

## Vaping and IP Rights Infringement

Trading Standards are seeing vaping fluids and accessories being “passed off” as being associated with established brands. Many of these brands do not manufacture vaping fluids or accessories and have no intention to do so.

This is an attempt to:

- associate vaping with popular brands
- make vaping products more attractive to young people
- sell more products

Associating vaping fluids with the trade reputation and goodwill that exists in relation to other well-known brands is known as trading ‘off the coat tails’ of the established brands, exploiting their trade reputation and goodwill without permission.

Many of the brands who are the victims of this unauthorised association or “passing off” have no intention to register their trade marks in Class 34.

Registration of an existing Brand or RTM in Class 34 for tobacco products could “be detrimental to, the distinctive character or the repute of the trade mark”.

## Trade Marks Act Section 92 offences

However, the fact that a trade mark is registered in the relevant class is an element of the TMA s92 offence, see TMA s92(4):

*“A person does not commit an offence under this section unless—*

*(a) the goods are goods in respect of which the trade mark is registered [i.e.use in class], or*

*(b) **the trade mark has a reputation** in the United Kingdom and the use of the sign takes or would take **unfair advantage** of, or is or would be **detrimental** to, the distinctive character or the repute of the trade mark.” [i.e.use out of class]*

Therefore, to substantiate a TMA offence, if a RTM is used outside class, the rights owner must be able to state in their witness statement and prove that the unauthorised trade mark use “takes... unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark” - s92(4)(b).

## Consumer Protection from Unfair Trading Regulations 2008

Additionally, an offence contrary to the CPRs can be laid.

*“Regulation 5(3) A commercial practice satisfies the conditions of this paragraph if—*

*(a) it concerns any marketing of a product (including comparative advertising) **which creates confusion with any products, trade marks, trade names or other distinguishing marks of a competitor;***

*and it causes or is likely to cause the average consumer to take a transactional decision he would not have taken otherwise, taking account of its factual context and of all its features and circumstances.”*

The average consumer does not have to be misled – the marketing just has to be likely to affect their transactional decision. It is a misleading action if 'it concerns any marketing which creates confusion with any products, trade marks, trade names or other distinguishing marks of a competitor'. There is no need to produce a confused consumer to prove the offence.

In other words, does the fact that the trade name is on the product, make it more likely that a young consumer would buy the vaping product or less likely. If it were 'less likely' the trade name would not be on the product.

### **Similarity**

It is common for trade marks that are 'similar' or 'likely to be mistaken for' the RTM to be used in relation to these products, if the infringing mark is confusingly similar it is likely to mislead consumers. This is a fact that should be covered in the rights owners witness statement.

The test is one of 'imperfect recollection' – “the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them...”

### **Class 34**

Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporizers for smokers; smokers' articles; matches

A search of Class 34 for “Vaping” lists nearly 100 different types of goods

<https://www.search-uk-trade-mark-classes.service.gov.uk/searchclasses>

Results: 14 classes, 150 goods/services

Other searches can be made for ecigarette, e cigarette, tobacco etc all with differing results.

## Statements

Rights Owners who will provide witness statements include:

<b>Mark</b>	<b>Contact/Rights Owner</b>	
Skittles	“Mars” Mars/Wrigley c/o Stobbs	<a href="mailto:Jessica.Chee@iamstobbs.com">Jessica.Chee@iamstobbs.com</a>
TANGO	Britvic UK)	<a href="mailto:Jody.Tsigarides@britvic.com">Jody.Tsigarides@britvic.com</a>
FANTA	The Coca-Cola Company	