

O-351-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3047942
BY PAUL WATERHOUSE
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS IN CLASS 34:**



&

VAPOUR BLUE

AND

**OPPOSITION THERETO (NO. 402555) BY
LORILLARD TECHNOLOGIES, INC**

Background and pleadings

1. The above series of trade marks were filed by Mr Paul Waterhouse (“the applicant”) on 21 March 2014. They were published for opposition purposes on 18 April 2014 for the following goods in class 34:

Smokers’ articles; electronic smokers’ articles.

2. Registration is opposed by Lorillard Technologies, Inc. (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on three earlier marks, as follows:

- i) International registration (“IR”) 1051365 for the mark: **BLU ECIGS** which designated the UK for protection on 16 September 2010 with protection being conferred on 29 March 2011. The mark is protected for the following goods in class 34:

Class 34: Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes for use as an alternative to traditional cigarettes; smokeless cigarette vaporizer pipe; tobacco substitutes.

- ii) IR 1051607 for the mark: **BLU CIGS** which designated the UK for protection on 16 September 2010 with protection being conferred on 12 April 2011. The mark is protected for the same goods as above.
- iii) IR 1058275 which designated the UK for protection on 26 October 2010 with protection being conferred on 9 June 2011. The mark, which is depicted below, is protected for the same goods as above:



The colours white, grey and blue are claimed as a feature of the mark.

3. Given the dates on which the opponent’s marks designated the UK for protection, they all qualify as earlier marks in accordance with section 6 of the Act. Furthermore, given the dates on which protection was subsequently conferred (less than five years before the date on which the applicant’s marks were published), the proof of use provisions contained in section 6A of the Act do not apply. The earlier marks may, consequently, be relied upon for all their protected goods.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. Both sides have been professionally represented throughout the proceedings. The applicant is represented by National Business Register LLP, the opponent by Bird & Bird LLP. Both sides filed evidence, albeit, the opponent only filed evidence in response to the applicant's evidence. A hearing took place before me on 1 July 2015 at which the opponent was represented by Mr Allan Poulter of Bird & Bird LLP. Neither the applicant nor his representative attended the hearing, but written submissions were filed in lieu.

The evidence

Applicant's evidence

6. A witness statement is provided by Mr Michael Wilmott, the applicant's trade mark agent. His evidence goes to the significance of the word/colour blue in the relevant field. Exhibit MW1 contains a print of existing trade marks in class 34 which contain the word BLU/BUE. There are over 100 trade marks listed. I do not intend to detail them all. Whilst a good number use the word BLUE as a qualifier of another word to create a whole phrase (e.g. BLUE CHIP, BLUE RIDGE, BLUE DOG), others, on the face of it, use the word as some form of sub-designator (e.g. JOHN PLAYER BLUE, SILK CUT BLUE, BENSON & HEDGES BLUE, EMBASSY BLUE). Mr Wilmott goes on to state that after conducting Internet research, he identified that the word/colour blue is commonly used in relation to cigarettes and smokers' articles. Exhibit MW2 contains prints relating to his research. It is fair to say that there are a large number of UK uses that show the colour and/or the word blue on packaging and/or alongside the name of a cigarette brand.

7. In terms of the supporting material provided by Mr Wilmott, there is only one example that does not relate to tobacco cigarettes. This is the use of the word BLUE in relation to pipe tobacco, albeit the word is used as part of the word combination BLUE RIDGE. The same exhibit includes a print from the website Pintrest about "colour/colour coding packaging". The writer of this article discusses various products including cigarettes:

"colour can be used on cigarettes for their strength, as well as menthol ones being green".

8. Mr Wilmott also provides some prints from Wikipedia, one of which relates to the Silk Cut cigarette brand. There is some background information which indicates that the use of designations such as "light" or "low tar" have been banned. However, it is not clear if this relates to the position in the UK. In a paragraph relating to low tar variants, Silk Cut derivatives are listed including Silk Cut Blue, Silk Cut Silver and Silk Cut White. The entries list the respective tar/nicotine contents - of the three variants listed, the blue variant has the highest quantity of those ingredients. Another Wikipedia entry relates to John Player & Sons. It lists a number of brand variants which include the word Blue (e.g. John Player (Blue)/(Bright Blue), John Player Standard Blue, John Player Special Blue). There are other variants including plain, black & red, black & gold, black & silver, special red and special silver.

9. Mr Wilmott then goes on to explain why blue is being used. He states that it could be used to indicate the colour of the packaging, or that some element of the product

is blue. He states that some electronic cigarettes have a blue LED tip that lights up when used. However, he states that the main reason is to “denote a low delivery”. In support of this he exhibits (at MW3) a report (from March 2012) issued by the Centre for Tobacco Control Research entitled “The Packaging of Tobacco Products”. The report appears to have been funded by Cancer Research UK. One section of the report focuses on the use of colour. The information contained therein is drawn from a number of sources including previous research initiatives. Two extracts highlighted by Mr Wilmott state:

“Colour psychology has shown that people attach meanings and emotionally respond to colour. For example, cross culturally, blue, green and white are associated with gentleness and calmness, while, black and red are strong, potent colours (Adam & Osgood 1973) “

and

“Lower delivery products tend to be featured in blue packs. Indeed, as one moves down the delivery sector then the closer to white a pack tends to become. This is because white is generally held to convey a clean healthy association (Philip Morris 199, In Wakefield ET AL 2002).”

10. Mr Wilmott states that in other jurisdictions terms such as light, mild and low have been banned and, so, colour coding has been adopted by manufacturers to replace those words. Exhibit MW4 contains an article in Everyday Health which explains:

“In many cases, cigarette manufacturers have responded by simply removing the banned words from their cigarette packages and letting colours do the talking. For example, now blue, gold and silver are typically reserved for the supposedly milder products, while red is used for traditional cigarettes and the colour green for menthol cigarettes.”

This above article appears to have a US focus.

11. Mr Wilmott provides a report from November 2013 by Cancer Research UK (Exhibit MW5) relating to the marketing of electronic cigarettes in the UK. The report indicates that manufacturers use colours to increase cosmetic appeal. There is, though, no suggestion that the word/colour blue has any particular significance. I note, though, that one manufacturer produces a pack of electronic cigarettes called “5 Colours”. As the name suggests, the electronic cigarettes come in five colours (one of which is blue) which match five different flavours.

Opponent’s reply evidence

12. A witness statement is provided by Ms Theresa Castle, a trade mark attorney at Bird & Bird LLP. Her evidence/submission is that:

- i) The word “vapour” is descriptive of the flavoured and heated air produced by an electronic cigarette. In support of this she provides an extract from the Oxford Dictionary for the word VAPOUR. Although the

definition provides an explanation of what this word means (a substance diffused or suspended in the air) the definition makes no specific mention of electronic cigarettes.

- ii) The state of the register evidence should be disregarded as it does not show the state of the marketplace and, furthermore, some of the marks containing the word BLU are owned by the opponent. It is added that the marks on the register have other distinctive elements which, therefore, does not support the proposition that the marks at issue in these proceedings could co-exist without confusion.
- iii) The applicant's reliance on the significance of the word/colour BLUE is not relevant because the current dispute is about the distinctive element BLUE in the applicant's mark.
- iv) In any event, the examples of the word/colour BLUE being used relate to tobacco cigarettes not electronic cigarettes.

13. At the hearing, Mr Poulter indicated that he did not rely on Ms Castle's evidence at point i) above. This stemmed from a complaint by the applicant in its written submissions that such evidence was being slipped in through the back door. The opponent did not provide any primary evidence, so its evidence should only be in reply to the evidence of the applicant (evidence which does not deal with the word VAPOUR).

14. There are three different earlier marks against two applied for marks (in a series). I will make an initial assessment on the basis of **VAPOUR BLUE v BLU ECIGS**. What I say in relation to that conflict will largely map across to the other assessments, assessments which I will return to, to the extent necessary, later.

The case-law and legislation

15. Section 5(2)(b) of the Act states that:

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

(a)

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

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

16. The following principles are gleaned from the judgments 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The goods

17. In its counterstatement the applicant accepted the opponent's claim that the respective goods were identical or similar. However, given point (g) in paragraph 16 above, whether the goods are identical or just similar (and to what degree) is a factor that needs to be taken into account in the global assessment of the likelihood of confusion.

18. In relation to understanding what terms used in the respective specifications mean/cover, the case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

"..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

19. Even if goods/services are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

20. In its written submissions, the applicant stated:

"The "smokers articles" contained in the applicant's specification are identical to the goods covered by the opponent's earlier marks. The "electronic smokers articles" are identical to the opponent's goods when the goods are "electronic cigarettes for use as an alternative to traditional cigarettes" and "smokeless cigarette vaporizer pipe" and similar to the remaining goods."

21. I will work on the basis that all of the applied for goods are identical to the goods of the earlier mark. Even for the term "electronic smokers articles", no sub-set of these goods has been identified as a fall-back specification, so the goods may be considered identical on the principle identified in *Gérard Meric*. If the opposition

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

succeeds on this basis, I will return to the question of whether any form of restricted specification will assist.

Average consumer and the purchasing act

22. 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. 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.”

23. The applied for goods are smokers articles (including electronic smokers articles). Such goods are aimed at the general public, particularly those that smoke (or use electronic cigarettes). The goods, do not, however, cover tobacco cigarettes (or other tobacco products), so the regulations that place certain prohibitions on their sale³ do not apply. Nevertheless, the goods may still be kept behind a counter, so may be requested aurally, or, alternatively, could be available for self selection. Both visual and aural impacts are, thus, important. The goods will, in my view, be selected with an average (no higher or lower than the norm) degree of care and attention. All of this applies in equal measure to the goods of the earlier mark.

Distinctiveness character of the earlier mark

24. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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

³ The prohibitions include: age limits; that they are sold behind a counter; that packaging of tobacco products is not, other than in certain circumstances, on display.

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)."

25. No evidence of use has been provided by the opponent, so I have only the inherent characteristics of the earlier mark to consider. The mark is BLU ECIGS. ECIGS is a term that will easily be understood by the average consumer, indicating electronic cigarettes. The applicant accepts this in its written submission. BLU will be perceived as a misspelling of the word BLUE. The applicant has provided evidence as to the significance of the word/colour blue in the relevant field. However, I agree with the submission made by Mr Poulter that the evidence relates only to the position regarding tobacco cigarettes. I also agree with his submission that it would be wrong to conclude that because the colour has some significance for tobacco cigarettes, such significance will automatically jump across to electronic cigarettes. In this regard, it is noteworthy that whilst the word/colour blue may be recognised as something commonly used for tobacco cigarettes, the exact characteristic it denotes is somewhat vague. It may indicate a brand variant with perceived benefits over other cigarettes (e.g. cigarettes with lesser amounts of harmful ingredients) but it is no more precise than that. Indeed, as there appears to be no industry standard colour coding then this may be nothing more than a mere perception. Furthermore, given that the imprecise characteristic I have described will be perceived to relate in some way to the inherent health dangers of tobacco cigarettes, the colour will not resonate in the same way with regard to electronic cigarettes because they are not associated with such inherent dangers.

26. There is also evidence relating to colour being used for electronic cigarettes. But, again, I agree with Mr Poulter that this is not overly significant because, at best, this is merely indicative of manufacturers wishing to use colour to make its products look nicer. This applies to all products. Therefore, the word/colour blue has no specific significance (beyond being a colour) in relation to electronic cigarettes.

27. Nevertheless, colours rarely make for particularly distinctive trade marks. The colour could simply be perceived as a reference to the colour of the goods. For this reason, I would have found that the word BLUE for electronic cigarettes was possessed of only a very low degree of inherent distinctive character. The mark in question, though, is BLU ECIGS not BLUE ECIGS. This misspelling adds distinctiveness, although, only to the degree that it becomes a moderately distinctive mark at best.

28. It must be stressed, though, that the distinctiveness that is added by way of the misspelling does not increase the likelihood of confusion. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

Comparison of marks

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

30. 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. The marks to be compared are:

VAPOUR BLUE v **BLU ECIGS**

31. In terms of the earlier mark, and as stated already, ECIGS is a term that will easily be understood by the average consumer, indicating electronic cigarettes. It is clear, therefore, that the element BLU strongly dominates the overall impression of the earlier mark, with ECIGS playing a purely descriptive role.

32. In terms of the applied for mark, the opponent argues that the word VAPOUR is descriptive/non-distinctive, with the result that the word BLUE dominates the mark. The opponent filed no evidence in support of this proposition. At the hearing Mr Poulter relied on the fact that the specification of the earlier mark includes the term “vaporizer pipe”, that the term “vapour cigarettes” has been added to the Nice Classification, that in its written submissions the applicant stated that the concept behind VAPOUR BLUE will be that the goods produce a blue vapour, and, finally, it is submitted that judicial notice can be taken of the fact that the word vapour is descriptive/non-distinctive due to the use of terms such as vaping. The applicant argues that neither word dominates the other and that it will be seen as a word combination, a combination which is suggestive of a vapour that is coloured blue.

33. Although the opponent filed no evidence directed to the significance of the word VAPOUR, this does not prevent it from making the arguments it has. It has referred to matters of public record, or, submits that judicial knowledge is applicable. I do not, however, place much weight on Mr Poulter’s submissions as there is nothing to show how commonly known vaping is, or what significance in trade the term vapour has – it is not a notorius enough fact. Nevertheless, an average consumer will, in my view, perceive the word VAPOUR, when used on electronic cigarettes, to indicate a vapour that is being produced. Furthermore, I agree with the applicant that in the context of the mark before me, the mark will be seen as a word combination which is indicative of the goods producing a vapour of a blue colour. Accordingly, it is my view that neither the word VAPOUR or BLUE dominates the mark.

34. In terms of the visual similarity between the marks, both contain the letters BLU, albeit at the front of the opponent’s mark compared to it being at the beginning of the second element in the applied for mark. There is a difference in that an E is added to the letters BLU in the applied for mark whereas it is not in the applied for mark. The word VAPOUR at the beginning of the applied for mark creates a further visual difference. The addition/absence of the word ECIGS is another difference, however, given my observations about the role this plays (a descriptive one) this has little significance. I consider the degree of visual similarity to be low.

35. In terms of aural similarity, the assessment is similar, albeit the element BLUE/BLU will be pronounced in the same way. I consider there to be a moderate level of aural similarity.

36. Conceptually, both marks are suggestive of something blue, the ecigs in the earlier mark, the vapour in the applied for mark. I consider there to be a reasonable level of conceptual similarity.

Likelihood of confusion

37. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment

of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

38. That there is identity between the goods is an important point because a lesser degree of similarity between the marks may be offset by a greater degree of similarity (in this case identity) between the goods. The concept of imperfect recollection must also be borne in mind. However, having regard to the differences I have identified between the marks, including that the applied for mark as a whole reads VAPOUR BLUE, that BLUE does not dominate the mark or stand as an independently distinctive component, that the point of similarity BLUE/BLU is not identical (although I accept that the point of similarity does not need to be identical) and given the degree of distinctiveness of the earlier mark (and where that distinctiveness comes from), my finding is that the average consumer will not mistake one mark for the other.

39. Confusion can, though, be indirect. This was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

40. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis are just illustrative – he stated that indirect confusion “tends” to fall in one of them. The categories should not, therefore, be considered a straightjacket. In my view there will be no indirect confusion, in any of the categories identified by Mr Purvis, or any other categories. Again, the net effect of the points I made in paragraph 38 would not combine to indicate to the average consumer that the goods are the responsibility of the same or economically linked undertaking. To come to the view the opponent is asking me to reach would require an unnaturally analytical approach on the part of the average consumer. The average consumer would, in my view, simply see the word BLUE in the applied for mark as the use of a colour to signify the vapour that is being produced. They will not see the use of that word as signifying that the goods come from the same (or related) undertaking that is responsible for the goods of the earlier mark.

41. In terms of the other earlier marks, I do not consider the opponent to be in any better position compared to the applied for mark already assessed, or the other mark in the applied for series. **The opposition fails in its entirety.**

Costs

42. The applicant has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side’s statement - £300

Filing and considering evidence - £500

Written submissions - £500

43. I therefore order Lorillard Technologies, Inc to pay Mr Paul Waterhouse the sum of £1300. This should be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of July 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**