

O-461-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2618288
IN THE NAME OF POSEIDON HEALTH LIMITED FOR REGISTRATION OF THE
TRADE MARK



AND

OPPOSITION THERETO UNDER NO 104340
BY VITABAY CORP

Background

1. Application No. 2618288 has a filing date of 20 April 2012 and seeks registration of the trade mark shown on the front page of this decision. It stands in the name of Poseidon Health Limited (“the applicant”) and seeks registration in respect of the following goods:

Class 5

Vitamin and mineral supplements for use as ingredients in the food and pharmaceutical industry; mineral food supplements; mineral nutritional supplements; vitamin and mineral supplements; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; health food supplements; health food supplements for persons with special dietary requirements; health food supplements made principally of minerals; health food supplements made principally of vitamins; dietary supplements for non-medical use based on proteins, fats, or fatty acids or carbohydrates all with or without plant extracts; protein dietary supplements.

Class 29

Food products based on proteins or fats with or without plant extracts, namely, protein milk, beverages made from milk or yoghurts, namely, yoghurt drinks and milk beverages with high milk content, milk drinks containing fruits and drinks based on yoghurt; yoghurt; edible oils and fats; vegetable extracts; edible fats containing ginkgo biloba, maca root, guarana, baobab fruit; milk and milk products; edible oils and fats; dietary foods products (other than for medical use) based on proteins, fats, fatty acids with or without plant extracts included in Class 29; preserved, frozen, dried and cooked food products, namely mango, maraschino cherries, acacia berries, artichoke, montmorency cherries, whey, edible oils derived from fish; green lipped mussels (not live); food products made from fish; fish and fish extracts; preserved, frozen, dried and cooked fruits and vegetables; fruit and fruit extracts; vegetable and vegetable extracts; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; nuts; preserved garlic.

Class 30

Food products based on carbohydrates with or without plant extracts, all those goods containing ginkgo biloba, maca root, guarana, baobab fruit namely, breakfast cereals, cereal based energy bars not for use as a meal replacement, cereal based snack foods, ready to eat cereals, processed cereals, multi-grain based snack bars, rice based snack bars, snack foods, namely, chocolate based snack foods containing but not confined to chocomine, konjac fibre, ginseng, palmetto, manuka honey; coffee, tea, green tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, (condiments); spices; food products namely extruded food products made from wheat, rice, maize; powdered garlic, ginseng tea; processed ginseng used as a herb, spice or flavouring, green coffee and green tea; nuts; garlic powder; processed garlic.

2. Following publication of the application in the *Trade Marks Journal* No 6961 on 12 October 2012, notice of opposition was filed by Vitamins Best Corporation which changed its name to Vitabay Corp. (“the opponent”). There is a single ground of opposition founded on section 5(2)(b) of the Act based on the following International trade mark:

Mark	Dates	Specification
916499 Vitabay	International registration date: 20 December 2006 Date protection granted: 12 February 2008 Office of Origin: Germany	<p>Class 5</p> <p>Mineral food-supplements, vitamin preparations.</p> <p>Class 29</p> <p>Dietetic foodstuffs or dietary supplement for non medical purposes on the basis of protein, fat, fatty acid, in addition with vitamins, mineral nutrients, trace elements in combination or alone, as far as included in this class, food supplements on the basis of protein.</p> <p>Class 30</p> <p>Dietetic foodstuffs or food supplements for non medical purposes on the basis of carbohydrates, roughage, with addition of vitamins, minerals, nutrients, trace elements in combination or alone, as far as included in this class.</p> <p>Class 35</p> <p>Advertising and business management consultancy, namely compilation of goods (except their transport) for others for the purpose of the distribution of the goods to customers; services of an online trading business, namely procurement of contracts on the purchase or sale of goods and services at the Internet.</p>

3. The applicant filed a counterstatement in which, essentially, it denied the grounds of opposition.

4. The opponent filed evidence but as this was directed solely to the change of name of the opponent, I do not intend to summarise it. The opponent also filed written submissions dated 18th June and 21st October 2013 which I will refer to as necessary in this decision. Neither party sought to be heard. I give this decision after a careful review of all the papers before me.

The objection under section 5(2)(b) of the Act

5. The single ground of opposition is founded on section 5(2)(b) of the Act which reads:

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.”

6. An “earlier trade mark” is defined in section 6 of the Act, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

7. The opponent relies on its International trade mark no 916499. This is an earlier trade mark within the meaning of section 6(1) of the Act. Given the interplay between the date of protection of this earlier mark and the date the application was published, the provisions of section 6A of the Act are not relevant and thus the opponent is not required to prove use of its mark but is entitled to rely on it for each of the goods and services as protected.

8. In considering the objection under section 5(2)(b) and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; nevertheless, the

overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

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

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods and services

9. Whilst the opponent relies on its registration both in respect of goods and services, I intend to confine my comparison to the respective goods. On that basis, the respective specifications to be compared are:

Earlier mark	Application
Class 5 Mineral food-supplements, vitamin preparations.	Class 5 Vitamin and mineral supplements for use as ingredients in the food and pharmaceutical industry; mineral food supplements; mineral nutritional supplements; vitamin and mineral supplements; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; health food supplements; health food supplements for persons with special dietary requirements; health food supplements made principally of minerals; health food supplements made principally of vitamins; dietary supplements for non-medical use based on proteins, fats, or fatty acids or carbohydrates all with or without plant extracts; protein dietary supplements.

<p>Class 29 Dietetic foodstuffs or dietary supplement for non medical purposes on the basis of protein, fat, fatty acid, in addition with vitamins, mineral nutrients, trace elements in combination or alone, as far as included in this class, food supplements on the basis of protein.</p>	<p>Class 29 Food products based on proteins or fats with or without plant extracts, namely, protein milk, beverages made from milk or yoghurts, namely, yoghurt drinks and milk beverages with high milk content, milk drinks containing fruits and drinks based on yoghurt; yoghurt; edible oils and fats; vegetable extracts; edible fats containing ginkgo biloba, maca root, guarana, baobab fruit; milk and milk products; edible oils and fats; dietary foods products (other than for medical use) based on proteins, fats, fatty acids with or without plant extracts included in Class 29; preserved, frozen, dried and cooked food products, namely mango, maraschino cherries, acacia berries, artichoke, montmorency cherries, whey, edible oils derived from fish; green lipped mussels (not live); food products made from fish; fish and fish extracts; preserved, frozen, dried and cooked fruits and vegetables; fruit and fruit extracts; vegetable and vegetable extracts; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; nuts; preserved garlic.</p>
<p>Class 30 Dietetic foodstuffs or food supplements for non medical purposes on the basis of carbohydrates, roughage, with addition of vitamins, minerals, nutrients, trace elements in combination or alone, as far as included in this class.</p>	<p>Class 30 Food products based on carbohydrates with or without plant extracts, all those goods containing ginkgo biloba, maca root, guarana, baobab fruit namely, breakfast cereals, cereal based energy bars not for use as a meal replacement, cereal based snack foods, ready to eat cereals, processed cereals, multi-grain based snack bars, rice based snack bars, snack foods, namely, chocolate based snack foods containing but not confined to chocomine, konjac fibre, ginseng, palmetto, manuka honey; coffee, tea, green tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, (condiments); spices; food products namely extruded food products made from wheat, rice, maize; powdered garlic, ginseng tea; processed ginseng used as a herb, spice or flavouring, green coffee and green tea; nuts; garlic powder; processed garlic.</p>

10. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

11. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed. He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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.”

He went on to say:

“in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”.

12. I also take note of the comments of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 where it stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13. With the above in mind, I go on to carry out the comparison of the respective goods:

Class 5

The term *mineral food supplements* appears in both specifications and are clearly identical goods.

The applicant’s *Vitamin and mineral supplements for use as ingredients in the food and pharmaceutical industry; mineral nutritional supplements; vitamin and mineral supplements; pharmaceutical and veterinary preparations; dietetic food and substances adapted for medical or veterinary use; food for babies; dietary*

supplements for humans and animals; health food supplements; health food supplements for persons with special dietary requirements; health food supplements made principally of minerals; health food supplements made principally of vitamins are each identical to the opponent's goods in class 5 on the basis set out in *Meric*.

I find the applicant's *dietary supplements for non-medical use based on proteins, fats or fatty acids or carbohydrates all with or without plant extracts; protein dietary supplements* to be highly similar, if not identical, to the opponent's goods in class 5. Each is in the nature of a supplement and whilst the respective supplements may have different ingredients, each will be used by those who wish to use them for the benefit to their health or well-being, they will be supplied through the same trade channels and sold in the same places.

That leaves *sanitary preparations for medical purposes* which I find to be at least reasonably similar to the opponent's goods in this class. These are goods for the protection of health and well-being, will be used by the same user and supplied through the same trade channels as the goods of the earlier mark.

Class 29

I find each of the respective goods in this class to be identical on the basis set out in *Meric*.

Class 30

I find each of the respective goods in this class to be identical on the basis set out in *Meric*.

The average consumer and the nature of the purchasing process


14. The goods are such as are widely available, either in a specialist store such as a pharmacy, health food or sports supplement shop, or in a more general retail environment such as a supermarket whether on the high street or by mail order or via the internet and, whilst they may vary in price, each is likely to be a relatively low cost item. Given that the respective goods are for ingestion and/or for use as an aid to health and well-being, the average consumer is likely to pay a reasonable, though not the highest degree of care to the purchase. Each of the respective goods is such as will be used by the general public either of their own choice or on the recommendation of a health care practitioner thus both visual and aural considerations are likely to play a part in the purchasing process.

Comparison of the respective marks

15. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must compare the respective trade marks from the visual, aural and

conceptual perspectives identifying, where appropriate, what I consider to be their distinctive and dominant elements.

16. For ease of reference, the marks to be compared are:

Earlier mark	Application
Vitabay	

17. The earlier mark consists of the word Vitabay presented in title case. As a single word, there is no dominant element and the distinctiveness of the mark rests in its whole.

18. The application consists of the word Vitaday where the initial letter V is presented in a much larger, though otherwise unremarkable, font. The remaining letters of this word are presented in lower case. Underneath the middle five letters of the word, and in much smaller, lower case letters, are the words “the healthy way”. The words “the healthy way” are not distinctive for the goods at issue and, if they are noticed by the average consumer, will not be given any trade mark significance. Despite the size of the initial letter V, it does not stand alone but acts as a capital letter and reads into the dominant and distinctive element of the mark, which is the word Vitaday”.

19. There is a very high degree of both visual and aural similarity between the respective marks. This comes from the fact that the words Vitabay and Vitaday, each of which is seven letters long, differ only in respect of the fifth of those letters: the letters b and d. Visually, each of these letters consists of an upright and a loop and are, essentially, mirror images of each other. Aurally, the letters b and d are not easily distinguishable in ordinary usage other than by very careful enunciation. Both visually and aurally, the letters are subsumed within the remainder of the words.

20. I have no evidence before me that either mark is anything other than an invented word. In light of the goods at issue, however, it is possible that the average consumer will think that both marks have something to do with vitamins which would lead to there being a reasonably high degree of similarity between them.

The distinctive character of the earlier mark

21. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade 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 from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

22. No evidence of the use made of the earlier mark has been filed and therefore there is nothing to show the mark benefits from any enhanced distinctive character. It is a mark with an average level of inherent distinctive character.

Likelihood of confusion

23. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier mark, as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in his mind.

24. Earlier in this decision I found that:

- The average consumer of the goods at issue will be a member of the general public;
- The average consumer is likely to pay a reasonable, though not the highest degree of care to the purchase:
- The purchase of the goods will involve both visual and aural factors;
- The respective marks are very highly similar from the visual and aural considerations and they share a reasonably high degree of similarity from the conceptual perspective;
- The respective goods are at least reasonably similar with most being identical.

25. Taking all matters into account, I have no hesitation in finding that there is a likelihood of direct confusion between the respective marks.

Summary

26. The opposition succeeds in full.

Costs

27. The opposition having succeeded, the opponent is entitled to an award of costs in its favour. I take account that the only evidence it filed related to the locus of the opponent for which I consider it should not be compensated. I also take note that no hearing took place and only the opponent filed written submissions. I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
Opposition fee:	£200
For the preparation of written submissions:	£300
Total:	£800

28. I order Poseidon Health Limited to pay Vitabay Corp the sum of £800 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of November 2013

**Ann Corbett
For the Registrar
The Comptroller-General**