

O/0311/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF
TRADE MARK APPLICATION NOS. 3788447, 3788497, 3788818 & 3788508
BY CCHM LTD
TO REGISTER THE FOLLOWING TRADE MARKS:

ELF JUICE

S-ELF JUICE



IN CLASS 34

AND


IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 600002499, 600002500, 600002501 & 600002502
BY IMIRACLE (SHENZHEN) TECHNOLOGY CO., LTD.

Background and pleadings

1. On 16 May 2022, **CCHM Ltd** (“the applicant”) applied to register the trade marks **ELF JUICE** under number **3788447** (“the first contested mark”), **S-ELF JUICE** under



number **3788497** (“the second contested mark”) and **ELF JUICE** under number **3788508** (“the fourth contested mark”) in the UK.

2. On 17 May 2022, the applicant also applied to register the trade mark  under number **3788818** (“the third contested mark”) in the UK.

3. The second and fourth contested marks were published in the Trade Marks Journal for opposition purposes on 3 June 2022. Details of the first and third contested marks were published in the Trade Marks Journal for opposition purposes on 10 June 2022.

4. Registration is sought in respect of all four marks for the following goods:

Class 34: Personal vaporisers and electronic cigarettes; tobacco free cigarettes; inhalers for use as an alternative to tobacco cigarettes; electronic smoking pipes; electronic vaporiser pipes; pipes for smoking tobacco substitutes; smokeless cigarette vaporiser pipes; electronic cigarettes; tobacco substitutes; mouthpieces for electronic cigarettes; oral vaporisers for smokers; electronic cigarettes for use as an alternative to traditional cigarettes; tobacco free cigarettes, other than for medical purposes; refill cartridges for electronic cigarettes; electronic cigarette cases; vaporiser cases; electronic cigarette boxes; vaporiser boxes; pipe cleaners for vaporisers; tobacco and tobacco products (including substitutes); flavourings and solutions for vaporisers and electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes and vaporisers; liquid solutions for use in electronic cigarettes and vaporisers; flavourings, other than essential oils,

for use in electronic cigarettes and vaporisers; parts and fittings for electronic cigarettes; parts and fittings for vaporisers.

5. On 1 August 2022, **Imiracle (ShenZhen) Technology Co., Ltd.** (“the opponent”) opposed all four of the contested marks. The oppositions are all brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and are directed against all of the goods in each of the applications. To support its claims, the opponent relies upon its UK trade mark **3646223**,¹ **ELFBAR** (“the earlier mark”). The earlier mark was filed on 29 December 2020 and registered on 15 October 2021 in respect of the following goods, all of which are relied upon for the purpose of the opposition:

Class 34: Tobacco; cigarettes containing tobacco substitutes, not for medical purposes; electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; filter-tipped cigarettes; oral vaporizers for smokers; lighters for smokers; cigarette filters; cigarettes; flavorings, other than essential oils, for use in electronic cigarettes; pipe racks for tobacco pipes; tobacco pouches; tobacco pipes; cigarette cases; cigars; herbs for smoking; cigar cases; tobacco jars; ashtrays for smokers; matches.

6. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing dates of the applications, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant’s EUTM **18365272** number was filed at the EUIPO on 29 December 2020, whereas its UK application was filed on 25 May 2021. Accordingly, the UK application was given the same filing date as its EUTM.

7. The opponent essentially argues that the respective marks are similar, and the competing goods are similar, giving rise to a likelihood of confusion.

8. The applicant filed a counterstatement in respect of each opposition. In each of its counterstatements, the applicant denies that the marks are similar.² The applicant accepts that there is similarity between the parties' respective goods,³ though disputes that there is a likelihood of confusion.

9. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit". The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

10. The opponent is professionally represented by Whalemaks Service Limited, whereas the applicant is professionally represented by Lawrie IP Limited. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard only if (i) the Office requests it, or (ii) 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. A hearing was neither requested nor considered necessary. Only the applicant filed written submissions in lieu of an oral hearing. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

² Applicant's counterstatements for 60002499, 600002500, 600002501, 600002502, paragraph 3a

³ Applicant's counterstatements for 60002499, 600002500, 600002501, 600002502, paragraph 9

Decision

Section 5(2)(b)

12. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

14. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

15. 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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,⁴ the General Court ("GC") stated that:

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

17. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

18. 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

⁴ Case T-133/05

between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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”.

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

20. The goods to be compared are those in paragraphs 4 and 5.

21. The applicant accepts that the goods are similar, however, fails to outline the degree of similarity or if the goods are identical. Therefore, I will proceed to conduct a full comparison.

Electronic cigarettes; oral vaporisers for smokers; tobacco

22. The above terms are explicitly named in both the applicant's and the opponent's specifications. They are clearly identical.

Tobacco free cigarettes; tobacco free cigarettes, other than for medical purposes

23. The above terms are an alternative way of expressing the opponent's term "cigarettes containing tobacco substitutes, not for medical purposes". They are self-evidently identical.

Personal vaporisers and electronic cigarettes; inhalers for use as an alternative to tobacco cigarettes; electronic smoking pipes; electronic vaporiser pipes; smokeless cigarette vaporiser pipes; electronic cigarettes for use as an alternative to traditional cigarettes

24. These terms are all types of handheld products that allow users to inhale liquid vapors as a substitute for inhaling cigarette smoke. These terms are included within the opponent's broader terms "Electronic cigarettes; oral vaporisers for smokers". Therefore, they are *Merit* identical.

Flavourings and solutions for vaporisers and electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes and vaporisers; liquid solutions for use in electronic cigarettes and vaporisers; flavourings, other than essential oils, for use in electronic cigarettes and vaporisers

25. The above terms are tobacco substitutes, such as liquid substitutes for using in electronic vaporisers, i.e. e-liquids, or flavourings for such liquids. They fall within the opponent's terms "liquid nicotine solutions for use in electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes". Consequently, they are *Merit* identical.

[...] Tobacco products (including substitutes); tobacco substitutes

26. The applied-for goods include tobacco products and substitutes, which cover the opponent's terms "Tobacco; herbs for smoking", as such these goods are identical as outlined in *Meric*.

Pipes for smoking tobacco substitutes

27. These goods are used for smoking tobacco substitutes other than those in liquid form. There is an overlap in nature, method of use and intended purpose with the opponent's "electronic cigarettes" as substances are added to these goods for the purpose of inhaling. They are likely to have the same trade channels as they are likely to be sold in the same retail establishments, such as supermarkets or newsagents, where they will be located in the same area. They may also be produced by the same undertakings. Furthermore, users will overlap, i.e. adult members of the general public that wish to vape/smoke but avoid tobacco. The goods are competitive in nature as users may choose to purchase an electronic cigarette or a pipe for smoking tobacco substitutes. However, the goods are not complementary as they use of one is not important or essential to the use of the other. Overall, taking all the above factors into account, the goods are highly similar.

Mouthpieces for electronic cigarettes; refill cartridges for electronic cigarettes; parts and fittings for electronic cigarettes; parts and fittings for vaporisers.

28. The above terms are all parts of electronic cigarettes and vaporisers. The applicant's goods and the opponent's goods "electronic cigarettes; oral vaporisers for smokers" ultimately have an overlapping intended purpose as they are used to allow consumers to inhale various vapours. Furthermore, the goods share the same trade channels as the goods are produced by the same manufacturers and will be found in the same type of retail premises (or online equivalent) i.e. vape stores or the same section of supermarkets. The goods also share end users. I also find that they share a complementary relationship in that the parts and fittings are important to enable e-cigarettes and vaporisers to perform their role, and consumers are likely to believe that the same undertaking is responsible for both. However, the goods differ in nature and method of use as the applicant's goods are parts of the e-cigarettes or vaporisers

and fulfil specific functions based on its particular part or fitting. Overall, I find these goods are similar to a medium degree.

Electronic cigarette cases; vaporiser cases; electronic cigarette boxes; vaporiser boxes

29. The above applied-for terms are items for storing electronic cigarettes and vaporisers. When compared with the opponent's "electronic cigarettes; oral vaporisers for smokers" the goods differ in nature, method of use and intended purpose. Electronic cigarettes and vaporisers are used by consumers to inhale vapor, whilst electronic cigarette cases are for the purpose of storing electronic cigarettes to keep them safe and prevent damage. The goods will target the same users and the trade channels will overlap as the goods are likely to be sold in the vape stores, their online equivalents, or supermarkets (where they will be found in the same area). The goods are not complementary as electronic cigarette cases are not important or essential to the function of electronic cigarettes. Neither are the goods competitive in nature as they cannot satisfy the role of the other. Overall, taking all the factors into account, the goods are similar to a low degree.

Pipe cleaners for vaporisers

30. The applicant's above term and the opponent's term "oral vaporisers for smokers" are different in nature, method of use and intended purpose as the pipe cleaners for vaporisers are products that are self-evidently used for cleaning, whereas the opponent's goods are used to inhale vapor. The end users will be the same as consumers of vaporisers may also purchase the pipe cleaners to maintain them. The trade channels are also the same as the stores that sell the vaporisers are also likely to sell cleaning equipment specifically for vaporisers. However, pipe cleaners are not important or indispensable to the use of vaporisers, as other products can be used to clean them, and, moreover, cleaning is not essential to the functioning of vaporisers. Neither are the goods competitive as pipe cleaners cannot perform the role of vaporisers. Consequently, I find that the goods are similar to a low degree.

The average consumer and the nature of the purchasing act

31. 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.

32. 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. (as he then was) 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.”

33. I find that the average consumer of the respective goods are adult members of the general public who vape/smoke. The cost of the goods is likely to vary, from cleaning equipment, which is likely to be relatively inexpensive, to electronic cigarettes themselves, which although more expensive are unlikely to be at the highest end of the spectrum. On average, consumers are likely to purchase these goods on a regular basis to sustain smoking or vaping. I find that the purchasing process is likely to be more than merely casual with consumers considering factors, such as, safety of the product, nicotine content and flavour (in the case of e-liquids) and technical features (in the case of electronic cigarettes). Taking the above factors into account, I find that, overall, consumers will demonstrate an average level of attention in respect of these goods. The goods are likely to be obtained through retail outlets, where they are usually kept behind a counter due to the age restrictions on the products. Furthermore, cigarettes and tobacco are subject to visual branding restrictions. In these

circumstances, consumers will request the goods aurally from a retail assistant after viewing the products on a price list, or (for products that are not subject to branding restrictions) behind the counter. I note that some goods, such as e-liquids, may be self-selected from shelves. The goods will also be sold online where the goods will be selected by consumers after viewing information on a website. Overall, the purchasing process would be primarily visual in nature, though I do not discount that aural considerations will play their part.⁵

Distinctive character of the earlier mark

34. The distinctive character of a trade mark can be measured only, first, by reference to the goods in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public

⁵ *Simonds Farsons Cisk plc v OHIM*, Case T-3/04

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).”

35. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

36. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

37. The earlier mark is a word-only mark which consists of the word “ELFBAR”. Although it is presented as one word, consumers will immediately recognise the words “ELF” and “BAR” and will perceive the mark as, essentially, being “ELF BAR”. The word “ELF” will be recognised by consumers as a magical/mythical being with pointed ears that is commonly associated with Christmas in the UK. The word “BAR” will be understood as either an establishment where drinks are served, or a block of material, such as, a bar of chocolate, or a metal bar. In the sense of the latter, the word bar could be mildly allusive of electronic cigarettes which give the appearance of a block/bar. Together, the words create the concept of either a bar that is owned by, or is for, elves, or a block of material that has been created by elves. Regardless of how the word “BAR” is perceived, the meaning of the word “ELF” within the mark does not change. For consumers that perceive the word “BAR” as allusive of the goods at issue, the word “ELF” is more distinctive. For consumers that understand the word “BAR” as a place where drinks are served, therefore not possessing any allusive qualities, the word “ELF” is still the more distinctive element as the word “BAR” is a more commonplace word. Overall, I consider that the earlier mark enjoys a medium degree of inherent distinctive character.

Comparison of the marks


38. It is clear from *Sabel BV v. Puma AG*⁶ that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

39. It would therefore be wrong to artificially dissect the trade 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 they create.

40. The respective trade marks are shown below:

⁶ Case C-251/95, paragraph 23

The earlier mark	The first contested mark
ELFBAR	ELF JUICE
	The second contested mark
	S-ELF JUICE
	The third contested mark
	

	The fourth contested mark
	

Overall impressions

The earlier mark

41. The earlier mark is a word-only mark and encompasses the words “ELF” and “BAR” joined together to comprise “ELFBAR”. There are no additional elements to the earlier mark. Consequently, the overall impression lies in the words “ELF” and “BAR” in equal measure.

The first contested mark

42. The first contested mark is a word-only mark comprising the words “ELF” and “JUICE” with no other elements. Therefore, the overall impression of the mark lies equally in the word elements.

The second contested mark

43. As for the second contested mark, (which is also a word-only mark) it contains the word “S-ELF” with a hyphen between the letters “S” and “E”, followed by the word “JUICE”. In my opinion, the overall impression rests in the words in equal measure.

The third contested mark

44. The third contested mark is a figurative mark depicted in stylised black font. The third contested mark, like the first, encompasses the words “ELF” and “JUICE”. However, the mark is figurative, and the word “ELF” is positioned at the top of the mark with the word “JUICE” sat beneath. Also, the words are underlined, and decorative dots and shooting lines surround the words giving the impression that they have been splashed in juice, particularly as the word “JUICE” is present in the mark. In my view, the overall impression of the mark lies predominantly in the words in roughly equal measure, however, the word “ELF” has slightly more impact as it appears in slightly larger font. The decorative elements also provide a contribution, although they play a lesser role.

The fourth contested mark

45. The fourth contested mark, (also a figurative mark) includes the same words as the second contested mark, i.e. “S-ELF” and “JUICE”. The positioning of these words replicates the format used in the third earlier mark, with the word “S-ELF” sat above the word “JUICE”. The words are also presented in the same stylised font and contain the same decorative elements around the words. Overall, the impression of the fourth contested mark lies predominantly in the words themselves in equal measure with the decorative elements providing a smaller contribution.

Visual comparison

The earlier mark and the first contested mark

46. The competing marks are visually similar as they are both word-only marks that contain the word “ELF” at their beginnings, a position where consumers attention is usually drawn. However, the marks differ as the earlier mark also includes the word “BAR” which is joined with the word “ELF” to form “ELFBAR”. In contrast, the word “ELF” in the first contested mark is followed by the word “JUICE”. In my view, the marks are visually similar to a medium degree.

The earlier mark and the second contested mark

47. Both marks are word-only marks which contain the letters “ELF”. In the earlier mark these letters form the first word of the mark, whereas in the second contested mark the letters appear in the hyphenated word “S-ELF”. Furthermore, the competing marks contain different second words, “BAR” in the earlier mark and “JUICE” in the second contested mark. Taking everything into account, I find the marks are visually similar to between a low and medium degree.

The earlier mark and the third contested mark

48. The third contested mark includes the same words as the first contested mark; therefore, the competing marks will contain the same visual similarities and differences with regard to the words used. However, the third contested mark is a figurative mark, and as such, presents further visual differences. The words are positioned differently in the respective marks; in the figurative mark, the first word, “ELF”, is set above the word, “JUICE”, in slightly larger font, whilst in the earlier mark the words are next to one another. Although, I acknowledge that normal and fair use of a word-only mark, such as the earlier mark, would allow it to be presented in different ways, including one word above another. Furthermore, the third contested mark comprises stylised font and decorative elements which (as discussed above) create the impression of juice covered words; these elements are not found in the earlier word-only mark. Overall, I find that the marks are visually similar to between a low and medium degree.

The earlier mark and the fourth contested mark

49. As for the fourth contested mark, it contains the same words as the second contested mark, therefore, (with regards to the words used within the marks) it will have the same similarities and differences when compared to the earlier mark. However, the fourth contested mark, which is also a figurative mark, replicates the stylisation and decorative elements found in the third contested mark. None of which are present in the earlier mark. Consequently, I find that the competing marks are visually similar to a low degree.

Aural comparison

The earlier mark and the first and third contested marks

50. In my opinion, consumers will make no attempt to articulate the decorative elements in the third contested (figurative) mark. Therefore, both the first and third contested marks consist of two syllables, i.e. “ELF-JUICE”. The earlier mark also comprises two syllables, i.e. “ELF-BAR”. As such, the marks share the same first syllable, but the second syllables differ. In my opinion, the first and third contested marks are aurally similar to the earlier mark to a medium degree.

The earlier mark and the second and fourth contested marks

51. The decorative elements of the fourth contested mark will not be voiced, neither will the hyphen in the word “S-ELF”. Furthermore, consumers will often try to find the quickest verbal path when interpreting a mark, therefore, rather than pronounce the letter “S” separately from the rest of the word “ELF” the hyphenated word will be recognised as a single word and articulated as such, i.e. “SELF”. Consequently, the second and fourth contested marks contain two syllables, i.e. “SELF-JUICE”. Whilst the earlier mark will be pronounced as described above, i.e. “ELF-BAR”, also containing two syllables. The marks aurally overlap only insofar as both marks contain the letters “ELF” in the first syllable. Taking all the factors into account, I find that the second and fourth contested marks are aurally similar to the earlier mark to between a low and medium degree.

Conceptual comparison

The earlier mark and the first and third contested marks

52. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ The shared word, “ELF”, will be perceived identically in both marks, i.e. as a magical/mythical being with pointed ears that is typically associated with Christmas in the UK.

⁷ *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

53. In relation to the word juice, the opponent argues within its notice of opposition “The wording “JUICE” in the applicant’s mark is merely descriptive for the applicant’s goods. Generally, the fruit flavoured cigarettes and e-cigarettes are common and very popular in the cigarette industry. Thus, this wording “JUICE” is less significant in terms of affecting the mark’s commercial impression and renders the wording “ELF” the more dominant element of the mark.” Conversely, the applicant states, “The Applicant maintains its position that the term “JUICE” within the Applicant’s mark is not descriptive of the applied for goods. The word “JUICE” is not descriptive in relation to electronic cigarettes, inhalers, pipes and apparatus relating to such goods. Furthermore, the term “JUICE” is not even a typical way of referring to liquids such as oils and flavourings for vapourisers and pipes etc. The term “JUICE” is unusual and fanciful in relation to such goods and is therefore a distinctive component of the applied for mark.”⁸ Without any evidence to demonstrate consumers will perceive the word “JUICE” as descriptive, I find that the word “JUICE” is not directly descriptive of the goods. However, given that the word refers to a liquid, I accept that it is mildly allusive of goods such as e-liquids.

54. The word “BAR” in the earlier mark will be understood as either a place where drinks are served, or a block of material as described above. In my view, the same way that “JUICE” is mildly allusive of e-liquids, the word “BAR” could be viewed by some consumers as mildly allusive of an electronic cigarette or vapouriser as discussed above.

55. In relation to the earlier mark, the word “ELFBAR” will either be seen as referring to a magical place ran by elves, or a block or bar produced by elves that is allusive of e-cigarettes. In contrast, the words “ELF JUICE”, in the first and third contested marks, will conjure the impression of a juice produced by, or for, elves, thereby, possibly alluding to e-liquids. In relation to the figurative elements in the third contested mark, these will not add conceptually to the mark as they simply reinforce the meaning of the word “JUICE”. The marks conceptually coincide in the meaning of the word “ELF” which bears the same meaning when used in each of the marks. Regardless of how the word “BAR” is perceived, the marks overlap in the common meaning in the word

⁸ Applicant’s written submissions, page 2

“ELF”, but differ in their other words, resulting in a medium degree of conceptual similarity.

The earlier mark and the second and fourth contested marks.

56. The earlier mark will be perceived as I have described above. As for the second and fourth contested marks, both contested marks contain the words “S-ELF JUICE”. The word, “SELF”, will be recognised by the dictionary definition, “the set of someone's characteristics, such as personality and ability, that are not physical and make that person different from other people”.⁹ The word, “JUICE”, will be understood in the context of the goods as alluding to e-liquids. When combined consumers will perceive the mark as referring to goods, i.e. e-liquids, that they can create themselves or are perhaps personalised in some way. The decorative elements of the fourth contested mark, like the third contested mark, fail to add anything over and above the concept of juice. The second and fourth contested marks do not share the concept of an elf found in the earlier mark. Indeed, there is no conceptual overlap between the earlier mark and the second and fourth earlier marks. Consequently, the competing marks are conceptually dissimilar.

Likelihood of confusion

57. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

⁹ <https://dictionary.cambridge.org/dictionary/english/self>

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

59. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained 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).”

60. These examples are not exhaustive but provide helpful focus.

The earlier mark and the first contested mark.

61. I have found that the applicant’s goods are identical, or similar to at least a low degree to those of the earlier mark. I have found that the relevant consumers of the goods are adult members of the general public that vape/smoke, who would pay an average level of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the earlier mark is dominated by the words “ELF” and “BAR” which are joined together, whereas the overall impression of the first contested mark is co-dominated by the words “ELF” and “JUICE”. I have found that the earlier mark and the first contested mark are visually, aurally and conceptually similar to a medium degree. I have also found that the earlier mark has a medium level of inherent distinctive character.

62. The marks are similar in that they are both word-only marks that contain the word “ELF” at the beginning of the competing marks, a position to which the attention of consumers is usually directed. However, the marks differ as the earlier mark comprises two words “ELF” and “BAR” joined together, i.e. “ELFBAR”, whereas the first contested mark are two separate words, i.e. “ELF” and “JUICE”. The second word clearly differs in the respective marks. In my opinion, the differences would not go unnoticed and are of heightened importance given that I have found the purchasing

process to be predominantly visual in nature.¹⁰ Aurally, the marks share only the first syllable with the second syllable differing entirely. Furthermore, the conceptual difference created by the words “BAR” and “JUICE”, along with the visual and aural differences created by these words are enough to prevent consumers from mistaking or misremembering the competing marks for one another, even when factoring in the principle of imperfect recollection. Accordingly, consumers will be able to sufficiently differentiate between them. In my judgement, taking all the above factors into account, the similarities between the competing trade marks are not likely to cause consumers, paying an average level of attention, to mistake the marks, even taking account of the principle of interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to identical goods.

63. That leaves indirect confusion to be considered. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹¹

64. Furthermore, in *Liverpool Gin*¹², Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (Case BL O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

65. As explained above, consumers will recognise that there are differences between the competing marks in the words “JUICE” and “BAR”. However, they will also recognise the common element “ELF”, which is the more distinctive element of both trade marks. Whether consciously or unconsciously, this will lead consumers through the mental process described above, namely, that there is a difference between the

¹⁰ *Quelle AG v OHIM*, Case T-88/05

¹¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

marks, but there is also something in common. The word “ELF”, in relation to the goods at issue, is sufficiently distinctive that consumers are likely to believe that only the opponent will be using it in a trade mark. Alternatively, it is my view that the contested mark, i.e. “ELF JUICE” is likely to be viewed as a brand extension or sub brand of the earlier mark created for flavoured e-liquids, rather than the electronic cigarettes and vapourisers, which the word “BAR” may be allusive of. The difference between the earlier mark combining the words, and the first contested mark separating them, if noticed, will be seen as a simple brand variation with a minor presentational difference. Taking all this into account, I am satisfied that consumers, paying an average degree of attention, would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared element “ELF” which is distinctive in relation to the goods relied upon. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even in relation to goods which are similar to only a low degree.

The earlier mark and the second contested mark.

66. I have found that the applicant’s goods are identical, or similar to at least a low degree to those of the earlier mark. I have found that the relevant consumers of the goods are adult members of the general public that vape/smoke who would pay an average level of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the earlier mark is dominated by the words “ELF” and “BAR” joined together, whereas the overall impression of the second contested mark is co-dominated by the words “S-ELF” and “JUICE”. I have found that the earlier mark and the second contested mark are visually and aurally similar to between a low and medium degree, and conceptually dissimilar. I have also found that the earlier mark has a medium level of inherent distinctive character.

67. I acknowledge that both marks are word-only marks and contain the identical letters “ELF”. However, these letters appear in different positions within the competing marks. In the earlier mark these letters form the first identifiable word within the mark, whereas in the second contested mark the letters appear at the end of the hyphenated

word “S-ELF”; as such, the marks have different beginnings. The marks also differ as they have different second words that can be readily identified within the marks, i.e. “JUICE” in the second contested mark and “BAR” in the earlier mark joined at the end of the word “ELF”. In my opinion, the differences would not be overlooked given the visual importance of the marks.¹³ Aurally, although the number of syllables is the same, the marks share no identical syllables, however, I accept there is an aural overlap generated by the letters “ELF”. Furthermore, the marks fail to share any conceptual similarity that might lead consumers to mistake the marks for one another. It is my view that, despite the similarity between the marks created by the commonality of the letters “ELF”, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. Therefore, in my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, paying an average level of attention, to avoid mistaking the marks for one another, even when factoring in the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

68. Turning to indirect confusion, consumers will recognise the common letters “ELF”. However, they form different parts of the respective marks to create different words and concepts. I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared letters “ELF”. It is my view that the differences between the competing marks are not conducive to any logical brand extension, sub brand or brand variant. There is no logical reason why a company would take the more distinctive element of their mark, i.e. the word “ELF”, and add a hyphenated letter “S” resulting in the creation of an entirely different word and concept to the original mark and vice versa. Instead, the similarities between the marks are likely to be seen as purely coincidental with different undertakings merely using the

¹³ *Quelle AG v OHIM*, Case T-88/05

same letters. In my opinion, this remains the case even in relation to goods that are identical. Therefore, I find that there is no likelihood of indirect confusion.

The earlier mark and the third contested mark

69. I have found that the applicant's goods are identical, or similar to at least a low degree to those of the earlier mark. I have found that relevant consumers of the goods are members of the general public that vape/smoke who would pay an average level of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the earlier mark is dominated by the words "ELF" and "BAR" joined together, whereas the overall impression of the third contested mark is predominately dominated by the words "ELF" and "JUICE" in roughly equal measure. I have found that the earlier mark and the third contested mark are visually similar to between a low and a medium degree, and aurally and conceptually similar to a medium degree. I have also found that the earlier mark has a medium level of inherent distinctive character.

70. As with the first contested mark, the marks are similar in that they both contain the word "ELF" at the beginning of the competing marks, (a position to which the attention of consumers is usually directed) and differ in the second words used, i.e. "JUICE" and "BAR". However, unlike the first contested mark, the third contested mark has further differences as it is a figurative mark rather than a word-only mark. The third contested mark contains figurative decoration surrounding the word elements that along with the stylisation give the impression that the words have been splashed in juice, these figurative elements are absent in the earlier mark. I note that although the words are positioned differently within the marks (as discussed above) normal and fair use of a word-only mark, such as the earlier mark, would allow it to be presented in different ways, including one word above another. The font also differs; in the earlier mark it appears in normal typeface whilst the third contested mark uses stylised font. In my view, these differences would be difficult to overlook. Aurally, although the respective marks have the same number of syllables, only the first syllable overlaps. Moreover, there is a conceptual difference created by the words "JUICE" and "BAR",

in addition to the visual and aural differences stemming from these words. Overall, I am satisfied that the aforementioned differences are enough to prevent consumers from mistaking or misremembering the competing marks for one another, even when factoring in the principle of imperfect recollection. Rather, the differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the similarities between the competing trade marks are not likely to cause consumers, paying an average level of attention, to mistake the marks, even taking account of the principle of interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to identical goods.

71. As for indirect confusion, consumers will recognise that there are differences between the competing marks in the words “JUICE” and “BAR”. However, they will also recognise the common element “ELF”, which is the more distinctive element of both trade marks. Whether consciously or unconsciously, this will lead consumers through the mental process described above, namely, that there is a difference between the marks, but there is also something in common. The word “ELF”, in relation to the goods at issue, is distinctive enough that consumers are likely to believe that only the opponent will be using it in a trade mark. Alternatively, like with the first contested mark, it is my view that the third contested mark is likely to be viewed as a brand extension or sub brand of the earlier mark created for flavoured e-liquids, rather than electronic cigarettes and vaporisers, which the word “BAR” may be allusive of. The differences created in the figurative mark with the stylisation are minimal and will be perceived as a brand variation with added decorative elements, as will the separation between the words. Taking all this into account, I am satisfied that consumers, paying an average degree of attention, would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared element “ELF” which is distinctive in relation to the goods relied upon. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even for goods that are similar to only a low level.

The earlier mark and the fourth contested mark

72. I have found that the applicant's goods are identical, or similar to at least a low degree to those of the earlier mark. I have found that relevant consumers of the goods are adult members of the general public that vape/smoke who would pay an average level of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the earlier mark is dominated by the words "ELF" and "BAR" joined together, whereas the overall impression of the fourth contested mark is predominately co-dominated by the words "S-ELF" and "JUICE". I have found that the earlier mark and the fourth contested mark are visually similar to a low degree, aurally similar to between a low and medium degree, and conceptually dissimilar. I have also found that the earlier mark has a medium level of inherent distinctive character.

73. I appreciate the marks are similar as both marks contain the identical letters "ELF" within their respective marks. However, as with the second contested mark, these letters appear in different positions within the competing marks, creating overall different words. The marks also have different beginnings, with the fourth contested mark starting with the hyphenated letter "S". The marks also differ as they have different additional words identified within the competing marks, i.e. "JUICE" and "BAR". The fourth contested mark is a figurative mark, and as such, presents further differences to the earlier word-only mark. The stylisation and decorative elements in the figurative mark create the impression that the words have been splashed in juice, particularly as the word "JUICE" is encompassed within the contested mark; these elements are not repeated in the earlier mark. In my opinion, the differences would not be ignored by consumers and are of heightened importance given that I have found the purchasing process to be predominantly visual in nature.¹⁴ Aurally, as with the second contested mark, the marks overlap only as a result of the letters "ELF". Furthermore, the marks do not share a conceptual overlap. It is my view that, despite the similarity between the marks created by the common letters "ELF", it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the abovementioned differences will adequately enable consumers to differentiate between the marks. Consequently, in my judgement, considering all the above factors, the differences between the competing trade marks are likely to enable consumers,

¹⁴ *Quelle AG v OHIM*, Case T-88/05

paying an average level of attention, to avoid mistaking the marks for one another, even when factoring in the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

74. I accept that consumers will recognise the common letters “ELF”. However, like with the second contested mark, they form different parts of the respective marks to create different words and concepts. I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; merely because of the shared letters “ELF”. It is my view that the differences between the competing marks are not conducive to any logical brand extension, sub brand or brand variant. Although I can understand that the differences in positioning and stylisation of the font as well as the minor decorative figurative elements may be liable to be perceived as a brand variation, in my view, an undertaking would not take the more distinctive element of their mark, i.e. the word “ELF”, and add a hyphenated letter “S”, resulting in the creation of an entirely different word and concept to the original mark. As such, the similarities between the marks are likely to be seen as purely coincidental with different undertakings merely using the same letters. In my opinion, this remains the case even in relation to goods that are identical. Therefore, I find that there is no likelihood of indirect confusion.

Conclusion

75. The oppositions under section 5(2)(b) of the Act against application numbers **3788447** and **3788818** have been successful. Subject to any appeal, the applications will be refused.

76. However, the oppositions against application numbers **3788497** and **3788508** have failed. Subject to any appeal, the applications will proceed to registration in the UK in respect of all the applied-for goods.

Costs

77. As both parties have achieved what I consider to be a roughly equal measure of success, I direct that each party should bear their own costs.

Dated this 28th day of March 2023

**Sarah Wallace
For the Registrar**