

O/808/21

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3506668
BY PRIME FLAVOURS LTD
TO REGISTER:



AS A TRADE MARK
IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 421479
BY INDEJUICE LIMITED

Background and Pleadings

1. On 1 July 2020 Prime Flavours LTD (“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 July 2020 in respect of the following goods:

Class 34: *Cartridges 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; Cases for electronic cigarettes; Electric cigarettes [electronic cigarettes]; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette cases; Electronic cigarette cleaners; 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 propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigars; Electronic nicotine inhalation devices; Liquid for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Refill cartridges for electronic cigarettes; Flavourings for electronic cigarettes.*

2. On 17 September 2020, IndeJuice Limited (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the application in its entirety. The opponent relies on the following series trade marks:

PRIME

prime

Prime

(Series of 3)

UK registration no. 3364125

Filing date 1 January 2019; registration date 22 March 2019

Relying on all goods, namely:

Class 34: Electronic cigarettes.

("the opponent's registration")

3. The opponent submits that there is a likelihood of confusion because the applicant's mark is similar to the opponent's registration and the respective goods are identical or similar.

4. The applicant filed a defence and counterstatement denying the claims made.

5. The opponent is represented by Squire Patton Boggs (UK) LLP and the applicant is represented by Roger Moore & Associates Limited. Both parties filed evidence and written submissions. No hearing was requested, and no submissions were filed in lieu of a hearing. The decision is taken following a careful perusal of the papers.

Evidence

6. As set out above, both parties filed evidence. The opponent filed evidence in the form of a witness statement of George Muharib dated 1 February 2021. Mr Muharib is the Director at IndeJuice Limited, a position he has held since September 2018. Mr Muharib's statement is accompanied by 19 exhibits.

7. The applicant filed evidence in the form of the witness statements of Lee Bateman dated 26 April 2021 and Roger Gillard Moore dated 3 June 2021. Mr Bateman is the Director at Prime Flavours Limited, a position he has held since June 2016. Mr Bateman's statement is accompanied by 34 exhibits. Mr Moore is a Trade Mark Attorney and Director at Roger Moore & Associates Limited. Mr Moore's statement is accompanied by 3 exhibits.

8. I do not propose to summarise the evidence in full at this stage. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

Preliminary Issue

9. In its counterstatement applicant states:

“12. The allegation in paragraph B that there is a risk of confusion and/or association between the applicants mark and that of the opponent is rejected for the following reasons:

i. The applicants were incorporated on 20 June 2016 as is evidenced by an extract of the Register from Companies House which forms Attachment A.

ii. The mark of the applicant has been used throughout the United Kingdom since November 2016 in relation to the goods sought to be protected. The use after November 2016 has been continuous up to the present day and evidence as to the nature of the use and in support of this statement will be submitted in due course in these proceedings.

iii. The opponents were incorporated on 4 September 2017 as is evidenced by an extract of the Register from Companies House which forms Attachment 8. The date of incorporation is after the date of incorporation of the applicant and after the date when use by the applicant commenced.

iv. The date of application of the opponent's mark was 1 January 2019 which is a date significantly after the date when use by the applicant commenced.

13. By virtue of their use since 2016, the applicants have acquired a protectible reputation since 2016 at Common Law in the mark the subject of application number UK00003506668 and are proprietors of an earlier right within the meaning of those words within the Trade Marks Act, 1994.”

10. For reasons that I will now explain, the applicant's comments regarding its ownership of an earlier unregistered right have no bearing on the outcome of this opposition.

11. The proviso referred to by the applicant relating to ownership of an earlier unregistered right applies where an opposition or application for invalidation under section 5(4)(a) of the Act is raised. That is, where a trade mark shall not be registered (or shall be invalidated) because its use would be contrary to law of passing off, due to the fact that an earlier unregistered right exists. For the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent's mark being applied for/registered, is not a defence in law to the opposition under section 5 of the Act. Tribunal Practice Notice 4/2009 explains this as follows:

"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

12. As set out in the above Tribunal Practice Notice, if the applicant wanted to challenge the validity of the opponent's registration, then the correct course of action would have been to issue proceedings for invalidation. The applicant has not done so.

13. The outcome of this opposition will, therefore, be determined after making a global assessment whilst taking into account all relevant factors and the existence of an earlier unregistered right by the applicant is not relevant to that assessment.

Decision

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

14. Section 5(2)(b) of the Act is as follows:

(2) A trade mark shall not be registered if because –

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

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

15. An earlier trade mark is defined in Section 6 of the Act, the relevant parts state:

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

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

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

16. The opponent's registration qualifies as an earlier mark within the meaning of Section 6(1) of the Act because it has an earlier filing date than the contested application. The applicant put the opponent to proof of use. However, as the opponent's registration completed its registration process less than five years before the application date of the applicant's mark, it is not subject to proof of use provisions. The opponent can, therefore, rely upon all of the goods for which its registration is registered.

17. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

18. 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 impression 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

19. The goods to be compared are as follows:

Applicant's goods	Opponent's goods
<p><u>Class 34</u></p> <p><i>Cartridges 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; Cases for electronic cigarettes; Electric cigarettes [electronic cigarettes]; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette cases; Electronic cigarette cleaners; 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 propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigars; Electronic nicotine inhalation devices; Liquid for electronic cigarettes; Liquid nicotine solutions for electronic</i></p>	<p><u>Class 34</u></p> <p><i>Electronic cigarettes.</i></p>

<i>cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Refill cartridges for electronic cigarettes; Flavourings for electronic cigarettes.</i>	
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20. The applicant acknowledges in the counterstatement that “the allegation [...] that the goods covered by the applicant and those of the opponents are identical or they are similar is accepted”, but the applicant does not accept that the trade channels are shared. As the applicant does not clarify to what degree it considers the goods to be similar or which goods it considers to be identical, I will conduct a full comparison of the goods at issue.

21. 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 of its judgment that:

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

22. Guidance on this issue has also come from Jacob J. (as he was then) 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.”

23. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

24. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

25. “*Electronic cigarettes*” appears in both parties’ specifications and are self-evidently identical.

26. I find that “*electric cigarettes [electronic cigarettes]*”, “*electronic cigarettes for use as an alternative to traditional cigarettes*”, “*electronic nicotine inhalation devices*” and “*electronic cigars*” in the applicant’s specification fall within the broader category of “*electronic cigarettes*” in the opponent’s specification. Therefore, I find these goods to be identical on the principle outlined in *Meric*.

27. “*Cartridges 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*”, “*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 propylene glycol*”, “*electronic cigarette liquid [e-liquid] comprised of vegetable glycerin*”, “*liquid for electronic cigarettes*”, “*liquid nicotine solutions for electronic cigarettes*”, “*liquid nicotine solutions for use in electronic cigarettes*”, “*liquid solutions for use in electronic cigarettes*”, “*liquids for electronic cigarettes*”, “*refill cartridges for electronic cigarettes*”, “*cases for electronic cigarettes*”, “*electronic cigarette atomizers*”, “*electronic cigarette boxes*”, “*electronic cigarette cartomizers*”, “*electronic cigarette cases*”, “*electronic cigarette cleaners*” and “*flavourings for electronic cigarettes*” in the applicant’s specification are all goods used together or in combination with “*electronic cigarettes*” in the opponent’s specification. While the goods differ in nature and method of use, they do share trade channels as the goods will be found at the same type of retail premises (or online equivalent) i.e. a vape store or within the same section of a supermarket. The goods also share end-users, manufacturers, and distribution channels. I also find that they share a complementary relationship in that they are important and/or indispensable to one another and the average consumer is likely to believe that the undertaking responsible for one goods is also responsible for the other.¹ Therefore, I find the goods to be similar to a medium degree.

¹ *Boston Scientific Ltd v OHIM*, (Case T-325/06)

The average consumer and the purchasing process

28. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29. Both parties submit that the average consumer for the goods at issue will be a member of the public. I agree with these submissions but given that the goods at issue are subject to an age limit, the average consumer will be limited to members of the general public over the age of 18. Both parties have also provided me with submissions as to how their goods are sold. While these submissions are noted, my assessment of the purchasing process is a notional one and I must take into account all of the ways in which the goods will be sold, not the particular method of sale the parties adopt.

30. The goods at issue will generally be sold through a range of retail shops and their online equivalents. In shops, the goods will normally be stored behind a counter and to purchase the goods, the average consumer is likely to request them from a shop assistant. For these purchases, the aural component will, of course play a role. However, once the request has been made, the average consumer will still have sight of the packaging at the point of purchase, and so visual considerations cannot be discounted. I also recognise that the goods can, in some outlets, be purchased by self-selection and that visual considerations will play a greater role in this selection

process. A similar process will apply to online retailers, where the consumer will select the goods having viewed an image displayed on a webpage. For the most part, I consider the purchasing process will be primarily visual with the aural component playing a part. However, in some instances, I consider the purchasing process will be both visual and aural.

31. The applicant submits that the goods at issue range from low value consumables to higher value vaping devices that can retail in excess of £150. The opponent submits that the goods are not especially expensive and that they will be purchased relatively frequently. In my view, the goods are, for the most part, inexpensive but I do appreciate the applicant's submissions that some devices will be relatively expensive. As for the frequency of the purchase, this will also vary between frequent and infrequent purchases.

32. In respect of the level of attention paid, the applicant submits that the average consumer will consider the suitability, price and business reviews for products and that they will pay "an appropriate degree of attention". On the other hand, the opponent submits that the average consumer will pay a low to medium degree of attention when making their selection. I accept that the average consumer will consider the factors listed by the applicant as well as various factors such as nicotine content and flavour. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods at issue.

Comparison of the marks

33. The respective trade marks are shown below:

<p>PRIME</p> <p>prime</p> <p>Prime</p>	
<p>The opponent's registration</p>	<p>The applicant's mark</p>

34. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU 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.”

35. 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.

Overall impression

36. The opponent's registration consists of a series of three word-only marks of the word PRIME. The first mark of the series presents the word in upper case, the second

mark in lower case and the third mark in title case. There are no other elements that contribute to the overall impression of the mark.

37. The applicant's mark is a composite mark that is made up of the words "Prime" and "Vapes" which appears stylised and in red, white and black. In my view, these words will be viewed as a unit by the average consumer and, therefore, read as "Prime Vapes". Below the word element are five star devices. The applicant submits that the most prominent feature of its mark is the word "Vapes". I disagree with this. While I note that "Vapes" is presented slightly larger than the remaining elements, I am of the view that it has little trade mark significance, the reasons for which I will come to discuss below when considering the conceptual comparison between the marks. As a result, I consider the word "Prime" to be the word that has a greater impact on the overall impression of the mark with the word "Vapes", the device element, the stylisation and colours used all playing lesser roles.

Visual comparison

38. Visually, the marks share the word 'PRIME'. This is the only element in the opponent's registration and I have found that it also plays a greater role in the applicant's mark. All other elements in the applicant's mark are not present in the opponent's registration. While the word "Vapes", the device element, stylisation and use of colour in the applicant's mark play lesser roles, they still constitute visual differences. Having said that, I note that the opponent's registration is made up of word only marks which can be used in any standard typeface and any colour. Taking all of this into account, I am of the view that the marks are visually similar to between a medium and high degree.

Aural comparison

39. The applicant's submissions in regard to the aural comparison of the marks is contradictory. On one hand, the applicant submits that the marks are "somewhat similar aurally" and "may contain the word 'PRIME'" but, on the other hand, the applicant submits that the "marks are not considered aurally similar" overall. The

opponent's registration consists of one word and will be pronounced as such. As for the applicant's mark, this will be pronounced as "Prime Vapes". The word "Prime" at the beginning of both marks will have the same pronunciation. However, the additional element of "Vapes" creates a point of aural difference. I do not consider that the device element in the applicant's mark will be pronounced. Taking all of this into account and given that the average consumer tends to focus on the beginnings of marks,² being where the identity between these marks lies, I consider the marks to be aurally similar to a high degree.

Conceptual comparison

40. Both parties submit that the word "Prime" has multiple meanings; the word can be construed as "main or most important", "of best quality" or "to prepare someone or something for a particular situation". When considering the word "Prime", I am of the view that the average consumer will attribute the same meaning to the word, regardless of which mark they are confronted with. Whilst, I note the presence of "Vapes" in the applicant's mark, which differs from the opponent's registration, the word "Vapes" is descriptive of the goods for which it is used in that they are 'vaping' related goods. Similarly, the five star devices in the applicant's mark, are symbolic of the classic five star rating, which is descriptive of the quality of the goods. In my view, despite the descriptive nature of the differences, they are still very slight points of conceptual difference. Therefore, I find the marks to have a high degree of conceptual similarity.

Distinctive character of the opponent's registration

41. 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

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

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 1-2779, 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).”

42. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

43. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use and has not filed evidence to support such a claim. I have, therefore, only the inherent position of the earlier mark to consider.

44. The applicant’s registration consists of the word “Prime”, which both parties submit is a recognised English word which has no direct meaning in relation to the goods covered in Class 34. The applicant admits that the opponent’s mark is “distinctive/non-descriptive”. While I accept that the word ‘Prime’ is not descriptive, it is not, from a trade mark perspective, particularly remarkable. Therefore, I find the opponent’s registration enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

46. I have found the marks to be visually similar to a medium to high degree and aurally and conceptually similar to a high degree. I have identified the average consumer as the general public who will purchase the goods by both aural and visual means. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the earlier mark to be inherently distinctive to a medium degree. I have found the goods to vary from identical to similar to a medium degree.

47. Taking the above factors into account, I consider that the differences between the marks are insufficient to avoid confusion, particularly when the principle of imperfect recollection is considered. In my view, it is plausible that the average consumer will overlook the word "Vapes" and the device element in the applicant's mark, especially given the descriptive nature of those elements. I consider it likely that the marks will be misremembered or mistakenly recalled as each other. Consequently, I consider there to be a likelihood of direct confusion, even on those goods that I have found similar to a medium degree. In the event that I am wrong in my finding of direct confusion, I will proceed to consider indirect confusion.

48. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.

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).”

49. Even if the differences are taken into account, I consider the presence in the applicant's mark of the identical "Prime" element will lead the average consumer to think that the marks came from the same or related undertaking. I make this finding on the basis that "Prime" plays a greater role in both parties' marks. Further, I am of the view that the word "Vapes" in the applicant's mark, will be put down to a form of brand variation or alternative mark, particularly given its descriptive nature in relation to the goods at issue. Finally, in the event that the differences in stylisation and presentation of the marks (such as the typeface, colour and device element used) are noticed, I am of the view that they will be seen as indicative of an alternative mark being used by the same or economically linked undertakings and consistent with a re-branding. Consequently, I find that there is a likelihood of indirect confusion, even on those goods that I have found to be similar to a medium degree.

Conclusion

50. The opposition succeeds in full. As a result, the application is refused in its entirety.

Costs

51. The opponent has been successful as it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the opponent the sum of £900 as a contribution towards its costs. The sum is calculated as follows:

Preparing as statement and considering the opponent's statement	£300
Preparing evidence and considering/commenting on the other side's evidence	£500
Official fee	£100
Total	£900

52. I therefore order Prime Flavours LTD to pay IndeJuice Limited the sum of £900. 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 2nd day of November 2021

A Klass

For the Registrar,

the Comptroller - General