O/0956/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003784323 & UK00003784701 BY SAMI ASGHAR & RAFI ASGHAR TO REGISTER:

Bar Liquid

AND

Bar E Liquid
Bar E-Liquid

(SERIES OF TWO)

AS TRADE MARKS IN CLASS 34

AND

IN THE MATTER OF THE OPPOSITIONS THERETO UNDER NOS. 435759 & 437218 BY VAPE SUPPLIER LIMITED

AND

IN THE MATTER OF APPLICATION NOS. UK00003813049 & UK00003782448 BY VAPE SUPPLIER LIMITED TO REGISTER:

BAR LIQUID 3000

AND

Bar Liquid

AS TRADE MARKS IN CLASS 34

AND

IN THE MATTER OF THE OPPOSITIONS THERETO UNDER NOS. 437624 & 437960 BY SAMI ASGHAR

BACKGROUND AND PLEADINGS

1. These proceedings involve cross-oppositions between Sami Asghar ("SA") and Rafi Asghar (collectively "the Asghars") and Vape Supplier Limited ("VSL"). I will summarise the relevant proceedings below, beginning with the oppositions brought by VSL on the basis that they were brought first.

VSL's oppositions

2. The Asghars applied to register the trade marks 'Bar Liquid' ("the Asghars' first registration") and 'Bar E Liquid'/'Bar E-Liquid' (series of two) ("the Asghars' second registration") on 4 and 5 May 2022, respectively, in the UK for the following goods:

Class 34: Cartridges for electronic cigarettes; cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; chemical flavourings in liquid form used to refill electronic cigarette cartridges; chewing tobacco; devices for heating tobacco for the purpose of inhalation; electric cigarettes [electronic cigarettes]; electronic cigarette atomizers; electronic cigarette boxes; electronic cigarette cartomizers; electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; electronic cigarette liquid [e-liquid] comprised of propylene glycol; electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic devices for the inhalation of nicotine containing aerosol; electronic nicotine inhalation devices; flavorings, other than essential oils, for tobacco; flavorings, other than essential oils, for use in electronic cigarettes; flavourings, other than essential oils, for tobacco; flavourings, other than essential oils, for use in electronic cigarettes; liquid for electronic cigarettes; liquid nicotine solutions for electronic cigarettes; liquid nicotine solutions for use in 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; smokers' articles; snus; tobacco and tobacco products (including substitutes); vaporizers for smoking purposes; electronic cigarettes for use as an alternative to traditional cigarettes; cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; chemical flavorings in liquid form used to refill electronic cigarette cartridges; electric cigarettes [electronic cigarettes]; liquid solutions for use in electronic cigarettes; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor.

3. The Asghars' first and second registrations were published for opposition purposes on 20 May and 29 July 2022, respectively. VSL opposed the Asghars' first registration on 22 August 2022 under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act"). Then, on 31 October 2022, VSL opposed the Asghars' second registration under section 5(2)(b) of the Act. Both oppositions are reliant upon the following mark:

Bar Liquid
UKTM no. 3782448
Filing date 28 April 2022
Relying on all goods, namely:

Class 34: Electronic cigarettes; electric cigarettes [electronic cigarettes]; electronic cigarette cleaners; electronic cigarette atomizers; electronic cigarette cartomizers; electronic cigarette boxes; electronic cigarette cases; cases for electronic cigarettes; liquids for electronic cigarettes; holders for electronic cigarettes; liquid for electronic cigarettes; cartridges for electronic cigarettes; refill cartridges for electronic cigarettes; smoking sets for electronic cigarettes; replaceable cartridges for electronic cigarettes; liquid

nicotine solutions for electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; liquid solutions for use in electronic cigarettes; 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; liquid nicotine solutions for use in electronic cigarettes; electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; electronic cigarette liquid [e-liquid] comprised of propylene glycol; flavorings, other than essential oils, for use in electronic cigarettes; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; chemical flavorings in liquid form used to refill electronic cigarette cartridges; flavourings, other than essential oils, for use in electronic cigarettes; cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; chemical flavourings in liquid form used to refill electronic cigarette cartridges; cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes.

4. The nature of VSL's opposition in reliance upon section 5(1) is that Asghars' first registration should not be registered on the basis that the marks and goods at issue are identical. Alternatively, VSL relies on section 5(2)(a) and maintains that the marks at issue are identical but that the goods are similar. As such, VSL claims that there exists a likelihood of confusion between the marks. As for the opposition against the Asghars' second registration, VSL claims that the marks at issue are similar and that the goods at issue are identical and/or similar. Therefore, VSL claims that there exists a likelihood of confusion on the part of the public, including a likelihood of association.

5. The Asghars filed counterstatements wherein they denied the claims on the basis that VSL's mark was itself subject to opposition proceedings. That being said, I note that the Asghars did admit that, as it stood at the date of the

counterstatements being filed, the marks were identical. Further, the Asghars accepted that the goods were similar. I note that in both counterstatements, the Asghars requested that VSL prove use of its mark. However, as I will come to explain further below, VSL's mark is not subject to the proof of use provisions.

SA's oppositions

6. On 28 April and 25 July 2022, VSL applied, respectively, to register the trade marks 'Bar Liquid' ("VSL's first mark") and 'BAR LIQUID 3000' ("VSL's second mark") in the UK for an identical set of goods in class 34, being those I have reproduced at paragraph 3 above.[1]

7. Despite being filed second, it was VSL's second mark that was published first, on 18 August 2022. VSL's first mark was published for opposition purposes shortly thereafter on 16 September 2022. Both marks were opposed in their entirety by SA (the second mark being opposed on 21 November 2022 with the first being opposed on 9 December 2022).

8. The oppositions were brought in reliance upon section 5(4)(a) of the Act. In both oppositions, SA relies on the earlier right 'Bar Liquid' which he claims to have used throughout the UK since 2020 in respect of the following goods:

> "Electronic cigarettes; electronic cigarette atomizers; electronic cigarette cartomizers; electronic cigarette cases; cases for electronic cigarettes; liquids for electronic cigarettes; liquid for electronic cigarettes; cartridges for electronic cigarettes; refill cartridges for electronic cigarettes; smoking sets for electronic cigarettes; replaceable cartridges for electronic cigarettes; liquid nicotine solutions for electronic cigarettes; liquid solutions for use in electronic cigarettes; electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; electronic cigarette liquid [e-liquid]

[1] For the sake of completeness, the mark that VSL relies on in its opposition against the Asghars' registrations is that for which registration is sought here.

comprised of propylene glycol; flavorings, other than essential oils, for use in electronic cigarettes; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; chemical flavorings in liquid form used to refill electronic cigarette cartridges; flavourings, other than essential oils, for use in electronic cigarettes; cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; chemical flavourings in liquid form used to refill electronic cigarette cartridges; cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes."

9. VSL filed counterstatements wherein it denied the claims against it.

10. Upon the filing of the counterstatements, the Tribunal consolidated the proceedings under the power given to it under Rule 62(1)(g) of the Trade Mark Rules 2008. This was communicated to the parties by way of written correspondence dated 20 February 2023.

11. VSL is represented by J A Kemp LLP and neither the Asghars nor SA have legal representation. Only SA filed evidence in respect of his own oppositions. No hearing was requested and only VSL filed written submissions in lieu. This decision is taken after careful consideration of the papers.

12. 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

13. SA's evidence came in the form of two witness statements in his own name. Both statements are dated 25 August 2023. The two statements were separately filed under each of SA's oppositions. Despite very slight differences in the narrative

evidence between the statements,[2] their contents are identical as they cover the same substantive points. In terms of exhibits, I note that each statement is accompanied by four exhibits, being those labelled Exhibit 1 to 4. Having considered these exhibits, I can confirm that they are identical. In light of the identical substantive content of the statements, I will deal with them as one. SA's evidence was adduced for the purpose of proving that his unregistered sign enjoys goodwill in the UK.

14. I do not intend to summarise the parties' evidence or submissions in full here. However, I confirm that I have taken all evidence and filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

15. Since one of SA's oppositions is targeted at the mark relied upon in VSL's opposition, I will consider SA's oppositions first. I do so because if SA's opposition against VSL's relied upon mark succeeds then that mark will be refused registration. If this happens, VSL will be unable to rely on that mark for the purpose of its own oppositions meaning that they will fall away. Alternatively, if SA's opposition against the relied upon mark fails, I will proceed to consider VSL's opposition in the ordinary way.

DECISION

SA's oppositions

Section 5(4)(a)

16. Section 5(4)(a) of the Act reads as follows:

[2] In relation to the dates and trade marks at issue in the separate proceedings

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(a) […]

(b) […]

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

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

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

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

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

19. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source[2] or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

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

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

21. VSL's marks do not have priority dates, and neither is there any evidence of use prior to their filing dates that is capable of being considered as the start of the behaviour complained about. Therefore, the relevant dates for the assessment of SA's claim under section 5(4)(a) of the Act is the filing dates of VSL's first and second marks, being 28 April and 22 July 2022, respectively.

Goodwill

22. The first hurdle for SA is that he needs to show that he had the necessary goodwill in the sign relied upon at the relevant dates. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

23. In *South Cone* (cited above), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

24. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

25. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was

needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

26. Goodwill arises as a result of trading activities. I remind myself that SA claims to have accrued goodwill in its unregistered sign of 'Bar Liquid' in respect of the following goods:

"Electronic cigarettes; Electronic cigarette atomizers; Electronic cigarette cartomizers; Electronic cigarette cases; Cases for electronic cigarettes; Liquids for electronic cigarettes; Liquid for electronic cigarettes; Cartridges for electronic cigarettes; Refill cartridges for electronic cigarettes; Smoking sets for electronic cigarettes; Replaceable cartridges for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid solutions for use in electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Flavorings, other than essential oils, for use in electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Flavourings, other than essential oils, for use in electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes."

27. SA claims that it has used his sign for the above goods throughout the UK since 2020.

28. SA's evidence consists of three separate invoices dated 28 July, 15 August and 15 October 2021 (Exhibits 1 to 3) and a printout showing a range of the products he sells (Exhibit 4). Before discussing the invoice evidence, I wish to briefly discuss the type of products that SA sells. At Exhibit 4, a range of undated printouts from the website 'vapedistrubtion.com' are provided. The printouts show a number of different products under the 'Bar Liquid' branding. While the printouts are taken from a '.com' website and do not show any prices, a Union Jack flag is shown so it can be taken that the website is UK facing. As for the goods themselves, it is not explicitly stated what they are. That being said, the goods are shown as being under the 'E-LIQUID' category of goods. It is my understanding that this is the liquid that a user may install into their vape/e-cigarette. The liquid is then vaporized by the vape/e-cigarette and inhaled by the user. Despite the printouts being undated, I am content to conclude that the goods shown are reflective of the goods covered by the invoices provided.

29. Before getting into the substance of the invoices provided, I wish to briefly discuss two issues in respect of the fact that the addressees of the invoices have been redacted. They are as follows:

    a. The removal of the entirety of the addressee could potentially give rise to an issue for SA in that it could be argued that the goods were not shipped to addresses in the UK. However, I can see that at the top of two of the three invoices (Exhibits 1 and 3), the products are confirmed as being those shipped within the UK. Clearly these invoices relate to goods sold in the UK. As for the third invoice (Exhibit 2), which does not include this same wording, it does show goods listed in British pounds. On balance, I am content to conclude that this invoice does cover the shipment of goods within the UK; and

    b. The redaction of *all* information means that I am unable to make any determination as to whether the recipients of the goods were repeat customers. Under section 5(4)(a) claims, evidence of repeat custom can go some way to supporting a claim by a business that it enjoys a protectable level of goodwill

in the UK.[3] Without this information or confirmation by SA of repeat custom, I am not willing to infer that the recipients of the three invoices were the same.

30. Having considered the goods covered by the invoices, I note that the majority of them appear to be under brandings other than 'Bar Liquid'. It is not clear whether these other brands were sub-brands of the 'Bar Liquid' brand or not. However, upon re-considering the narrative evidence, I note that SA only seeks to mention the 'Bar Liquid' goods in his explanation of the appended invoices. For example, in respect of the first invoice, SA specifically mentions line 24 of the invoice which covers a 'Bar Liquid' product. He makes absolutely no reference to goods other than those under the 'Bar Liquid' brand. As such, I do not consider that there can be any doubt that the only goods relevant here are those that are expressly referred to as 'Bar Liquid' goods in the invoices.[4]

31. By my count, there are six entries covering 'Bar Liquid' products spread over the three invoices. These entries amount to the total shipment of 100 individual 10ml e-liquid goods in four different flavours. SA has not provided any overall sales figures in relation to these products. While that may be the case, I have undertaken my own calculations which show that the invoices demonstrate a total wholesale net value of £71.10. I appreciate that the products would have gone on to be sold to end consumers at a higher value, however, I do not consider the total turnover associated with 100 products of what are likely to be low-cost goods would be *that* much higher.[5]

32. At this point in my assessment, I do not consider it controversial to state that SA's evidence shows a vanishingly small level of use prior to the relevant dates. I say this particularly whilst bearing in mind the size and nature of the market in which SA operates, being the e-cigarette/vaping market in the UK. I note that no evidence

[3] See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 wherein the Court of Appeal found that repeat purchases by 37 customers was sufficient to give rise to a finding of goodwill despite the overall level of use being limited.
[4] On this point, I consider it reasonable to suggest that if it were the case that these other goods were sub-brands of 'Bar Liquid', it was on SA to prove as such.
[5] While I have no evidence as to the actual retail price of these goods, it is my understanding that they are inexpensive goods. This is supported by the very low wholesale value of said goods, being around 76p per item.

is before me in respect of this market but I consider it reasonable to find that it is a large market and, further, one that is highly competitive with countless businesses operating within it. In addition, I appreciate that the volume of use for e-liquids will depend on the user and how frequently they vape, however, I am of the view that the goods at issue are those that are, generally speaking, purchased with a high level of frequency. Lastly, I note that there is no evidence of marketing expenditure or examples of advertising efforts undertaken prior to the relevant dates that may be of assistance in pointing to at least some recognition across the relevant section of the public.

33. Taking all of the above into account, I find that SA's evidence of use falls far short of the level required to support a finding that he enjoys a protectable level of goodwill in his business. In making this finding, I bear in mind that while small businesses can succeed in bringing claims for passing off, the evidence still needs to demonstrate a qualifying level of use.[6]

34. Given that there exists no protectable level of goodwill in SA's business, it follows that there cannot be a misrepresentation or damage. The section 5(4)(a) grounds of opposition must, therefore, fail. As this was the only ground relied upon, SA's oppositions both fall away at this stage.

Final remarks in respect of SA's oppositions

35. In light of SA's oppositions failing VSL's marks may (subject to any successful appeal against my decision, of course) proceed to registration for all the goods. More importantly to my present decision, however, is that VSL's first mark remains a valid mark that it is capable of relying on for the purpose of its own oppositions, which I will now proceed to consider.

[6] On this point, I refer, again, to *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590. In that case, the level of use demonstrated covers a turnover of £2,000 per quarter between early 2008 and September 2009 which increased to £10,000 per quarter by September 2010. While this was considered 'very limited' by the court in the judge in the first instance, it is considerably larger than the use shown before me here.

VSL's oppositions

36. While SA's oppositions were targeted at both of VSL's marks, the following oppositions brought by VSL are reliant upon one mark only. This was defined as 'VSL's first mark' above. However, for the purposes of VSL's oppositions, I will simply refer to it as 'VSL's mark'.

Sections 5(1) and (2): legislation and case law

37. Section 5(1) of the Act reads as follows:

> "(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

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

> "(2) A trade mark shall not be registered if because-
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> (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 or association with the earlier trade mark."

39. 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."

40. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

41. While the opposition against VSL's mark failed, meaning that it may proceed to registration, it is still technically a pending mark. Regardless, it still qualifies as an "earlier trade mark" for the purposes of VSL's oppositions since it was applied for at an earlier date than the filing date of the Asghars' applications.[7] In the present circumstances, clearly it has yet to complete its registration process more than five years prior to the filing date for the Asghars' registrations, meaning that it is not subject to proof of use pursuant to section 6A of the Act. This means that VSL can rely upon all of the goods highlighted in its notices of opposition.

[7] See Section 6(1)(a) of the Act.

42. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P 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.

Identity of the marks at issue in VSL's opposition of the Asghars' first registration

43. It is a pre-requisite of both section 5(1) and 5(2)(a) of the Act that the trade marks are identical. Plainly, the mark in Asghars' first registration is identical to VSL's mark and I note that this point is accepted in their counterstatement. As a result, the opposition against the Asghars' first registration may proceed.

Similarity of the Asghars' second registration

44. As the opposition against Asghars' second registration is reliant upon section 5(2)(b) only, I must consider whether it is similar to VSL's mark. I note that in their counterstatement in defence of the opposition against their second registration, the

Asghars' accept that the marks at issue were identical. While I consider that it would be acceptable to proceed on the basis of this concession, I do not intend to do so. I say this because, plainly, it is not the case that the marks in Asghars' second registration are identical to VSL's mark. That being said, the marks (being 'Bar Liquid' and 'Bar E Liquid'/'Bar E-Liquid') are clearly highly similar from a visual, aural and conceptual standpoint and I will proceed as such.

Distinctive character of VSL's mark

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union ("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 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)."

46. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. While the distinctiveness of a mark can be enhanced by virtue of the use made of it, VSL has not pleaded as such and neither has it filed any evidence in support of this. As such, I only have the inherent position to consider.

47. VSL's earlier mark is a word only mark made up of two words, being 'Bar Liquid'. Individually, both of these words have an obvious meaning to the UK consumer.[8] While 'Bar' has no descriptive or allusive qualities, it is not particularly remarkable from a trade mark perspective on the basis that it is an ordinary dictionary word. As for 'Liquid', I find that where the mark is viewed on goods that cover liquid refills or flavourings, this word will be descriptive. However, when viewed on goods such as electronic cigarettes, the word 'Liquid' will not describe the actual goods but will, instead, allude to the fact that the electronic cigarettes use liquid refills/capsules.

48. I appreciate that the words in VSL's mark may be ordinary, however, I am of the view that when they are viewed in combination, consumers will not derive any unitary meaning from the mark as a whole. Instead, I consider that consumers will view the mark as a somewhat unusual combination of two normal words which, when viewed together, form no obvious meaning outside of the individual meanings of the words themselves. Regardless of the descriptive/allusive nature of the word 'Liquid', I consider that the mark when viewed as a whole will enjoy a medium degree of inherent distinctive character.

Comparison of goods

49. In its counterstatements, the Asghars conceded that the goods at issue were similar. While this is noted, they did not state the level of similarity they believed to

[8] In respect of the word 'Bar', I note that neither party has provided any submission or argument in support of this word having any meaning in the context of the goods at issue. Without anything on this point, I am not willing to conclude that 'Bar' has any meaning in the context of the goods at issue here.

exist between the goods. In light of the Asghars' concession, the oppositions reliant upon the section 5(2)(a) and 5(2)(b) grounds will proceed regardless of the level of similarity. That being said, I still consider it useful to determine the actual level of similarity. This is on the basis that differing levels of similarity are factors to take into account when considering a likelihood of confusion. In addition, the opposition in reliance upon the section 5(1) ground requires a level of identity between the goods in order for it to succeed. As a result, it is still necessary for me to conduct a full goods comparison.

50. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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".

51. 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.

52. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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."

53. The goods across the Asghars' registrations' specifications are identical and are set out at paragraph 2 above. The goods in VSL's mark's specification are set out at paragraph 3 above.

Cartridges for electronic cigarettes; cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; refill cartridges for electronic cigarettes.

54. The first term set out above is self-evidently identical to "cartridges for electronic cigarettes" in VSL's specification. The remaining terms set out above are all identical under the principle outlined in *Meric* with that same term of the opponent.

Electric cigarettes [electronic cigarettes]; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic devices for the inhalation of nicotine containing aerosol; electronic nicotine inhalation devices; electronic cigarette atomizers; electronic cigarette cartomizers; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; vaporizers for smoking purposes; electronic cigarettes for use as an alternative to traditional cigarettes; personal

vaporisers and electronic cigarettes, and flavourings and solutions therefor; electric cigarettes [electronic cigarettes].

55. All of the above term describes different types of electronic cigarettes or vaping devices. Some of the terms also make reference to the flavouring and solutions used in said devices. Therefore, I find that the above terms can either be said to be self-evidently identical or identical under the principle outlined in *Meric* with "electronic cigarettes" and ""flavorings, other than essential oils, for use in electronic cigarettes" in VSL's specification.

Electronic cigarette boxes.

56. The above term appears in VSL's specification. These goods are, therefore, self-evidently identical.

Chemical 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 cigarette liquid [e-liquid] comprised of propylene glycol; electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; flavorings, other than essential oils, for use in electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes; liquid for electronic cigarettes; liquid nicotine solutions for electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; liquid solutions for use in electronic cigarettes; liquids for electronic cigarettes; cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; chemical flavorings in liquid form used to refill electronic cigarette cartridges; liquid solutions for use in electronic cigarettes.

57. The above terms all describe various types of liquids for electronic cigarettes. Despite the use of alternate wording, I consider that the above terms all describe the same goods as "liquids for electronic cigarettes", "flavorings, other than essential oils, for use in electronic cigarettes" and "electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette

cartridges" in VSL's specification. However, where the goods are not self-evidently identical, I find that they are still identical under the principle outlined in *Meric*.

Tobacco and tobacco products (including substitutes).

58. The inclusion of 'including substitutes' in the above term means that they can cover electronic cigarette liquids and capsules. I say this because electronic cigarette products are widely considered as substitutes for traditional tobacco and tobacco products. As a result, I consider that the above term encompasses "liquids for electronic cigarettes", "flavorings, other than essential oils, for use in electronic cigarettes" and "electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges" in VSL's specification. As such, I find that these goods are identical under the principle outlined in *Meric*.

Flavorings, other than essential oils, for tobacco; flavourings, other than essential oils, for tobacco.

59. The above terms do not cover flavourings for electronic cigarette or vaping products. Therefore, they cannot be said to be identical with any of VSL's terms. That being said, I do consider that they are similar to "flavorings, other than essential oils, for use in electronic cigarettes". I say this because their nature is likely to overlap on the basis that both sets of goods are types of flavourings. I appreciate that their methods of use may differ as flavourings applied to tobacco products are not likely to be applied in the same way as they are applied to electronic cigarette flavourings. As for purpose, I consider that this will overlap on the basis that while the delivery method will not be the same, both products aim to flavour a product that is being inhaled by the user to get nicotine into their system. Both parties' goods are likely to be sold via the same establishments such as specialist smoking retailers and are likely to be displayed on the same shelves or at least in close proximity to one another. Taking all of this into account, I consider that these goods are similar to a medium degree.

Chewing tobacco; snus; devices for heating tobacco for the purpose of inhalation; smokers' articles.

60. The nature and method of use of the above goods will differ from the goods in VSL's specification. That being said, I do consider that they are similar to "electronic cigarettes" and/or "flavorings, other than essential oils, for use in electronic cigarettes" in VSL's specification. I say this because while the method of delivery differs, the purpose of both sets of goods is to introduce nicotine into the users' system. Further, the goods are likely to be available via the same trade channels in that they will be sold by the same specialist smoking stores and are likely to be placed in close proximity with one another in said stores. Taking all of this into account and also bearing in mind the Asghars' concession as to similarity, I consider that these goods are similar to a low degree.

Final comments in respect of the goods comparison

61. Given that I have found identity between the majority of the goods at issue, VSL's opposition against the Asghars' first registration in respect of those goods succeeds under the section 5(1) ground of opposition at this stage. As it is a pre-requisite of section 5(1) grounds that goods be identical, the opposition under this ground must fail in respect of the following goods:

Class 34: Flavorings, other than essential oils, for tobacco; flavourings, other than essential oils, for tobacco; chewing tobacco; snus; devices for heating tobacco for the purpose of inhalation; smokers' articles.

62. The above being said, VSL's opposition against the above goods in the Asghars' first registration will, however, proceed in respect of the section 5(2)(a) ground on the basis that there exists a degree of similarity between them. For the avoidance

of doubt, the opposition against the Asghars' second registration proceeds against all goods.

The average consumer and the nature of the purchasing act

63. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

64. The goods at issue will be sought by members of the general public who smoke or vape. For the most part, the goods are likely to be available via general retailers or specialist vape/smoking retailers or their online equivalents. The goods relating to vaping (unlike cigarettes or other tobacco products) are not subject a ban that bars them from being displayed on shelves in stores. As such, those goods are likely to be selected by the consumer after a visual inspection of the same. As for the tobacco related products, these are not permitted to be displayed on shelves and will, therefore, be selected aurally. Having said that, a visual component will still play a part on the basis that the consumer will view the goods before making their purchase. In my view, the selection of the vaping related goods will be dominated by the visual component (though I do not discount aural considerations in the form of word of mouth recommendations or advice from sales staff) whereas the

selection of tobacco products will be done so primarily based on the aural component (though as above, the visual component will still play a role).

65. All of the goods at issue are likely to be purchased reasonably frequently and at a relatively low cost. For the tobacco products, various factors will be taken into account, such as the type or strength of the product. As for electronic cigarettes, consumers are likely to consider the materials used, ease at which the product can be refilled and its advertised battery life. For the refill products, the consumer is likely to consider how long it will last, its flavour and the ingredients used. Regardless of whether the goods are tobacco or electronic cigarette related, the consumer will, in my view, pay a medium degree of attention during the purchasing process.

Likelihood of confusion

66. 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of VSL's mark, 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 or she has retained in his or her mind.

67. For the most part, I have found the goods to be identical. However, some goods I have found to be similar to a medium or low degree. I have found the average

consumer for the services to be members of the general public at large who either smoke or vape. These consumers will select the goods whilst paying a medium degree of attention and, depending on what is being selected, the selection process will be dominated by the visual or aural component. In respect of the marks at issue, I remind myself that the mark in Asghars' first registration is identical to VSL's mark and the marks in their second registration are visually, aurally and conceptually similar to a high degree with VSL's mark. I have found VSL's mark to be inherently distinctive to a medium degree.

68. I will consider the issue of confusion in respect of the Asghars' registrations separately.

The Asghars' first registration

69. Taking all of the above factors into account, I am satisfied that the average consumer would likely mistake the parties' marks for each other, even on goods that are similar to a low degree. I make this finding because the marks at issue are identical and also whilst bearing in mind the principle of interdependence which I have discussed above. I am, therefore, satisfied that there will be a likelihood of direct confusion between VSL's mark and the mark in Asghars' first registration.

The Asghars' second registration

70. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I find that consumers are likely to mistake the parties' marks for one another, especially in light of the high levels of similarity between them. The only points of difference come in one letter or one letter and a dash, being 'E' and 'E-', respectively, that sit in the middle of the marks in Asghars' second registration. All other elements of the marks (being the word 'Bar' at the beginning of the marks and 'Liquid' at their ends) are the same. On this point, I remind myself that not only is there case law that suggests common elements at the beginnings of marks is

sufficient to point towards confusion,[9] there is also case law that suggests that common elements at the ends of marks may also be sufficient.[10] In the present case, the marks share identical beginnings and ends. For the avoidance of doubt, I am of the view that regardless of the descriptive nature of the word 'Liquid' in respect of certain goods, it is still a point of identity between the marks that will be noticed.[11] Consequently, I consider that there is a likelihood of direct confusion between the marks. Bearing in mind the interdependence principle, I consider that this finding applies in circumstances where the marks are viewed on goods that are similar to a low degree.

71. For the sake of completeness, I turn now to consider indirect confusion.[12] In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, 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:

[9] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[10] *Bristol Global Co Ltd v EUIPO,* T-194/14
[11] For the avoidance of doubt, if it can be said that 'Bar' is descriptive or allusive of vaping products, then I consider that this same finding applies in that instance also.
[12] For the avoidance of doubt, the assessment of indirect confusion relates to the Asghars' second registration only.

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

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

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

72. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

73. In the event that the letter 'E' or 'E-' in the middle of the marks in Asghars' second registration are noticed and used to accurately recall the marks for one another, I am of the view that consumers will still believe that the marks originate from the same undertaking. In the context of the goods at issue here, I consider that the addition of the letter 'E' (with or without a dash) is such that it will be seen as a reference to 'electronic cigarettes'. I say this because the use of the letter 'e' in relation to electronic goods/services is something that is common place across several trades. For example, I do not consider it controversial to suggest that electronic cigarettes are commonly referred to as 'e-cigarettes'.[13] As such, the

[13] I appreciate that this is not something that is supported by any evidence before me but, in my view, it is something that I am entitled to take judicial notice on as, in accordance with the comments of Ms Anna Carboni sitting as the Appointed Person in *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08, I do not consider it to be a point of serious dispute.

letter ‘E’ (again, with or without a dash) will simply be seen by consumers as an indicator that ‘Bar Liquid’ has expanded its brand or created a sub-brand to focus on ‘e-cigarettes’ or the sale of ‘e-liquids’ for use in ‘e-cigarettes’. Consequently, I consider that there exists a likelihood of indirect confusion between the marks at issue. For the same reasons discussed above when considering direct confusion, I consider that this applies in circumstances where the marks are viewed on goods that are only similar to a low degree.

Final remarks in respect of VSL’s oppositions

74. VSL’s opposition against the Asghars’ first registration in reliance upon the section 5(1) ground only partially succeeded. However, the success of the section 5(2)(a) ground of that opposition against the remaining goods means that VSL’s opposition against the Asghars’ first registration has succeeded in full.[14] Further, VSL’s opposition against the Asghars’ second registration has also succeeded in full. As a result, both of the Asghars’ registrations are to be refused registration for all goods.

CONCLUSION

75. The outcome of these consolidated proceedings is as follows:

a. Both of SA’s oppositions failed in their entirety meaning that VSL’s marks may, subject to any successful appeal against my decision, proceed to registration in respect of all goods applied or; and

b. Both of VSL’s oppositions have succeeded in full meaning that the Asghars’ registrations are, subjected to any successful appeal against my decision, hereby refused registration for all goods applied for.

[14] For the avoidance of doubt, I wish to briefly set out that if any of the goods I have found to be identical are not, in fact, identical, then the Asghars’ concession as to similarity is such that it still would have led me to find that VSL’s opposition against the identical mark in Asghars’ first registration was successful in full. In making this point, I again rely on the principle of interdependence in that the identical nature of the marks is sufficient to offset any lowly similar goods.

COSTS

76. As VSL has succeeded in defending SA's oppositions against its marks and also in opposition the Asghars' registrations, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016 ("the TPN"). While I appreciate that there is overlap in respect of the fact that SA was the sole opponent in his own oppositions but a co-applicant in VSL's oppositions, I am of the view that the costs awards for these proceedings should be made separately.

77. Firstly, I note that VSL only filed one set of written submissions in these consolidated proceedings. In the circumstances, I consider it a reasonable approach to split the costs for this task equally across the separate costs awards. Secondly, I note that in SA's oppositions, VSL did not file its own evidence. It was, however, required to consider SA's evidence in full. While I consider it necessary to make a costs award in respect of this task, I will do so at an amount below the amount published in the relevant scale on the basis that the evidence filed was not particularly extensive.

<u>Costs of proceedings numbered 437624 and 437960.</u>

78. In respect of the costs associated with defending SA's oppositions against it, I hereby award VSL the sum of £750 as a contribution towards its costs. This sum is calculated as follows:

Considering two oppositions brought by SA and filing counterstatements in respect of the same:	£300
Considering SA's evidence:	£300
Preparation of written submissions (half of the TPN's scale costs of £300):	£150

Total:	**£750**

79. I hereby order Sami Asghar to pay Vape Supplier Limited the sum of £750. 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.

Costs of proceedings numbered 435759 and 437218.

80. In respect of the costs associated with bringing its own oppositions, I hereby award VSL the sum of £650 as a contribution towards its costs. This sum is calculated as follows:

Preparing two notices of opposition and considering the counterstatements in respect of the same:	£300
Preparation of written submissions: (half of the TPN's scale costs of £300):	£150
Official fees (£100 x 2)	£200
Total:	**£650**

81. I hereby order Sami Asghar and Rafi Asghar to pay, jointly and severally, Vape Supplier Limited the sum of £650. 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 7th day of October 2024

A COOPER
For the Registrar