

BL O/028/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3301469

BY

FIVE PERCENT NUTRITION, LLC

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION THERETO (NO. 600000914)

BY

5 PERCENT NUTRITION LIMITED

Background and pleadings

1. FIVE PERCENT NUTRITION, LLC (the applicant) applied to register the trade mark:



in the UK on 04 April 2018. It was accepted and published in the Trade Marks Journal on 27 April 2018, in respect of the following goods:

Class 05: Dietary and nutritional supplements.

2. 5 Percent Nutrition Limited (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is raised against all of the goods applied for. The opposition is based on an earlier UK Trade Mark, namely:

UK 3121806, filed on 11 August 2015 and registered on 06 November 2015, for the mark:

5% Nutrition

The opponent's earlier mark is registered in several classes, however, for the purposes of this opposition, the opponent relies only on the goods covered under the class 05 element of its earlier UK mark, namely:

Class 05: Pharmaceutical and veterinary preparations; Sanitary preparations for medical use; Dietetic food and substances adapted for medical or veterinary use; Dietary supplements for humans and animals; all supplements

for humans and animals; Supplements; Supplements, medical and non-medical used in combination with fitness, nutrition, health and sports; supplements for humans and animals, beverages, powders, vitamins, minerals, solids, liquids and gases.

3. In its statement of grounds, the opponent claims that due to the stylised way in which the name 'Rich Piana' is presented, that element of the mark is difficult to read. The dominant part of the applied for mark is '5% NUTRITION'. The goods are the same and so the end-user will be the same. Regardless of what might be placed in front of 5% NUTRITION, it would not be enough to disassociate itself from the earlier brand name. Confusion would certainly occur.
4. In its counterstatement, the applicant denies all of the claims of the opponent and states that the marks and goods are not similar and confusion or association would not arise.
5. The opponent provided written submissions which will not be summarised here, but will be referred to later in this decision if necessary.
6. No hearing was requested and so this decision is taken following a careful perusal of the papers.
7. Throughout the proceedings the applicant has been represented by Katarzyna Eliza Binder-Sony. The opponent has represented itself.

Decision

Section 5(2)(b) of the Act

8. 5(2)(b) of the Act states:

“(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.”

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

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

12. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, Case T- 133/05, the General Court 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 für 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”.

13. The parties’ respective specifications are:

| Earlier marks | Application |
|--|--|
| <p>Class 05: Pharmaceutical and veterinary preparations; Sanitary preparations for medical use; Dietetic food and substances adapted for medical or veterinary use; Dietary supplements for humans and animals; all supplements for humans and animals; <u>Supplements</u>; Supplements, medical and non-medical used in combination with fitness, nutrition, health and sports; supplements for humans and animals, beverages, powders, vitamins, minerals, solids, liquids and gases.</p> | <p>Class 05: Dietary and nutritional supplements.</p> |

14. The applied for goods ‘*Dietary and nutritional supplements*’ are wholly contained under the term ‘*Supplements*’ within the opponent’s earlier mark, which encompasses all types of supplements including those used for dietary or nutritional purposes. The goods at issue are identical.

Average consumer and the purchasing act

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

16. 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.”

17. To my mind, the average consumer of dietary and nutritional supplements will be a member of the general public.

18. The average consumer will purchase the goods at issue in the traditional manner, from retail outlets such as supermarkets, high street shops and retail outlets specialising in supplements, or online using retail websites. The selection of these goods will generally be a visual process however, it cannot be discounted that purchases will be made aurally through discussion with sales assistants.

19. As the goods at issue are day to day items, the level of attention paid by the average consumer will generally be normal, however it may be the case that a part of the relevant public will take a higher than normal level of care and attention at the point of selection, due to the nature of the goods at issue.

Comparison of marks


20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

The 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:

| Earlier marks | Contested trade mark |
|--|--|
| <p data-bbox="256 1317 603 1370">5% Nutrition</p> |  The contested trade mark logo features the name 'Rich Piana' in a cursive script at the top. Below it, the number '5%' is written in a large, bold, black font. Underneath the '5%', the word 'NUTRITION' is written in a smaller, spaced-out, sans-serif font. |

23. The opponent’s mark is comprised solely of the verbal element ‘5% Nutrition’. As no one element can be said to dominate the mark, the overall impression of this mark lies in its totality.

24. The applicant’s mark is comprised of the stylised verbal elements ‘Rich Piana’ and ‘5% NUTRITION’. The element ‘5%’ is placed at the centre of the mark and is presented in a much larger size than the other elements in the mark, which allows

that element to dominate the mark. As such the overall impression of the applied for mark is dominated by the element '5%'.

Visual similarity

25. Visually, the respective marks are similar inasmuch as they share the elements '5%' and 'NUTRITION'. They differ visually in the words 'Rich Piana' in the later mark which are presented in a stylised, signature style font. The element '5%' in the later mark is, due to its larger size and prominent central position, deemed to be dominant in that mark. Beneath the '5%' element is the word 'NUTRITION' in smaller but clearly legible standard lettering. The words 'Rich Piana' in the later mark are placed above the dominant element '5%' and is also presented in smaller lettering. The marks are considered to be visually similar to at least a medium degree.

Aural similarity

26. Aurally the earlier mark '5% Nutrition' is wholly contained within the later mark. The marks differ in the words 'Rich Piana' of the later mark, which has no counterpart in the earlier mark. The marks are considered to be aurally similar to a medium degree.

Conceptual similarity

27. The earlier mark is comprised of the element '5%' and the word 'Nutrition'. The element '5%' relates to the concept of percent, which is commonly represented by the globally understood symbol '%'. Percent refers to a part of 100. In this instance the element '5%' will be understood to refer to 5 parts from a total of 100. The word 'Nutrition' refers to the process of taking food into the body and absorbing the nutrients in that food. The more nutritious a foodstuff, the healthier it is. The earlier mark, as a whole, will be considered to be vague and allusive when considered in the context of dietary and nutritional supplements. The average consumer will understand both elements of the mark separately, but will appreciate that the whole mark is either meaningless, or that it suggests that only 5% of the product contains any nutrition.

28. The later mark also contains the elements '5%' and 'NUTRITION', which will be interpreted in the same way as in the earlier mark, and the stylised element 'Rich Piana' which may possibly be perceived as a fortified ingredient in the goods due to the common word 'Rich', although this is unlikely as the word 'Piana' has no meaning in English. The element '5% NUTRITION' will either be considered to be meaningless, or indicating that only 5% of the product contains any nutrition.
29. The marks to hand can be said to be conceptually identical for that part of the relevant public for which the element '5% Nutrition' is perceived as a descriptive message. For that part of the relevant public which does not perceive any meaning at all from the element '5% Nutrition', the marks have no concept.

Distinctive character of the earlier trade mark

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31. The opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character. I must therefore assess the mark purely on its inherent distinctive character.

32. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

33. The earlier mark ‘5% Nutrition’ can be said to be an allusive and impenetrable expression which, at first sight, may appear to be somewhat weak in respect of goods that have an association with food, health or nutrition. However, it is apparent that the term, as a whole, creates an impact which may be perceived as the opposite of a laudatory expression and is thereby inherently distinctive to at least an average degree.

Likelihood of Confusion

34. 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 they are likely to be confused.
35. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).
36. The marks have been found to be visually and aurally similar to a medium degree and either conceptually identical or having no conceptual impact at all.
37. The goods applied for have been found to be identical to the opponent's goods.
38. The goods concerned are day to day products and as such the level of attention being paid by the consumer during the selection process will generally be no higher than normal. It is possible however, that a part of the relevant public may take more care when selecting the goods at issue as they are intended to be ingested by the user.
39. During the selection process the visual impact of the marks will carry most weight, however the potential for an aural selection cannot be ruled out.
40. Taking all of the aforesaid into account, I find that the visual and aural differences between the marks are such that they will be perceived by the average consumer. Consequently, I am satisfied that direct confusion will not occur i.e. the relevant public will not mistake the earlier mark for the later one, or vice-versa.

41. Having found that direct confusion will not occur when the average consumer is faced with one of the marks to hand, having previously encountered the other, I now go on to consider whether the average consumer, would consider the common elements in the marks and determine, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking, thereby indirectly confusing the marks.

42. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

43. These examples are not exhaustive, but provide helpful focus.

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

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

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

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

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

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

45. I believe that the average consumer will perceive the applied for mark as a composite mark made up of two distinctive signs, where the element ‘5% Nutrition’ plays an independent distinctive role in the later mark. I do not accept that the average consumer would perceive the mark ‘Rich Piana 5% NUTRITION’ as a unit having a different meaning to the meanings of the separate components

46. Consumers of nutritional supplements are used to seeing promotional and marketing terms as part of, or alongside, brand names, often combined with laudatory expressions or claims, intended to entice the consumer into making a purchase. The earlier mark ‘5% Nutrition’ does not appear to fall into this kind of strategy. If anything, the term may be perceived as a negative, with only 5% of the product claimed to be nutritious or concerned with the user’s nutrition.

47. I find that, as the dominant parts of the marks are identical in nature, and the goods at issue are also identical, these marks will be indirectly confused.

48. I find therefore, that there is a likelihood of confusion.

Conclusion

49. The opposition is successful. Subject to appeal, the application is refused for all of the applied for goods.

Costs

50. The opponent has been successful and is entitled to a contribution towards its costs.
51. It is noted that the opponent has submitted a costs pro forma outlining the number of hours spent on these proceedings. The pro forma provided by the opponent covers the time spent on this opposition case and a highly similar parallel case, namely Opposition 600000913. The opponent's personal time spent on both cases amounts to 13 hours in total. In light of this, I have made a single award of costs in relation to Opposition 600000913 reflecting the total time spent on both cases, to the opponent in respect of the parallel case. I will not duplicate the award of costs here, as it would be unreasonable to do so.
52. The opponent is however entitled to costs for the time spent in the preparation and submission of the TM7 in this case. I therefore award the opponent a nominal sum of £50 to cover administration and time spent on that task. The opponent is also entitled to the fee that it paid to file the opposition, which was £100.
53. I therefore order FIVE PERCENT NUTRITION, LLC to pay 5 Percent Nutrition Limited the sum of £150. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 15th day of January 2019

**Andrew Feldon
For the Registrar
The Comptroller-General**