent's term that I will focus on for this comparison is 'Electronic cigarettes'. Whilst the goods share the same user, namely the general public, there is a difference in nature and method of use. Further, the applicant's goods are lighters intended to be used to light cigarettes, cigars, and other smoking articles whereas, plainly, the opponent's goods are not. It is therefore considered that the purpose of the goods is different. Both sets of goods share the same trade channels, being sold through traditional retail outlets and specialist smoking/vaping retailers, as well as online. I do not believe there to be a complementary or competitive relationship between the goods. I say this because electronic smoking articles are not required to be lit before being used. Bearing all of the above in mind, I find that the goods are similar to a low degree.

Steam stones for water pipes.

25. In general, the contested goods are to be used in shisha and hookah pipes to create flavoured steam that can be inhaled. I note that the opponent's specification includes 'Electronic hookahs' and 'Electronic shisha pipes'. The goods broadly share the same user in that they are aimed at the section of general public who use shishas. The contested goods are steam stones that, as I understand it, are porous minerals which soak up vegetable glycerol and flavours to generate flavoured vapor when being heated. It is therefore considered that there is a difference in nature. This is plainly different from the opponent's goods meaning that there is no overlap in nature, method of use or purpose. Both sets of goods share some of the same trade channels as a producer of shishas may produce and sell both traditional shisha equipment and electronic shisha equipment. Further, the goods will be sold via the same retailers. I do not believe there to be a complementary relationship between the goods on the basis that electronic smoking articles do not require steam stones to be burned before being consumed. Lastly, I consider that there is an element of competition between the goods concerned. Bearing all of the above in mind, I find that the goods are similar to a low degree.

Cigarette filters.

26. The contested goods are component parts of cigarettes to reduce the harm caused by smoking by reducing harmful chemicals inhaled by smokers. While the opponent's specification includes 'Electronic cigarettes' and 'Smoking sets for electronic cigarettes', none of these will use cigarette filters. There is clearly a difference in nature, method of use and purpose. Both sets of goods share the same trade channels, being sold through traditional retail outlets, as well as online. I do not believe there to be a complementary relationship between the goods, nor is there any direct competition. Bearing all of the above in mind, I find that the goods are dissimilar.

Cigarette holders; Cigarette cases.

27. The opponent argues that the word cigarette is broad enough to encompass both traditional and electronic cigarettes and therefore the above terms would be considered to include the opponent's goods namely, 'Cases for electronic cigarettes' and 'Holders for electronic cigarettes' rendering them identical. I do not necessarily agree. The word cigarette is defined as 'a small paper tube filled with cut pieces of tobacco that people smoke.[1] In my view the average consumer's perception of the word cigarette is that of the traditional item as per the dictionary definition, which is markedly different to an electronic cigarette. In general, the primary purpose of the contested goods is to hold or store traditional cigarettes, whereas the opponent's goods are to be used to hold or store an electronic cigarette. That being said, I consider that there is some overlap in purpose on the basis that both sets of goods are used to store and transport goods used for the consumption of nicotine. In respect of the nature of the goods, I appreciate that there is a slight difference due to the size and shape of the differing goods to be held or contained within. That being said, both goods are containers that are likely to be made of the same materials and used in the say way. Both sets of goods share the same trade channels, being sold through traditional retail outlets, as well as online. I do not believe there to be a complementary relationship between the goods, however there is competition. Bearing all of the above in mind, I find that the goods are similar to a medium degree.

Cigars.

28. The opponent argues that the word cigar is broad enough to encompass both traditional and electronic cigars and therefore the above term would be considered to include the opponent's goods namely, 'Electronic cigars' rendering them identical. I do not necessarily agree. The word cigar is defined as 'a tube made from dried and rolled tobacco leaves that people smoke'. [2] In my view the average consumer's perception of the word cigar is that of the traditional item as per the dictionary definition. The primary purpose of the

[1] https://dictionary.cambridge.org/dictionary/english/cigarette
[2] https://dictionary.cambridge.org/dictionary/english/cigar

contested goods is to be smoked. The opponent's goods on the other hand are not smoked *per se,* but the purpose is still similar. The nature of the goods is also similar; Electronic cigars are produced in similar guises in an attempt to replicate the traditional cigar shape. Both sets of goods share the same trade channels, being sold through traditional retail outlets, as well as online. Whilst the goods do not share a complementary relationship, there is certainly a degree of competition between them. Bearing all of the above in mind, I find that the goods are similar to a high degree.

Smoking pipes; Pipes.

29. These terms are deemed to be broad, and unlike the word cigarette, in my opinion would encompass the electronic versions of such goods. Cigarettes are more synonymously known as being rolled tobacco products that are lit and smoked, whereas for pipes, being a less common method of smoking, there is not necessarily the same instant connection made by the consumer. As a result, these goods are considered identical in line with the principals of *Meric*.

Cigarette tobacco.

30. The above term covers cured and cut tobacco leaves that are used in the making traditional smoking articles which are then smoked by the user. The opponent's goods are 'electronic cigarettes' and 'Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes.' Whilst the goods share the same user, namely the section of the general public who consume nicotine, there is a difference in nature and method of use. Both sets of goods may share some of the same trade channels, being sold through specialist tobacconists or shops specialising in smoking or vaping, as well as traditional retail outlets and online retailers. There may be an element of competition between the goods due to them sharing the same purpose in that both sets of goods are inhaled in order to deliver nicotine to the user. The consumer may make a choice as to whether they smoke tobacco cigarettes or use an electronic cigarette or vaporiser meaning that there is a degree of competition between the goods. There is no complementarity as the goods are plainly not

important or indispensable to one another. Bearing all of the above in mind, I find that the goods are similar to a medium degree.

Ashtrays for smokers.

31. In general, the primary purpose of the contested goods is to be used to discard of tobacco ash and cigarette ends. The opponent's goods are 'Electronic cigarettes' which do not share the same user as those who choose to vape or use electronic cigarettes will have no use for an ashtray. There is also a stark difference in nature and method of use. Further, the applicant's goods are receptacles for tobacco ash and cigarette ends. it is considered that the purpose of the goods is significantly different. Both sets of goods share the same trade channels, being sold through traditional retail outlets, as well as online, however they are not necessarily sold in the same or similar sections of those stores. I also do not believe there to be a complementary relationship between the goods, as well as no competition. I say this because electronic smoking articles do not produce waste such as ash or cigarette ends. While there may be some overlap in trade channels, I do not consider that this is sufficient to warrant a finding of similarity between the goods. Therefore, I find that the goods are dissimilar.

Snuff dispensers.

32. In general, the primary purpose of the contested goods is to be used to store snuff. The goods do not share the same user as the opponent's 'Electronic cigarettes' as those who choose to vape or use electronic cigarettes will have no use for a container to store snuff. There is also a stark difference in nature and method of use. Further, the purpose of the goods is significantly different. Both sets of goods may share the same trade channels, being sold through traditional retail outlets, as well as online, however they are not necessarily sold in the same or similar sections of those stores. I also do not believe there to be a complementary relationship between the goods, as well as no competition. While there may be some overlap in trade channels, I do not consider that this

is sufficient to warrant a finding of similarity between the goods. Therefore, I find that the goods are dissimilar.

33. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail.[3]

The average consumer and the nature of the purchasing act

34. 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).

35. 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."

36. The average consumer for the goods will be members of the general public who smoke or vape. The goods in question are not particularly expensive. They are

[3] See *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA and *Waterford Wedgwood PLC v OHIM* - C-398/07 P

all likely to be purchased reasonably frequently. For goods, such as cigars and cigarettes, various factors will be taken into account, such as the type or strength of the product. These particular goods are sold via the same retail outlets as electronic smoking articles however they are sold in a different manor and location. It is illegal to display tobacco products at the point of sale in the UK meaning they will be kept behind the counter where the consumer is required to ask a shop assistant for a particular brand of cigarette or tobacco product. On the other hand, electronic cigarettes are able to be self-selected in many retail establishments as they are not subject to the same rules. It is therefore considered that the primary selection method of the applicant's aforementioned goods will be aural. Nevertheless, I do not discount visual considerations as the consumer may view the mark in literature such as price lists displayed in the retail environment. For these goods, a medium degree of attention will be paid during the purchasing process. Further, for goods such as electronic cigarettes and oral vaporisers, flavour may be a factor taken into consideration. As previously mentioned, unlike traditional cigarettes, electronic cigarettes and vaporisers are not subject to the same display ban and commonly appear on show on shelves, as well as behind the counters of retail outlets. The selection of these goods will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations. For these goods, a medium degree of attention will be paid during the purchasing process. For other goods, such as lighters, cases or ashtrays, a lower degree of attention is likely to be paid during the purchasing process.

Comparison of trade marks

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the

European Union ("CJEU") stated at paragraph 34 of its judgement 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".

38. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

39. The trade marks to be compared are as follows:

The opponent's registrations	The applicant's mark
UK00003364125 (series of 3) **PRIME** **prime** **Prime** UK00003545734 (series of 3) **PRIME** **prime** **Prime**	**Prime Mary**

40. The opponent relies on two registrations, each of these are the series of three word only marks, being the word ‘Prime’ presented in upper, lower, and title case. As word only marks are covered for use in either upper case, lower case or any customary combination of the two, the opponent’s marks are materially identical. I will therefore refer to them as one, being 'the Opponent's Marks'.

41. The opponent submits that the marks at issue are visually and aurally highly similar since they both contain the word ‘PRIME’ as their sole or dominant element. Additionally, the opponent argues that the fact the word ‘PRIME’ appears as the first word in the sign contained in the application enhances the degree of visual and aural similarity with the Opponent’s Marks, as it is the first word that consumers will view or hear/pronounce in the sign, and the word will generally hold the greatest degree of their attention and recollection. The opponent also submits that, in the context of the goods (which includes herbs for smoking), the word ‘Mary’ will be perceived by the average consumer as a reference to ‘Mary Jane’ and ‘Aunty Mary’ which are slang terms for marijuana. In an attempt to prove this, the opponent relies on Exhibit CB1 of their evidence which contains printouts of websites that refer to the use of those phrases as slang for marijuana. With that in mind, the opponent asserts that the word ‘Mary’ would be perceived as a descriptive reference to the fact that the products covered by the application consist of, or, relate to, smoking and smoking related articles that contain, consist of, or can be used with marijuana. However, the opponents submits that even if the average consumer does not perceive the word ‘Mary’ as a slang reference to marijuana, they would perceive it as a common personal name which itself possesses a very low degree of inherent distinctive character. Whilst I take on board the opponent’s submission that the word ‘Mary’ would be perceived as descriptive reference to marijuana, I do not agree. Exhibit CB1 that accompanied the witness statement of Callum Burbidge, demonstrates that the phrases ‘Mary Jane’ and ‘Aunt Mary’ are recognised as slang terms for marijuana, however, there is no evidence that the word Mary, in and of itself, is. I do not agree that the average consumer would perform the mental gymnastics to link the words Prime Mary to Mary Jane (marijuana), even in respect of goods such as herbs for smoking.

Overall Impression

42. The opponent's marks consist solely of the word 'Prime'. There are no other elements in the marks to contribute to their overall impression, which lies in the word itself. On the other hand, the applicant's mark consists of two words, namely, 'Prime Mary'. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves. In my view, neither word dominates due to them being ordinary English words. Therefore, the overall impression conveyed by the mark rests in the combination of the two words.

Visual Comparison

43. The opponent's marks consist of the single, five-letter word 'Prime'. The applicant's mark on the other hand consists of two words, the first being the identical word 'Prime', and the second being the word 'Mary'. Though the first element in applicant's mark, and the sole element in the opponent's marks are the same, the additional word in the applicant's mark creates a visual point of difference between them. As a result I consider the marks to be visually similar to between a medium and high degree.

Aural Comparison

44. Aurally, the opponent's marks will be articulated as 'Prime' and pronounced in the ordinary way, as would the first word in the applicant's mark. However, the applicant's mark also contains the word 'Mary' which will be articulated in the ordinary way. It is considered that the applicant's mark will be pronounced as a whole. The opponent's mark is just one syllable in length, whereas the applicant's mark is three. On this point, I remind myself that while there is no special test which applies to the comparison of 'short' marks,[4] I am of the view that in the present case, the shortness of the marks at issue means that the

[4] *Bosco Brands UK Limited vs Robert Bosch GmbH,* BL O/301/20

average consumer is more likely to notice the differences, resulting in the marks being aurally similar to no more than a medium degree.

Conceptual Comparison

45. The opponent argues that the marks are conceptually similar. This is on the basis that the applicant's mark is made up of two words 'Prime' and 'Mary' and that the average consumer will perceive them as distinct elements rather than a conjoined phrase. 'Prime' means to be of first or main importance, whereas 'Mary' is likely to be perceived as a slang reference to marijuana, or otherwise as a personal name. Therefore, the average consumer will not view the words as portraying one single overall conceptual meaning. As such, the opponent argues that as the signs share the word 'Prime', the average consumer will perceive the conceptual meaning of those words to be the same. I have set out above that I disagree with the submission in respect of 'Mary' being slang for marijuana. While I do accept that 'Mary' will be understood as a female forename, I do not agree that the average consumer will view the applicant's mark as distinct elements as opposed to a joint phrase. I say this because the applicant's mark is likely be understood as a unitary phrase conveying a message about an individual person called Mary who *prime*, i.e. is the most important. Alternatively, some consumers may perceive the mark as a play on the word 'Primary'.

46. Turning to the opponent's marks, I consider that they will be understood as per the dictionary definition of 'Prime'[5], namely, 'main or most important' or, 'of the best quality'. I appreciate that whilst the shared use of 'Prime' gives the parties' marks a slight conceptual similarity, the addition of 'Mary', creates a unitary phrase and contributes as a point of difference. Taking all of the above into account, it is considered that the marks are conceptually similar to a low degree.

Distinctive character of the opponent's mark

[5] https://dictionary.cambridge.org/dictionary/english/prime

47. 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)."

48. 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. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and did not file any evidence to that effect. As such, I have only the inherent position to consider.

49. The opponent's mark consists of the plain word 'Prime' without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the word itself. Whist the word 'Prime' is not considered descriptive of the goods concerned, it is a readily understood dictionary word that is considered to hold laudatory connotations that convey a promotional message regarding the quality of the goods. As a result, I find that the opponent's mark possesses a low degree of distinctive character.

Likelihood of confusion

50. 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 and services down to the responsible undertakings being the same or related.

51. 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 (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be alive to the fact 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.

52. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the

goods at issue are marketed, and in which type of store/platform they are made available.

53. Throughout the course of this decision, I have determined that:

- The respective goods range from being low to identical depending on the goods.

- The average consumers are members of the general public at large who will demonstrate between low and medium level of attention during the purchasing process depending on the goods concerned.

- The purchasing process for some of the goods will be primarily aural in nature, though visual considerations have not been excluded. However, for other goods, the purchasing process will primarily visual, though aural considerations have not been excluded.

- The opponent's mark possesses low degree of inherent distinctive character.

- The marks at issue are visually similar to medium degree. The marks are aurally similar to no more than a medium degree. The marks are conceptually dissimilar.

54. I acknowledge that both marks contain the identical word "Prime" at their beginnings, a position where the attention of consumers is usually directed.[6] However, the marks differ visually, aurally and conceptually as the contested mark contains the additional word "Mary". Although the marks overlap in the shared word "Prime", the additional word in the applicant's mark creates a visual, aural and conceptual difference that is unlikely to be overlooked, especially given that 'Prime Mary' forms a unitary meaning. Therefore, despite

[6] While it a general rule that beginnings of marks have more of an impact (see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), it is not always the case (see *CureVac GmbH v OHIM,* T-80/08)

some overlap created by the commonality of the word “Prime”, in my view, this will be outweighed by the differences. Consequently, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, even those paying a medium level of attention, to avoid mistaking the marks for one another, notwithstanding the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

55. I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(a) 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)".

56. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (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, 16 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.

57. As highlighted above, Mr Purvis Q.C. in *L.A Sugar* sets out that there are three main categories of indirect confusion, and that indirect confusion 'tends' to fall in one of them. I note that the opponent hasn't stated specifically what category this case would fall within. However, for the sake of completeness, I will go through each category.

58. Firstly, where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using

it. In this instance, I do not consider that the ordinary dictionary word, 'Prime', which has a recognisable meaning to the average consumer, is so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. As established above, it has a low degree of inherent distinctiveness, which has not been enhanced. In view of this, it is considered that the consumer would perceive the shared use of the well-known dictionary word Prime as coincidental and would not assume the marks were economically linked. The first category is therefore not satisfied.

59. This leads to the second category from *L.A Sugar*, where the later mark simply adds a non-distinctive element to the earlier mark. The examples provided by Mr Purvis Q.C. for this category are separate words which are frequently used to indicate that they are sub-categories/brands. However, the word 'Mary' is not a non-distinctive element. As highlighted above, neither the word 'Mary' nor 'Prime' play a more dominant role than the other in the overall impression of the applicant's mark. It is a feminine forename which is neither descriptive nor allusive of the applicant's goods. The word Mary is also not a word which is frequently used to indicate sub-brands such as 'LITE' or 'EXPRESS'. Consequently, the second category cannot be satisfied.

60. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. I do not consider that the addition of the word Mary at the end of the applicant's mark is a logical brand extension of the opponent's mark, or vice versa. As highlighted above, the words 'Prime' and 'Mary' play an equally dominant role in the overall impression of the applicant's mark. The use of the two words together creates a new unitary meaning, different than those of its individual components. Alternatively, even if the consumer does not perceive the two words as forming a unitary phrase, they would instead merely see it as a combination of two random words with no logical or obvious meaning. I therefore consider that the applicant's mark is a step too-far removed from being a logical brand extension, or a logical sub-brand of the opponent's mark. I therefore do not consider that the third category is satisfied.

61. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's mark. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. It is considered that common use of a laudatory term such as 'Prime' would be coincidental and something that more than one undertaking would wish to use. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the opponent's mark is brought to mind when viewing the applicant's mark, this is mere association, not confusion. [7] Consequently, I consider there is no likelihood of indirect confusion.

Conclusion

62. The opposition has failed in its entirety. Therefore, subject to any successful appeal, the application may proceed to registration for all goods.

Costs

63. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In considering the costs award, I note that the applicant did not file any evidence. However, the opponent did, and the applicant would have been required to incur the costs of undertaken a review of the evidence. I appreciate that the evidence filed consisted of just one exhibit of dictionary printouts, however, I consider it reasonable to make a limited award in respect of the costs associated with this task. In the circumstances, I hereby award the applicant the sum of £350 calculated as follows:

Filing a Counterstatement and considering the Notice of Opposition	£250

[7] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

Considering the opponent's evidence	£100
Total	£350

64. I therefore order **IndeJuice Limited** to pay **Dongguan Delin Technology Co., LTD** the sum of £350. 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 7th day of October 2024

Oliver Rose'Meyer
For the Registrar