O/0996/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3858810
IN THE NAME OF JUST MIST WHOLESALE LTD
TO REGISTER AS A TRADE MARK

Misty Mary

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 439880
BY STARBUZZ TOBACCO, INC.

BACKGROUND AND PLEADINGS

1. On 13 December 2022, Just mist wholesale Ltd ("the applicant") applied to register the trade mark **Misty Mary** in the United Kingdom. The application was accepted and published for opposition purposes on 23 December 2022, in respect of goods in class 34, as listed in the table under paragraph 19 of this decision.

2. The application is opposed by Starbuzz Tobacco, Inc. ("the opponent"). The opposition was filed on 23 March 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon the following comparable mark:

MISTY MOON
UK trade mark registration number 917834342
Filing date: 20 February 2018
Registration date: 5 July 2018
Registered in Class 34, relying on all goods, as listed in the table under paragraph 19 of this decision.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[1]

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

[1] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

5. The opponent submits that the contested goods are identical with the goods of the earlier mark or are similar or complementary to those goods. It submits that both marks share the word “MISTY” at the beginning followed by a four-letter word which is likely to be perceived as marks within the same family; and further, that any risk of confusion will be further heightened when taking into account imperfect recollection.

6. The applicant filed a counterstatement denying the claim that the marks are confusingly similar, although it admits that its goods are either identical with or are similar or complementary to the opponent’s goods. The applicant denies that there is a likelihood of confusion between the marks and requests that the opposition be dismissed in its entirety.

7. Only the applicant elected to file evidence, neither party requested a hearing. Both parties filed written submissions in lieu of a hearing which will be referred to as and where appropriate during this decision. This decision has therefore been taken following careful consideration of the papers on file.

8. In these proceedings, the opponent is represented by Keltie LLP and the applicant is represented by Adamson Jones[2].

EVIDENCE

9.The applicant filed evidence in support of the defence in the form of three witness statements.

10. The first witness statement is in the name of Cherrie Stewart, a trade mark attorney of Ansons, who at the time of filing were the then recorded representatives of the applicant. The witness statement is dated 27 November 2023 and is accompanied by four exhibits, labelled EXHIBIT 1 to EXHIBIT 4.

[2] Form TM33 notifying the change of representative from Ansons to Adamson Jones as representatives to the applicant was filed on 23 August 2024, the details of which have been recorded accordingly in these proceedings. I note that all correspondence, including the final written submissions in lieu of a hearing, were filed on behalf of the applicant by Ansons.

11. The second witness statement is in the name of Paul Wilkinson and is dated 9 December 2023. Mr Wilkinson is a director of S&P Wilkinson Services Ltd and is a specialist within the vaping industry. The witness statement is accompanied by two exhibits labelled EXHIBIT PW1 to EXHIBIT PW2

12. The third witness statement is in the name of Karl Andrew Crozier, being the founder and former owner of the brand "Pure Mist" and the company registered as Pure Mist Limited. The witness statement is dated 1 December 2023 and is accompanied by two exhibits labelled Exhibit 1 to Exhibit 2.

13. The purpose of the evidence is to demonstrate the descriptive or non-distinctive nature of the terms "mist" and "misty" in relation to at least some of the goods at hand. I have taken the evidence into account in reaching my decision and I will refer to it during the decision to the extent I consider necessary.

DECISION

14. 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.

Section 5(2)(b)

15. Section 5(2)(b) is relied on and reads as follows:

> "5(2) A trade mark shall not be registered if because -
>
> (a) …

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

16. Section 5A states:

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

17. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation 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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

18. Pursuant to section 60A of the Act, goods are not to be automatically regarded as being similar to each other on the ground that they appear in the same class.

19. The goods to be compared are:

Opponent's goods	**Applicant's goods**
Class 34 *Hookahs and electronic hookahs and accessories thereof; tobacco products; Tobacco substitutes, in particular those made out of tea and tea plants; cut and uncut tea for smoking as tobacco substitute; cigarette tobacco; chewing tobacco; pipe tobacco; shisha tobacco; smokers' articles of all kinds, in particular matches; shishas and electronic shishas and accessories thereof; electronic cigarettes; cigars; small cigars; electronic cigars; electronic vaporizing smoking device; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smoking pipes; steam stones, in particular steam stones for water pipes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; all the aforesaid goods not for medical purposes.*	*Class 34* *Tobacco; Tobacco and tobacco substitutes; Tobacco products; Cigarettes; Electronic cigarettes; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; Filter tips for cigarettes; Hand-held machines for making cigarettes; Pocket apparatus for rolling cigarettes; Cases for electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid for electronic cigarettes; Smoking sets for electronic cigarettes; Tobacco and tobacco products (including substitutes); Ashtrays incorporating match lighters; Cigarette lighters; Cigarette lighters of precious metal; Ashtrays for smokers; Ashtrays of precious metal.*

20. Where the goods in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: See *Gérard Meric v OHIM,* Case T-133/05 at [29].

21. I note that in relation to the goods at issue, some of the goods are self-evidently identical, for example, the applicant's "*Tobacco; Tobacco and tobacco substitutes; Tobacco products; Liquid for electronic cigarettes"* with the opponent's "*tobacco products; Tobacco substitutes, in particular those made out of tea and tea plants; E-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes."* I also consider that the opponent's "*smokers' articles of all kinds, in particular matches"* would encompass the applicant's various ashtrays and cigarette lighters and thus are identical as per the principle outlined in *Meric*.[3] Given that at least some of the goods are identical, and the applicant's admission of identity or similarity of the competing goods,[4] I do not intend to undertake a full comparison of the goods at issue. If there is a finding of no likelihood of confusion for the mark on identical goods, then it follows that there will be no confusion between the marks for goods which are only considered similar (to any degree). However, if a likelihood of confusion is found, I will return to assess the degree of similarity between the goods at issue in full.

The average consumer and the nature of the purchasing act

22. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

[3] In *Häfele GmbH & Co. KG v OHIM*, Case T-336/09, the General Court ("GC") stated that the words "in particular" used in a description are merely indicative of an example, rather than limiting those goods (or services) to those listed following the term.
[4] In its counterstatement, and again in its written submissions in lieu (at [24]), the applicant admits that the opposed goods are either identical with or are similar or complementary to the goods of the earlier mark, although it has not said to what degree it considers them to be similar.

23. In its written submissions in leu of a hearing, the opponent submits that in the case at issue, the average consumer is a smoker or vaper who, given the nature of the goods, will not pay a particularly high attention when purchasing the goods. The applicant submits in its submissions in lieu that "smokers are considered to be particularly careful and selective about the brand of cigarettes they smoke, so a higher degree of … attention is assumed when tobacco products are involved". I also note the applicant's references to previous Board of Appeal decisions.[5]

24. Due to the legal age restrictions placed on the sale of goods of this nature, I consider the average consumer of tobacco products, tobacco substitutes and liquid for electronic cigarettes will be an adult member of the general public of 18 years of age or older.

25. The goods are sold through a range of channels, including newsagents, supermarkets and tobacconists, as well as specialist "vaping" suppliers, and via the internet. In large stores, tobacco-based products are hidden from view and are restricted to 'behind the counter' cabinets, where they will need to be requested by the consumer; at the time of writing, the consumer may view e-cigarettes on display for sale. For online sales, the consumer will select the goods having viewed an image displayed on a webpage. Considered overall, the selection process will be by a combination of both visual and aural means, with aural considerations being particularly pertinent where the goods are requested from behind the counter displays, or are selected following verbal advice from sales staff, and visually when purchased online. Tobacco-based cigarettes are likely to be purchased frequently, as are single-use (disposable) electronic cigarettes which are considered to be relatively inexpensive, while multiple use electronic cigarette devices will be more expensive but purchased less frequently.

26. In my view, the average consumer will make their selection based on a range of factors, including strength/tar content of the tobacco-based cigarettes, and the choice of flavours available and the nicotine strength of the liquid for disposable electronic

[5] At [25-26].

cigarettes, as well as the cost and the capacity of the device for non-disposable e-cigarettes. Overall, I consider that at least a medium level of attention will be paid during the purchasing process for these goods.

Comparison of marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, that:

> "34. ....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."

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

29. The opponent submits that the marks are highly similar visually, that the shared first word "MISTY" is aurally strong, and that conceptually, neither mark has a meaning in its whole. The applicant submits that the distinctive elements of the marks are the second element in each, being "MARY" and "MOON", with the word "MISTY" being allusive of the goods at issue. It submits that conceptually, the marks differ significantly and that each mark has a clear and specific, but very different, meaning.

30. The respective trade marks each consist of two words: "**MISTY MOON**" vs "**Misty Mary**". Both marks are presented in a standard black typeface, with no other elements

to contribute to the overall impression. While the opponent's mark is presented in capital letters and the applicant's mark is presented in Title Case, I note that the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. I do not consider that either of the two words which makes up each of the marks dominates, therefore the overall impression of each of the marks rests in the combination of words which make up the whole.

31. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, however, I accept that this is not always the case.

32. Visually, the marks share the identical first word "MISTY" while the second word of each mark is made up of four letters, both of which begin with the letter "M". The words are relatively short, and as such the variance between the marks is more likely to be noticed by the average consumer.[6] Considering the identical first word, overall I consider the marks to be visually similar to at least a medium degree.

33. The first word of each mark would be articulated identically as two syllables, MISS-TEE. The second word in each mark would be pronounced as one syllable and two syllables respectively, the marks as a whole being voiced as MISS-TEE-MOON and MISS-TEE-MARE-REE, resulting in aural commonality between the first two syllables only of the competing marks. Overall, I consider the marks to be aurally similar to a medium degree.

34. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

> "8. … In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the 'concepts' that the signs at issue convey. The term 'concept' means, according to the definition given, for example, by the Larousse dictionary, a 'general and abstract idea used to denote a specific or

[6] *dm-drogerie markt GmbH & Co. KG v OHIM,* Case T-304/10.

abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it."

35. In *Whyte and Mackay Ltd v Origin Wine UK Ltd*[7] Arnold J. (as he was then) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson* in relation to components of composite marks which play an independent, distinctive role. In my view, in the case before me the shared word "MISTY" would not be considered in isolation, with each of the marks being perceived as a whole. I consider that the shared element is unlikely to be viewed as being either distinctive or independent from the subsequent words "MOON" and "Mary", with the adjective "MISTY" in both marks seen as qualifying the word which follows it. The opponent's mark evokes a moon that is shrouded with cloud and so is somewhat indistinct; the applicant's mark, would, to my mind, be perceived as referring to a female called Mary who is a somewhat ethereal character, hence the name "Misty Mary". While there is a conceptual overlap in the "MISTY" element present in both marks, I consider that the marks send out different overall messages and therefore any conceptual similarity between the marks is to a very low degree.

Distinctive character of the earlier marks

36. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

"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

[7] *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

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)."

37. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

38. The opponent's mark comprises two dictionary defined words, "MISTY" and "MOON". While some of the goods at hand may be described as mists, as found earlier in this decision, the meaning of the earlier mark resides in the whole, and in my view would be seen as referring to a cloud-shrouded moon. As such, I do not find the mark to be allusive of the goods for which it is registered. Consequently, I consider the words in combination which form the composite mark "MISTY MOON" to possess a medium level of inherent distinctive character.

Likelihood of confusion

39. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

40. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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.).

(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)."

41. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

42. As explained earlier in this decision, I have proceeded on the basis that at least some of the competing goods are identical. I found the level of attention of the average consumer during the selection of the goods to be at least medium and I considered that the selection process would be by a combination of both visual and aural means.

43. I found the competing marks to be visually similar to at least a medium degree and aurally similar to a medium degree, and to be conceptually similar overall to a very low degree. I found the earlier mark to be inherently distinctive to a medium degree.

44. I note that in her witness statement, Cherrie Stewart states that several undertakings within the vaping market use signs that contain the words "mist" or "misty" and adduces Exhibit 2 which shows details of fourteen such "mist" marks included in the UK Trade Mark Register under class 34. However, this in itself is insufficient for me to automatically establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned: *Zero Industry Srl v OHIM*, Case T-400/06.[8] I acknowledge the evidence of Paul Wilkinson, including descriptive use of the term "mist" in relation to vaping products by way of the investigative article contained within Exhibit 1, and I note that the existence of a number of similar signs in the relevant market *may* reduce the distinctiveness of a trade mark[9]. However, the evidence before me is in relation to the word "mist" and not to the adjective "misty" as common to the competing marks. Further, I have already found that the word in common "misty" is used as a qualifier to the subsequent words "MOON" and "Mary" in each mark respectively, and that when viewed as a whole each mark evokes a different conceptual message, neither of which is allusive of the goods

[8] At [73].
[9] *Lifestyle Equities CV & Ors v Royal County of Berkshire Polo Club Ltd & Ors* [2024] EWCA Civ 814.

at hand. I take into account that while it is not always the case, in some circumstances, conceptual differences may be enough to offset visual and aural similarities: *The Picasso Estate v OHIM*, Case C-361/04 P.[10]

45. I have weighed up each of the competing factors in my decision, not least the similarities as well as the differences between the competing marks, as identified above. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer paying at least a medium degree of attention will notice and recall the differences between the marks, even though the visual and aural differences between them are found at the end of the respective marks. Given the difference in overall concept, those differences stand out and will not be overlooked. I find this even where the respective goods are held to be identical, which offsets a lesser degree of similarity between the marks. Overall, I do not consider there is any likelihood of direct confusion.

46. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

47. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold 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". Lord Justice Arnold added that there must be “a proper basis” for

[10] At [20].

concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

48. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive. I have made a multi-factorial assessment of the various considerations in play. I do not consider that the common element "MISTY" at the beginning of the respective marks is so strikingly distinctive that the consumer would assume that only the opponent would be using it as part of its trade mark. While sight of one mark may bring to mind the other mark, and consumers may consider that the marks coincidentally begin with the same first word, to my mind there is no compelling reason for consumers to mistakenly believe that there is an economic connection between the undertakings. As I have found that the common element "MISTY" does not play an independent role within either of the marks at hand, I do not agree with the opponent's submissions that they are likely to be perceived as marks within the same family. I therefore find no likelihood of indirect confusion.

49. The opposition fails under section 5(2)(b) of the Act.

FINAL REMARKS

50. Earlier in this decision, I explained that I did not intend to undertake a full comparison of the competing goods, but I would instead proceed on the basis that at least some of the opposing goods were identical, of which I provided examples. In light of my findings of no likelihood of confusion, it is unnecessary for me to return to undertake a comparison for the remaining goods as this would not improve the opponent's position.

CONCLUSION

51. The applicant has been successful. Subject to any successful appeal, the application by Just mist wholesale Ltd may proceed to registration.

COSTS

52. The applicant has been successful and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I do not consider that the evidence submitted by the applicant in support of its defence had any positive bearing on my decision, and consequently I make no award for such evidence. Applying the guidance in the TPN, I consider the following to be fair:

Considering the notice of opposition and filing a counterstatement:	£300
Preparing and filing written submissions in lieu of a hearing:	£500
Total:	**£800**

53. I therefore order Starbuzz Tobacco, Inc. to pay Just mist wholesale Ltd the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 17th day of October 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General