

**O/534/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3295814**

**BY REFILL 2 SAVE LTD**

**TO REGISTER THE TRADE MARK:**



**IN CLASSES 29, 30 AND 34**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413041**

**BY MAJID KHAN**

## Background and pleadings

1. On 10 March 2018, Refill 2 Save Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in respect of the following goods:

**Class 29:** *Coconut oil; Edible oil; Edible oils; Edible oils and fats; Jellies; Jellies, compotes.*

**Class 30:** *Aerated drinks [with coffee, cocoa or chocolate base]; Beverages based on tea; Beverages (Chocolate-based -); Beverages (Cocoa-based -); Beverages (Coffee-based -); Snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Snacks made from muesli; Sweets [candy]; Sweets (candy), candy bars and chewing gum; Sweets (Non-medicated -); Sweets (Non-medicated -) being honey based; Sweets (Non-medicated -) containing herbal flavourings; Sweets (Non-medicated -) in the nature of sugar confectionery; Sweets (Non-medicated -) in the nature of toffees; Sweets (Peppermint -); Candy; Candy bars; Chewing gum, not for medical purposes; Chocolate based products; Chocolate confectionery; Chocolates; Coffee; Coffee bags; Coffee based drinks; Coffee beans; Coffee capsules; Coffee drinks; Herb teas, other than for medicinal purposes; Herb teas, other than for medicinal use; Herbal flavourings for making beverages; Herbal honey; Herbal honey lozenges [confectionery]; Herbal infusions [other than for medicinal use]; Honey; Honey [for food]; Edible ice.*

**Class 34:** *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.*

2. The application was published for opposition purposes on 06 April 2018.

3. The application is opposed by Majid Khan (“the opponent”). The opposition is based upon Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is, under each of these grounds, directed against all of the goods in the application. Under Section 5(2)(b), the opponent relies upon the following mark:



UK trade mark registration no. 3259620

Filing date: 27 September 2017

Date of entry in register: 22 December 2017

4. The opponent states that it is relying on all the goods in its registration, namely:

**Class 34:** *Cases for electronic cigarettes; Electric cigarettes [electronic cigarettes]; Electronic cigarette cases; Electronic cigarette cleaners; 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; Flavorings, other than essential oils, for use in electronic cigarettes.*

5. The opponent’s mark is an earlier mark within the meaning of Section 6(1) of the Act because it has a filing date earlier than the filing date of the contested application. As the earlier mark completed its registration process less than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to Section 6A of the Act.

6. For the purposes of its opposition based upon Section 5(2)(b) of the Act, the opponent claims that the respective marks are similar and that the goods are identical or similar. In particular, it states that (1) the dominant and distinctive element of the contested application is the element JAMMIN and (b) the element CBD of the contested application is an industry abbreviation for “cannabidiol” and will be seen as non-distinctive.

7. For the purposes of its opposition based upon Section 5(4)(a) of the Act, the opponent claims that it has made extensive use of the sign JAMMIN throughout the UK since September 2017 in respect of *electronic cigarettes; cases for electronic cigarettes; electronic cigarette cleaners; electronic cigarette liquid; electronic cigarette liquid comprised of propylene glycol; electronic cigarette liquid comprised of vegetable glycerin; flavorings for use in electronic cigarettes; parts and fittings for electronic cigarettes; accessories for electronic cigarettes.*

8. The applicant filed a defence and counterstatement, denying all the grounds. It states that the opponent sells jam flavoured e-liquids for e-cigarettes, whereas the applicant sells CBD and hemp-based products incorporating “cannabidiol”. Part of the applicant’s case is that the element CBD of the applicant’s mark is equally as important as the element JAMMIN given that CBD is an essential ingredient of the applicant’s products.

9. In these proceedings the opponent is represented by Shoosmiths LLP and the applicant is represented by Solicitors Title LLP. Both parties filed evidence in these proceedings. They also filed written submissions. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

10. I now make this decision after a careful consideration of the papers before me.

### **The opponent’s evidence**

11. The opponent’s evidence comes from Rachel Nicholls, who is a trade mark attorney and partner in the firm of Shoosmiths LLP, the opponent’s representatives. Ms Nicholls’s witness statement is dated 24 December 2018. Ms Nicholls’s evidence is very brief and relates to the use of the earlier mark by the opponent in relation to flavoured vape and e-liquid products. It consists of (1) undated prints from three websites showing articles of JAMMIN branded e-liquid products available for purchase and (2) a copy of two Google searches for ‘JAMMIN VAPE’. Ms Nicholls confirms that the copies were printed, and the Google searches was carried out, on 5 December 2018.

12. It is clear from Ms Nicholls's arguments that her evidence is provided with the aim of demonstrating that the relevant public associate the mark JAMMIN with the opponent and that the opponent "enjoys a monopoly" in the same sign.

### **The applicant's evidence**

13. The applicant's evidence consists of a witness statement by Richard Stephen James of Solicitors Title LLP, the applicant's representatives. Mr James's witness statement is dated 22 February 2019. His statement is mainly a vehicle to re-file website prints that the applicant had filed with its counterstatement in order to support the submission that the opponent sells jam-flavoured e-liquid products.

14. The applicant's evidence also includes a witness statement by Bapander Singh Khaneja, the applicant's Managing Director. Mr Khaneja's witness statement is also dated 22 February 2019. Mr Khaneja provides, inter alia, the following exhibits:

- BSK1-4-7: these consist of (1) prints showing the results of two Google searches for 'JAMMIN VAPE CO' and 'JAMMIN CBD', respectively (BSK1 and 4) and (2) website prints from myvapery.com (which, according to Mr Khaneja is another website operated by the opponent) showing use of the opponent's mark as well as the words JAMMIN VAPE CO in relation to e-liquid products (BSK7). The purpose of this evidence is to demonstrate that the results for 'JAMMIN VAPE' relate to the opponent whereas those for 'JAMMIN CBD' relate to the applicant. This, according to Mr Khaneja, supports the view that the two businesses will not be confused and that that the brand used by the opponent is 'JAMMIN VAPE CO' not 'JAMMIN' alone;
- BSK3: Mr Khaneja states that there has been use of the applicant's mark online since 6 January 2018 and, in this exhibit, he provides undated prints from the applicant's website which shows the applicant's mark applied to goods described as CBD-based products. Mr Khaneja explains that the applicant's products are sold directly to consumers via the applicant's online store or to selected retail partners with a strict compliance network as opposed to the

opponent's products, which can be purchased from various online retail stores. This, according to Mr Khaneja, will extinguish any likelihood of confusion between the respective products because it will always be clear to the average consumer that that the contested goods come from the applicant;

- BSK5: This includes website prints showing a few reviews for JAMMIN CBD products. According to Mr Khaneja, it demonstrates that consumers associate the applicant's brand with the contested mark;
- BSK6: This is a website print from urbandictionary.com which gives the definition of 'Jammin' as "*Chillin out/hangin out*";
- BSK8: This is a website print from the aforementioned myvapery.com showing e-liquid products sold under the mark POD SALT. According to Mr Khaneja, the relevance of this evidence is that the mark POD SALT was opposed unsuccessfully by British American Tobacco Ltd on the basis of their earlier mark PODS registered in class 34. Mr Khaneja states that the opposition was refused on the basis of an argument similar to that put forward by the applicant in these proceedings, namely that "*the inclusion of the word SALT after PD was a result of the constituent ingredient salt, being nicotine salt, which is found naturally in tobacco leaf*". Neither a reference nor a copy of that decision is provided;
- BSK9: This is a print from the applicant's website showing articles described as CBD oils and capsules available for purchase. Mr Khaneja explains that these goods (1) are classed as 'coconut oils, edible oils and fats' in class 29, (2) cannot be vaped and (3) are different from the opponent's goods in class 34.

## **DECISION**

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

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

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

[...]

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

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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 the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

17. In comparing the respective specifications, all the relevant factors 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:



“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”.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

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

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

20. The law requires that goods be considered identical where one party’s description of its goods encompasses the specific goods covered by the other party’s description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC.

21. The grounds of opposition under Section 5(2)(b) of the Act require at least some degree of similarity between the goods and services. The goods to be compared are:

<b>Applicant’s goods</b>	<b>Opponent’s goods</b>
<p><b>Class 29:</b> <i>Coconut oil; Edible oil; Edible oils; Edible oils and fats; Jellies; Jellies, compotes.</i></p> <p><b>Class 30:</b> <i>Aerated drinks [with coffee, cocoa or chocolate base]; Beverages based on tea; Beverages (Chocolate-based -); Beverages (Cocoa-based -); Beverages (Coffee-based -); Snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Snacks made from muesli; Sweets [candy]; Sweets (candy), candy bars and chewing gum; Sweets (Non-medicated -); Sweets (Non-medicated -) being honey based; Sweets (Non-medicated -) containing herbal flavourings; Sweets (Non-medicated -) in the nature of sugar confectionery; Sweets (Non-medicated -) in the nature of toffees; Sweets</i></p>	<p><b>Class 34:</b> <i>Cases for electronic cigarettes; Electric cigarettes [electronic cigarettes]; Electronic cigarette cases; Electronic cigarette cleaners; 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; Flavorings, other than essential oils, for use in electronic cigarettes.</i></p>

*(Peppermint -); Candy; Candy bars; Chewing gum, not for medical purposes; Chocolate based products; Chocolate confectionary; Chocolates; Coffee; Coffee bags; Coffee based drinks; Coffee beans; Coffee capsules; Coffee drinks; Herb teas, other than for medicinal purposes; Herb teas, other than for medicinal use; Herbal flavourings for making beverages; Herbal honey; Herbal honey lozenges [confectionery]; Herbal infusions [other than for medicinal use]; Honey; Honey [for food]; Edible ice.*

**Class 34:** *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.*

22. The applicant denies that the goods are similar because, it states, its products contain CBD. It claims that:

- The parties' goods will not be used by the same consumers and are not in competition;
- Consumers who decide to take the applicant's CBD products through vaping do so because the speed of the delivery to their bloodstream is greater compared to other methods, e.g. edibles, topical, sublingual, so they feel the effects of CBD more rapidly. According to the applicant "*these consumers have never smoked traditional or electronic cigarettes*";
- The applicant's approved stocklist includes health stores, pharmacies, vape shops, gyms, cafes, convenience stores and the opponent's online store. The only instance of the goods being offered in the same retail outlets is limited to vape shops;
- The applied for goods in class 29 and 30 are not similar to the opponent's e-liquid products.

23. Some of the parties' evidence and submissions seem to proceed on a misapprehension of the legal test. Section 5(2)(b) requires me to consider all of the goods for which registration is sought and whether they are similar to those for which the earlier trade mark is protected. What I must considered is 'notional' use of the competing goods across the full breadth of the specifications, so it does not avail the applicant that in practice the parties may have hitherto operated in different areas of the vaping market.

24. As regards the applicant's argument that the contested products in class 34 are not similar to the opponent's products in the same class because they contain CBD, it cannot be accepted. Firstly, although the applicant is using the contested mark in commerce in connection with CBD products, the applied for specification is not limited to CBD and CBD-related products. Likewise, the opponent's goods are not limited to jam and/or dessert-flavoured e-liquid products. Whilst the applicant's comments may well be a fair reflection of the position in the marketplace, there is no restriction of either side's goods' specification which reflects current trading patterns. Consequently, there is nothing to prevent the parties from directing their trade at the same segment of vaping market.

25. Secondly, the fact that the contested mark incorporates the letters 'CBD' cannot be carried forward into it being a limitation to the specification for which registration is sought. Hence, it is not a factor which is engaged in the test I must carry out when assessing the similarity of the goods under Section 5(2)(b).

26. I proceed on that basis.

### **Class 34**

27. The contested *Electronic cigarette liquid [e-liquid] comprised of propylene glycol* and *Electronic cigarette liquid [e-liquid] comprised of vegetable glycerine* are self-evidently identical to the opponent's *Electronic cigarette liquid [e-liquid] comprised of propylene glycol* and *Electronic cigarette liquid [e-liquid] comprised of vegetable glycerine*.

28. The contested *Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges* (reproduced twice in the specification) either encompass or are encompassed by the opponent's *Electronic cigarette liquid [e-liquid] comprised of propylene glycol* and *Electronic cigarette liquid [e-liquid] comprised of vegetable glycerine* and are identical on the principle outline in *Meric*.

29. The contested *Electronic cigarettes* and *Electronic cigarettes for use as an alternative to traditional cigarettes* are also identical to the opponent's *Electric cigarettes [electronic cigarettes]*.

### **Class 29 and 30**

30. The contested goods in these classes consist of *Coconut oil; Edible oil; Edible oils; Edible oils and fats; Jellies; Jellies, compotes* (class 29) and *Aerated drinks [with coffee, cocoa or chocolate base]; Beverages based on tea; Beverages (Chocolate-based -); Beverages (Cocoa-based -); Beverages (Coffee-based -); Snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Snacks made from muesli; Sweets [candy]; Sweets (candy), candy bars and chewing gum; Sweets (Non-medicated -); Sweets (Non-medicated -) being honey based; Sweets (Non-medicated*

*-) containing herbal flavourings; Sweets (Non-medicated -) in the nature of sugar confectionery; Sweets (Non-medicated -) in the nature of toffees; Sweets (Peppermint -); Candy; Candy bars; Chewing gum, not for medical purposes; Chocolate based products; Chocolate confectionery; Chocolates; Coffee; Coffee bags; Coffee based drinks; Coffee beans; Coffee capsules; Coffee drinks; Herb teas, other than for medicinal purposes; Herb teas, other than for medicinal use; Herbal flavourings for making beverages; Herbal honey; Herbal honey lozenges [confectionery]; Herbal infusions [other than for medicinal use]; Honey; Honey [for food]; Edible ice (class 30).* The opponent's goods in class 34 cover electronic cigarettes and liquids used to re-fill electronic cigarettes.

31. The opponent's argument that the contested goods in classes 29 and 30 are similar to the opponent's goods in class 34 places significance on the fact that the opponent's e-liquid products can be available in a variety of different flavours and are designed to provide a sweet, sugary taste based on traditional desserts (such as jam tarts and sorbets) similarly to the contested goods in classes 29 and 30.

32. Strictly speaking, the opponent's products are intended for former smokers of traditional cigarettes or smokers trying to reduce traditional smoking and produce artificial smoke. Whilst e-liquids can be available in a range of flavours including food-based flavours, this does not make the goods similar from a trade mark perspective. The uses, nature, purpose and methods of use are different, the goods are produced by different undertakings and are neither complementary nor in competition. As regards trade channels, there is no evidence that the goods may be purchased by the same consumers in the same outlets, such as off-licences, newsagents and supermarkets. But even if I were to accept that the goods could be bought in the same outlets, the restrictions on the sale of tobacco products mean that the goods will not appear on the same shelves or aisles. I accept that the goods may be purchased by the same consumers, however, too much emphasis should not be placed on this fact as this would make similar goods of all kinds. These goods are dissimilar.

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

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade. 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.”

34. The goods at issue are vaping products, namely e-cigarettes and e-liquids. The relevant consumer is the public at large (albeit those over the age of 18), including smokers. The goods may be selected from, for example, the pages of a website or traditional retail outlets. This suggests that visual considerations are likely to form a significant part of the selection process. However, as the goods may also be the subject of word-of-mouth recommendations and requests to sales assistants, aural considerations will, in my view, have a not insignificant part to play.



35. Turning now to the level of attention the average consumer will display when selecting the goods, given that these products are regular purchases and are neither prohibitively expensive nor particularly cheap, but bearing in mind that the average consumers will wish to ensure they are selecting the correct style, strength, flavour, etc. of vaping products, they are in my view likely to pay, at least, an medium degree of attention to the selection of the goods at issue.

## Comparison of marks

36. 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 them, 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.”

37. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The marks to be compared are:

Applicant's mark	Opponent's mark
	



## **The applicant's mark**

38. The applicant's mark is a figurative mark, consisting of two primary components. The first component is the verbal element 'JAMMIN CBD'. It is written in bold upper-case letters on a slightly wavy baseline, in black, and it is placed at the top of the mark. Below it, is the device of a skull wearing a black hat with red, yellow and green horizontal stripes and a pair of sunglasses. The skull device is placed against the images of green leaves which appear to protrude from its left and right side. Both the words and the device are framed within a green square background.

39. The opponent submits that the most distinctive element of the applicant's mark is the word JAMMIN because (1) the element CBD is commonly known by the relevant public to refer to products containing cannabis oil and, as such, it will be perceived as descriptive and non-distinctive; (2) the verbal component of the marks in principle has a stronger impact on the consumer than the figurative component because the public will more easily refer to a mark by its verbal element rather than by describing its figurative element and (3) the device element only reinforces the concept of JAMMIN, which will be taken as a slang term for "playing a musical instrument in particular a guitar" and it is associated, in the mind of the average consumer, with the singer Bob Marley. In this connection, the opponent refers to a double link, namely that some of Bob Marley's songs make a reference to JAMMIN and that the hat depicted in the mark is a Jamaican-style hat which is associated with the Rastafarian movement to which Bob Marley is connected.

40. The applicant denies that the word JAMMIN is the dominant and distinctive element of the mark, because, it asserts: (1) CBD stands for cannabidiol which is the key ingredient in all of the applicant's goods; (2) the element CBD within the mark is fundamental in ensuring that the applicant's consumers know that its products contain only CBD and no other cannabinoids such as THC, which is illegal in the UK and (3) the element CBD in the applicant's mark will not be discarded by the public as non-distinctive and it is an essential identifier of the goods concerned.

41. The applicant's argument must be dismissed. Whilst I understand that it is important for consumers to know that the applicant's goods contain CBD, the applicant

appears to be suggesting that a trade mark is a mere description, rather than a badge of origin. The function of a trade mark is to identify a particular business as the source of goods and services, not to provide consumers with the necessary information regarding the products and services they purchase. There are specific packaging and labelling regimes which aim to ensure that the appropriate information is provided. I therefore dismiss the applicant's submission that the element CBD is distinctive because it identifies an essential ingredient of the goods concerned.

42. The degree of distinctiveness of an element of a composite mark determines its ability to dominate the overall impression created by the mark. The rules for the assessment of distinctive character follow those established by examination on absolute grounds, namely, that elements which are descriptive of the goods and services themselves or of their characteristics are non-distinctive.

43. The contested goods in class 34 include a number of electronic cigarette liquid products which, the evidence shows, might contain CBD. Whilst there is no evidence that CBD is a well-known abbreviation for "cannabidiol", I accept that the average consumer of these products will understand what CBD stands for. The inevitable consequence of this is that, in the context of e-liquid products containing CBD, the average consumer will perceive the element CBD as being descriptive (of a quality of the products) and non-distinctive in the overall impression of the mark. The contested specification also includes goods such as electronic cigarettes which, I understand, can be used to inhale CBD products and for which the term CBD is also non-distinctive, because it is descriptive of the purpose of the goods. As regards the distinctiveness of the word JAMMIN and the device, I find that the two elements are the most dominant and eye-catching elements in the mark and make a roughly equal contribution to the overall distinctive character of the mark. The green background is a banal element. It will be seen as decorative and will have little or no distinctive character.

### **The opponent's mark**

44. The opponent's mark consists of the word JAMMIN written in title case, in red in a slightly stylised bold typeface. The mark also contains two figurative elements, namely

a wavy line and the device of a small heart, however, they are not particularly striking and whilst they have a visual impact, the dominant impact of the mark will be associated with the word JAMMIN.

### **Visual similarity**

45. Visually, the marks coincide in the verbal element JAMMIN which constitutes the most distinctive element of the opponent's mark and a dominant and distinctive element of the applicant's mark. They differ in (1) the element CBD which is non-distinctive (as described above) and the figurative elements in the applicant's mark and (2) the stylisation of the verbal element in the opponent's mark. Therefore, the marks are visually similar to a low to medium degree.

### **Aural similarity**

46. Aurally, the pronunciation of the marks coincides in the sound of the word JAMMIN, present identically in both marks, and differ in the sound of the letters CBD of the contested mark, which has no counterparts in the earlier mark and is non-distinctive. Therefore, the marks are aurally similar to a high degree.

### **Conceptual similarity**

47. The applicant claims that the marks are conceptually different because the applicant's mark conveys the concept of 'relaxation' and the opponent's mark conveys the concept of 'jam'. In this connection, it included in its evidence a definition of JAMMIN from the urban dictionary online as "*Chillin out/hangin out*" and stated that "*the applicant's proposed "JAMMIN CBD" has overall flow to represent relaxation or being chilled which is also represented by the relaxed skull and use of glasses along with the Hemp leaves*" and that "*certain studies have found CBD to aid relaxation which was a fundamental element within the creation of the applicant's mark*". It also filed evidence to show that the opponent uses the brand JAMMIN in relation to jam-flavoured products.

48. Once again, the applicant's argument appears to be based on a misapprehension of the relevant test. As I explained above, the evidence relating to how the opponent has used the mark in the marketplace is not relevant for the purpose of the opposition based under Section 5(2)(b). The opponent's e-liquid products (as they appear in the registered specification) are unlimited and could be produced without any flavour, i.e. plain, in which case there is no basis for the applicant's claim that the word JAMMIN in the opponent's mark will necessarily be seen as a play on the word JAM.

49. As regards the meaning of the word JAMMIN, the applicant also accepted, in written its submissions, that JAMMIN is a slang term with a variety of meanings and the opponent referred to the term JAMMIN being associated with music. In my view, in the context of identical goods consisting of e-cigarettes and e-liquid products, both marks have the potential of being seen as conveying the same concept, be it that of 'being relaxed' or that of 'playing music'. The device in the applicant's mark introduces an additional concept which has a link to CBD consumption (a concept reinforced by the component CBD and the image of the hemp leaves) and has no counterpart in the opponent's mark. I find that the marks are therefore conceptually similar to a medium to high degree.

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

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

51. The opponent has not claimed to have used its earlier mark to the extent that it has an enhanced degree of distinctive character. However, even if it had, the evidence provided consist of some website prints dated after the relevant date which I find completely inadequate to demonstrate that the earlier mark has an enhanced distinctive character. Accordingly, I have only the inherent distinctiveness of the earlier mark to consider.

52. The opponent’s earlier mark consists of the word JAMMIN. It is accepted that the word is a slang term (recognisable to the average consumer) with slight stylisation. The word JAMMIN is not descriptive or allusive of the goods for which the mark is registered. Consequently, I find the earlier mark to have an average degree of distinctive character.

### **Likelihood of confusion**

53. In determining whether there is a likelihood of confusion, 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 marks may be offset by a greater degree of similarity between the respective goods and services vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

54. 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. This distinction was summed up by Mr 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.”

55. To determine whether there is a likelihood of direct or indirect confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I have set out above.

56. Since similarity between goods and services is essential for finding a likelihood of confusion, where no similarity is found, the Section 5(2)(b) claim fails<sup>1</sup>. **Therefore, the opposition under Section 5(2)(b) fails against the following goods:**

**Class 29:** *Coconut oil; Edible oil; Edible oils; Edible oils and fats; Jellies; Jellies, compotes.*

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<sup>1</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77

**Class 30:** *Aerated drinks [with coffee, cocoa or chocolate base]; Beverages based on tea; Beverages (Chocolate-based -); Beverages (Cocoa-based -); Beverages (Coffee-based -); Snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Snacks made from muesli; Sweets [candy]; Sweets (candy), candy bars and chewing gum; Sweets (Non-medicated -); Sweets (Non-medicated -) being honey based; Sweets (Non-medicated -) containing herbal flavourings; Sweets (Non-medicated -) in the nature of sugar confectionery; Sweets (Non-medicated -) in the nature of toffees; Sweets (Peppermint -); Candy; Candy bars; Chewing gum, not for medical purposes; Chocolate based products; Chocolate confectionary; Chocolates; Coffee; Coffee bags; Coffee based drinks; Coffee beans; Coffee capsules; Coffee drinks; Herb teas, other than for medicinal purposes; Herb teas, other than for medicinal use; Herbal flavourings for making beverages; Herbal honey; Herbal honey lozenges [confectionery]; Herbal infusions [other than for medicinal use]; Honey; Honey [for food]; Edible ice.*

57. With regard to the remaining goods, I have found them to be identical. This is a factor weighing in the opponent's favour. Of course, pulling against this, in the applicant's favour, is the degree of visual similarity, which is low to medium. However, the marks are aurally similar to a high degree and conceptually similar to a medium to high degree, another factor weighing in the opponent's favour. The goods will be selected primarily by the eye with a medium degree of attention, but aural considerations must not be ignored. The earlier mark has an average degree of inherent distinctiveness.

58. In my opinion, whilst not likely to be directly confused by the target public, the marks in question are likely to be perceived as being two marks belonging to the same undertaking. This is because, whilst the stylisation of the earlier mark is not reproduced in the applicant's mark, and the applicant's mark comprises other elements, the shared verbal element JAMMIN plays an independent, distinctive and dominant role within the applicant's mark (and within the combination JAMMIN CBD) along with the device, and it is the verbal element by which both marks are likely to be remembered. **There is a likelihood of indirect confusion.**

59. To summarise, the Section 5(2)(b) claim succeeds against the following goods (which, subject to appeal, will be refused registration):

**Class 34:** *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.*

60. Since the Section 5(2)(b) claim has only succeeded in part, I shall consider the Section 5(4)(a) claim against the remaining goods.

#### **SECTION 5(4)(a)**

61. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

62. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and iii) damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:



“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

### **Relevant date**

63. Whether there has been passing off must be judged at a particular point in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-

registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;

- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

64. The date of the application is 10 March 2018. The applicant claims that the applicant's mark has been used since 6 January 2018, a fact which is not contested by the opponent. I will therefore consider whether the opponent owned goodwill on both dates.

## Goodwill

65. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

66. The opponent claims to have made extensive use of the sign JAMMIN throughout the UK since September 2017 in respect of electronic cigarettes and e-liquid products. For its claim to succeed, the opponent must provide evidence that it has goodwill associated with the sign. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J commented:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the

prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

67. However, in *Miramax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J (as he then was) said:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in the application in the applicant’s specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

68. I also bear in mind that a key requirement of goodwill is the presence of clients or consumers for the products in questions<sup>2</sup>.

69. The opponent claims to have made significant use of the mark online however, the paucity of the evidence means that only the following material facts have been provided:

- That at 5 December 2018, 11 months after the relevant date, the opponent’s mark was used on a number of websites in relation to e-liquid products available for purchase;
- That at 5 December 2018, a Google search for JAMMIN VAPE returned a number of results and reviews relating to the opponent’s and the opponent’s e-liquid products, 3 of which seem to have been posted online in November 2017;

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<sup>2</sup>*Starbucks (HK) Ltd v British Sky Broadcasting Group* [2015] UKSC 31, [2015] 1 WLR 2628. See also BL 606/18

70. Whilst some of the web prints filed show how the opponent's goods are presented to the potential customers, the opponent has given no indication of sales figures. So, even if I were able to find that the sign had been used online in relation to the goods before the relevant date, the absence of sales figures means that the evidence is insufficient for me to find that there is a protectable (more than trivial) goodwill on any of the relevant dates.

71. I find that the opponent has not demonstrated that it has a protectable goodwill associated with the sign in relation to the goods upon which it seeks to rely. The Section 5(4)(a) ground therefore fails.

## **COSTS**

72. As both parties have achieved a measure of success, I direct that they bear their own costs.

Dated this 10<sup>th</sup> day of September

Teresa Perks

For the Registrar

The Comptroller – General