

**O-476-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3047162  
BY ANYTHING 4 HOME LTD TO REGISTER THE TRADE MARK**

**Breathin'**

**IN CLASS 34**


**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 402253  
BY IBREATHE LIMITED**

## Background and pleadings

1) Anything 4 home Ltd (“the applicant”) applied to register the trade mark no. 3047162 in respect of the mark breathin’ in the UK on 17 March 2014. It was accepted and published in the Trade Marks Journal on 11 April 2014 in respect of the following Class 34 goods:

*Cigarettes containing tobacco substitutes; Cigarettes containing tobacco substitutes, not for medical purposes; electronic cigarettes; electronic cigarettes; Filters (Cigarette -); Filter-tipped cigarettes; Herbs for smoking; Hookahs; Humidors; Mouth pieces for pipes; Mouthpieces for cigarette holders; Pipe cleaners; Pipe holders; Pipe pouches; Pipe stands; Pipe stands [smokers requisites]; Tobacco free cigarettes, other than for medical purposes; Tobacco substitutes not for medical purposes; Wicks for lighters.*

2) iBreathe Limited (“the opponent”) opposes the mark on the basis of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (“the Act”). Both grounds are based upon conflict with its earlier UK mark no. 3008953, the relevant details of which are shown below:

| Mark and relevant dates  | Goods relied upon   |
|--|---|
|  <p>Filing date: 6 June 2013<br/>Publication date: 28 June 2013</p> | <p><i>Cigarettes containing tobacco substitutes; Cigarettes containing tobacco substitutes, not for medical purposes; electronic cigarettes; electronic cigarettes; Filters (Cigarette -); Filter-tipped cigarettes; Herbs for smoking; Hookahs; Humidors; Mouth pieces for pipes; Mouthpieces for cigarette holders; Pipe cleaners; Pipe holders; Pipe pouches; Pipe stands; Pipe stands [smokers requisites]; Tobacco free cigarettes, other than for medical purposes; Tobacco substitutes not for medical purposes; Wicks for lighters.</i></p> |

3) The opponent submits that the respective goods are identical or similar and that the marks are similar and that the application, therefore, offends under Section 5(2)(b) of the Act.

4) The opponent also claims that the application offends under Section 5(3) of the Act because it “has created with great effort a reputation widely spread across the electronic cigarette market” and has “had a major response over the last 15 months from both the end user as well as stockists”. It claims that registration of the applicant’s mark will result in unfair advantage and detriment to the reputation and

distinctive character of its mark. It claims that its mark “has gained a reputable image” and because of “such a similar name” there will “be a great advantage” to the applicant.

5) The applicant filed a counterstatement denying the claims made and submitting that “it is unclear how ‘ibreathe’ can suggest the two trademarks can be associated with each other”.

6) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Neither side filed submissions nor requested a hearing and so this decision is taken following careful consideration of the papers.

### **Opponent’s Evidence**

7) This takes the form of a witness statement by Bilalur Rahman, director of the opponent. At Annex 1, he provides extracts from the Amazon.co.uk online market place to illustrate that the applicant sells the same products as the opponent.

8) Mr Rahman states that the opponent is:

*“one of the fastest growing electronic cigarette companies in UK, with over 4 millions e-liquids and electronic devices sold nationally throughout the UK. This has been featured on MEN News (Manchester Evening News) for its success. It has also been feathered (sic) on various radio channels such as Wythenshaw FM. IBreathe Ltd has got a huge reputation within the UK...”*

9) No corroboratory evidence is provided to support this statement.

### **DECISION**

#### **Section 5(2)(b)**

10) Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

#### **Comparison of goods**

11) The respective lists of goods are identical and it follows that the respective goods covered by these lists are also identical.


## Comparison of marks

12) 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

13) 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.

14) The respective marks are shown below:

| Opponent's mark   | Applicant's mark |
|---|------------------|
|  | Breathin'        |

15) The opponent's mark consists of the letter and word "iBreathe" appearing in the centre of a green circular device. Whilst the device is not negligible, the position within the mark, its size and the fact that it is the component of the mark by which it will be referred, results in the "iBreathe" component being the dominant and distinctive component of the mark, having a greater relative weight than the device component.

16) The applicant's mark consists of a contraction of the ordinary dictionary word "breathing" with the letter "g" being dropped off the end and replaced by an apostrophe. Being the only component of the mark, it follows that it must also be the dominant and distinctive component.

17) There is some visual similarity between the marks because the opponent's mark contains the verb "breathe" whilst the applicant's mark consists of a contraction of the noun "breathing". Consequently, the same letters b-r-e-a-t-h appear in the same order in both marks. In other respects, the marks differ. The opponent's mark also has the letter "i" appearing at the start of the word component and also has a large circular device component. The applicant's mark has the letters "IN" and an apostrophe replacing the letter "G". Taking account of this similarity and the differences, I conclude that the respective marks share a moderate level of visual similarity.

18) Aurally, the opponent's mark consists of the short syllable "i" and the long syllable "breathe". The applicant's mark consists of the two syllables "breathe" and "in". Therefore, both marks consist of two syllables with the second syllable of the opponent's mark being the same as the first syllable in the applicant's mark. The other syllable in each mark is different. Taking these points together, I conclude that the respective marks share a moderate level of aural similarity.

19) I begin considering the conceptual similarity between the marks by firstly noting the following definitions:

**Breathe:** *verb* to take in oxygen from (the surrounding medium, esp air) and give out carbon dioxide<sup>1</sup>

**Breathing:** *noun* 1. the passage of air into and out of the lungs to supply the body with oxygen<sup>2</sup>

20) From these definitions, it can be seen that the word components of the respective marks have the same root, one being a noun and the other the verb that both describe the act of inhaling/exhaling air. The replacement of the letter "g" by an apostrophe in the applicant's mark does not diminish this. Consequently, there is some conceptual similarity between the marks. Conceptual difference also exists because one is a verb and the other is a noun. The meaning of the addition prefix "i" in the opponent's mark is less clear, possibly being perceived as an abstract reference to the Internet or to innovation. In conclusion, the respective marks share a medium level of conceptual similarity.

### **Average consumer and the purchasing act**

21) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

22) 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:

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<sup>1</sup> Collins English Dictionary <http://www.collinsdictionary.com/dictionary/english/breathe>

<sup>2</sup> Collins English Dictionary <http://www.collinsdictionary.com/dictionary/english/breathing>

“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.”

23) With the respective goods being identical, it follows that the respective average consumer for both is also the same. The average consumer of these goods is the subset of the general public that smokes. The cost of such goods is generally not high and, consequently, the level of care and attention paid during the purchasing process is not the highest. However, there is likely to be an element of personal preference involved that means that the level of care and attention is not the lowest.

24) In respect of all the goods except *filter-tipped cigarettes*, the nature of the purchasing act is predominantly visual, with the goods being selected from displays, shelves or vending machines. In respect of *filter-tipped cigarettes*, the term includes cigarettes containing tobacco and the sale of these is controlled by specific regulations that require the goods to be kept from view and the goods must be requested aurally.

### **Distinctive character of the earlier trade mark**

25) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

26) Whilst the opponent claims that the opponent has sold “4 millions e-liquids and electronic devices ... nationally throughout the UK”, there is no corroboratory

evidence that its sales are indeed at this level or that any/all such sales relate only to goods sold under the mark relied upon. Consequently, I am unable to conclude that the distinctive character of its mark has been enhanced through use. Therefore, I only have to consider its inherent level of distinctive character. In this respect, the mark has a visual impact created by the circular device and the letter and word “iBreathe”. It is not obvious what this letter and word combination mean in respect of the goods covered. It is therefore endowed with a normal level of distinctive character, not the lowest or the highest.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

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

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

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

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

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

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

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

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

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

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

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

28) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

29) In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”



30) The respective goods are identical and the average consumer is the general smoking public. I have found that the respective marks share a moderate level of visual and aural similarity and a medium level of conceptual similarity. The majority of the goods covered by the parties' specifications are goods chosen from a shelf, display or vending machine where visual considerations are uppermost in identifying the product. With this being the case, the visual differences between the marks take on greater importance.

31) The addition of the circular device and the differences in the word component of the marks are likely to be sufficient to prevent the average consumer from confusing the two marks (so called direct confusion) or leading them to believe that the goods provided under the respective marks originate from the same or linked undertaking (so called "indirect confusion"). Verb and noun use is one of the fundamental building blocks of the English language and UK consumers are well practiced at differentiating words in the form of verbs from those in the form of nouns, even when those words relate to the same action. Further the letter "i" present at the beginning of the opponent's mark will not go unnoticed and further adds to the visual difference (and aural, insofar as it may play a part). The similarity in meaning of the applicant's mark with the BREATHE component of the opponent's mark may bring the other mark to mind, but the connection created by this similarity is not so strong as to create direct or indirect confusion.

32) In respect of the applicant's *filter-tipped cigarettes*, the visual differences between the marks have less relevance in the purchasing process. However, on balance, even where the purchase is primarily oral in nature, the addition of the "i" component at the start of the opponent's mark and the fact that one mark uses a verb and the other a noun will not go unnoticed and I find that there is no likelihood of confusion.

33) Taking all of the above into account, I find that the opponent's case based upon Section 5(2)(b) of the Act fails in its entirety.

### **Section 5(3)**

34) Section 5(3) of the Act states:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

35) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of

the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

36) The opponent's case falls down at the first hurdle. It must demonstrate that it has the necessary reputation in the UK in that it must show that its mark is known by a significant part of that relevant public. Its evidence falls a long way short of illustrating this. It has not provided any turnover figures or marketing spend, it has not indicated market share. It has not provided any corroboratory evidence such as invoices, a lists of retailers stocking its products and virtually no evidence showing the mark in use. It has merely produced a statement that the opponent is "one of the fastest growing electronic cigarette companies in UK, with over 4 millions e-liquids and electronic devices sold nationally throughout the UK", and that the product has been promoted in one local publication and on one local radio station. Further, it is not clear whether all of the opponent's sales relate only to products sold under the mark relied upon.

37) In the absence of cogent evidence illustrating that the opponent's mark has acquired the necessary reputation in the UK, I dismiss its case based upon Section 5(3) of the Act.

### **Summary**

38) The opposition fails in its entirety.

### **COSTS**

39) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that only the opponent filed evidence, and that this was only light. Further, a hearing was not held and neither side filed written submissions in lieu of a hearing. Also, I take account that the applicant was unrepresented and did not incur legal fees. I award costs as follows:

Considering the opponent's statement and preparing counterstatement £50

**Total: £50**

40) I order iBreathe Limited to pay Anything for home Ltd the sum of £50 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 12th day of October 2015**

**Mark Bryant  
For the Registrar,**