O/1189/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004052358
IN THE NAME OF OXHOLM INTERNATIONAL LLC
TO REGISTER THE FOLLOWING TRADE MARK:

GW-SWITCH

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000449405
BY BRITISH AMERICAN TOBACCO
(BRANDS) LIMITED

Background and pleadings

1. On 16 May 2024, OXHOLM INTERNATIONAL LLC ("the Applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 31 May 2024 in respect of the goods set out below:

Class 34: Oral vaporizers for smokers; Smokeless cigarette vaporizer pipes; Vaporizers for smoking purposes; Electronic cigarette cartomizers; Electronic cigarette atomizers; Cigar humidifiers; Humidifiers for cigars; Hookah tobacco; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; 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; Humidifiers for tobacco; Hookahs; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Shisha tobacco; Menthol cigarettes; Menthol pipe tobacco; Tobacco containers and humidors; Mouthpieces for cigarettes; Electronic hookahs; Pipes for smoking mentholated tobacco substitutes; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Electronic shisha pipes; Humidors; Lighters for smokers; Smokers (Lighters for -); Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Electronic nicotine inhalation devices; Flavored tobacco; Snus with tobacco; Cigar lighters; Cigar tubes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Firestones for lighters for smokers; Refill cartridges for electronic cigarettes; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; Shisha pipes; Liquids for electronic cigarettes; Devices for extinguishing heated cigarettes and cigars as well as heated tobacco sticks; Smokeless tobacco; Cigar pouches; Cigars for use as an alternative to tobacco cigarettes; Cigars; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Portable cigarette ash pouches; Cartridges for electronic

cigarettes; Electronic cigars; Liquid for electronic cigarettes; Hemp for smoking; Cigarillos; Mentholated tobacco; Electronic devices for the inhalation of nicotine containing aerosol; Snus; Tobacco free oral nicotine pouches [not for medical use];Cigar filters; Cigarette tubes; Gas containers for cigar lighters; Cigar lighters (Gas containers for -);Herbs for smoking; Cigarette tobacco; Flavorings, other than essential oils, for use in electronic cigarettes; Lighters for smokers [cigarette lighters] [not for automobiles]; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Roll-your-own tobacco; Snus without tobacco; Inhalers for use as an alternative to tobacco cigarettes; Cigarettes; Ashtrays for smokers; Cigarette lighters; Smoking tobacco; Smoking sets for electronic cigarettes; Replaceable cartridges for electronic cigarettes; Flavourings for tobacco; Electronic smoking pipes; Humidified cigar boxes; Tobacco tar for use in electronic cigarettes; Pipe stands [smokers requisites];Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Smoking pipe cleaners; Filters for tobacco products; Tobacco pipe cleaners; Electric cigarettes [electronic cigarettes]; Mouthpieces for cigarette holders; Cigarette holders (Mouthpieces for -); Pouches for tobacco; Tobacco pouches; Pouches (Tobacco -);Tea for smoking as a tobacco substitute; Electronic cigarette cleaners; Tobacco products; Devices for heating tobacco for the purpose of inhalation; Cigar clippers; Humidors for cigars of precious metal; Mentholated pipes.

2. On 30 August 2024, British American Tobacco (Brands) Limited (“the Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all goods in the application. The Opponent relies upon the following mark:[1]

SWITCH ORIGINAL

[1] At the time of filing the form TM7, the Opponent also relied upon the earlier right UK00911353109, however reliance of this earlier right was withdrawn by the Opponent on 06 January 2025. This change was communicated to the Applicant in the official letter of 07 January 2025.

UK Registration no. UK00004013772
Filing date: 13 February 2024
Date of registration: 10 May 2024
Relying upon the following goods:

Class 34: Cigarettes; tobacco, raw or manufactured; roll your own tobacco; pipe tobacco; tobacco products; tobacco substitutes (not for medical purposes); cigars; cigarillos; cigarette lighters for smokers; cigar lighters for smokers; matches; smokers' articles; cigarette paper; cigarette tubes; cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; liquids for electronic cigarettes; tobacco products for the purpose of being heated; electronic devices and their parts for the purpose of heating tobacco.

3. By virtue of its earlier filing date, the above mark constitutes an earlier mark in accordance with section 6 of the Act. The Applicant requested the Opponent provide proof of use, however, as the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions contained in section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use of the mark.

4. The Opponent submits that the marks are highly similar and that the goods are identical or similar.

5. The Applicant filed a counterstatement within which it denied the claims made.

6. Neither party filed evidence during proceedings. Neither party requested a hearing, however, the Opponent filed submissions in lieu. This decision is taken following careful consideration of the papers.

7. The Applicant is represented by Yogesh Bali; the Opponent is represented by Baker & McKenzie LLP.

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

DECISION

Section 5(2)

9. The opposition is based upon Sections 5(2)(b) of the Act, which read 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".

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa; Page 8 of 20

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

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

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

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

Comparison of goods

11. The goods for comparison are as follows:

Opponent's goods	Applicant's goods
Class 34: Cigarettes; tobacco, raw or manufactured; roll your own tobacco; pipe tobacco; tobacco products; tobacco substitutes (not for medical purposes); cigars; cigarillos; cigarette lighters for smokers; cigar lighters for smokers; matches; smokers' articles; cigarette paper; cigarette tubes; cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; liquids for electronic cigarettes; tobacco products for the purpose of being heated; electronic devices and their parts for the purpose of heating tobacco.	Class 34: Oral vaporizers for smokers; Smokeless cigarette vaporizer pipes; Vaporizers for smoking purposes; Electronic cigarette cartomizers; Electronic cigarette atomizers; Cigar humidifiers; Humidifiers for cigars; Hookah tobacco; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; 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; Humidifiers for tobacco; Hookahs; Cigarettes, cigars, cigarillos and other ready-for-use smoking articles; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Shisha tobacco; Menthol

	cigarettes; Menthol pipe tobacco; Tobacco containers and humidors; Mouthpieces for cigarettes; Electronic hookahs; Pipes for smoking mentholated tobacco substitutes; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Electronic shisha pipes; Humidors; Lighters for smokers; Smokers (Lighters for -); Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Electronic nicotine inhalation devices; Flavored tobacco; Snus with tobacco; Cigar lighters; Cigar tubes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Firestones for lighters for smokers; Refill cartridges for electronic cigarettes; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; Shisha pipes; Liquids for electronic cigarettes; Devices for extinguishing heated cigarettes and cigars as well as heated tobacco sticks; Smokeless tobacco; Cigar pouches; Cigars for use as an alternative to tobacco cigarettes; Cigars; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Portable cigarette ash pouches; Cartridges for electronic cigarettes; Electronic cigars; Liquid for electronic cigarettes; Hemp for

	smoking; Cigarillos; Mentholated tobacco; Electronic devices for the inhalation of nicotine containing aerosol; Snus; Tobacco free oral nicotine pouches [not for medical use]; Cigar filters; Cigarette tubes; Gas containers for cigar lighters; Cigar lighters (Gas containers for -); Herbs for smoking; Cigarette tobacco; Flavorings, other than essential oils, for use in electronic cigarettes; Lighters for smokers [cigarette lighters] [not for automobiles]; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Roll-your-own tobacco; Snus without tobacco; Inhalers for use as an alternative to tobacco cigarettes; Cigarettes; Ashtrays for smokers; Cigarette lighters; Smoking tobacco; Smoking sets for electronic cigarettes; Replaceable cartridges for electronic cigarettes; Flavourings for tobacco; Electronic smoking pipes; Humidified cigar boxes; Tobacco tar for use in electronic cigarettes; Pipe stands [smokers requisites]; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Smoking pipe cleaners; Filters for tobacco products; Tobacco pipe cleaners; Electric cigarettes [electronic cigarettes]; Mouthpieces for cigarette holders; Cigarette holders (Mouthpieces for -);

	Pouches for tobacco; Tobacco pouches; Pouches (Tobacco -); Tea for smoking as a tobacco substitute; Electronic cigarette cleaners; Tobacco products; Devices for heating tobacco for the purpose of inhalation; Cigar clippers; Humidors for cigars of precious metal; Mentholated pipes.

12. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "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".

13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon,* Case C-39/97, the court stated at paragraph 23 that:

> > "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.

14. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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.

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

16. For the purposes of considering the issue of similarity of the goods, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

Cigarettes; Cigarillos; Cigars; Cigarettes, cigars, cigarillos […]; Tobacco products; Liquids for electronic cigarettes; Liquid for electronic cigarettes.

17. The above terms are explicitly named in both the Applicant's and the Opponent's specifications. They are self-evidently identical.

Electric cigarettes [electronic cigarettes].

18. Although expressed slightly differently, the Applicant's above goods are self-evidently identical to the Opponent's "electronic cigarettes".

Cigars for use as an alternative to tobacco cigarettes.

19. The Applicant's above goods are types of cigars, which I consider to be encompassed by the Opponent's wider category "cigars". They are therefore identical on the principle outlined in *Meric.*

Menthol cigarettes.

20. The Applicant's above goods are a type of cigarette, which I consider to be encompassed by the Opponent's wider category "cigarettes". They are therefore identical on the principle outlined in *Meric.*

Hookah tobacco; Shisha tobacco; Menthol pipe tobacco; Flavored tobacco; Snus with tobacco; Smokeless tobacco; Mentholated tobacco; Snus; Cigarette tobacco; Roll-your-own tobacco; Smoking tobacco.

21. The Applicant's above goods are all types of tobacco product, which I consider to be encompassed by the Opponent's wider category "tobacco products". They are therefore identical on the principle outlined in *Meric.*

Tobacco tar for use in electronic cigarettes.

22. It is my understanding that tobacco tar is not routinely used within electronic cigarettes. Electronic cigarettes are generally considered not to be tobacco products, as their core function is the heating of a liquid to produce a vapour which can be inhaled. However, as the Applicant's above term specifically states, 'tobacco tar for use in electronic cigarettes', it is undeniably a tobacco product. On this basis I consider the Applicant's above goods to be encompassed by the Opponent's wider category "tobacco products". They are therefore identical on the principle outlined in Meric.

Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; 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; Liquid nicotine solutions for use in electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Flavorings, other than essential oils, for use in electronic cigarettes.

23. The Applicant's above goods are all liquids for use in electronic cigarettes, which I consider to be encompassed by the Opponent's wider category "liquids for electronic cigarettes". They are therefore identical on the principle outlined in *Meric.*

Mouthpieces for cigarettes; Lighters for smokers; Smokers (Lighters for -); Cigar lighters; Cigar tubes; Cigar pouches; Portable cigarette ash pouches; Cigar filters; Cigarette tubes; Lighters for smokers [cigarette lighters] [not for automobiles]; Ashtrays for smokers; Cigarette lighters; Pipe stands [smokers requisites]; Smoking pipe cleaners; Filters for tobacco products; Tobacco pipe cleaners; Mouthpieces for cigarette holders; Cigarette holders (Mouthpieces for -); Pouches for tobacco; Tobacco pouches; Pouches (Tobacco -); Cigar clippers; Devices for extinguishing heated cigarettes, cigars and heated tobacco sticks; […] other ready-for-use smoking articles; Mentholated pipes; Gas containers for cigar lighters; Cigar lighters (Gas containers for -); Firestones for lighters for smokers.

24. I consider the Opponent's "smokers' articles" is a broad category of goods, which encompasses a range of smoking products and accessories, such as pipes, cigarette holders, lighters and ashtrays. In view of this, I consider the Applicant's above goods all fall within the Opponent's wider category of "smokers' articles". They are therefore identical on the principle outlined in *Meric.*

Tea for smoking as a tobacco substitute; Hemp for smoking; Herbs for smoking.

25. The Applicant's above goods are types of tobacco substitutes, which I consider to be encompassed by the Opponent's wider category "tobacco substitutes (not for medical purposes)". They are therefore identical on the principle outlined in *Meric.*

Tobacco free oral nicotine pouches [not for medical use]; Snus without tobacco.

26. The Applicant's above goods are types of tobacco substitutes for people who wish to consume nicotine without tobacco. I consider the goods to be encompassed by the Opponent's wider category "tobacco substitutes (not for medical purposes)". They are therefore identical on the principle outlined in *Meric.*

Electronic devices for the inhalation of nicotine containing aerosol; Inhalers for use as an alternative to tobacco cigarettes; Devices for heating tobacco for the purpose of inhalation; Electronic nicotine inhalation devices; Vaporizers for smoking purposes; Oral vaporizers for smokers; Smokeless cigarette vaporizer pipes; Electronic cigars; Electronic smoking pipes; Electronic shisha pipes; Smoking sets for electronic cigarettes.

27. I understand 'vapourizers' in the Applicant's specification to be devices which convert liquids (which may or may not contain nicotine) into a vapour which be inhaled. I consider that electronic shisha pipes, electronic smoking pipes and electronic cigars are all be types of vapouriser, I say this because as they work on the same principle, of heating a liquid (which may or may not contain nicotine) into a vapour which can be inhaled. I understand the Opponent's "electronic cigarettes" to be battery-powered devices that heat a liquid (which may or may not contain nicotine) to create an inhalable aerosol or vapor. In view of this, I consider that the

Applicant's above goods to be encompassed by the Opponent's wider category of "electronic cigarettes". They are therefore identical on the principle outlined in *Meric.*

Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor.

28. I understand personal vaporisers to be a type of electronic cigarette, due to them being a battery-powered device that heats a liquid to create an inhalable vapor. I therefore find "personal vaporisers and electronic cigarettes" to be identical on the principle outlined in *Meric* to the Opponent's "electronic cigarettes". I find the "flavourings and solutions therefor" part of the term to be identical on the principle outlined in *Meric* to the Opponent's wider category "liquids for electronic cigarettes".

Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Cartridges sold filled with chemical flavourings in liquid form for electronic cigarettes; Refill cartridges for electronic cigarettes; Cartridges for electronic cigarettes; Replaceable cartridges for electronic cigarettes.

29. The Applicant's above goods are component parts of an electronic cigarette, being a cartridge filled with liquid, which I consider to be a step removed from the Opponent's "liquids for electronic cigarettes", which is the liquid itself. The goods differ in nature, as the Opponent's are in liquid form which would need to be manually poured/added to an electronic cigarette, while the Applicant's are cartridges, likely made of metal, containing a liquid, which will be added to an electronic cigarette as a whole component part. The goods overlap in user, being members of the general public who use electronic cigarettes, and I consider that the respective goods will be sold within the same type of retail premises (or online equivalent) such as a vape store. The respective goods are complementary, as the Opponent's "liquids for electronic cigarettes" are indispensable to the Applicant's above goods and the average consumer is likely to believe that an undertaking responsible for liquids for electronic cigarettes would also provide those liquids in pre-filled cartridge form. I consider that the goods would also be in competition, as they overlap in purpose, and a consumer may choose to buy a pre-filled cartridge

rather than a liquid to refill an electronic cigarette manually. Overall, I find the goods to be similar to a high degree.

Electronic cigarette cartomizers; Electronic cigarette atomizers.

30. The Applicant's above goods are component parts of an electronic cigarette. There is an overlap in intended purpose with Opponent's "electronic cigarettes" as they are used to enable consumers to inhale various vapours. However, they differ in nature and method of use as the Applicant's goods are parts of the e-cigarettes and fulfil specific functions based on its particular part or fitting. The goods overlap in user, being members of the general public who use electronic cigarettes. I consider that the respective goods will be produced by the same manufacturers and sold within the same type of retail premises (or online equivalent) such as a vape store. There is a degree of competition as a consumer may choose to buy component parts to modify or repair an electronic cigarette as required, rather than buying a new pre-assembled, ready to use product. The goods share a complementary relationship in that the Applicant's goods are component parts which are essential for electronic cigarettes to function, and the average consumer is likely to believe that the undertaking responsible for one good is also responsible for the other. Overall, I find the goods to be similar to a medium to high degree.

Flavourings for tobacco.

31. I understand the Applicant's above goods are substances used to add flavour to tobacco. There will be an overlap in user of these goods and the Opponent's 'tobacco', being members of the general public who are smokers. There is an overlap in trade channels whereby both parties' goods would be obtainable from tobacconists. I understand that tobacco flavourings would be added to tobacco, and that both goods would be inhaled in the same way, at the same time, through devices such as pipes or rolled cigarettes. The goods themselves will differ in nature, as the flavourings may be either natural or artificial and would likely come in the form of liquids or powders, while tobacco is a natural product often in loose leaf form, which has been shredded/cut and dried. The Opponent's goods are essential for the use of the Applicant's goods but I do not consider that the average

consumer would assume that they come from the same undertaking. I do not consider that the goods are complementary, nor are they in competition. Overall, I find that there is a low to medium degree of similarity between the goods.

Cigar humidifiers; Humidifiers for cigars; Humidifiers for tobacco; Tobacco containers and humidors; Humidors; Humidified cigar boxes; Humidors for cigars of precious metal.

32. As set out in paragraph 24, I consider "smokers' articles" is a broad category of goods, which encompasses a range of smoking accessories; I consider that this may include, containers for cigars or tobacco. In view of this, I consider the Applicant's above goods all fall within the Opponent's wider category of "smokers' articles". They are therefore identical on the principle outlined in *Meric.* However, if I am wrong in this finding I still consider there to be an overlap in user. I say this because the respective goods will all be used by smokers in conjunction with or alongside tobacco products but are not the tobacco product itself. In the absence of any submissions from the parties, I consider the Applicant's above goods to be containers used to preventing cigars and tobacco from drying out, which is important to the flavour and longevity of the products. This purpose will be shared with certain goods under the broad category of 'smokers' articles', including, for example, tobacco pouches, however, I do not believe the goods will be in competition. The exact nature of the goods will vary; however, it is likely that the average consumer would expect the goods at issue to come from the same undertakings. While the respective goods may be sold in high street shops (or their online equivalents) such as tobacconists, higher value goods, such as 'humidors for cigars of precious metal' will likely only be available from specialist retailers for gift or collectibles. Although the goods may be used alongside each other, I do not consider them to be complementary in the way set out in caselaw. Overall, I consider the goods to be similar to a medium degree.

Electronic cigarette cleaners.

33. The Applicant's above term overlaps in user with the Opponent's "electronic cigarettes", as members of the general public who use electronic cigarettes may

also purchase the cleaners to maintain them. However, the goods differ in nature, method of use and intended purpose as the electronic cigarette cleaners are products that are used for cleaning, whereas the Opponent's goods are used to inhale vapor. There is an overlap in trade channels, as stores that sell the electronic cigarettes are likely to also sell cleaning equipment specifically for those devices. However, the cleaners are not important or indispensable to the use of electronic cigarettes, as other products could be used to clean them, and cleaning is not essential to their function. The goods are not in competition as electronic cigarette cleaners cannot perform the role of electronic cigarettes themselves. Consequently, I find that the goods are similar to a low degree.

Comparison of the marks

34. The respective trade marks pleaded under 5(2)(b) are shown below:

Earlier trade mark	Applicant's trade mark
SWITCH ORIGINAL	**GW-SWITCH**

35. The Opponent's mark consists of two words 'SWITCH' and 'ORIGINAL' with no stylisation or embellishment. The Opponent submits that the word "ORIGINAL" is a non-distinctive and laudatory term.[2] I consider that the word 'ORIGINAL' is laudatory and will be seen to indicate that the products offered by the Applicant are original products, in the sense of being early or first versions of something, however, I do not consider it to be non-distinctive. Overall, I consider the word 'SWITCH' plays a greater role in the overall impression of the mark, with the word 'ORIGINAL' playing a lesser role.

36. The Applicant's mark consists of the elements 'GW' and 'SWITCH', joined by a hyphen. I consider that the overall impression of the mark lies in the combination of these elements.

[2] Opponent's submissions in lieu, paragraph 7.

37. Visually the marks coincide in their use of the six-letter word ‘SWITCH’. A point of visual difference is that this element appears in different positions within the mark. This results in the marks having different beginnings, a position which is generally considered to have more impact, although this is not always the case.[3] The Applicant’s mark contains the letters ‘GW’ and a hyphen at its beginning which is not replicated in the Opponent’s mark. The Opponent’s mark also contains the word ‘ORIGINAL’, which is not replicated in the Applicant’s mark. While I the word "ORIGINAL" is commonly used in marketing to refer to something being the initial product in a range of products, I do not consider that such use renders this element visually negligible. Overall, I consider the marks to be similar to a medium degree.

38. Both marks consist of five syllables, with the Opponent’s mark being pronounced in the ordinary way with the Applicant’s being pronounced as the letters ‘G-W’ followed by the word ‘SWITCH’. The marks coincide insofar as they contain the identical pronunciation of ‘switch’. The marks differ in all other syllables present within the marks. While the word “ORIGINAL” may be less distinctive for the reasons set out in paragraph 35, this does not render it negligible or aurally invisible.[4] I consider that the marks will be aurally similar to a medium degree.

39. Conceptually, the marks coincide in their use of the word ‘SWITCH’, which can be defined as either a noun, being a small control for an electrical device which you use to turn the device on or off, or a verb, meaning to change to something different, for example to a different system, task, or subject of conversation.[5] The Applicant submits that the ‘GW’ element of their mark is the initials of their brand ‘GoldWhip’, however, I do not consider that the average consumer will immediately make this link, but instead will see the ‘GW’ element purely as initials with no obvious meaning. While the word ‘ORIGINAL’ is laudatory in that it will likely convey to the average consumer that the goods offered under the mark are early or first versions of the goods, it is not negligible. While I have found it plays a lesser

[3] *El Corte Inglés, SA v OHIM,* Cases T-183/02 and T-184/02
[4] *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22
[5] Collins Dictionary (https://www.collinsdictionary.com/dictionary/english/switch#google_vignette accessed 24 November 2025

role in the overall impression of the Applicant's mark it still acts as a point of conceptual difference. Overall, I consider the marks to be conceptually similar to a medium degree.

Average consumer and the purchasing act

40. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

41. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* In *Hearst Holdings Inc, Fleischer Studios Inc v A. V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "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."

42. I find that the average consumer of the respective goods are members of the general public who vape or smoke. In view of legislation around the sale of tobacco and smoking products, the average consumer will be over the age of 18. The cost of the goods will vary, from ashtrays for smokers, which are likely to be relatively inexpensive, to electronic cigarettes or humidors, which although more expensive are unlikely to be at the highest end of the spectrum. On average, consumers are

likely to purchase these goods on a regular basis to sustain their smoking or vaping. However, some goods (such as humidors for cigars of precious metal) will be purchased infrequently. During the purchasing process, consumers will consider factors such as safety of the product, technical features, nicotine content and flavour (where applicable). I consider that overall consumers will demonstrate a medium level of attention in respect of the goods. Many of the goods are likely to be kept behind a counter due to age restrictions and legislation on visual branding around the sale of cigarette and tobacco products. In these circumstances, consumers will request the goods aurally from a retail assistant after viewing the products on a price list, or behind the counter. However, some goods, such as ashtrays and lighters, may be self-selected from shelves of retailers. The goods will also be sold online, where the goods will be selected by consumers after viewing information on a website. Overall, the purchasing process would be primarily visual in nature, though I do not discount that aural considerations will play their part.

Distinctive character of the earlier trade mark

43. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

44. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

45. The Opponent has not filed any evidence to support that the earlier mark's distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

46. The words 'SWITCH' and 'ORIGINAL' are ordinary dictionary words. The word 'ORIGINAL' would be seen to have a laudatory meaning, alluding to the goods offered under the mark being early or first versions, however, it is not descriptive nor allusive of the goods at issue. In the absence of submissions from the parties, I consider that the word 'SWITCH' does not have any meaning in relation to the goods at issue. Consequently, I consider the Opponent's mark to be inherently distinctive to a medium degree.

Likelihood of confusion

47. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the

more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*).

48. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

49. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be between identical and similar to a low degree.

50. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. Despite the shared 'SWITCH' element, I consider the differences in marks will not go unnoticed by the average consumer. The Applicant's mark starts with the initials "GW", creating a visual and aural point of difference between the parties' marks. I consider these initials will not go unnoticed

by the average consumer, especially in view of their location at the beginning of the mark. In addition, while the laudatory nature of the word 'ORIGINAL' means it plays a lesser role in the overall impression of the mark, it does not make this element of the Opponent's mark negligible. Even where the goods are identical, and a medium degree of attention is being paid by the average consumer, I consider that the additional elements in the Applicant's and Opponent's marks (being the letters 'GW' the word 'ORIGINAL' respectively) will be used to distinguish such marks from each other. Consequently, I do not consider that there exists a likelihood of direct confusion.

51. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

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

distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

(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)."

52. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[6]

53. Furthermore, in *Liverpool Gin*,[7] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. While I note the examples set out by Mr Purvis are not exhaustive, in this case I see no reason why a consumer would believe the marks at issue are from the same or economically linked undertakings. Bearing in mind my findings set out in paragraph 49, while the shared use of "SWITCH" may bring the other mark to mind, I consider this would be mere association, rather than indirect confusion. Mr Iain

[6] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[7] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

Purvis commented that any 'belief' in a connection between the marks is more than "mere idle wondering or speculation that there might be a connection".

55. I do not consider 'SWITCH' to be so strikingly distinctive that the average consumer would assume that no-one other than the brand owner would be using it in a trade mark. This is because the common element is not a made-up word and there is no case of acquired distinctiveness. Rather, it is a fairly common English word that the average consumer would not be surprised to find appearing in trade marks which have no commercial connection with each other. Further, I see no reason why the average consumer would see the use of 'GW' at the beginning of the Applicant's mark to be a logical indicator of a sub-brand or brand extension of the Opponent's mark (or vice versa). Further, I do not consider that the marks would be the result of a re-branding of one another, as, it is not my view that 'Switch Original' would not rebrand itself as 'GW-Switch' or vice versa.

56. In addition, I note that I found that the common element plays a greater role in the earlier mark 'Switch Original' and that the overall impression of the mark as a whole lies in the application 'GW-Switch.' I consider that this is inconsistent with a brand extension, as one would anticipate an element which plays a greater role in the earlier mark to remain dominant and distinctive in any brand extension. Further, the circumstances are not such where the later mark simply adds a non-distinctive elements to the earlier mark, as would be expected in a sub-brand or brand-extension. Consequently, I do not consider that there exists a likelihood of direct confusion. I find this to be the case even where the goods are identical.

CONCLUSION

57. The opposition based upon 5(2)(b) has failed, and the application subject to any appeal, will be registered for all goods.

COSTS

58. The Applicant has been successful and would normally be entitled to a contribution towards their costs based upon the scale published in Tribunal Practice Notice

1/2023. However, as the Applicant is not professionally represented, at the conclusion of the evidence rounds the tribunal wrote to the Applicant and invited them to indicate whether they intended to make a request for an award of costs. The Applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

59. The Applicant did not file a completed Pro Forma and as the Applicant paid no official fees arising from the action, I make no award of costs.

Dated this 19th day of December 2025

Emma Rees
For the Registrar