

O/0228/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3662699
BY RADNOR HILLS MINERAL WATER COMPANY LIMITED**

TO REGISTER:



VITs

AS A TRADE MARK IN CLASSES 5 & 32

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 428666 BY
VIT HIT LIMITED**

BACKGROUND AND PLEADINGS

1. Radnor Hills Mineral Water Company Limited (“the applicant”) applied to register the trade mark shown on the front cover of this decision in the United Kingdom on 30 June 2021. The application was accepted and published on 24 September 2021 in respect of goods in Classes 5 and 32. Following an amendment filed on 29 March 2022, the specification is as follows:

Class 5

Vitamin drinks.

Class 32

Non-alcoholic beverages and soft drinks; mineral water, spring water, drinking water; aerated water, carbonated water; non-alcoholic carbonated drinks; fruit flavoured carbonated drinks; fruit drinks; fruit juice beverages; fruit juices; fresh fruit juices; beverages consisting of a blend of fruit and vegetable juices; juice drinks; flavoured waters; aerated mineral waters; carbonated and non-carbonated fruit drinks; bottled fruit drinks; waters [beverages]; bottled water; flavoured mineral water; bottled drinking water; drinking spring water; drinking mineral water; preparations for making mineral water; essences for flavouring mineral water [not in the nature of essential oils]; preparations for making aerated water; mineral enriched water; beverages containing vitamins; vitamin fortified non-alcoholic beverages; non-alcoholic drinks enriched with vitamins and mineral salts; syrups and other preparations for making beverages.

2. On 1 December 2021, the application was opposed by VIT HIT LIMITED (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods in the application.

3. Under section 5(2)(b), the opponent is relying on the following marks:

Earlier Mark	Goods Relied Upon
UKTM No. 903840411 (“the 411 mark”) VIT HIT Filing date: 19 May 2004 Priority date: 16 April 2004 ¹ Registration date: 11 June 2009	<u>Class 32</u> <i>Non-alcoholic drinks, fruit drinks and fruit juices.</i>
UKTM No. 915991219 (“the 219 mark”) VIT HIT Filing date: 3 November 2016 Registration date: 31 March 2017	<u>Class 5</u> <i>Vitamin drinks, vitamin supplements, vitamin preparations, effervescent vitamin tablets; effervescent vitamin powders.</i>

4. Both these marks are comparable marks. As a result of the opponent’s EU Trade Mark (“EUTM”) Nos 3840411 and 15991219 being protected as at the end of the Implementation Period (11pm on 31 December 2020), comparable UK trade marks were automatically created under Article 54 of the Withdrawal Agreement. The comparable UK marks now recorded on the UK Trade Mark Register have the same legal status as if they had been applied for and registered under UK law, and retain their original filing and priority dates. These marks qualify as earlier marks under section 6 of the Act and the 411 mark is subject to the proof of use requirements specified in section 6A of the Act.

5. The opponent claims that the marks are highly similar and that the applicant’s goods are identical or at least highly similar to goods covered by the earlier marks, such that there is a likelihood of confusion, including a likelihood of association, between the marks. It also claims that the earlier marks enjoy an enhanced level of distinctive character acquired through the use made of them, and that this increases the likelihood of confusion.

¹ Priority is claimed from Irish Trade Mark No. 2004/00878.

6. Under section 5(3), the opponent is relying on the 411 mark and claims that it has an extensive reputation for the goods relied on under section 5(2)(b) and that the similarity between the marks will, in the light of this reputation, create a link in the mind of the consumer. It claims that use would be without due cause and that damage would occur in one of the following ways:

- The applicant would gain an unfair advantage through free-riding off the reputation of the opponent;
- The use by the applicant of the dominant and distinctive “VIT” risks damaging the distinctive character of the opponent’s mark, by leading consumers to believe that “VIT” is a common term in the field;
- The consumer is likely to perceive goods bearing the contested mark as emanating from the same or related source of origin as the opponent’s goods, and may alter their economic behaviour; and/or
- The use of the contested mark would be detrimental to the repute of the opponent’s mark as the opponent would have no control over the quality of the goods offered under the contested mark.

7. Under section 5(4)(a), the opponent claims to have used the sign **VIT HIT** throughout the UK since 2004 for *Non-alcoholic beverages being enriched by vitamins and fruit and/or tea* and to have built up a significant goodwill, which is protectable within the UK under the law of passing off. Use of the contested mark would amount to a misrepresentation that the goods were associated with the opponent and consequently there would be a risk of damage.

8. The applicant filed a defence and counterstatement on 14 February 2022. It admits that there is some similarity between the parties’ goods and that the letters “VIT” are common in both marks, but denies that “VIT” is the most dominant element of, or plays an independent distinctive role in, the earlier marks. It denies all the rest of the opponent’s claims and puts the opponent to proof of use of the 411 mark.

9. Both parties filed evidence, which is briefly detailed below. Neither side requested a hearing, and both parties filed written submissions on 24 November 2022. I have taken this decision following a careful consideration of the papers.

10. In these proceedings, the opponent is represented by Tomkins & Co. and the applicant by Marks & Clerk LLP.

EVIDENCE

11. The opponent's evidence in chief comes from Mr Ryan Hacker, Director of VIT HIT UK LIMITED, a subsidiary of the opponent. He has held the position of UK Sales Director at the company since August 2017. His witness statement is dated 13 May 2022 and goes to the use made of the earlier marks.

12. The applicant's evidence comes from Megan Rannard, a Chartered Trade Mark Attorney at the applicant's representatives, Marks & Clerk LLP. Her witness statement is dated 13 July 2022 and presents evidence of the use of the verbal element "VIT" in the beverage market.

13. The opponent's evidence in reply comes from Neil Ritchie, a Chartered Trade Mark Attorney and Associate at the opponent's representatives, Tomkins & Co. His witness statement is dated 15 September 2022 and replies to the applicant's evidence.

DECISION

Proof of Use

14. Section 6A of the Act is as follows:

“(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section '*the relevant period*' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

...”

15. As the 411 mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.”

16. Section 100 of the Act is as follows:

“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.”

17. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):²

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

² Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the implementation period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts, although the UK has left the EU.

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the

mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

18. The relevant period is the five-year period ending with the application date for the contested mark, i.e. 1 July 2016 to 30 June 2021. As the 411 mark is a comparable mark, the relevant territory is the EU up to IP Completion Day and the UK thereafter.

19. The opponent's founder created the VIT HIT range of non-alcoholic drinks in 2000 with the aim of producing healthy drinks that tasted as good as, or better than, sugary alternatives.³ The drinks shown in the evidence are a blend of water, juice, tea and vitamins.

20. For the opponent, Mr Hacker states that his company's products have been sold in the UK since 2013, either through authorised retailers (including Sainsbury's, Tesco, Boots, WH Smith and Asda) or directly from the opponent itself.⁴ Since 2015, the drinks have also been sold on the amazon.co.uk platform.⁵ UK turnover for drinks bearing the earlier mark is shown in the table below:⁶

Year	Turnover in GBP £	Number of units
2017	1,855,758	3,280,536
2018	3,004,951	4,901,508
2019	3,520,691	5,859,648
2020	2,152,810	3,707,160
2021	4,145,118	7,042,092

21. A selection of 49 invoices dated from 30 June 2016 to 5 May 2021 shows sales of products bearing the mark to customers in the UK. Only one of these falls outside the relevant period. While the names of the customers have been redacted, the value of the invoices (from £2,451.46 to £203,980.37) suggests that these are sales to retailers.⁷

22. An article from *The Irish Times* dated 3 September 2018 entitled "Healthy soft drink developed by Dubliner proves a hit in the UK" said that "*The range is the second best-selling healthy drink brand in Britain in the so-called 'functional beverage' category, which covers soft drinks that purport to have health benefits.*"⁸

³ Witness statement of Ryan Hacker, paragraph 6.

⁴ Paragraph 12.

⁵ Paragraph 14.

⁶ Paragraph 9.

⁷ Exhibit RH5.

⁸ Exhibit RH21, page 1.

23. Mr Hacker states that the drinks are also available in various EU markets including Ireland, France, Portugal, Spain, Denmark, Sweden, Belgium and the Netherlands.⁹

24. Throughout the relevant period, the mark has appeared on the bottles as shown in the following screenshot from the opponent's website dated 17 September 2017:¹⁰

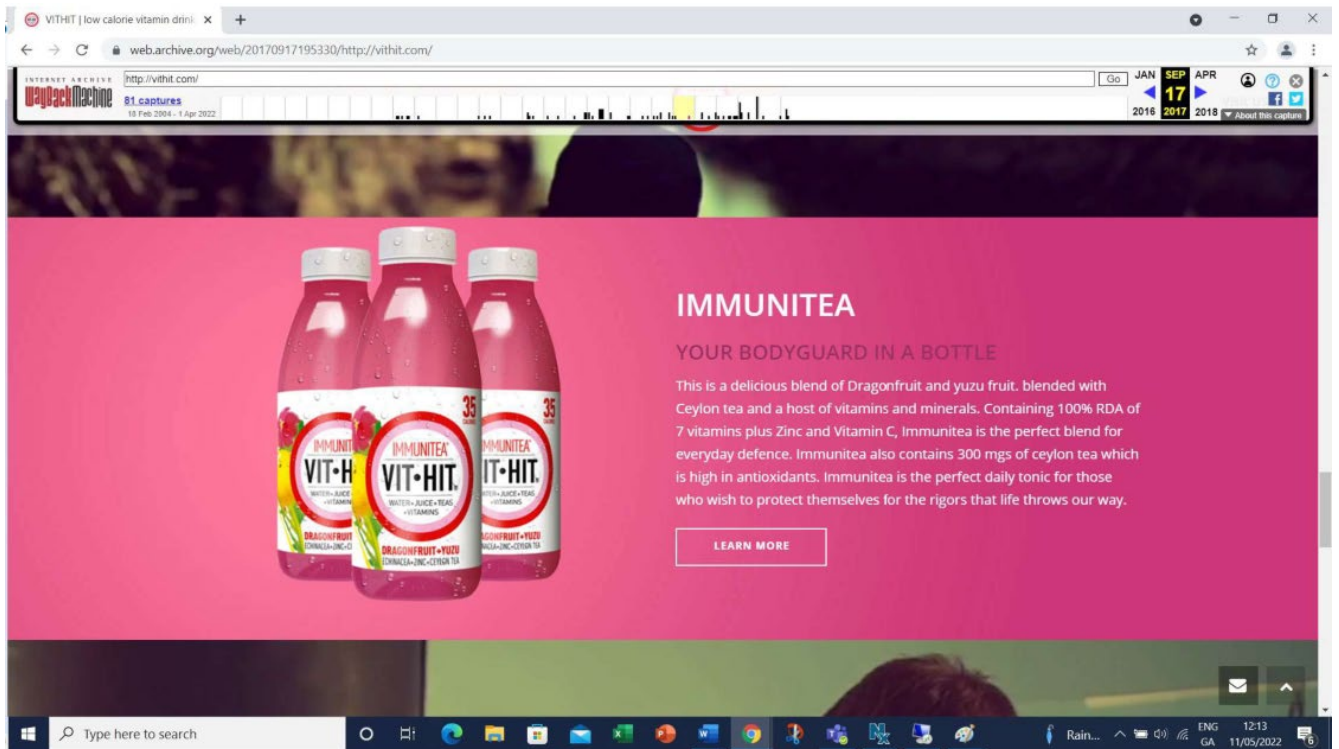


Exhibit RH4 also includes screenshots from 22 January 2019 and 2 February 2021 showing the mark. An earlier screenshot from 6 February 2005 shows the mark but not any products.

25. The products are promoted through editorial advertising in trade publications, such as *The Grocer* on 28 November 2017, *TalkingRetail* on 29 January 2020 and *Convenience Store* on 18 March 2021. The articles all show images of the bottled drink as below:¹¹

⁹ Paragraph 12.

¹⁰ Exhibit RH4, page 25.

¹¹ Exhibit RH19.

Vithit expands listings in convenience channel

By Ellis Cronin in Soft Drinks © 29th January 2020

Functional drinks brand Vithit will be available to Londis and Budgens stores nationwide from March this year.



26. The opponent attended the Lunch! trade show in 2017, 2018 and 2019.

27. The drinks have also been promoted to end-consumers. Exhibit RH20 contains an image of a full-page advertisement placed in *The Mail on Sunday* on 8 May 2016 promoting the products and showing that they were available for purchase in Tesco, Boots and Superdrug. The opponent has also provided an undated image of in-store advertising in WH Smith.¹² It was a sponsor at the Gold Coast Oceanfest music festival at Croyde Bay in Devon in 2017 and has promoted its drinks at Freshers' events at universities since 2015.¹³ In addition, it has offered sampling at railway stations and other areas with high footfall. The image below was taken in London in 2019.¹⁴



¹² Exhibit RH18.

¹³ Exhibits RH24 and RH25.

¹⁴ Exhibit RH26, page 1.

28. One of the opponent's varieties, VIT HIT Lean and Green, won the Best Functional Drink award at the InnoBev Global Soft Drinks Awards in 2018.¹⁵

29. On the basis of this evidence, the applicant accepts that the opponent has made genuine use of its earlier mark, and that the forms used are acceptable variants of the mark as registered, for non-alcoholic beverages flavoured with tea, and herbal and fruit-flavoured non-alcoholic drinks. However, it submits that the opponent has not shown genuine use in relation to *Fruit juices* and that there are no proper reasons for non-use. While the opponent's drinks do include fruit juices as an ingredient, I agree with the applicant that no use has been shown for fruit juices *per se*.

30. The applicant submits that the specification that the opponent can rely on should be narrowed to cover only those goods which the evidence shows that they have sold, "namely non-alcoholic beverages flavoured with teas, herbs and fruit".¹⁶ I must therefore decide on a fair specification.

31. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

"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."¹⁷

32. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J said:

¹⁵ Exhibit RH6.

¹⁶ Applicant's written submissions in lieu of a hearing, paragraph 28.

¹⁷ Pages 10-11.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different

from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”¹⁸

33. The term *Non-alcoholic drinks* is a broad term that includes a number of subcategories of goods that are capable of being viewed independently. The evidence shows that the opponent produces a particular type of drink that is made from a blend of water, fruit juice and tea extracts and are fortified with vitamins, minerals and/or herbs, and is marketed as being a healthy soft drink. In my view, the average consumer would describe these as *Non-alcoholic drinks fortified with vitamins*.

34. The opponent is also able to rely on the mark in relation to the goods for which the applicant has conceded use has been shown. These are Non-alcoholic beverages flavoured with tea and Herbal and fruit flavoured non-alcoholic drinks. I have considered the applicant’s submissions on what it sees as a fair specification (*non-alcoholic beverages flavoured with teas, herbs and fruit*) but this is narrower than the concession that it has made, only covering beverages that are flavoured with all three of those types of ingredients. I am mindful of the need not to cut down protection to just those goods for which the mark has been used. The average consumer would perceive the opponent’s drinks as belonging to the category of fruit-flavoured drinks.

35. In my view, a fair specification for the 411 mark is:

Class 32

Non-alcoholic drinks fortified with vitamins; non-alcoholic drinks flavoured with tea; non-alcoholic drinks flavoured with fruit.

Section 5(2)(b)

36. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because –

¹⁸ Paragraph 47.

...

(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.”

37. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings 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; and
- k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

38. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These may include the nature of the goods, their purpose, their

users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods are complementary when

“... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”¹⁹

39. The goods to be compared are shown in the table below:

Earlier goods	Contested goods
<u>Class 5</u> <i>Vitamin drinks, vitamin supplements, vitamin preparations, effervescent vitamin tablets; effervescent vitamin powders.</i>	<u>Class 5</u> <i>Vitamin drinks.</i>
<u>Class 32</u> <i>Non-alcoholic drinks fortified with vitamins; non-alcoholic drinks flavoured with tea; non-alcoholic drinks flavoured with fruit.</i>	<u>Class 32</u> <i>Non-alcoholic beverages and soft drinks; mineral water, spring water, drinking water; aerated water, carbonated water; non-alcoholic carbonated drinks; fruit flavoured carbonated drinks; fruit drinks; fruit juice beverages; fruit juices; fresh fruit juices; beverages consisting of a blend of fruit and vegetable juices; juice drinks; flavoured waters; aerated mineral waters; carbonated and non-carbonated fruit drinks; bottled fruit drinks; waters [beverages]; bottled water; flavoured mineral water; bottled drinking water; drinking spring water; drinking mineral water; preparations for making mineral water; essences for flavouring mineral water [not in the nature of essential oils]; preparations for making aerated water; mineral enriched water; beverages containing vitamins; vitamin</i>

¹⁹ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Earlier goods	Contested goods
	<i>fortified non-alcoholic beverages; non-alcoholic drinks enriched with vitamins and mineral salts; syrups and other preparations for making beverages.</i>

40. In construing the meaning of the above terms, I shall be guided by the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”²⁰

Class 5

41. *Vitamin drinks* appears identically in both specifications.

Class 32

42. The contested *Vitamin fortified non-alcoholic beverages* are self-evidently identical to *Non-alcoholic drinks fortified with vitamins*.

²⁰ Paragraph 12.

43. Goods may also be considered as identical when one party's goods are included in a more general category covered by the other party's mark: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. The contested *Non-alcoholic beverages and soft drinks* includes the terms on which the opponent may rely and so they are, in the light of the aforementioned case law, identical.

44. I shall consider the following terms as a group, as permitted in *SEPARODE Trade Mark*, BL O-399-10, paragraph 5: *Mineral water, spring water, drinking water; aerated water, carbonated water; aerated mineral waters; waters [beverages]; bottled water; bottled drinking water; drinking spring water; drinking mineral water; mineral enriched water*. These drinks are consumed to quench thirst, as are the opponent's *Non-alcoholic drinks flavoured with tea* and *Non-alcoholic drinks flavoured with fruit*. The users will be the same and the goods are likely to be sold in the same retail outlets, frequently fairly close together. The goods are in competition with each other, but are not complementary. I find that they are similar to at least a medium degree.

45. The applicant's *Non-alcoholic carbonated drinks* includes carbonated drinks that are also covered by the opponent's *Non-alcoholic drinks flavoured with fruit*. They are identical per *Meric*.

46. The contested *Fruit flavoured carbonated drinks; carbonated and non-carbonated fruit drinks* and *bottled fruit drinks* would be included in the opponent's *Non-alcoholic drinks flavoured with fruit* and be identical per *Meric*.

47. I consider that the applicant's *Fruit drinks* would include the opponent's *Non-alcoholic drinks flavoured with fruit* and be identical per *Meric*. If I am wrong in this, and the applicant's term implies more than just a flavouring, they are highly similar.

48. In my view, the natural and ordinary meanings of the contested *fruit juice beverages; beverages consisting of a blend of fruit and vegetable juices; juice drinks; fruit juices; fresh fruit juices* comprise drinks that are wholly or predominantly composed of fruit juice (or fruit and vegetable juice). This is in contrast to the goods on which the opponent may rely. Those drinks will contain other ingredients and the fruit content of the beverage may be relatively small. Their primary purpose is to quench

thirst, although I accept that they may also be consumed in order to obtain important nutrients, including vitamins. The users are the same and the goods will be sold in the same retail outlets, frequently fairly close together. There is competition between them, but they are not complementary. I find that they are highly similar.

49. Goods covered by the contested *Flavoured waters; flavoured mineral water* are included in the broader categories of *Non-alcoholic drinks flavoured with teas* and *Non-alcoholic drinks flavoured with fruit* and so are identical per *Meric*.

50. The applicant's *preparations for making mineral water; essences for flavouring mineral water [not in the nature of essential oils]; preparations for making aerated water; syrups and other preparations for making beverages* are ingredients added to liquids such as water to produce beverages. I shall compare them to the opponent's *Non-alcoholic drinks flavoured with teas* and *Non-alcoholic drinks flavoured with fruit*. They are generally used by producers of beverages, but may also be purchased by members of the general public. Consequently, the users overlap. There will also be a degree of overlap in trade channels. The method of use differs: the applicant's goods are not drunk on their own, but are combined with other ingredients to produce the finished beverage. I do not find that the goods are complementary in a trade mark sense, but there may be a small degree of competition as the end consumer may choose between a ready-prepared tea- or fruit-flavoured drink or buy the flavourings and other ingredients to make their own. Overall, I find that the goods are similar to a low degree.

51. The applicant's *beverages containing vitamins* and *non-alcoholic drinks enriched with vitamins and mineral salts* include the opponent's *Non-alcoholic drinks fortified with vitamins*, and so are identical per *Meric*.

Average consumer and the purchasing process

52. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”²¹

53. Both parties agree that the average consumer will be a member of the general public exhibiting a relatively low level of attention. I agree: the goods are low in cost and purchased fairly frequently, which point towards a lower degree of attention. However, the applicant also submits that, where the goods are *Vitamin drinks* or vitamin-infused beverages, the average consumer will pay more attention as these goods are purchased by those members of the public who have a particular interest in the health benefits of products. I accept that they will be more attentive than the purchaser of non-alcoholic drinks in general, but I do not consider that they will be paying any more than a medium level of attention.

54. The goods will be chosen from the shelf or a chilled cabinet in retail outlets such as supermarkets or convenience stores or from their websites. They may also be purchased in bars or cafes. In such a scenario, the consumer is still likely to see marks, for example on a drinks list or on goods to be selected from a refrigerator. I consider that the visual aspect of the mark will be the most important, although I accept that the aural element may also play a role if the consumer orders the goods from a bar or seeks the assistance of sales staff.

Comparison of marks

55. It is clear from *SABEL* (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


²¹ Paragraph 60.

marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”²²

56. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. The respective marks are shown below in the table below. As the earlier marks are identical, I shall refer to them in the singular for the purposes of this comparison.

Earlier mark	Contested mark
VIT HIT	

58. The contested mark is the word “VITS” in a slightly stylised form. This stylisation lies in the use of a plus sign in place of the dot on a lower case “i”; the remaining four letters are all in upper case. The opponent submits that the stylisation is “*highly negligible and is only known upon a detailed inspection of the Applicant’s mark*”.²³ The applicant, on the other hand, submits that the public would notice this feature, particularly as it is a relatively short mark. As the average consumer does not analyse the details of the mark, I find that it is the word “VITS” that makes the greater contribution to the overall impression of the mark. The part played by the stylisation, including the plus sign (which is very small in relation to the mark as a whole), is minor.

²² Paragraph 34.

²³ Opponent’s written submissions in lieu of a hearing, paragraph 59.

59. I turn now to the earlier mark. This consists of two words of three letters each. The opponent submits that it is “VIT” that is the dominant element of this mark, partly because of its position at the start of the mark. It refers me to the decision of the GC in *El Corte Inglés, SA v OHIM (MUNDICOR)*, Joined cases T-183/02 and T-184/02 as authority for the principle that the beginnings of marks tend to have more impact on the average consumer than the ends. The opponent also submits that the element “VIT” plays an independent distinctive role in the earlier mark and that both this element and the mark as a whole have “a normal degree of inherent distinctive character”.²⁴

60. I find it convenient now to consider the applicant’s evidence which has been adduced to show that the word “VIT” is used on other beverage products to indicate that those products contain vitamins. I have reproduced images below:²⁵



²⁴ Written submissions in lieu of a hearing, paragraph 76.

²⁵ Exhibit MR1, page 2; Exhibit MR2, page 2; Exhibit MR6, page 2

WHAT ARE VIT STIX?

Vit Stix are flavoured, low calorie, single liquid portions of vitamins.

A great way to flavour your water and take your daily dose of vitamins to enhance cognitive & physical performance

Shop Vitamins
(<https://www.stixdrinks.com/shop?cat=vit-stix>)



62. In addition, the applicant has adduced evidence of the use of the word “VIT” for vitamin products.

63. The opponent has criticised this evidence. It is valid to point out that the print outs are undated, apart from the date of printing in July 2022. However, the text in one print out in Exhibit MR6 states that AquaVit was introduced in 2013.²⁶ I have considered the evidence provided by Mr Ritchie that shows that applications to register the trade marks shown in the images above were made after the application date of the 411 mark, but do not see how these facts shed any light on the position in the market at the relevant date for these proceedings.

²⁶ Exhibit MR6, page 5.

64. The opponent's Exhibit NR5 is a print out from Holland & Barrett's website showing the products for sale in the category "Vitamin C supplements". Mr Ritchie notes that out of 40 products, only 5 bear the term "VIT".

65. Exhibit NR6 contains the results of a Google search for the term "VIT DRINK" conducted on 13 September 2022. Mr Ritchie states that around 75% of the results on the first six pages relate to the opponent's use of the mark "VIT HIT". However, it is difficult to draw conclusions from the evidence of Google searches. Search engine algorithms take account of previous searches undertaken by a particular user, so it is unsurprising that a Google search by the opponent's representatives produces a large number of hits relating to the opponent.

66. Further evidence that I have considered is the opponent's own use of the word "VIT" on its website and in promoting its products, as shown below in the advertisement from *The Mail on Sunday* on 8 May 2016. Underneath the phrase "HEALTH YOURSELF" can be seen four symbols above the words "VITS", "JUICE", "AQUA" and "TEAS". I agree with the applicant that the average consumer will understand "VITS" to indicate vitamins and "AQUA" water.



67. I have considered this evidence and come to the view that “VIT” alludes to vitamins and the mark as a whole alludes to a high dose of vitamins (i.e. a “hit” of vitamins). The consequence of this is that I do not agree that “VIT” and “HIT” play independent distinctive roles within the earlier mark. The mark as a whole has a meaning that is more than the sum of its parts. This is reinforced by the rhyming of the two words, which will aid the memorability of the mark as a whole. The overall impression of the mark lies in “VIT HIT” as a unit.

Visual comparison

68. The earlier mark consists of two words of three letters each, while the contested mark has a single word of four letters. The first three letters of the contested mark are identical to the first word in the earlier mark. I find that the marks are visually similar to a medium degree.

Aural comparison

69. The earlier mark has two syllables and both words will be pronounced in the usual way: “VIT HIT”. The contested mark has a single syllable that would be pronounced “VITS”. I find that the marks are aurally similar to a medium degree.

Conceptual comparison

70. I have already found that the earlier mark would bring to the mind of the average consumer the notion of a high dose of vitamins. Turning now to the contested mark, I consider that those consumers that notice the plus sign will identify this as denoting something additional to the product. The word “VITS” will, in my view, bring to mind the thought of vitamins. I find that there is a medium to high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

71. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

72. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive of, or allude to, a characteristic of the goods or services, ranging up to high for invented words which have no allusive qualities.

73. The distinctiveness of the mark lies in the combination of the words “VIT” and “HIT”. I find that the inherent distinctiveness of the mark is low when it is used for vitamin-fortified or vitamin drinks, as the mark alludes to the boost of vitamins the consumer will gain from the drink. Even where the drinks are merely flavoured with teas or fruit, I consider that the mark has a degree of allusiveness, as fruit is known to be a source of vitamins. The inherent distinctiveness is, in this case, slightly higher, but still relatively low.

74. The opponent claims that the inherent distinctive character of the mark has been enhanced through use. The evidence shows that the mark has been used consistently in the UK since 2013 and its products have been on sale in major retailers. As shown above there has been advertising in print media and also in stores, trade shows, festivals and sampling on the street. I do not have any evidence on the size of the market for vitamin-fortified or fruit-flavoured drinks, although I note the *Irish Times* article already referred to in paragraph 22 above that states that the opponent's products were the second best-selling "functional drink" brand in Britain. The market for vitamin-fortified drinks is likely to be smaller than that for fruit-flavoured drinks or drinks flavoured with tea. I consider that the sales and promotional activity are sufficient to enhance the distinctiveness of the earlier mark for *Non-alcoholic drinks fortified with vitamins* to a medium level, but they are not sufficient to enhance the distinctiveness of the mark for *Non-alcoholic drinks flavoured with teas* or *Non-alcoholic drinks flavoured with fruit*.

Conclusions on likelihood of confusion

75. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

76. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect

confusion, on the other hand, only arises where the consumer has actually recognised 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)."

77. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”²⁷

78. Earlier in my decision, I found that:

- The opponent had shown use of the 411 mark for *Non-alcoholic drinks fortified with vitamins; Non-alcoholic drinks flavoured with teas; Non-alcoholic drinks flavoured with fruit;*
- The goods at issue were either identical, similar to a high degree or similar to a low degree;
- The average consumer would be a member of the general public paying a relatively low degree of attention, although in the case of vitamin-fortified drinks the level of attention may rise to medium;
- The marks are visually and aurally similar to a medium degree and conceptually similar to a medium to high degree;
- The earlier mark has an inherent distinctive character towards the low end of the spectrum but this has been enhanced to a medium level in the case of vitamin drinks. However, I remind myself that that a low level of distinctive character does not preclude a finding of likelihood of confusion: see *L’Oréal SA v OHIM*, Case C-235/05 P, paragraph 45.

79. Where the goods are identical or highly similar and the marks have a medium degree of similarity, it might be expected that there would be a likelihood of confusion on the part of the public. However, as I have already noted, conducting the global assessment is not a question of simply applying a formula. I must also bear in mind the distinctive character of the earlier mark. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting as the Appointed Person, pointed out 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:

²⁷ Paragraph 12.

“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.”

80. I found that the distinctiveness of the earlier mark lay in the combination of the two words “VIT” and “HIT”, which I found hung together as a unit. It has a conceptual hook that will engage the mind of the average consumer and the rhyme makes the mark more memorable. These have no counterpart in the contested mark. These factors make it, in my view, unlikely that the average consumer will mistake one mark for the other, even taking into account the relatively low level of attention being paid for some of the goods in question. I find that there is no likelihood of direct confusion.

81. Indirect confusion is where the average consumer recognises that the marks are different, but believes that they belong to the same undertaking or to economically-related undertakings: see *LA Sugar*, paragraph 16. I remind myself that I must not make a finding of indirect confusion just because the two marks share a common element, but must consider the context of each mark as a whole: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.4. As I have found the “VIT” element to be allusive, I do not consider that the average consumer would assume that the later mark was another brand of the same undertaking or that there was a relationship between the parties. The later mark does not fall under any of the types of indirect confusion suggested by Mr Purvis in *LA Sugar*, or any other possible relationship, such as co-branding. I find that there is no likelihood of indirect confusion.

82. The opposition under section 5(2)(b) has failed.

Section 5(3)

83. Section 5(3) of the Act is as follows:

“A trade mark which –

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

84. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the application. I have already made a finding of similarity under section 5(2)(b). Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

85. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77.

g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

86. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

87. The relevant date on which reputation needs to be shown is 30 June 2021. As the earlier mark is a comparable mark, reputation in a substantial part of the EU must be taken into account up to 31 December 2020. The evidence of use, let alone reputation, outside the UK is patchy. The newspaper articles suggest that sales have been strong in Ireland and I note that it is also mentioned that the drinks have been available in a number of other EU member states, listed in paragraph 23 above. I have no EU-wide sales figures or information on where the goods have been sold or how they have been promoted in these countries. However, in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, the CJEU held that the territory of a single Member State may be considered to constitute a substantial part of the territory of the EU. It was confirmed in *Easygroup Limited v Easy Live (Services) Limited & Ors* [2022] EWHC 3327 (Ch) that this should be taken to include the UK up to IP Completion Day.²⁸

88. The factors that I must take into account when assessing reputation are the same as those that are relevant for a consideration of enhanced distinctive character. Earlier in my decision, I found that the level of sales and the promotional activity within the UK were sufficient to produce a slight enhancement of the distinctive character of the earlier mark in so far as it related to *Non-alcoholic drinks fortified with vitamins*. I am satisfied that the earlier mark also has a moderate reputation for these goods.

²⁸ Paragraph 41.

Link

89. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

I found the marks to be visually and aurally similar to a medium degree and conceptually similar to a medium to high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The goods at issue are all beverages or preparations for making or flavouring beverages. I found that all the applicant's beverages were identical or highly similar to goods on which the opponent may rely, while the preparations were similar to the opponent's goods to a low degree.

The strength of the earlier mark's reputation

The earlier mark has a moderate reputation for non-alcoholic drinks fortified with vitamins.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I found that the earlier mark had a medium degree of distinctive character for the goods for which it has a reputation.

Whether there is a likelihood of confusion

There is no likelihood of confusion, as the distinctiveness of the earlier mark lies in the combination of "VIT" and "HIT" to make a unit with a conceptual hook. This makes it unlikely that the average consumer will mistake one mark for the other and I see no reason why the average consumer would assume that the goods came from the same or related undertakings.

90. I have found that the average consumer would understand “VIT” to allude to vitamins and in the light of this and my findings summarised above, I do not consider that the relevant public would make a link of any kind between the respective marks.

91. In the absence of a mental link, there is no possibility that use of the contested mark would take unfair advantage of, and/or be detrimental to, the reputation or distinctive character of the earlier mark.

92. The section 5(3) ground fails.

Section 5(4)(a)

93. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

94. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

95. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”²⁹

96. *Halsbury’s Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

²⁹ Page 406.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged are likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant date

97. The relevant date for determining whether the opponent has established the necessary goodwill is the date of the commencement of the conduct complained of: see *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429; *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, paragraph 165. This is the date of application for the mark, i.e. 30 June 2021. The applicant has not claimed to have used

the contested mark before applying for it, and so I do not need to consider what the position would have been at an earlier date.

Goodwill

98. The opponent must show that it had goodwill in a business at the relevant date of 30 June 2021 and that the sign relied upon, **VIT HIT**, is associated with, or distinctive of, that business.

99. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

100. The opponent claims to have used the sign in the UK since 2004 for *Non-alcoholic beverages being enriched by vitamins and fruit and/or tea*. On the basis of the evidence I have already discussed, I am satisfied that the opponent has shown that it had a protectable goodwill at the relevant date for these goods and that the sign **VIT HIT** was distinctive of that goodwill.

Misrepresentation

101. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

102. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. In my view, the public will assume that the presence of the word “VIT” or “VITS” in both the earlier sign and the contested mark is a reflection of its allusiveness and will not be deceived.

103. The section 5(4)(a) ground fails.

OUTCOME

104. The opposition has failed and Application No. 3662699 will proceed to registration.

COSTS

105. The applicant has been successful and is entitled to a contribution towards the costs of these proceedings in line with the scale set out in Tribunal Practice Notice 2/2016. The award is calculated as follows:

Considering the notice of opposition and filing a counterstatement: £300

Preparing evidence and considering the other side's evidence: £500

Written submissions in lieu of a hearing: £400

TOTAL: £1200

106. I therefore order VIT HIT LIMITED to pay Radnor Hills Mineral Water Company Limited the sum of £1200. This sum is to be paid within twenty-one days of the expiry of the appeal period of, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 2nd day of March 2023

Clare Boucher

For the Registrar,

Comptroller-General