

O-106-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3010144  
BY  
SYED NASEER  
TO REGISTER A SERIES OF TWO TRADE MARKS  
IN CLASS 34**

**e-Vap**

**eVap**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 60000005  
BY  
AHMED EL-ZALABANY**

## BACKGROUND

1. On 14 June 2013, Syed Naseer (the applicant) applied to register the above trade marks in class 34 of the Nice Classification system.<sup>1</sup> The specification stands as follows:

Class 34  
Electronic Cigarettes or Vapour Cigarettes.

2. Following publication of the application, on 5 July 2013, Ahmed El-Zalabany (the opponent) filed notice of opposition against the application under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the UK mark 3007304, shown below:

Mark details and relevant dates	Goods relied on
<p><b>Mark:</b></p>  <p><b>Filing date:</b> 24 May 2013</p> <p><b>Date of entry in the Register:</b> 30 August 2013</p>	<p><b>Class 34</b></p> <p>Smokers' articles, electronic smokers' articles.</p>

4. On 21 November 2013, the applicant filed a counter statement. Attached to the counter statement were a number of additional documents in the nature of evidence. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions.

6. Tribunal Practice Notice 2/2013 states:

“6. The Registrar can usually make an assessment of the likelihood of confusion between the opposed mark and the earlier mark(s) relied on by the opponent, without further evidence. Therefore applicants should not expect to have the automatic right to file evidence in a fast track opposition.

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

7. Where either party considers it necessary to file (further) evidence, a request for leave to file such evidence should be submitted as soon as possible and, at the latest, within 14 days of the serving of the Form TM8 (counterstatement). Each such application will be considered on its merits.”

7. On 27 November 2013 a formal request was made by the applicant to seek leave to file evidence. The request was allowed and the evidence the applicant had initially filed with its counterstatement was duly admitted on 14 January 2014.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

9. A hearing was neither requested nor considered necessary. The opponent filed written submissions, which I will refer to as necessary, below.

10. I give this decision following a review of all of the material before me.

## **EVIDENCE**

11. The applicant’s evidence consists of a witness statement by Peter Mansfield, a Chartered Patent Attorney and a Registered Trade Mark Attorney at Collier IP. His statement is dated 20 November 2013 and is accompanied by 2 exhibits.

12. The applicant was given leave to file evidence to show that the use of a prefix E is common in trade marks which relate to electronic cigarettes. It also sought to show the verb “to vape” and the derived terms “vaping” and “vaped” are widely used to describe the functioning of electronic cigarettes.

13. To that end, exhibit 1 consists of prints showing eight marks on the UK register which are registered in class 34 for electronic cigarettes. Five of these begin with “e-“, while three begin with “e-“ followed by a word. There are also included prints of six marks registered at OHIM. Five of these begin with “e-“, while the remaining one has “e-“ followed by a word.

14. Exhibit 2 comprises five articles about electronic cigarettes found during an internet search, a print following a Google® search and a print from the opponent’s website.

Article 1. “BMA calls for stronger regulation of e-cigarettes, A briefing from the Board of Science and the Occupational Medicine Committee.” March 2012. The terms ‘vape with style’ and ‘passive vaping’ have been highlighted. It is not clear where this article was taken from.

Article 2. “French study shows significant health improvements for smokers using electronic cigarettes.” The article is taken from the Electronic Cigarette Industry Trade Association blog and is dated 9 January 2013. There are six references to ‘vape’ or ‘vaping’ throughout the article, in the context of using electronic cigarettes.

Article 3. “Vape ‘em if you got ‘em.” Taken from The Economist®, the article is dated 23 March 2013. The first paragraph of the article states:

“But these are uncertain times for Big Tobacco. Electronic cigarettes, once dismissed as a novelty, now pose a serious threat. E-cigarettes work by turning nicotine-infused liquid into vapour, which is then inhaled. A user is therefore said to be “vaping”, not smoking.”

Article 4. “E-cigarettes may damage lungs.” Taken from NHS choices website and dated 3 September 2012. The first line of the article states:

“Vaping’ e-cigarettes: could it damage the lungs?”

The third paragraph of the same article reads:

“The news is based on a press release of preliminary findings of a small study investigating the short-term effects of smoking an e-cigarette, commonly known as ‘vaping’.”

Article 5. “E-cigarettes to be regulated as medicines.” Taken from NHS choices website and dated 12 June 2013. On page two of the article is the heading, “DIY vaping”, under which is the following text:

“Some vapers build their own cigarettes – known as ‘rebuildables’ or ‘personal vapourisers’ (PVs). These can be from components ordered online and many vapers even make their own cigarette fluid (‘juice’). The same safety issues apply to this form of vaping, but it generally works out cheaper...”

Article 6. “Why do my gums bleed now I’ve switched to vaping?”, taken from Totally Wicked-ELiquid Blog and dated 14 June 2012. There are six references to ‘vape’ or ‘vaping’ in relation to using electronic cigarettes, one within the article and five in the following blog comments.

A print from a Google® search screen shows the term ‘vaping uk 2011’ in the search field. The exhibit is a screen shot which only identifies five ‘hits’, though the total returned hits are stated at the top of the page to be ‘About 462,000 results’. The page is not dated. The first four hits are all from [www.ecigarettedirect.co.uk](http://www.ecigarettedirect.co.uk) and are titled:

Ten top celebrities who vape...8 July 2011

Vaping, Nicotine and Pleasure – 24 October 2011

Vapefest 2011 & the dangers of excessive vaping – 20 July 2011

Sign the petition to protect vaping – 5 October 2011

The fifth page returned is from [ukvapefest.com](http://ukvapefest.com) and is titled:

UK Vapefest. The only date shown is the year 2013.

The final section of exhibit 2 is a screen shot of the home page of the opponent’s website. The earlier mark relied on is shown at the top of the page.

To the left of the page is shown a menu of product types and to the right there are five products highlighted with photographs and descriptions. The page is not dated. In his witness statement Mr Mansfield says: "The section entitled Newsletter refers to "vaping tips"."

15. This concludes my summary of the evidence.

## **DECISION**

16. The opposition is brought under section 5(2)(b) of the Act which reads as follows:

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

(a)...

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

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

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

(a) a registered trade mark, international trade mark (UK) 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."

18. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been protected for five years.<sup>2</sup>

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

19. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

## The CJEU cases

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

## The principles

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and the nature of the purchasing act**

20. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

21. In its submissions the opponent states:

*“12. This average consumer is likely to be the smoking proportion of the general public and the fact that electronic smokers’ articles are not expensive items means that the consumers level of attention when purchasing these goods will not be of the highest order. Overall, the level of attention of the average consumer will be average. Unless a vending machine is being used, the goods have to be requested aurally because they are sold behind the counter. The goods could be displayed on shelves but usually out of reach of the consumer due to the nature of the product and subsequently the purchasing act in a retail out[let] is usually performed by the aural reference to the products.*

22. The average consumer for these goods will be a member of the general public.<sup>3</sup> The nature of the purchase is likely to be both visual and aural. In my experience electronic cigarettes are usually sold from locked cabinets or shelves behind a counter and are not accessible to the consumer without assistance. However, in contrast with tobacco cigarettes, electronic cigarettes may be promoted through advertising, therefore, the potential for visual confusion still exists. Other smokers’ articles such as, inter alia, lighters, ashtrays and cases will be bought, for the most part, visually, the average consumer encountering the goods and trade marks on a shelf, the internet or in a catalogue. I note that the opponent refers to sale by vending machine, but, I have nothing in evidence to indicate that any of the parties’ goods would be offered in that manner. Given the nature of these products which are sold in a range of styles, strengths and flavours, the level of attention paid will be at least normal.

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<sup>3</sup> Tobacco products cannot be sold in England and Wales to anyone under the age of 18, see *The Children and Young Persons (Sale of Tobacco) Order 2007, Article 2* which amended s.7 of the *Children and Young Persons Act 1933*. In Scotland and Northern Ireland the minimum age at which tobacco can be purchased is also 18. Electronic cigarettes are currently unregulated so they may be purchased by a person of any age.

## Comparison of goods

23. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
Smokers' articles, electronic smokers' articles.	Electronic Cigarettes or Vapour Cigarettes.

24. The opponent states:

*"14. In this case the goods are identical and subsequently this is likely to offset the minimal differences that exist between the trade marks."*


25. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

*"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."*

26. The terms 'electronic cigarettes' and 'vapour cigarettes' were added to the NICE classification guide on 1 January 2014. Prior to this date such products would have been classified as electronic smokers' articles. The opponent's specification for electronic smokers' articles is a broad term which includes electronic and vapour cigarettes. Accordingly, these are identical goods.

## Comparison of marks

27. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
	e-Vap eVap

28. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>4</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

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<sup>4</sup> *Sabel v Puma AG*, para.23



29. The applicant's mark is a series of two marks, the first of which consists of a lower case 'e' followed by a hyphen and the three letters 'Vap, i.e. with the letter V capitalised. The second is the same but for the hyphen which is omitted. Neither are stylised in any way and are presented in plain black type. In both cases the distinctiveness rests in the mark as a whole.

30. The opponent's mark consists of the letter 'E' followed by the word 'Vape'. The first two letters are presented as capital letters, in a grey colour, while the remaining three letters, 'ape', are shown in lower case and in black. The mark is presented in a script font in which the capital letters E and V feature curled terminals. To the right of the word 'Vape' are three cloud shapes shown in a triangular formation.

31. In his witness statement for the applicant Mr Mansfield concludes that the prints from the UK and European Trade Mark Databases show that,

*"...a prefix E is commonly used in trade marks that relate to electronic cigarettes (often referred to as 'e-cigarettes')."*

32. In its submissions the opponent comments:

*"2. It is not disputed that the prefix E is commonly used abbreviation for the term "electronic" which is all that can be adduced by the "State of the Register" evidence that the Applicant refers to in its evidence of registered marks at the UK IPO and the OHIM."*

33. It has long been established that state of the register evidence of this type does not assist the applicant. It does not indicate whether the marks are being used, or give any indication of the goods on which there is use, or what agreements may be in place between those parties. It is not, therefore, an indicator of whether or not there will be confusion in the market place in relation to the respective trade marks.<sup>5</sup> However, I accept that the letter 'e' may be used to substitute for the word 'electronic' in relation to the goods at issue.

34. In respect of the dominant and distinctive elements of its mark, the opponent states in its notice of opposition:

*"5...The Opponent's earlier mark consists of the term EVape together with 3 puffs of smoke placed to the right of the word EVape. The single dominant and distinctive component in the Opponent's earlier mark is the term EVape as the device of three puffs of smoke in respect to smokers' articles is non-distinctive."*

35. The applicant states:

*"3.2 It will also be appreciated that the verb "to vape" (and the derived terms "vaping" and "vaper") is used to describe the use of an electronic cigarette."*

...

*5. The opponent has stated that the three small clouds or puffs of smoke are not distinctive. So the distinctive components are only the florid italic font of the*

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<sup>5</sup> see Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

*letters EV and the difference in colour between the letters EV and the letters ape.”*

...

*6. As explained above, the word component of the opponent’s mark would have little distinctiveness in isolation, because it combines the standard prefix E with the word Vape, and both the prefix and the word are directly descriptive of the goods (electronic cigarettes).”*

36. The evidence provided by the applicant, from a range of organisations, including the BMA and the NHS; as well as news and media articles and a trade blog, indicate that the term ‘vape’ or ‘vaping’ is used to describe the act of using an electronic cigarette and that those who use them are referred to as ‘vapers’. It is reasonable to assume, from the evidence provided that to ‘vape’ is to ‘smoke’ an electronic cigarette. I have also concluded above that E or E- may be used to indicate the word ‘electronic’. I also accept that the puffs of smoke, or clouds, in the opponent’s mark are non-distinctive for these goods. However, the law requires me to make a finding without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

37. The goods are electronic cigarettes, which evidence confirms are often referred to as ‘e-cigarettes, the ‘e’ being used as a short form of the word electronic. Users of these goods may ‘vape on them but, it does not follow that the combination ‘e-vape’ is a natural one and there is nothing in the applicant’s evidence to suggest this is the case. Taking all of these factors into account, for electronic cigarettes, the whole of the opponent’s mark is, in my view, greater than the sum of its parts. Its distinctiveness rests in the presentation of the mark as a whole.

### **Visual similarities**

38. The applicant submits:

*“Considering the words of the marks in isolation, the present application includes the syllable Vap which is clearly different both phonetically and visually from the syllable Vape. The present application includes the prefix e or e-, which is visually different to the florid italic capital letter E of the cited mark.”*

39. The opponent submits:

*“23. When comparing the marks visually, they are of [sic] clearly similar in length and both contain the same number of syllables. However, the whole of the opposed mark appears at the start of the Opponent’s earlier trade mark. Clearly the presence of the opposed mark at the start of the Opponent’s earlier mark in suit provides a level of similarity even if the opposed mark has the letter E added to the end.”*

40. The opponent draws my attention to the fact that the beginnings of words are more important. The general rule, that the average consumer tends to place most importance on the start of a word<sup>6</sup>, is exactly that - a general rule, to which an exception can be made depending on the circumstances of the case.<sup>7</sup> In this case the first four letters of the

<sup>6</sup> *Les Editions Albert Rene v OHIM, Case T-336/03*

<sup>7</sup> *Castellani SpA v OHIM, T-149/06 ans Spa Monopole, Campagnie Fermiere de Spa SA/NV v OHIM, T-438/07*

opponent's mark are the entirety of the applicant's mark. Only an additional letter 'e' at the end of the earlier right distinguishes them in terms of the letters used within the marks.

41. In considering the presentation of the marks at issue I am mindful of the comments in *Sadas*<sup>8</sup>, where the Court of First Instance (now the General Court) assessed the similarity of 'Arthur' (in script) against the application 'ARTHUR ET FÉLICIE', in plain block capital letters. It held,

"47. At the visual level, given that the figurative elements of the earlier mark are secondary relative to its word element, the comparison of the signs may be carried out on the basis of the word element alone, whilst still adhering to the principle that an assessment of the likelihood of confusion, with regard to the similarity of the signs, must be based on the overall impression given by them. Accordingly, since the earlier mark Arthur is entirely included in the trade mark sought ARTHUR ET FÉLICIE, the difference linked to the addition of the words 'et' and 'Félicie' at the end of the trade mark sought is not sufficiently large to counter the similarity created by the coincidence of the dominant element of the trade mark applied for, namely the word 'Arthur'. Moreover, since registration of the trade mark ARTHUR ET FÉLICIE was sought as a word mark, nothing prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar."

42. The CFI also applied *Sadas* in similar circumstances in *Peek & Cloppenburg v OHIM*<sup>9</sup>, where the earlier mark was the plain word mark. It stated,

"27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. ... since the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for."

43. Accordingly, in this case, normal and fair use of the applicant's mark would include use of the mark in normal scripts, including normal cursive scripts which would reduce the apparent visual difference between the marks when the applicant's mark is considered in block capitals. Taking all of these factors into account, considering the presentation of the earlier mark as a whole, overall, I find the degree of visual similarity to be medium.

### **Aural similarities**

44. The applicant submits:

*"4. The Opponent has suggested that the Opponent's mark EVAPE and the marks of the present application (e-Vap and eVap) are phonetically similar. This is not realistic. The English language clearly distinguishes between the sound of the letter 'a' in these two different contexts (i.e. followed by p or followed by pe), for example: bap, cap, chap, clap, flap, gap, lap, map, nap, pap, rap, sap, slap, strap, tap, trap all have the same vowel sound; and ape, cape, drape, gape, grape, jape, nape, rape, shape, tape all have the same vowel*

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<sup>8</sup> *Sadas SA v OHIM*, T-346/04

<sup>9</sup> T-386/07

sound; and there is no difficulty in distinguishing between pairs of words such as:

cap	cape
gap	gape
nap	nape
rap	rape
tap	tape

*It is therefore clear that the marks are phonetically different.”*

45. The opponent submits:

*“21. The Applicant is wrong in its assessment of the phonetic references to the opposed trade mark and the opponent’s earlier trade mark. The only phonetic terms to be considered are EVAPE v. EVAP/E-VAP. The Applicant’s reference to words that change meaning by the addition of the letter E to the end of the stem is unhelpful and irrelevant to the phonetic assessment between the opposed mark and the Opponent’s earlier trade mark.”*

46. Both versions of the applicant’s mark will be pronounced ‘EE’-‘VAP’ (to rhyme with TAP). In the first mark of the series the hyphen provides a natural break between the ‘e’ and the three letters ‘Vap’. In the second mark of the series a natural break occurs in the word due to the ‘e’ in lower case, which starts the mark and the following letters ‘Vap’, which begin with a capital letter V.

47. The opponent’s mark will be pronounced EE-VAPE (to rhyme with TAPE). Both marks are fairly short and begin with the same EE sound, which in both cases is followed by a V. They are both two syllables long. The aural difference between the marks rests in the longer ‘APE’ ending of the opponent’s mark and the shorter ‘AP’ ending of the applicant’s mark.

48. Taking these factors into account, I find that overall there is a medium degree of aural similarity between these marks.

### **Conceptual similarities**

49. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>10</sup> The assessment must be made from the point of view of the average consumer.

50. In respect of the conceptual comparison the opponent submits:

*“16. The terms VAP and VAPE are obvious references to the term VAPOUR which is a characteristic of electronic smokers’ articles, the exact goods covered by the Opposed application and the Opponent’s earlier mark. The prefix E, as the Applicant has already pointed out, is an abbreviation for “electronic”. Subsequently, when consumers make reference to the trade mark aurally the same idea left on the consumer’s mind is the same.*

...

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<sup>10</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

22. *The addition of the letter E to the words CAP, GAP, NAP, RAP and TAP creates an entirely different word with a completely different meaning. However, in this case, the additional letter E does not create a new word nor change the conceptual similarity between the trade marks.*”

51. The applicant submits:

*“5...Thus not only are the syllables Vap and Vape orally and visually different, they are conceptually different: the syllable Vape is the verb used by users of electronic cigarettes to describe their use of an electronic cigarette. In the context of class 34, the term Vape is therefore a descriptive term. In contrast the syllable Vap is meaningless.”*

52. The evidence filed by the applicant shows that in the context of the goods, electronic cigarettes, the words ‘vape’ and ‘vaping’ are used to describe the act of using an electronic cigarette. It is also clear that these terms are a direct reference to the vapour which characterises an electronic cigarette in contrast to the smoke associated with a tobacco cigarette. Accordingly, the opponent’s mark will bring to mind the act of using an electronic cigarette. The applicant’s mark also includes the letter e at the beginning, which both sides agree is a shortened form of the word electronic. In the context of the goods, the remaining letters ‘Vap’ will, in my view, evoke an impression of the vapour associated with electronic cigarettes or be seen as a shortened form of VAPE. In making a finding on this point I have considered the comments of the General Court in *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* in relation to evocative effects when it said:

91. This evocative effect is independent of whether or not the word mark EURON designates a characteristic of the goods for which registration of the earlier mark was made, since that fact does not influence the ability of the relevant public to make an association between that word mark and the words ‘euro’ and ‘Europe’ (see, by way of analogy, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the same way, the evocative force of the earlier mark cannot be altered by the fact that it is supposedly ‘made up’. Even a made-up word may carry conceptual weight.”

53. Taking all of these factors into account there is a medium degree of conceptual similarity between the parties’ marks.

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

54. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

55. The opponent’s earlier mark is the stylised mark EVape, with clouds or puffs of smoke. No element being particularly distinctive. In line with my findings above at paragraphs 36-37, as a whole, the mark has a fairly low degree of inherent distinctive character.

## Likelihood of confusion

56. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>11</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

57. Earlier in this decision I concluded that the goods at issue are identical, that the competing trade marks are visually, aurally and conceptually similar to a medium degree, and that the opponent's earlier trade mark is possessed of a fairly low degree of inherent distinctive character. In reaching a conclusion on the likelihood of confusion, I also note the following comments of the CJEU in *L'Oréal SA v OHIM* – Case - C-235/05 P:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

58. Notwithstanding that the opponent's earlier mark has a fairly low distinctive character, taking all of these factors into account, particularly the concept of imperfect recollection, in

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<sup>11</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

my view, the similarity of the marks is such that in the context of identical goods, I find that there will be direct confusion (where one mark is mistaken for the other).

## **CONCLUSION**

### **59. The opposition succeeds under section 5(2)(b) of the Act:**

#### **Costs**

60. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Considering evidence and preparing submissions:	£400
Official fee:	£200
Total	£800

61. I order Syed Naseer to pay Ahmed El-Zalabany the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6<sup>th</sup> day of March 2014**

**Ms Al Skilton  
For the Registrar,  
The Comptroller General**