

O/037/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK3261067

BY

REDEMPTION VAPE LIMITED

TO REGISTER THE FOLLOWING MARK
IN CLASS 34

BRAIN FREEZE

AND

THE OPPOSITION UNDER NO. 411401 THERETO

BY

STARBUZZ TOBACCO INC

Background and Pleadings

1. REDEMPTION VAPE LIMITED (the Applicant) applied to register the mark BRAIN FREEZE on the 3 October 2017 for goods in Class 34 shown below. It was accepted and published on the 20 October 2017.

Class 34: Food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice.

2. STARBUZZ TOBACCO INC (the Opponent) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (the Act), relying on its earlier EU registered marks shown below:

<p>Mark 1</p> <p>EU014973457</p> <p>ALASKAN FREEZE</p> <p>Filed: 4 January 2016 Registered: 22 April 2016</p>	<p>Class 4: Candles; charcoal.</p> <p>Class 5: Air fresheners.</p> <p>Class 34: Tobacco; tobacco substitute; smokers' articles, in particular hookahs and e-hookahs and accessories thereof; electronic cigarettes; electronic vaporizing smoking device; e-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smoking pipes; steam stones, in particular steam stones for water pipes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; all the aforesaid goods not for medical purposes.</p>
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<p>Mark 2</p> <p>EU013367461</p> <p>Mighty Freeze</p> <p>Filed: 15 October 2014 Registered: 25 February 2015</p>	<p>Class 34: Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.</p>
<p>Mark 3</p> <p>EU013367511</p> <p>Grape Freeze</p> <p>Filed: 15 October 2014 Registered: 25 February 2015</p>	<p>Class 34: Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.</p>
<p>Mark 4</p> <p>EU013367537</p> <p>Watermelon Freeze</p> <p>Filed: 15 October 2014 Registered: 25 February 2015</p>	<p>Class 34: Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.</p>

3. The Opponent is relying on all its goods for which all its marks are registered, claiming that there is a likelihood of confusion because under section 5(2)(b) the trade marks are similar and are to be registered for goods identical or similar to those for which the earlier marks are protected.

4. The Opponent submits that the

“Goods and services are similar and highly similar”

“The respective marks contain identical components and are therefore visually highly similar”

“The marks are conceptually identical and therefore there exists a likelihood of confusion on the part of the average consumer.”

5. The Applicant filed a defence and counterstatement denying that its mark infringes the Opponent’s mark.

6. The Opponent is professionally represented by Bailey Walsh & Co LLP. The Applicant is unrepresented. Both parties filed evidence and the Opponent filed additional submissions in lieu of a hearing. Neither party requested a hearing. The decision is taken upon the careful perusal of the papers.

The Applicant’s evidence

7. The Applicant’s evidence consists of a statement and exhibits completed by Steven Perry Field dated the 19 August 2018.

Mr Steven Field’s statement

8. Mr Field states that he is the Director of Redemption Vape Ltd.

9. He states that the trademark “Brain Freeze” was applied for on 3 October 2017 and that he/they have used the name on their labels since this date.

10. He continues that the name was registered in order to protect the name of an additive which he/they had formulated as a cooling agent to be added to his/their range of E-juices.

11. He explains that the “cooling agent is an additive and not a flavour name” and that it is part of the “flavour PROFILE”.

12. Mr Field describes Exhibit RED1 as “A statement of facts”. The document is a copy email dated the 11 March 2018 from Mr Field to the Opponent’s solicitors and the Tribunal section. It is headed up Without Prejudice and ordinarily I would not be privy to such correspondence. However, in this case the email does not contain any negotiation or settlement details and merely gives an explanation of the Applicant’s use of the mark.

13. Within the email Mr Field explains that Brain Freeze is an additive to add a cooling effect to his/their range of juices and is “most definitely NOT a flavour name” and that it does not appear prominently on the packaging in any event. He offers to amend the records to show this as a cooling agent additive and not a flavour. To date however the classification has remained unaltered and for the purposes of this decision the use of the mark is irrelevant under section 5(2)(b) as I must consider the matter on the basis of the mark as applied for within Class 34. ¹

14. Attached to the statement are various pictures one of which is described as a “Redemption vape flavour label”. He states that the word “Brain Freeze is very small and is shown UNDER the name of our flavours. its[sic] part of the flavour profile components NOT the name of the juice.”

¹ It is not legally permissible to make amendments to the mark itself after it has been filed.

15. Exhibit RED2 is described as “Pictures of existing UK and Worldwide Brands currently using the name “Brain Freeze” as FLAVOUR names.” The images are undated and are copy screen shots of pictures of the Applicant’s products and other brands of e-cigarette vapours using the name “freeze” within their packaging.

Opponent’s evidence

16. The Opponent’s evidence consists of a witness statement and exhibits from Philip Stephenson, a senior partner at Bailey Walsh & Co LLP, the Opponent’s professional representatives, dated the 19 October 2018.

Mr Philip Stephenson’s statement

17. Mr Stephenson states that he is the Opponent’s attorney. The content of his statement sets out to counter the Applicant’s argument that there is a distinction between additives for e-juices and the names of the same.

18. Mr Stephenson exhibits screenshots of various vaping product retailers described as “showing e-juices sold alongside additives, such as concentrates and nicotine.” He states that the websites demonstrate that additives and e-liquids are sold through the same trade channels as well as other vaping paraphernalia.

Decision

19. The opposition is based on section 5(2)(b) of the Act which states:

“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”.

20. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

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

21. In these proceedings, the Opponent is relying upon its EU registrations shown above, which qualify as earlier trade marks under section 6 of the Act. As the earlier marks have been registered for less than five years at the date the application was published they are not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods of its registrations without having to establish genuine use.

22. 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.

The principles:

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

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

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

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

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

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

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

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

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

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

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

Comparison of Goods

23. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

24. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

25. The GC in the case of *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* defined “complementary”:

“82 It is true that goods are complementary if 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...”.

26. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

27. The Opponent has only commented on its Class 34 goods in its submissions and therefore for procedural economy my comparison will focus on the parties' goods in this class only, as this is the Opponent's best case for comparison. Its "*candles, charcoal and air fresheners*" in Classes 4 and 5 share no similarity with the Applicant's goods in Class 34 in any event.

28. The parties' goods are set out in the table below:

Applicant's goods	Opponent's goods
<p>Class 34: Food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice.</p>	<p>Mark 1 EU014973457: ALASKAN FREEZE</p> <p>Class 34: Tobacco; tobacco substitute; smokers' articles, in particular hookahs and e-hookahs and accessories thereof; electronic cigarettes; electronic vaporizing smoking device; e-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; smoking pipes; steam stones, in particular steam stones for water pipes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances; all the aforesaid goods not for medical purposes.</p>
<p>Class 34: Food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice</p>	<p>Mark 2 EU013367461: Mighty Freeze</p> <p>Class 34: Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs</p>

	and accessories; shishas; electronic and non-electronic cigarettes.
Class 34: Food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice	<p>Mark 3 EU013367511: Grape Freeze</p> <p>Class 34: Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.</p>
Class 34: Food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice	<p>Mark 4 EU013367537: Watermelon Freeze</p> <p>Class 34: Tobacco and tobacco products (including substitutes); articles for use with tobacco; matches; electronic and non-electronic hookahs and accessories; shishas; electronic and non-electronic cigarettes.</p>

29. E-cigarettes/electronic cigarettes are marketed as tobacco-free delivery devices which look and feel like a traditional cigarette. Typically, instead of burning tobacco the user inhales a vapour, produced from a liquid usually sold in cartridge form. This liquid is made up of various ingredients to include nicotine and flavourings. Flavourings are substances usually added in the manufacturing process to impart taste and/or smell. These flavourings are often used in the liquids accompanying e-cigarettes to make them more attractive to the user.

30. The contested *“Food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice”* are one of the many ingredients added to the liquid cartridges used in e-cigarettes which are added to enhance the flavour of the liquid and give it its distinctive taste and smell. The flavourings and liquids will be manufactured, distributed and sold by the same undertakings and found in the same

outlets. The flavourings used in these cartridges are an integral part of the vaping experience, they are indispensable to e liquids and are therefore complementary. The e-liquids and the flavourings target the same consumer who will purchase them in the same retail outlet and consumers would expect that such goods are manufactured and produced by the same undertaking. Therefore, they are similar to a medium degree with the Opponent's Mark 1 goods namely *"e-liquid for use in electronic smoking devices and electronic cigarettes, namely, refill liquid for electronic smoking devices and electronic cigarettes; mineral carrier substances for flavorings, for use in water pipes; inhalable aerosols and carrier substances therefor, for use in water pipes; substances for inhalation using water pipes, in particular aromatic substances."*

31. In relation to *"food grade flavourings used in electronic cigarettes; Food grade flavourings used in manufacturing of e juice"* and *"electronic cigarettes"* (Marks 2, 3 and 4) they are targeted towards the same end users and will be sold together from the same outlets. Whilst they differ in nature they are complementary to each other because electronic cigarettes require flavourings. I consider the contested goods share a low level of similarity to the Opponent's *"electronic cigarettes"*.

Average consumer

32. When considering the opposing marks, I must determine first of all who the average consumer is for the goods and the purchasing process. The average consumer is deemed reasonably informed and reasonably observant and circumspect. The level of attention may vary according to the category of goods and services in question.² In this particular case the goods in question are e-cigarettes, and the related e liquids and flavourings.

² Lloyd Schuhfabrik Meyer, case c- 342/97.

33. 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 Opponent submits that the average consumer of e cigarettes and e liquids are the same. The goods are of relatively low value with consumers not displaying the same level of brand loyalty as they would with traditional tobacco cigarettes.

35. To my mind the goods in question are consumable disposable items, of low value. E-cigarettes and the associated paraphernalia will be bought in supermarkets, corner shops or in specialist “vape” shops. The regulations are such that they are not to be sold to under 18-year olds. In supermarkets and corner shops they are not usually available for self-selection but are behind the counter goods asked for and then supplied by a member of staff. In this scenario aural considerations would play an important part in the selection process as it will involve a request to supply from a shop keeper. However, I do not discount visual considerations once the consumer has possession of the items at the point of sale. In specialist vape shops however the customer would be able to browse and self-select the goods from the range on display and therefore visual considerations are key. The consumers of the Applicant’s e-liquid/ e-cigarette flavourings will be the same as the part of the population who use e-cigarettes. I take the ordinary meaning of the words within the specification and consider that the average consumer of the contested goods to be an adult member of the general public who uses vaping products. I do not discount that a portion of the public may be manufacturers purchasing chemical flavourings to be added at the

production stage however to my mind taking into account the decision in *Hearst Holdings* above the typical consumer will be part of the smoking community rather than the manufacturer. Taking all these factors into account, I therefore consider that there will be an average degree of attention paid in the purchasing process.

Comparison of the 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

38. The respective trade marks are shown below:

Applicant’s Mark	Opponent’s Marks
BRAIN FREEZE	Mark 1: ALASKAN FREEZE

	Mark 2: Mighty Freeze
	Mark 3: Grape Freeze
	Mark 4: Watermelon Freeze

The Applicant's Mark

39. The Applicant's mark consists of two words BRAIN FREEZE presented in block capitals in conventional font. In my view neither word is more dominant than the other despite the word "FREEZE" being one letter longer because I consider the words will be read together to form a phrase. It is this phrase that is the dominant and distinctive element rather than the two separate individual words and therefore this combination of words taken as a whole forms the overall impression of the Applicant's mark.

The Opponent's Marks

Mark 1: ALASKAN FREEZE

40. The Opponent's first mark consists of two words ALASKAN FREEZE presented in conventional font. Both words are well known to the average UK consumer the first consisting of a place name. As ALASKAN is an adjective that qualifies the word FREEZE, the two elements contribute equally to the overall impression. Neither word dominates the other in the overall impression conveyed and neither word will be seen as separate elements.

Mark 2: Mighty Freeze

41. The Opponent's second mark again consists of two words but presented in title case. Again, both words are well known to the average UK consumer. As with earlier Mark 1 above, I would not consider that either word materially dominates the other as the first word is an adjective qualifying the second word FREEZE. In my view the two words will be read in combination and therefore contribute equally to the overall impression of the mark and not as individual elements.

Mark 3 and 4: Grape Freeze and Watermelon Freeze

42. Again, these earlier marks consist of two words presented in title case. Both words in each case are well known ordinary English words. Both "Grape Freeze" and "Watermelon Freeze" will be read in combination to evoke the phrase frozen watermelon and frozen grape. Neither "Grape" nor "Watermelon" will be distinctive as they will be considered as merely descriptive of the nature and flavour of the goods. I find that both elements make an equal contribution in the overall impression of the mark.

Visual

43. All the marks are comprised of two words. The common element and the only point of visual similarity between the marks is the word Freeze which is identical in all the marks and follows the pattern "+ FREEZE". It is the first word in each of the marks which separates them; BRAIN as opposed to ALASKAN, Mighty, Grape and Watermelon. A word trademark registration protects the word itself irrespective of the font, capitalisation or otherwise, therefore a trade mark in capital letters covers notional use in lower case and vice versa³. As a general rule of thumb beginnings of trade

³ Bentley Motors Limited v Bentley 1962 Limited O/159/17

marks have more visual and aural impact than their endings.⁴ Since the first word in each of the contested marks are completely different with no overlap, the main visual focus will therefore be on the word FREEZE and consequently there is a low to medium degree of visual similarity between the Applicant's mark and all the Opponent's marks.

Aural

44. From an aural perspective the second word in each mark, namely Freeze, is identical with a further verbal first element being different in each case. Each word will be given its ordinary English pronunciation being well known dictionary words. Since the first word in each mark shares no verbal similarity with the other and since the case law above confirms that generally beginnings of marks have a greater impact than their ends I consider the marks to be aurally similar to a low to medium degree.

Conceptual

45. Conceptually the Applicant's mark BRAIN FREEZE will be considered in combination rather than as two separate elements. When read together it will form a unit and be understood to refer to a well-known phrase describing an acute headache triggered by the consumption of a cold or iced product too quickly. The use of Alaskan in the Opponent's first mark is likely to be seen as a geographical reference to a US state that is renowned for its cold temperatures and might convey something that is extra cold. Similarly, Mighty Freeze conveys something cold to a large degree. The use of the fruit names Grape and Watermelon in the Opponent's third and fourth marks are descriptive of the nature of the product for sale and will allude to the flavouring used or the taste of that particular product. When read in combination with the word "freeze" they will be suggestive of frozen fruit. I consider the conceptual similarities between the contested marks to be low in relation to Grape Freeze and Watermelon Freeze and medium with regards to Alaskan Freeze and Mighty Freeze.

⁴ El Corte Ingles, SA v OHIM, cases T-183/02 and T-184/02

Distinctiveness of the earlier marks

46. The degree of distinctiveness of the earlier marks is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier marks the greater the likelihood of confusion. The Opponent has not filed any evidence regarding use of its marks. I must therefore consider the matter on inherent characteristics.

47. 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 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).”

48. Registered marks possess varying degrees of inherent distinctiveness on a scale of low to high. Some are descriptive or allusive of a characteristic of the goods or services whilst others have no such qualities if they are made up or invented.

49. There is no evidence that the earlier marks have been used. I will therefore consider the inherent distinctiveness of the earlier marks. All the marks contain the word FREEZE, strongly suggestive of something cold or frozen. The first word of each of the Opponent's earlier marks are different; the first mark begins with a place name, the second an adjective, descriptive of something large or grand and the third and fourth mark with the name of a fruit which indicates a related fruit flavour. The earlier marks are clearly English words but have no apparent allusive association with the goods covered by the registration namely smoking paraphernalia, e-cigarettes or e-liquids. Overall, I consider the marks to have an average level of inherent distinctive character.

Likelihood of confusion

50. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods originate from the same or related source.

51. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the respective trade marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to

make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

52. 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.”

53. I have identified the average consumer to be a member of the general public aged 18 years who will select the goods either through visual or aural means paying no more than an average level of attention in the purchasing process. I have found the respective parties’ goods to be similar between a low and no more than a medium degree. Conceptually the marks share a medium level of similarity in relation to Mark 1 and Mark 2 and low in relation to Mark 3 and Mark 4. I take into account that the inherent distinctiveness of the earlier marks is average with no further enhancement attributed to them through use.

54. When comparing the contested marks, I take into account the obvious visual similarities between them as a result of the shared presence of the word “FREEZE”

which is identical in both marks and the non-distinctive use of the first element in each case. My assessment however cannot be based on just the comparison between one part of a composite mark and comparing that with another. The comparison I must make must be made by looking at the marks as wholes.

55. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the

components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

56. The element Freeze in the earlier marks do not have an independent distinctive role in the applied for mark. BRAIN FREEZE will be seen as a unit having a different meaning as compared to its components taken separately and therefore I am unable to conclude that FREEZE has retained an independent distinctive role in it.

57. I am also mindful of the decision in *The Picasso Estate v OHIM*, Case C-361/04 P, where the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

58. “BRAIN FREEZE” has such a strong conceptual meaning that it counteracts the visual and aural similarities of the respective marks. The Applicant’s mark will be seen as a composite whole, the words hanging together to form a phrase, neither word playing an independent distinctive role.

59. Taking all these factors into account I do not consider that the marks will be directly confused. The difference with the inclusion of the first words in each case and the conceptual differences are sufficient to allow the average consumer to distinguish between them. There is therefore no likelihood of indirect confusion either as consumers would not conclude that the Applicant's mark is a sub brand or economically linked to the same undertaking.

Outcome

60. The opposition under section 5(2)(b) fails accordingly; subject to any successful appeal the application may proceed to registration.

Costs

61. As the Applicant has been successful ordinarily it would be entitled to an award of costs. However, the Applicant being unrepresented was invited by the tribunal to indicate whether it intended to make a request for an award of costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the proceedings. It was made clear by letter dated the 7 November 2018 that if the pro-forma was not completed, no costs arising from the action would be awarded. The Applicant did not respond to that invitation and therefore I make no award for costs in this case.

Dated this 21st day of January 2019

Leisa Davies
For the Registrar