

O-340-10

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION 2517770
BY VITABIOTICS LTD
TO REGISTER IN CLASSES 1 & 5 THE TRADE MARK:

SWEETELA

AND
IN THE MATTER OF OPPOSITION 99611 BY
RECKITT BENCKISER HEALTHCARE (UK) LIMITED

TRADE MARKS ACT 1994

**In the matter of application 2517770 by Vitabiotics Ltd
to register in classes 1 & 5 the trade mark SWEETELA**

and

**In the matter of opposition 99611 by Reckitt Benckiser Healthcare (UK)
Limited**

The background and the pleadings

1) On 3 June 2009 Vitabiotics Ltd (“Vita”) applied to register the trade mark SWEETELA for the following goods:

Class 01: Sweetening preparations, low calorie sweeteners for use in food and beverages.

Class 05: Pharmaceutical preparations; sweetening preparations for dieters, slimmers or medical purposes in tablet or powder form.

2) On 8 October 2009 Reckitt Benckiser Healthcare (UK) Limited (“Reckitt”) opposed the registration of the above trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Reckitt relies on three trade marks, UK registration 1120617, UK registration 771934 & Community trade mark (“CTM”) registration 5359369. Reckitt is the proprietor of two of these trade marks but the third (CTM 5359639) is owned by a different legal entity, namely: Reckitt & Colman (Overseas) Limited. As a consequence of article 2 of the Trade Marks (Relative Grounds) Order 2007, a trade mark application can only be refused through section 5 based opposition proceedings if the proprietor of the earlier mark relied upon raises the opposition itself. As Reckitt & Colman (Overseas) Limited have not raised the opposition then this CTM cannot be relied upon. However, given the nature of Reckitt’s other earlier marks, nothing significant is likely to turn on this.

3) The two remaining marks (both of which are for the word SWEETEX) were filed before Vita’s application and, therefore, qualify as earlier trade marks in accordance with section 6 of the Act. I also note that they completed their registration procedures more than five years before the publication of Vita’s trade mark. The consequence of this is that the proof of use provisions contained in section 6A¹ of the Act apply. Reckitt claim in its statement of grounds that the marks have been used on the goods for which they are registered (and on which they rely), a claim that when Vita filed its counterstatement it did not ask Reckitt

¹ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

to prove. Accordingly, the earlier marks may be taken into account for the following specifications:

1120617 - Class 01: Artificial sweetening preparations.

771934 -Class 05: Dietetic sweetening agents in tablet form for diabetics, all being goods for export

4) In its statement of grounds Reckitt explains its case in the following terms:

“The marks SWEETEX and SWEETELA are visually and phonetically very similar, have the same six letters. The only difference is the use of the letters LA in the applicant’s mark in place of the letter X in the opponent’s mark. As accepted in several reported cases, the first syllable of the mark is generally the most important, and it has been observed in many cases that there is a tendency of persons using the English language to slur the terminations of words.

Artificial sweeteners are items which are generally self-selected by consumers and little attention is made when making repeat purchases. In view of the identity of the goods and the similarity of the marks, there is a likelihood of confusion. Consumers, relying on their recollection of the opponent’s SWEETEX mark which they are used to seeing on the sweeteners they are seeking to buy, would be liable to pick up the opponent’s SWEETELA product believing it to be SWEETEX or a related product from the same company.”

5) Vita filed a counterstatement denying the grounds of opposition. Its defence was made in the following terms:

“We refute that SWEETEX and SWEETELA are sufficiently similar to prevent the registration of SWEETELA.

No company can claim sole use of the prefix “SWEET” which is a complete word. A search of the IP Office data base shows over 500 entries including “SWEET”, for example SWEETENCE in Class 1.

SWEETEX is highly established and since “SWEETELA” is both phonetically and visually different there is little risk of genuine confusion.”

6) Only Reckitt filed evidence. Vita filed submissions in response to Reckitt’s evidence. Neither side requested a hearing. Neither side filed any submissions beyond those that I have already mentioned.

The evidence

Reckitt's primary evidence – witness statement of Rosina Margaret Baxter dated 26 February 2010

7) Ms Baxter is a trade mark attorney working in the trade mark group of Reckitt's corporate services arm. Most of her evidence focuses on the use that has been made of Reckitt's SWEETEX trade mark. I do not consider it necessary to summarise this in detail. This is because it is clear from the evidence that the use of the SWEETEX mark is longstanding and prominent within the UK market for artificial sweeteners. The use dates back to 1957 (at this point the use was being made by the previous brand owner Boots²). In 2006 SWEETEX was the third largest brand in the UK in relation to artificial sweeteners with a 15% market share. The other reason why I do not need to provide a more detailed summary is because this factual evidence is not challenged by Vita and, indeed, I note from Vita's counterstatement that it regards the SWEETEX brand as "highly established".

8) In terms of other evidence, in response to Vita's counterstatement claim that there are over 500 marks on the register including the word SWEET, Ms Baxter states that the majority of these are in unrelated classes and she provides her own report (produced from the Intellectual Property Office's website – Exhibit RMB10) of 53 marks in relevant classes that contain the word SWEET (some of which are Reckitt's own SWEETEX marks). Ms Baxter also highlights that the mark singled out by Vita in its counterstatement (SWEETENCE) is limited to being for industrial purposes and that it is subject to an agreement between its proprietor and one of Reckitt's associated companies; the agreement is provided in Exhibit RMB11.

9) Ms Baxter accepts that no one company can claim exclusive rights in the prefix SWEET but, due to the overall similarities between the marks, Reckitt is concerned that due to imperfect recollection SWEETELA products may be picked up in the belief that they are SWEETEX products or related products.

10) Ms Baxter refers to other artificial sweetener brands used in the UK based on a report from *Marketing* magazine which uses data sourced from Mintel (Exhibit RMB5) and data supplied by AC Neilson showing annual value sales for artificial sweeteners in the UK in the three years to week ending 9 January 2010 (Exhibit RMB12). The brands include: CANDEREL, SPLEDA, SWEETEX, HERMESETAS and SILVER SPOON (the largest brands) and SLIMMERS, SLIMMER, SWEETHEART, KRUGER, SUCRPLS, GOLD SWEET, NEVELL, NOW SLIM, SUPASWEET, NATREEN and SWEET 'N LOW (this last brand is said to be discontinued). Ms Baxter states that although some of these names contain the word SWEET, SWEETELA is much closer to SWEETEX than any of

² Reckitt acquired the brand on 1 February 2006.

the other existing brand names. Ms Baxter also states that Reckitt is not aware of any use having been made of the SWEETELA brand.

Vita's written submissions in response dated 30 April 2010

11) The written submissions come from Mr Robert Taylor, Vice President of Vita. Mr Taylor states that the marks differ in their endings and overall impressions. He highlights that SWEETEX has two syllables whereas SWEETELA has three and that both endings are highly distinctive phonetically and visually.

12) Mr Taylor states that Vita's mark will only be used in conjunction with the VIABIOTICS name so this further reduces the likelihood of confusion. Whilst I note this, the tribunal can only assess the mark put forward for registration and not use limited to being in conjunction with another name. This cannot, therefore, have a bearing on my decision.

13) Reference is made, again, to the descriptive nature of the word SWEET and that the consumer (who is non-specialised) will be use to seeing competing products having similar descriptive elements and that they will be able to distinguish based on the distinctive elements EX and ELA at the end of the marks. I do not consider it necessary to detail the submissions any further than this, but they have all been borne in mind.

Reckitt's reply evidence – witness statement of Rosina Margaret Baxter dated 17 May 2010

14) Ms Baxter asks that Vita's "evidence" be disregarded as it was not filed in evidential form. This request is refused given that no evidence of fact has been filed only submissions. The rules³ which govern the form that evidence must take in trade mark proceedings for which this tribunal has jurisdiction applies to evidence of fact and not submissions. It was perfectly acceptable for Vita to file submissions instead of evidence if it had no factual evidence to file⁴.

15) Ms Baxter also comments about the potential use of the SWEETELA mark in conjunction with the VIABIOTICS name. She says that this is irrelevant as such an undertaking cannot be considered in the context of my decision. As I have already agreed with this (see paragraph 12 above) I need say no more.

16) The rest of the evidence is essentially submissions, submissions which Reckitt have already made in its statement of grounds or in its primary evidence. I need say no more about it. I note for the record, though, that Reckitt sell not just off-the-shelf, but also online as well as in major supermarkets, wholesalers, independent grocers and chemists.

³ Rule 64 of the Trade Marks Rules 2008 (as amended) ("the Rules").

⁴ As per Rule 20(c) of the Rules.

Section 5(2)(b) of the Act

17) This section reads:

“5.-(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

18) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

19) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

20) I intend to consider the opposition in relation, first of all, to the goods in class 1. I do so because there may be some subtle differences in relation to the class 5 assessment given that they include goods (even if they are sweeteners) for medical and dietetic purposes which may, when they are purchased, be a more considered process than artificial sweeteners per se. That is not to say that the opposition will fail in class 5, but it is more a case that if Reckitt cannot succeed in class 1 then it is unlikely to be in any better position in class 5.

21) There are some aspects of the case which are not really in dispute. There is no dispute that the goods are identical. Even though the terminology used differs a little, the goods that they cover are the same, namely, sweeteners (which must be artificial rather than natural given that they fall in class 1) of one form or another. There is also no real dispute as to the average consumer of the goods which both parties say will be non-specialist members of the general public. Reckitt say that the average consumer will undertake the selection of the goods in a casual manner paying little attention. Vita make no real submission on this point, although, I do note that it says that the average consumer will pay a high level of attention to differences between marks which are based on descriptive words (SWEET prefixed marks for example).

22) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting the goods can, however, vary depending on the particular goods in question (see, for example, the decision of the General Court⁵ ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). A blindingly obvious example is that an average consumer will pay more attention to the purchase of a car than he or she will pay to the purchase of a bag of sweets. In the case before me the goods are relatively low cost, and for those who buy artificial sweeteners such a purchase will be relatively frequent. This points towards a causal purchase in line with Reckitt's submission. That does not mean that no care and attention will be displayed at all because the goods, after all, are purchased to be ingested and, furthermore, brand loyalty may play a part in the selection process. However, the degree of care and attention is certainly at the lower end of the scale.

23) Another aspect on which there is little difference between the parties is the degree of distinctive character of the earlier mark. This is a factor because the more distinctive the earlier mark(s) (based either on inherent qualities or because of the use made of them), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent starting point the earlier mark is reasonably distinctive. It gives a strong allusion to the nature of the goods (due to the SWEET element) but the mark as a whole is SWEETEX which is reasonably distinctive in totality. However, the evidence of use of SWEETEX, together with

⁵ Previously known as the Court of First Instance of the European Communities.

Vita's concession that it is "highly established", informs me that the earlier mark(s) should be regarded as highly distinctive.

24) That leads to a comparison of the marks. The competing marks, for ease of reference, can be seen in the table below:

Reckitt's marks	Vita's mark
SWEETEX	SWEETELA

25) 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

26) The above comments are particularly apposite in the case before me because I believe it clear, particularly bearing in mind the nature of the goods, that both marks will be perceived by the average consumer as being based on the word SWEET (which both sides accept is a descriptive word for the goods at issue) together with the suffixes EX/ELA. Whilst the average consumer will notice that both marks are based on the word SWEET, this does not mean that this word SWEET should be discounted from the respective marks' overall impressions. Similar observations were made by the GC when considering the trade marks RESPICORT and RESPICUR in Case T-256/04 (*Mundipharma v OHIM, Altana Pharma*) where it stated:

"The above conclusions on the perception of the opposing marks are not affected by OHIM's argument that the component 'respi' cannot contribute to any similarity between the signs because of its descriptive character. In fact, in spite of that character, that component, which is placed at the beginning of the two marks, takes up two of their three syllables and is longer than the respective second components, makes a significant contribution to the overall impression produced by the two signs in question."

27) That deals, to some extent, with Vita's reference to the fact that no one party can claim a monopoly in the word or prefix SWEET. Whilst I understand the concern, the question that remains is to look at the totalities created by the overall impression of the respective marks.

28) I also note Reckitt's submission that beginnings of marks are, generally, more focused upon. However, a number of cases⁶ have stressed that this is not always the case and this must, therefore, be only a rule of thumb. In the case before me, the fact that the beginnings of the marks are descriptive will be something the average consumer is alive to and, thus, they will not focus on the beginnings. Whilst this does not mean that the average consumer will instead focus upon the endings, it is certainly, in line with the case-law, the whole mark and its full construction and overall impression that will be appreciated and focused upon.

29) In terms of visual similarity, the marks are of a similar length (7 and 8 letters respectively), the first 6 of which are shared. The last letter (in the case of Reckitt's mark) and the last two letters (of Vita's mark) differ. These letters show no real similarity and, furthermore, the letter X is one of the more unusual letters in the English language such that the difference at the end is more likely to stand out. Having said that, the differences do not outweigh all similarity, but I regard such similarity to be of only a moderate level.

30) In terms of aural similarity, there is a degree of aural similarity as both marks share the first syllable SWEET but there is a difference in the endings of the marks in that the second (and final) syllable of Reckitt's mark is EX and the final two syllables of Vita's mark is EL-A or E-LA. This results in the respective pronunciations being: (a) the two syllable SWEET-EX against (b) the three syllable SWEET-E-LA or SWEET-EL-A. These pronunciations also provide a further difference in that Vita's mark has a certain flow about it whereas Reckitt's mark has a more truncated feel. There are some clear differences but not that they outweigh all similarity. I regard there to be a low degree of aural similarity.

31) In terms of concept, neither party have made any submissions on this. Neither mark, in totality, has any real concept. Both, though, are based on the word SWEET, but given this words descriptive context, I do not regard this as particularly significant. There is no relevant conceptual similarity or dissonance.

32) The key question is whether these factors combine to create a likelihood of confusion. It is clear that all these factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

⁶ See, by way of example, the decisions of the GC in *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM* (Case T-438/07) and *Castellani SpA v OHIM* (T-149/06). These, of course, are not relied upon on their facts but only the point of principle.

33) I am considering here identical goods – this is important in view of the interdependency principle and the offsetting approach whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity (in this case identity) between the goods. I am also dealing with a highly distinctive earlier trade mark. The average consumer is a member of the general public who will select the products in a casual manner. The significance of this is that the concept of imperfect recollection is all the more important as the average consumer will not be particularly careful or attentive and will tend to rely more on imperfect recollection than he or she would have done had the goods been highly considered purchases. Imperfect recollection is also emphasised here as there is no real conceptual hook for either mark which can be stored away and which may have assisted in distinguishing the marks. All the factors mentioned so far in this paragraph point towards confusion rather than away from it. That being said, there are still differences between the marks residing in their endings such that the similarity between them is of only a low (aural) to moderate (visual) degree and that such similarity resides in a descriptive element.

34) Reckitt's concern is that the SWEETELA product may be selected in the mistaken belief that it is SWEETEX or that the average consumer will believe that SWEETELA is a variant product from the undertaking responsible for SWEETEX. Dealing with the first proposition of mistaken identity, I come to the view that there is no likelihood of confusion. Whilst the average consumer rarely has the opportunity to make direct comparisons (if a direct comparison were possible here then I have no doubt that mistaken identity will not occur), the differences in the endings of the marks, even bearing in mind imperfect recollection and the other relevant factors, are sufficient for the average consumer to be able to differentiate even when he or she is purchasing these identical goods. The endings are sufficiently and markedly different so that, when the marks are taken as a whole, their overall impressions are capable of differentiation. Whilst the purchase is a casual one, the average consumer is still reasonably observant and circumspect and they will not overlook the differences between the marks. There is no likelihood of direct confusion.

35) The other argument is that the average consumer will believe that the goods are the responsibility of the same or an economically linked undertaken. This is a relevant form of confusion⁷ often referred to as indirect confusion. I do not, though, accept this argument. Whilst the word SWEET is at the beginning of both marks and that it is used to create an invented word, the average consumer is likely to put this down to mere co-incidence rather than any form of economic connection. In my view SWEETELA will be seen for what it is, simply a competing brand in the field of artificial sweeteners. There is no likelihood of indirect confusion. The fact that there may be no other brands of a similar construction in use in the relevant field does not detract from this finding.

⁷ As per *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

36) Given my finding that there is no likelihood of confusion in relation to the goods sought to be registered in class 1, I do not consider it necessary to consider the goods in class 5. Reckitt is in no better position and, so, there is no likelihood of confusion in class 5. This comment also applies to the earlier mark I dismissed in paragraph 2 above – even if it could have been relied upon it would not place the opponent in any better position. The opposition fails in its entirety.

Costs

37) Vita has been successful and is entitled to a contribution towards its costs. Vita have not, though, been professionally represented in these proceedings and it is the registrar's practice to award costs to litigants-in-person at half the rate (save in respect of expenses) that he awards them where a party has had professional representation. I hereby order Reckitt Benckiser Healthcare (UK) Limited to pay Vitabiotics Ltd the sum of £450. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£200

Considering Reckitt's evidence
£100

Written submissions
£150

Total
£450

38) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 30 day of September 2010

Oliver Morris
For the Registrar,
The Comptroller-General