

O-216-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2657741
BY METABOLICS LTD
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:**

OptimEyes

&

OPTIMEYES

AND

OPPOSITION THERETO (400623) BY OPTIMA CONSUMER HEALTH LTD

The background and the pleadings

1) On 25 March 2013 Metabolics Ltd (“Metabolics”) filed an application for the series of two trade marks: **OptimEyes** and **OPTIMEYES**. The application was published for opposition purposes on 3 May 2013. The current specification is:

Class 5: Food supplements for eye health.

2) Optima Consumer Health Limited (“OCH”) filed a notice of opposition to the registration of the trade marks based on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), OCH relies on:

i) UK registration 2381978 for the series of trade marks:



It relies on the following goods:

Class 3: Soaps, perfumery, essential oils; cosmetics; hair lotions; toothpaste; non-medicated toilet preparations; non-medicated skin care preparations; non-medicated balms, ointments, creams, powders, gels, lotions and emollients; massage preparations; dentifrices, mouthwashes and other preparations for oral and dental hygiene, for teeth, gum, tongue, mouth and dentures;

Class 5: Pharmaceutical preparations and substances; dermatological products; medicated skin care preparations; dietetic substances adapted for medical use; food for babies; food supplements; vitamins; herbal preparations; fungicides and herbicides.

The marks were filed on 13 January 2005 and the registration procedure completed on 15 July 2005.

ii) UK registration 2198802 for the trade mark:

OPTIMA

It relies on the following goods:

Class 3: Soaps, perfumery, essential oils; cosmetics, hair lotions; toothpaste, dentifrices, mouthwashes and other preparations for oral and dental hygiene for teeth, gum, tongue, mouth and dentures;

Class 5: Dietetic substances; food for babies; vegetable plant extract, all for dietetic purposes.

The mark was filed on 29 May 1999 and the registration procedure completed on 30 June 2000.

iii) Community trade mark (“CTM”) registration 2081693 for the trade mark:

OPTIMA HEALTH

It relies on the following goods:

Class 3: Soaps, perfumery, essential oils; cosmetics, hair lotions; toothpaste, dentifrices, mouthwashes and other preparations for oral and dental hygiene for teeth, gum, tongue, mouth and dentures;

Class 5: Pharmaceutical preparations; dietetic substances, food for babies, plasters, materials for dressings; vegetable plant extract.

The mark was filed on 12 February 2001 and the registration procedure completed on 26 June 2003.

iv) CTM registration 4657714 for the trade mark:

Optima
Health & Nutrition

It relies on the following goods:

Class 3: Soaps, perfumery, essential oils; cosmetics; hair lotions; toothpaste; non-medicated toilet preparations; non-medicated skin care preparations; non-medicated balms, ointments, creams, powders, gels, lotions and emollients; massage preparations; dentifrices, mouthwashes and other preparations for oral and dental hygiene, for teeth, gum, tongue, mouth and dentures;

Class 5: Pharmaceutical preparations and substances; dermatological products; medicated skin care preparations; dietetic substances adapted for medical use; food for babies; food supplements; vitamins; herbal preparations; fungicides and herbicides.

The mark was filed on 17 October 2005 and the registration procedure completed on 1 July 2009.

3) In relation to marks i-iii, OCH made a statement that the marks have been used in respect of all of the goods relied on. This statement is made because the registrations are subject to the proof of use provisions contained in section 6A of the Act. Mark iv is not subject to these provisions so no statement of use was made.

4) In terms of the section 5(3) ground, OCH relies upon the same trade marks but relies upon additional goods, namely:

Class 32: Mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; syrups and other preparations for making beverages.

5) OCH claims that the marks have been used and have a reputation for the goods relied on under section 5(3). It claims that use of Metabolics' marks would take unfair advantage of the reputation of its marks by using the reputation to assist the sale of products. It claims that use of Metabolics' marks will have a negative impact on the image of its marks as OCH would have no control over the quality of the goods. It claims that the use of Metabolics' marks would weaken the distinctive character of its marks and will weaken its ability to "perform its essential function".

6) OCH claims that it has acquired a particular reputation in respect of its marks depicted in blue. It states that Metabolics' marks are in use and that some of that use is in a very similar colour blue to that used by it; it annexes pages from its own website and the website of Metabolics in relation to this. OCH states that the Metabolics' marks comprise the words optim and eyes; optim being, it claims, almost identical to the "essential" element of its trade marks and eyes being descriptive of the goods. It claims that the first trade mark in the series of Metabolics emphasises this construction. OCH claims that the differences between the respective trade marks are either negligible or relate to non-distinctive matter that carries no weight. OCH claims that the same goods, or highly similar goods, are covered by the respective trade marks. OCH claims that owing to the similarity of the trade marks and the identical nature of the goods, or high similarity, there is a likelihood of confusion.

7) Metabolics filed a counterstatement. It requires proof of use of the three earlier registrations that are subject to this proviso. It denies all the grounds and claims of OCH and puts it to proof of its claims. Only OCH filed evidence. Neither side requested a hearing. Both sides filed submissions.

The evidence of OCH

8) This consists of a witness statement by Frederick Whitcomb, a director of OCH. Mr Whitcomb states that he founded OCH's predecessor in title in 1993, sold it to William Ransom & Son Plc in 2008 and purchased it back in 2011.

9) Mr Whitcomb states that OCH has used the trade mark OPTIMA since 1993. He states that it specialises in natural consumer health products, including health supplements, foods and natural cosmetics. Owing to ambiguities in the evidence as to where Optima is used on, or in relation to products, the words of Mr Whitcomb have to be considered very carefully:

“In 1993, I co-founded a business that specialised in importing, manufacturing and marketing natural consumer health products, including health supplements, foods and natural cosmetics. The business traded under the trade mark OPTIMA”

10) The above words indicate that the evidence does not relate just to the use of Optima in relation to products but also in relation to the business of an importer and marketer of products; which is effectively acting as a wholesaler or retailer. Mr Whitcomb states that sales are made from the website of OCH: optimah.com.

11) Annual turnover of OCH in the UK is given as:

2006	not less than £7,507,206
2007	not less than £10,195,260
2008	not less than £10,329,110
2009	not less than £9,495,826
2010	not less than £6,727,865
2011	not less than £5,594,903
2012	not less than £5,863,525
2013 (to 23/10)	not less than £4,647,467

12) Turnover in relation to goods for export is given as:

2006	not less than £672,115
2007	not less than £1,433,175
2008	not less than £2,427,960
2009	not less than £2,300,671
2010	not less than £2,997,421
2011	not less than £3,453,676
2012	not less than £4,583,475
2013 (to 23/10)	not less than £2,737,979

13) Mr Whitcomb states that exhibit FW-1 gives details of annual monetary values of sales under the trade mark OPTIMA in the UK “for national sale and

export” from 2006 to date. The information in the exhibit actually commences in 2007. There is no clear explanation of the information within the exhibit. On page 19 of the exhibit there is a list of 46 codes. These codes are followed by some forms of explanation. Some of the explanations identify the product eg GB stands for Green Bean; others are followed by terms that do not indicate the nature of the product eg BU is followed by raw materials. In the third and final column either “Optima” or “Ignore” appears; without any guidance, it is not possible to understand clearly the meaning of the annotations on page 19. The material exhibited at FW-3 contains publicity for various products. However, in some examples there is no reference to Optima at all.

14) Exhibited at FW-3 is promotional material. Optima cannot be seen on some of the material. The following material is potentially pertinent to the case:

- *Health Food Business* – 1 October 2009, *Health Store Magazine* – Sep to Oct 2009, *TM Magazine* – 1 July 2009 - Australian antiseptic tea tree essential oil; Optima in the stylised format of mark i) appears upon the product.
- *HM Magazine* – December 2008/January 2009 – *Health Food Business* – June 2008 - pomegranate juice; Optima in the stylised format of mark i) appears upon the product.
- *Health Food Business* - June 2008, *Go Healthy* - May/June 2008 - AloeDent dental products – toothpaste, mouthwash, fresh breath spray and floss. It is possible that Optima appears to the left or above AloeDent but even with the aid of a magnifying glass and a bright light it is not possible to be certain about this.
- *Go Healthy* – May/June 2008 – natural sun protection products – Optima cannot be seen on the packaging but the reader is advised that the products are those of Optima in the text explaining the products.
- *Daily Mail* – 1 April 2008 – Australian tea tree antiseptic solution – no reference to Optima can be seen (although it appears to be the same packaging referred to at the first bullet point), a domain name of optimah.com is given for contact.
- *Daily Mail* – 15 May 2007 – Aloe Pura liquid fibre with syrup of figs - no reference to Optima can be seen, a domain name of optimah.com is given for contact.
- *HFB* – August 2005 – a company profile of Optima Health and Nutrition. The article advises that in addition to Optima’s range of Aloe Pura aloe vera products, the company markets and distributes a further 17 brands.

- *HM Magazine* – April 2005 – Aloe Pura aloe vera gel sun protection – Optima cannot be seen on the products, the reader is advised that the products are available from Optima Health and Nutrition.
- *HFB* – December 2005 – 6 products appear, they are described as the best products from Optima Health & Nutrition. Only the pomegranate juice bears the name Optima upon the packaging. The other products shown are Kordel's Phytofemme (a supplement), Aloe Pura products, Thursday Plantation range of skin care products, Activjuice (a supplement) and Ice Guard range of deodorants. The last goods are described as being "Optima's Ice Guard range".
- *Nine to five & Midweek* – 13 June 2005 – an advertorial which includes Aloe Pura sun care, there is no reference to Optima.
- *News of the World* – 22 May 2005 – owing to the size and quality of the copy it is not possible to see any reference to Optima (even with the aid of a magnifying glass).
- *Weight Watchers Magazine* - June 2005 – Aloe Pura organic sun lotion – there is no reference to Optima.
- *OK!* -17 May 2005 – Aloe Dent mouthwash – it is not possible to see any reference to Optima.
- *B Magazine* – July 2005 – Aloe Pura organic sun cream – there is no reference to Optima.
- *Milton Keynes Citizen – Style Magazine* – June 2005 - Aloe Pura organic sun cream – there is no reference to Optima.
- *Woman's Weekly* – 24 May 2005 – a clarification to a previous article advises that the Aloe Pura range from Optima Health & Nutrition is not endorsed by Dr Peter Atherton.
- *Woman's Own* – 6 June 2005 – no reference to Optima can be seen.
- *Yours* – 22 June 2005 – Aloe Pura aloe vera juice – there is no reference to Optima.
- *News of the World* – 5 June 2005 – there is no reference to Optima.
- *Now* – 18 May 2005 – there is no reference to Optima.
- *Chat* – 2 June 2005 - AloeDent toothpaste – there is no reference to Optima.

- *Closer* – 4 to 10 June 2005 – Aloe Dent toothpaste – there is no reference to Optima.
- *Health Plus* – June 2005 – Women’s toothpaste Aloe Dent – there is no reference to Optima.
- *Chat* - 2 June 2005 – there is no reference to Optima.
- *Northern Ireland Early Years* – May/June 2005 – no reference to Optima can be seen.
- *Pregnancy & Birth* – June 2005 – there is no reference to Optima.
- *Woman’s Weekly* – 7 June 2005 – there is no reference to Optima.
- *Chat* – 23 June 2005 – there is no reference to Optima.
- *Daily Mirror* – 16 June 2005 – the following appears: “Optima has launched Aloe Pura Organic Sun Lotion SPF 15 (£8 200ml) and Aloe Pura Organic After Sun Lotion (£5.98, 200ml)”.
- *OK!* – 21 June 2005 – Aloe Pura after sun lotion appears – there is no reference to Optima.
- *Chat* – 12 May 2005 – no reference to Optima can be seen.

15) OCH sells products throughout the UK. Exhibited at FW-2 are copies of invoices that were issued for Optima branded products from 2003 to 2007. The invoices exhibited are not pertinent to the issue of genuine use of the trade marks which are the subject of this requirement, as they were all issued prior to 4 May 2008.

16) Exhibited at FW-4 are examples of promotional material. There is no provenance by way of date or jurisdiction. The following material is exhibited:

- Effervescent herbs, Optima in the stylised format of mark i) appears.
- AloeDent oral care, Optima in the stylised format appears. On pictures of tooth paste and mouthwash, Optima in stylised format appears.
- Aloe Pura aloa vera juices, Optima in stylised format appears on the promotional material for the product, but not on products themselves.
- Brochures for Optima (stylised) Health & Nutrition. In the brochure Optima is used in standard typeface. At pages 368–370 information about Aloe Pura products is given; on pictures of the products, Optima cannot be

seen. Page 371 shows Aloe Dent toothpastes, Optima cannot be seen on pictures of the products. At page 372 pictures of Activejuice products for joints can be seen, Optima in the form of mark i) can be seen on the packaging. On page 373 Allergenics products can be seen. The products are described as being “natural emollient range of products suitable for use on dry, itchy skin conditions such as Eczema and Psoriasis”. The products shown include washes, skin lotions and shampoo. Optima does not appear on the packaging of the products. At page 374 Kordels products are shown, they are described as being the Optima Kordels range. The products shown are supplements. The pictures on the packaging do not show use of Optima. Page 375 shows Thursday Plantation products: deodorant, conditioner, shampoo, face wash, antiseptic cream, antiseptic and anti-fungal gel. The products are described as the Optima Thursday Plantation range. Optima cannot be seen upon any of the pictures of the products. Page 376 shows the Optima Organic Choice range of products, which are supplements. Optima cannot be seen upon the packaging. It can, however, be seen on the writing of the cap seal on one of the bottles that is shown. Page 377 shows Maxicol products for bowel health. Optima in the stylised format of mark i) appears on the packaging of the products. Other products shown in the brochure upon which Optima cannot be seen are: Swiss herbal confectionery, Echinaid supplements, Healthwise supplements, Vital Roobibos tea. Products in the brochure upon which Optima in the mark i) format can be seen are: Musseltone supplements, Olivera soap and Horny Goat Weed complex aphrodisiac.

- The other material in the exhibit from page 386 to 400, shows the following products upon which Optima in the mark i) format is shown: Montmorency cherry juice, lecithin granules, coconut oil, Activejuice for joints and Musselflex for joint maintenance. The advertisement at page 394 advises that the Kordel's range is now called Optima (in the mark i stylisation); a range of supplements are shown being sold under this range. The material in the exhibit from page 386 to 400 does not show use of Optima on the packing of the products for the following goods: Ice Guard deodorants (a handwritten date of 2010 appears), Aloe Pura (a handwritten date of 2010 appears), Green Bean dandelion coffee and hot chocolate drink. On all of the pages from 386 to 400 Optima in the mark i) format appears.

17) Exhibited at FW-5 are galley proofs for packaging. Handwritten at the tops of the pages are 2007, 2008, 2011 and 2011. Page 402 shows a galley proof for a label for Omega 3 + 6 + 9 capsules. The label is in Italian, the brand upon the label is Organic Choice. In relation to the producer of the product Optima Italia Srl is identified and it states that the product was produced in the factory of Optima Health. Page 403 is a galley proof for a label for Optima Musseltone green lipped mussel extract. Page 404 is a galley proof for Optima probiotic formula Maxicol capsules for bowel health. Page 405 is a galley proof for Optima Musseltone gel.

In the last three pages Optima Health or Optima Health & Nutrition appear as the supplier of the goods. Optima, where in use in the brand name, is in the stylised form of mark i).

The proof of use provisions

18) The proof of use provisions apply to earlier marks i-iii. Section 6A reads:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

19) Section 100 is also relevant, it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied, namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“Ansul”) and *Laboratoire de la Mer Trade Marks C-259/02* (“La Mer”). In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the CJEU in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-

2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(3) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(4) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is

appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

21) The proof of use period runs from 4 May 2008 to 3 May 2013. The evidence is not well marshalled. Copies of 315 invoices have been filed, presumably in relation to establishing proof of genuine use, and the latest of them emanates from over one year prior to the beginning of the proof of use period. The examples of publicity cease on 1 October 2009, so within the proof of use period but long before the date of publication. Mr Whitcomb’s commentary does little to distinguish between those goods which do not display an Optima trade mark and those that use another trade mark; the exhibited material shows that on certain of the products Optima cannot be seen in use. Exhibit FRW-1 lacks any explanation, in particular page 19. Exhibit FW-4 for the most part lacks any provenance. It is not a healthy state of affairs when certain of the exhibits have to be interrogated with the aid of a magnifying glass and a strong light; and the contents still cannot be clearly seen in some cases. The marketing to the general public, from the exhibits, has been in the form of advertorials and so not very prominent. Many of the publications from which examples of marketing have been given appear to be aimed at the trade rather than the end consumer.

22) However, despite the reservations I have expressed, it is clear that OPTIMA (particularly in the stylised form, a form which also counts as use of OPTIMA per se) has been used on a number of actual goods and that this can be taken as indicative of the type of use made in the relevant period. Further, the requirement of use is use “in relation to” so it does not have to be on the product or product packaging (unless for export purposes). There are a good many examples of the various OPTIMA marks being used in manner which is so closely related to the products themselves that those signs would be considered as use in relation to the goods. Therefore, when considering the evidence in totality, there was genuine use in the relevant period of all of the trade marks that are subject to proof of use for a variety of food supplements. (The term dietetic substances will include food supplements.)

23) It is necessary to consider how the use should be described; the description of the use shown must not be pernickety¹. It is necessary to consider how the relevant public, would describe the goods and services². The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

¹ *Animal Trade Mark* [2004] FSR 19

² *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

24) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

25) The use shown relates to a variety of food supplements which represents a recognisable category of goods. It would be pernicky to limit the goods to food supplements containing particular substances or for particular purposes. **Consequently, a fair specification is food supplements. As these goods encompass the goods of the application (food supplements for eye health) and so are identical, OCH cannot be in a better position in relation to any other goods and so it is not necessary to consider genuine use in relation to the other goods of the registrations.**

Section 5(2)(b) of the Act

26) Section 5(2)(b) of the Act 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.”

27) The CJEU has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

“(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, in certain circumstances, be dominated by one or more of its components;

(f) 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 of that mark;

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

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

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

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

(k) if the association between the marks 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."

The goods comparison

28) As stated in paragraph 25, the goods are identical.

The average consumer

29) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention they use can vary depending on what is involved. The average consumer for food supplements is the public at large. The relevant public will wish to purchase products for particular conditions or to have particular physiological effects. Consequently, the purchase is likely to be a reasonably careful one.

30) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

31) Food supplements will normally be bought from the shelves of stores or via the Internet where the visual impression will be important. Persons seeking food supplements may well ask shop assistants in health food shops and the like to give advice about the products, however, they are more likely to be asking about particular physical conditions or particular compounds, rather than referring to brands by name. Therefore, whilst it would be incorrect to ignore aural similarity completely, visual similarity will be of greater importance.

Comparison of the marks

32) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. If OCH does not succeed in relation to OPTIMA, word only, it will not succeed in relation to the other trade marks on which it relies as they have other matter that distances them from Metabolics' marks. In the first instance I will compare OPTIMA with the first mark in the applied for series:

OptimEyes v OPTIMA

33) From a conceptual perspective, OCH submits that the word OPTIMA has no meaning. This is not, strictly speaking, true because Collins English Dictionary defines OPTIMA as the plural of Optimum. However, I think it would be unsafe to conclude that the average consumer is aware of this dictionary definition. The average consumer will see it as a made up word, but, nevertheless, they may also realise that it is based upon and has the same root as words such as optimal, optimum etc. In terms of OptimEyes, I can see that the whole mark creates a play on words with the word OPTIMISE. However, in the context of consumers purchasing food supplements in the normal course of trade, I am unconvinced that the play on words will leap out, so meaning that the mark will most likely be perceived as the word Optim (another invented word perhaps with the same root as optimal etc) conjoined to the word Eyes (being descriptive of the goods). As Optim/OPTIMA are invented, it would be difficult to find that there is a high degree of conceptual similarity, but the possible shared root provides a degree of similarity. I accept that the average consumer is a legal construct, so it is possible that a range of views on concept will exist. For some the play on words may be more apparent which means that the concepts are different, however, as both still have the same root then such a difference is not a strong one.

34) From a visual perspective, both marks coincide in relation to the letters OPTIM at the start of the marks. Owing to the addition of the Eyes element in Metabolics' trade mark, and the addition of the letter A to OCH's trade mark, the degree of similarity is reduced. I consider there to be a moderate degree of visual similarity.

35) From an aural perspective, the respective marks commence with the same two syllables which will be pronounced in the same manner (as in optimum), so OPT-IM or OP-TIM. The last vowel of OPTIMA will be pronounced as the "ar" in tar or car, or, alternatively, with an "uh" sound. The second element of Metabolics' mark will be pronounced as "ize" as in size. There is a degree of aural similarity but, particularly taking into account the effect of the Eyes element, the similarity is, again, moderate.

36) In relation to the second mark in the series, the comparison is between:

OPTIMEYES v OPTIMA

37) Notional and fair use of the marks must be considered. In my view, a notional and fair use of OPTIMEYES would be in the same manner as the first mark in the series, the upper and lower casing falling where the mark breaks naturally i.e. OPTIM and EYES. In view of this the same analysis as above is applicable. However, even if I am wrong on that then the aural assessment made

with regard to the first mark is the same. The degree of visual similarity may be slightly reduced given that OPTIM does not stand alone, but this is fairly marginal and there would still be a moderate degree of visual similarity. From a conceptual point of view, some will still see the mark as OPTIM and EYES conjoined whilst others will see it as an invented word reminiscent of OPTIMISE. So the assessments I have already made are also applicable.

The distinctiveness of the earlier mark

38) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The trade mark will be seen as an invented word although, as stated earlier, it may be seen as having a mild allusion to the laudatory words optimum, optimal etc. The illusion is though mild and I consider the earlier mark to possess a reasonable degree of distinctiveness. Owing to the failings in the evidence it is not possible to find that the distinctiveness of the earlier trade mark has been increased by use. Reference is made by OCH to the colour blue it uses and that Metabolics' use a similar colour blue. However, the evidence presented by OCH does not demonstrate that the colour blue is particularly associated with it, so I do not consider this claim gets off the ground.

Likelihood of confusion

39) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether confusion is likely.

40) It is necessary to consider the interdependency principle – a lesser degree of similarity between the marks may be offset by a greater degree of similarity between goods, and vice versa. In this case the respective goods are identical. The concept of imperfect recollection is also important, although its effects are somewhat reduced (although not completely reduced) given the reasonably careful purchasing process. In relation to the first mark in the series, OptimEyes, the similarity between OPTIMA and the Optim element is close and may be perceived as having the same conceptual root. Even though it reduces the level of similarity, the addition of the word Eyes is not, bearing in mind the goods of interest to the applicant, sufficient to enable the average consumer to distinguish between the marks in an economic sense. Therefore, even if the average consumer realised that the marks are not the same, the similarities between them will nevertheless be put down to the responsible undertakings being the same or being related. Even for those who immediately see a play on words, this added

factor is still not enough as an economic link will still be assumed due to the similarity between OPTIM and OPTIMA. **There is a likelihood of confusion in relation to the first mark in the series.**

41) In relation to the second mark in the series, OPTIMEYES, I stated earlier that the notional and fair use of this mark would include that of the first. **Therefore, there must also be a likelihood of confusion in relation to this mark.** However, even if I am wrong in relation to the position on notional use, there is still a moderate degree of visual and aural similarity, which, bearing in mind the concept of imperfect recollection, and notwithstanding the degree of care taken during purchase, will, in my view, still lead to a likelihood of confusion.

Section 5(3) of the Act

42) It is not strictly necessary to comment on this ground given that the opponent has already succeeded. However, I express my brief view that the opponent would have failed under this ground. For the purpose of section 5(3) of the Act, OCH must establish that at the date of the filing of the application its mark(s) had a reputation i.e. that its marks were known by a significant part of the public concerned by the products covered (as per the judgment of the CJEU in *General Motors Corporation v Yplon SA*); in the same case the CJEU stated how a party would establish this reputation:

“27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

43) There is no indication as to the market share. The turnover figures appear quite large but without an indication of the market it is not possible to contextualise them. The others criticisms regarding the evidence made earlier are also applicable. **Taking into account all these issues with the evidence, OCH has not established that it has the requisite reputation for the purpose of section 5(3) of the Act.**

Costs

44) OCH having been successful, I consider it appropriate to make an award in its favour on the basis of the standard scale:

Official fee – £200

Preparing a statement and considering the other side's statement - £300

Preparing evidence - £700

Written submissions - £400

45) I hereby order Metabolics Ltd to pay Optima Consumer Health Ltd the sum of £1600. This should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of May 2014

**Oliver Morris
For the Registrar
the Comptroller-General**