

O/142/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003312705

BY DARKSTAR INTERNATIONAL LIMITED

TO REGISTER THE TRADE MARK:

KOOL SHOT

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 414318 BY

BRITISH AMERICAN TOBACCO (BRANDS) INC.

BACKGROUND AND PLEADINGS

1. On 23 May 2018, Darkstar International Limited (“the applicant”) applied to register the trade mark **KOOL SHOT** in the UK. The application was published for opposition purposes on 10 August 2018 and registration is sought for the following goods:

Class 34 Liquid for electronic cigarettes; Liquids for electronic cigarettes; Liquid solutions for use in electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin.

2. On 9 November 2018, British American Tobacco (Brands) Inc. (“the opponent”) opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

KOOL

EUTM no. 17895696

Filing date 4 May 2018; registration date 20 August 2018

Relying on all of the goods for which the mark is registered, namely:

Class 34 Cigarettes; tobacco, raw or manufactured; roll your own tobacco; pipe tobacco; tobacco products; tobacco substitutes (not for medical purposes); cigars; cigarillos; cigarette lighters; cigar lighters; matches; smokers' articles; cigarette paper; cigarette tubes; cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; liquids for electronic cigarettes; tobacco products for the purpose of being heated.

(“the First Earlier Mark”)



EUTM no. 5971494

Filing date 5 June 2007; registration date 8 February 2016

Relying on all of the goods for which the mark is registered, namely:

Class 34 Cigarettes; tobacco; tobacco products; Swedish style snuff; smokers' articles; lighters; matches; absorbent paper for tobacco pipes; ashtrays for smokers; books of cigarette papers; chewing tobacco; cigar cases; cigar cutters; cigar holders; cigarette cases; cigarette filters; cigarette holders; cigarette paper; cigarette tips; cigarettes; cigarettes containing tobacco substitutes, not for medical purposes; cigarillos; cigars; firestones; gas containers for cigar lighters; herbs for smoking; humidors; lighters for smokers; match boxes; match holders; matches; mouthpieces for cigarette holders; mouthpieces of yellow amber for cigar and cigarette holders / tips of yellow amber for cigar and cigarette holders; pipe racks for tobacco pipes; pocket machines for rolling cigarettes; snuff; snuff boxes; spittoons for tobacco users; tobacco; tobacco jars; tobacco pipes; tobacco pouches; none of the aforementioned goods including pipe cleaners for tobacco pipes.

("the Second Earlier Mark")

3. The opponent claims that there is a likelihood of confusion because the marks are similar, and the goods are identical or similar.

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

5. The opponent is represented by Baker & McKenzie LLP and the applicant is represented by Branded!. Both parties filed evidence. The opponent also filed evidence in reply. Neither party requested a hearing and only the opponent filed written submissions in lieu of attendance. This decision is taken following a careful perusal of the papers.

EVIDENCE

Opponent's Evidence in Chief

6. The opponent filed evidence in the form of the first witness statement of Mr Alexander Juras, dated 11 July 2019. This was accompanied by 14 exhibits. Mr Juras is the attorney acting for the opponent in these proceedings. I have read his evidence in its entirety and summarise it below only to the extent that I consider necessary.

7. A print out from Wikipedia states that the KOOL brand was launched in 1933.¹

8. Mr Juras has also provided a number of print outs from websites which show use of the terms "one-shot" or "nicotine shot" to describe certain types of products.² However, all of these are undated.

Applicant's Evidence in Chief

9. The applicant filed evidence in the form of the witness statement of Carin Burchell dated 28 October 2019. This was accompanied by 8 exhibits. Ms Burchell is the attorney acting on behalf of the applicant in these proceedings. I have read Ms Burchell's evidence in its entirety and summarise it below only to the extent that I consider necessary.

10. Ms Burchell states that the word KOOL is generic or descriptive for VAPE products. Ms Burchell states that this is a reference to the term "koolada" but provides no further information about what this is. Many of the examples provided Ms Burchell are undated or dated after the relevant date and are not, therefore, of assistance to the applicant in demonstrating the state of the market at the time the applicant's mark was applied for. A number of examples are also directed at countries other than the UK.

¹ Exhibit AJ1

² Exhibits AJ6 to AJ14

11. A print out from the Facebook page of 'KOOL BREATH' shows that it has been active since December 2014.³ This business states that it sells "37 flavours of high-quality crafted e-liquid/vapor juice" and is located in Ireland.

12. Ms Burchell refers to the fact that another of the opponent's trade marks (which is the same text as the mark relied upon in these proceedings, presented with a penguin device) is subject to a disclaimer which states: "Registration of this Trade Mark shall give no right to the exclusive use of the word "Kool".⁴ Ms Burchell has also provided state of the register evidence, which I will return to below.

Opponent's Evidence in Reply

13. The opponent filed evidence in reply in the form of the second witness statement of Mr Juras, dated 23 December 2019. This was accompanied by 8 exhibits. I have read Mr Juras' statement in its entirety. It relates entirely to information about KOOLADA referred to in the applicant's evidence. It appears that KOOLADA is a flavouring used to add freshness to e-liquids, but is not a ready-made e-liquid product.⁵

14. I have also read the opponent's written submissions in lieu. Whilst I do not propose to summarise them here, I have taken them into consideration and will refer to them below where necessary.

PRELIMINARY ISSUE

15. The applicant has filed state of the register evidence. I refer the applicant to the decision of the General Court ("GC") in *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, when it was stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the

³ Exhibit CEB4

⁴ Exhibit CEB8

⁵ Exhibit AJ6

word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71)."

16. It is clear from the case law that when assessing the likelihood of confusion under section 5(2)(b), it is necessary to consider the potential for conflict between the applied for mark and the earlier mark in light of all the relevant circumstances. The existence of other trade marks on the Register is not pertinent to the matter before me.

DECISION

17. Section 5(2)(b) of the Act states as follows:

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

(a)...

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

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

18. The trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the applicant's mark pursuant to

section 6 of the Act. As the opponent's marks had not completed their registration process more than 5 years before the publication date of the application in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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 trade marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 the trade 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.”

21. 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.

22. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="333 1131 655 1223">KOOL (the First Earlier Mark)</p>  <p data-bbox="311 1451 678 1487">(the Second Earlier Mark)</p>	<p data-bbox="1002 1131 1193 1167">KOOL SHOT</p>

23. The applicant's mark consists of the words KOOL SHOT. There are no other elements to contribute to the overall impression, which lies in the combination of these words. The First Earlier Mark consists of the word KOOL. There are, again, no other elements to contribute to the overall impression of the mark which lies in the word itself. The Second Earlier Mark consists of the word KOOL, with the first 'O' overlapping with the second. This is presented in a slightly stylised font. The word itself plays the greater role in the overall impression, with the presentation playing a lesser role.

The Applicant's Mark and the First Earlier Mark

24. Visually, the applicant's mark and the First Earlier Mark share the common word KOOL. They differ in the presence of the word SHOT in the applicant's mark which has no counterpart in the First Earlier Mark. I consider the marks to be visually similar to a medium degree.

25. Aurally, the First Earlier Mark will be pronounced in the same way as the ordinary dictionary word COOL. The first word in the applicant's mark will be pronounced in the same way. The point of aural difference between the marks is the addition of the word SHOT in the applicant's mark which has no counterpart in the First Earlier Mark. I consider the marks to be aurally similar to a medium degree.

26. Conceptually, the word KOOL in both marks is likely to be seen as a misspelling of the ordinary dictionary word COOL. Consequently, it is likely to be seen as either a reference to temperature or something that is fashionable. The word SHOT in the applicant's mark, in the context of the goods, is likely to be seen as something that is small and/or quick. I consider the marks to be conceptually similar to a medium degree.

The Applicant's Mark and the Second Earlier Mark

27. Visually, the same differences apply as for the First Earlier Mark. However, the Second Earlier Mark also appears visually different to the applicant's mark because of the stylisation and overlapping letters. I consider the marks to be visually similar to between a low and medium degree.

28. The only element of the Second Earlier Mark that will be pronounced is the word KOOL itself. Consequently, for the same reasons outlined in respect of the First Earlier Mark above, I consider the applicant's mark and the Second Earlier Mark to be aurally similar to a medium degree.

29. I do not consider that the presentation and overlapping letters have any meaningful impact on the conceptual message conveyed by the Second Earlier Mark.

Consequently, for the reasons outlined above in respect of the First Earlier Mark, I consider the applicant's mark and the Second Earlier Mark to be conceptually similar to a medium degree.

Comparison of goods

30. As I have found the First Earlier Mark to share the greater degree of similarity with the applicant's mark, I will proceed on the basis of that mark only, returning to the Second Earlier Mark only if it is necessary to do so.

31. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>First Earlier Mark</p> <p><u>Class 34</u></p> <p>Cigarettes; tobacco, raw or manufactured; roll your own tobacco; pipe tobacco; tobacco products; tobacco substitutes (not for medical purposes); cigars; cigarillos; cigarette lighters; cigar lighters; matches; smokers' articles; cigarette paper; cigarette tubes; cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; liquids for electronic cigarettes; tobacco products for the purpose of being heated.</p>	<p><u>Class 34</u></p> <p>Liquid for electronic cigarettes; Liquids for electronic cigarettes; Liquid solutions for use in electronic cigarettes; Flavourings, other than essential oils, for use in electronic cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin.</p>

32. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

33. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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 for 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.”

34. “Liquid for electronic cigarettes”, “Liquids for electronic cigarettes”, “Liquid solutions for use in electronic cigarettes”, “Electronic cigarette liquid [e-liquid] comprised of propylene glycol” and “Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin” in the applicant’s specification are either self-evidently or *Merici* identical to “liquids for electronic cigarettes” in the opponent’s specification.

35. I consider that there is likely to be overlap in trade channels and user between “Flavourings, other than essential oils, for use in electronic cigarettes” and “Flavorings, other than essential oils, for use in electronic cigarettes” in the applicant’s specification and “liquids for electronic cigarettes” in the opponent’s specification. I recognise that the goods may differ in method of use and nature. I consider the goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

36. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

37. The average consumer for the goods will be a member of the general public. The cost of the purchase is likely to be fairly low, and the goods are likely to be purchased reasonably frequently. However, the average consumer will still take various factors into account such as nicotine content and flavour. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods.

38. These goods are normally stored behind a counter and to purchase the goods, the average consumer is likely to request them from a shop assistant. However, once the request has been made, the average consumer will still have sight of the packaging at

the point of purchase. I, therefore, consider that both visual and aural considerations will play a role in the purchasing process for the goods.

Distinctive character of the earlier trade mark

39. 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-2779, 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).”

40. 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. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

41. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use. In any event, the only evidence filed by the opponent in this regard is evidence that its brand was launched in 1933. This is not enough, on its own, to justify a finding of enhanced distinctive character. Consequently, I have only the inherent position to consider. The First Earlier Mark consists of the word KOOL. As noted above, this is likely to be viewed as a misspelling of the ordinary dictionary word COOL. For those consumers who view this as a reference to something that is fashionable, this will be viewed as laudatory. For those who view this as a reference to temperature, it may be that it is seen as a quality of the flavour. For example, I am aware that mint-type flavours are often described as 'cool'. It is, of course, important to remember that the word has been misspelled and this does, of course, contribute to its distinctiveness. I consider the First Earlier Mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is 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 alive to 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 he has retained in his mind.

43. I have found the marks to be visually, aurally and conceptually similar to a medium degree. I have found the First Earlier Mark to have between a low and medium degree of inherent distinctive character. I have identified the average consumer to be a

member of the general public, who will purchase the goods by both visual and aural means. I have concluded that a medium degree of attention will be paid during the purchasing process for the goods. I have found the parties' goods to be identical or similar to a medium degree.

44. I consider that the differences between the marks are sufficient to avoid them being mistakenly recalled as each other. I do not consider that the addition of the word SHOT in the applicant's mark will be forgotten by the average consumer, notwithstanding the principle of imperfect recollection. I do not, therefore, consider there to be a likelihood of direct confusion.

45. I recognise that a finding of indirect confusion should not be made merely because two marks share a common element.⁶ However, the fact that the earlier mark has a weak distinctive character does not preclude a likelihood of confusion.⁷ The addition of the word SHOT in the applicant's mark is, in my view, likely to be viewed as indicating a smaller, or perhaps faster acting, product sold by the opponent. I consider that the marks, both of which include the same misspelling of the word COOL, will be viewed as originating from the same or economically linked undertakings. I consider there to be a likelihood of indirect confusion.

CONCLUSION

46. The opposition is successful, and the application is refused.

COSTS

47. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,100** as a contribution towards the costs of the proceedings. In making this award, I take into account the fact that both

⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

⁷ *L'Oréal SA v OHIM*, Case C-235/05 P

parties' evidence was of very limited assistance and have made an appropriate reduction. This sum is calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing evidence and considering and commenting on the applicant's evidence	£500
Preparing written submissions in lieu	£300
Official fee	£100
Total	£1,100

48. I therefore order Darkstar International Limited to pay British American Tobacco (Brands) Inc. the sum of £1,100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 05th day of March 2020

S WILSON
For the Registrar