**O/724/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3436592 BY VIDA FORTE NUTRIENTES INDÚSTRIA E COMÉRCIO DE PRODUTOS NATURAIS LTDA. TO REGISTER THE SERIES OF TWO TRADE MARKS:**



**IN CLASS 5**

**AND**

**OPPOSITION THERETO UNDER NO. 419948 BY MATTHIAS RATH**

## BACKGROUND & PLEADINGS

1. **VIDA FORTE NUTRIENTES INDÚSTRIA E COMÉRCIO DE PRODUTOS NATURAIS LTDA.** ("the applicant"), applied to register the (figurative and series of two) trade marks shown on the front page of this decision in the United Kingdom on 15 October 2019. They were accepted and published in the Trade Marks Journal on 3 January 2020 in respect of the following goods:

    **Class 5:** Nutritional supplements.

2. **Matthias Rath** ("the opponent") opposes the application on the basis of Section  of the Trade Marks Act 1994 ("the Act"). The opponent is the proprietor of the following marks:

| | |
|---|---|
| **Trade Mark no.** | EU000689018 ('018) |
| **Trade Mark** | Vitacor |
| **Goods & Services** | Goods in Classes 5, 16 & 41 |
| **Relevant Dates** | Filing date: 26 November 1997 |
| | Date of entry in register: 09 July 2002 |

| | |
|---|---|
| **Trade Mark no.** | EU001668565 ('565) |
| **Trade Mark** | Vitacor Plus |
| **Goods & Services** | Goods in Classes 5 & 32 |
| **Relevant Dates** | Filing date: 22 May 2000 |
| | Date of entry in register: 07 May 2002 |

3. Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the opposition was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit)

Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.

4. For the purpose of this opposition, the opponent relies on some goods in Class 5 for the first and the second earlier mark, as follows:

> **Class 5:** Food supplements, dietetic supplements, vitamins, minerals.

5. In his notice of opposition, the opponent argues that the competing marks are highly similar, and the respective goods are identical. Therefore, registration of the contested (series of two) marks should be refused under Section 5(2)(b) of the Act.

6. In response, the applicant filed a counterstatement, denying all the grounds and any likelihood of confusion between the marks. Moreover, the applicant asserts that "it is not admitted that either of the [earlier] marks the subject of those registrations has been put to genuine use in the European Union during the relevant five-year period (15 October 2014 to 14 October 2019). The Opponent is put to strict proof of its allegation in that regard." Therefore, the applicant requests that the opponent provides proof of use of his earlier marks relied upon.

7. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that I consider necessary. None of the parties filed submissions during the evidence rounds.

8. Although the applicant initially requested a hearing as a precaution, with its letter of 28 July 2021 it submitted a statement requesting the cancellation of the hearing, which the Tribunal subsequently vacated. The opponent filed written submissions in lieu of a hearing. Thus, this decision has been taken following a careful consideration of the papers.

9. In these proceedings, the opponent is represented by Walker Morris LLP and the applicant by Bromhead Johnson LLP.

10. Although the UK has left the EU, 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 transition 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.

**Relevant Date/Period**

11. An "earlier trade mark" is defined in Section 6(1) of the Act:

> "(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. […]"

12. As the earlier marks relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

> "(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), (b) or (ba) in relation to which the conditions set out in Section 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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."

13. In accordance with Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier marks. The relevant period for proof of use of the opponent's marks is **16 October 2014 to 15 October 2019**. I note that the applicant in its counterstatement erroneously stated a slightly different period as quoted in paragraph 6 of this decision. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **15 October 2019**.

## EVIDENCE

### Opponent's Evidence

14. The opponent filed a witness statement, dated 29 March 2021, of Dr Matthias Rath, the founder of the 'Dr. Rath Health Foundation' and Director of 'Dr. Rath Health Programs B.V.'. Dr Rath states that:

"2. I have licensed several of my trademarks to Dr. Rath Health Programs B.V., in particular the EU Trade Marks VITACOR (00689018) and VITACOR PLUS (002668565) as well as their UK clones after BREXIT. Dr Rath Health Programs B.V. is the owner of the website https://shop.dr-rath.com/en-us/.

3. Dr. Rath Health Programs B.V., my licensee, has been using the Trade Marks VITACOR and VITACOR PLUS since as early as the year 2000 and since then they have been used continuously in relation to "nutritional supplements" throughout the UK and EU."

15. It is clear from Section 6A(3)(a) of the Act that genuine use must be made by "[…] the proprietor or with his consent […]". It is also clear from the witness statement and the evidence that the use presented has been made not by the proprietor himself, but by 'Dr. Rath Health Programs B.V.'.[1] Whilst the witness makes specific reference to the licensing of the earlier marks to 'Dr. Rath Health Programs B.V.', he does not explicitly refer to the scope of the consent. However, consent may be inferred, in certain circumstances, from the facts and circumstances of the case.[2] In the present case, the opponent is the Director of the licensee, 'Dr. Rath Health Programs B.V.', which has been using the earlier marks since 2000. Therefore, it can be inferred from the facts of this case that the opponent consented to the use of the registered mark by 'Dr. Rath Health Programs B.V.'.

16. Dr Rath's Exhibits MR1 and MR2 consist of prints, dated with a print date of 24 March 2021, from the *shop.dr-rath.com/en-us* website illustrating the opponent's goods, including pictures, a short description, price, and recommended allowance. I note both exhibits demonstrate supplement products in different forms, such as tablets, drinks and capsules.

17. Dr Rath attests with his statement that Vitacor Junior, a product with adjusted dosage in tablet form for teenagers, was part of the product line until early 2020. Exhibit MR3 comprises a print, taken from the WayBack Machine Internet archive and dated 11 January 2020, from the *shop.dr-*

[1] See Exhibit RC4.

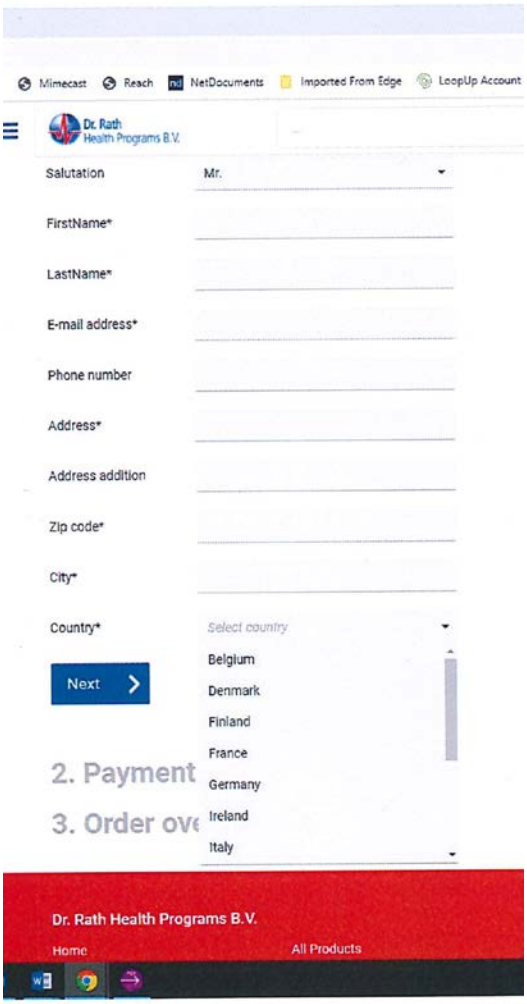
[2] See in this regard *Makro Zelfbedieningsgroothandel CV and others v Diesel SpA,* Case C-324/08, para 35.

*rath.com/en-us* website showing various products, including Vitacor Junior. I will return to this later in this decision.

18. Dr Rath, explains that:

> "The supplements are sold under the trade marks VITACOR and VITACOR PLUS on the following website (and are available for delivery throughout the EU and UK):
>
> https://shop.dr-rath.com/en-us/
>
> On this website, there is a possibility to choose between different languages, namely English, German, Spanish, French, Italian, and Polish. The products are not offered in retail stores as Dr. Rath Health Programs B.V. is a pure online-trader."

In this regard, Exhibit MR4 consists of three prints, dated 24 March 2021. Two of the prints show the website's "shopping cart" containing the products Vitacor CAP and Vitacor Plus. The last print, which is a screenshot from a browser, shows the online shopping customer's checkout form with fields such as personal, contact, and address details. Dr Rath states that the Exhibit MR4 is "an example of the purchase of each of the products with delivery options including the delivery options including the UK, Belgium, Denmark, Finland, France, Germany, Ireland, Italy, Luxembourg, Poland, Spain and Sweden", which, as shown below, shows part of the countries mentioned.




19. Dr Rath provides the following breakdown for the traffic that the *shop.dr-rath.com* website received from the UK (table a) and EU (table b):

a.

| Year | No of sessions |
|---|---|
| 2020 | 2,754 |
| 2019 | 2,685 |
| 2018 | 3,352 |
| 2017 | 2,418 |
| 2016 | 905 |
| 2015 | 478 |
| 2014 | 102 |

b.

| Year | No of sessions |
|---|---|
| 2020 | 158,134 |
| 2019 | 114,092 |
| 2018 | 124,525 |
| 2017 | 119,712 |
| 2016 | 95,695 |

He also states that 'Dr. Rath Health Programs B.V.' operates accounts on Twitter with 3,387 followers, Facebook with 4,430 followers, and Instagram with 1,438 followers. However, I note that Dr Rath does not indicate a date for these figures.

20. Dr Rath provides the following turnover figures in relation to:

    a. goods sold under the Vitacor and Vitacor Plus marks in the UK

| Year | Turnover £ |
|---|---|
| 2020 | £ 29,894.28 |
| 2019 | £ 26,904.36 |
| 2018 | £ 28,025.35 |
| 2017 | £ 24,674.84 |
| 2016 | £ 25,363.20 |
| 2015 | £ 26,713.03 |
| 2014 | £ 25,720.05 |
| 2013 | £ 33,641.21 |
| 2012 | £ 32,281.33 |
| 2011 | £ 35,364.13 |
| 2010 | £ 51,036.62 |
| 2009 | £ 66,594.20 |
| 2008 | £ 77,604.31 |

b. goods sold under the Vitacor Plus mark in Germany

| Year | Turnover EUR |
|---|---|
| 2020 | 2,769,399.83 |
| 2019 | 2,704,737.51 |
| 2018 | 2,998,545.15 |
| 2017 | 3,139,388.56 |
| 2016 | 3,387,880.06 |

c. goods sold under Vitacor Junior in Germany

| Year | Turnover EUR |
|---|---|
| 2020 | 7,727.27 |
| 2019 | 31,378.23 € |
| 2018 | 24,950.25 € |

d. goods sold under the Vitacor Plus mark in Spain

| Year | Turnover EUR |
|---|---|
| 2020 | 60,706.29 |
| 2019 | 54,252.82 |
| 2018 | 54,664.47 |
| 2017 | 59,784.56 |
| 2016 | 63.784,56 |

e. goods sold under Vitacor Junior in Poland

| Year | Turnover EUR |
|---|---|
| 2020 | 5,372.37 |
| 2019 | 15,389.14 |
| 2018 | 18,368.84 |
| 2017 | 18,341.04 |
| 2016 | 20,074.66 |

21. In addition to the above figures, a selection of UK invoices between 2008 and 2020 illustrate sales of the relevant goods under the earlier marks in the UK with Exhibit MR5. In particular, the following number of invoices per year are demonstrated: 3 from 2008, 3 from 2009, 3 from 2010, 3 from 2011, 3 from 2012, 3 from 2013, 3 from 2014, 3 from 2015, 3 from 2016, 3 from 2017, 3 from 2018, 3 from 2019, and 3 from 2020. The invoices were headed as being issued by 'Dr. Rath Health Programs B.V.' and include the description, quantity, price, discount, and total of the purchased items. As shown previously in this decision, the relevant period is 14 October 2014 to 15 October 2019. Thus, I will only take into account and delineate the invoices that fall within the relevant period. In this regard, I note that the invoices for 2014 pre-date the relevant period. The relevant invoices show 15 entries of products under the mark Vitacor Plus in various quantities (ranging between 1 and 30). All the invoices are UK sales and are addressed to various customers in the UK, namely London, Preston, Aberdeen, Essex, East Horsley, Bath, Worcester Park, Bankfoot, Chippenham, Dorset, Frimley Green, and Horsham.

22. Further, Exhibit MR6 includes invoices showing sales to Germany, Spain, and Poland dating between 2016 and 2018. Although the supporting documents are in the respective foreign languages and the currency is in Euros, I am of the view that the content is self-evident and does not necessarily require translation or currency conversion. In detail, I note that:

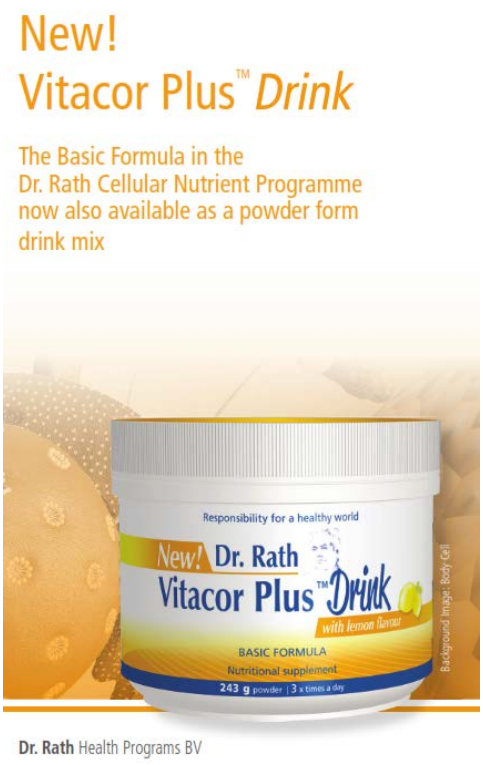
a. There are 3 invoices, one for each year from 2016 to 2018, in German containing Vitacor Plus products addressed to Berlin, Eichenbuehl, and Hamm.

b. Another two invoices, one from 2016 and one from 2017, showing the sales of Vitacor Plus and Vitacor Junior to Poland. The invoices are addressed to Kolobrzeg and Elk.

c. A set of 4 invoices, 2 from 2016, 1 from 2017, and 1 from 2018, in Spanish, exhibiting sales of the Vitacor Plus (ES) and Vitacor Junior (ES) delivered to Huesca, Cuenca, Tarragona, and Los Alcázares in Spain.

23. Exhibit MR7 is an undated promotional flyer illustrating the Vitacor Plus and ImmunoCell products under the headline “Synergy duo Double advantage”. The flyer contains some promotional messages and information about the products, including price, and the link *dr-rath.com* that appears at the bottom of the page.

24. Dr Rath provides an informational leaflet as Exhibit MR8, dated based on the promotional quote “[w]ith effect from October 1st, 2015, regular price: 55.90 Euro”. The leaflet provides information about ‘Dr. Rath Research Institute for Cellular Medicine’ outlining the Institute’s research field and its contribution to “research on the natural causes of cancer and other common diseases.” Further, the leaflet advertises the product “Vitacor Plus Drink” under the headline “New! Vitacor Plus™ Drink” (depicted below) with further promotional information about the formula, dosage, cost, and order information. In particular, the leaflet states that “Vitacor Plus™ is the Basic Formula in the Dr. Rath Cellular Nutrient Programme. It serves as a daily dietary supplement for everybody from adolescence to old age and has been designed to provide the body cells with a basic supply of selected micronutrients.”




25. Dr Rath provides with Exhibits MR9, MR11 and MR12 three order forms, dated 15 September 2017, 15 September 2015, and 3 December 2018, respectively. In accordance with the witness statement, all the forms were used for the UK and Western Europe. I note that Vitacor Plus, Vitacor Plus Drink, and Vitacor Junior appear under the product list in the forms.

26. An advert is presented with Exhibit MR10 showing the Vitacor Plus and Arteriforte products under the headline "ELASTICITY AND STABILITY FOR YOUR CONNECTIVE TISSUE". I note that the advert ran between October and December 2015, as this is evident based on the quote, stating "This offer is effective from 15.10.2015 to 15.12.2015 and applies to both members and customers." The advert includes relevant product information, price, discount, customer service contact details.

    Exhibit MR13 is an undated brochure titled "Combined Synergies for special demands". Dr Rath states that this brochure was distributed in the UK in May 2018. I note that the prices are in Euros and not in British pounds. That said, the brochure provides that calls from the UK are free of

charge, which indicates that it is targeted at UK customers. The preamble of the brochure details the advantages of the synergy combinations achieved via the "Basic Formula Vitacor Plus". The brochure demonstrates different combinations where the Vitacor Plus features throughout as the main component of a double-supplement regime.

27. That concludes my summary of the evidence filed insofar as I consider it necessary.

**DECISION**

**Proof of Use**

28. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

> "114. […]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 P *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 Bundervsvereinigung 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 Merken 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 P *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:

(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]."

29. As the earlier marks are EUTMs, the comments of the Court of Justice of the European Union ("CJEU") in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36.It should, however, be observed that […] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use. […]

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark. […]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider* v *OHIM*, paragraphs 72 and 77).”

30. The court held that:

> "Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.
>
> A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

31. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since *Leno* and concluded as follows:

> "228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in Leno are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.
>
> 229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been

genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted Leno as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]- [40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of Leno persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use."

32. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

33. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

    i. The scale and frequency of the use shown

    ii. The nature of the use shown

    iii. The goods and services for which use has been shown

    iv. The nature of those goods/services and the market(s) for them

    v. The geographical extent of the use shown

34. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

> "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."

35. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

Form of the Marks

36. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark."
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the

sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

37. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant. He said:

"33. […] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period. […]

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does

not depend upon the average consumer not registering the differences at all."

38. There are examples of use of the earlier word mark “Vitacor Plus” in the evidence, such as in invoices, for the duration of the relevant period. There is also use in the following forms:

a. 


b. 


c. 


d. 


39. In relation to the “Vitacor Plus” mark, the use on the invoices can obviously be taken into account, as can the uses in ‘a’ and ‘b’ above, as this is a clear form of use as per *Colloseum.* In relation to “Vitacor” per se, I consider the uses on the invoices, and the forms of use ‘a’ – ‘d’ can be taken into account. The manner of presentation shown in ‘c’ and ‘d’ are clear examples as per *Colloseum.* In relation to the invoices and ‘a’ and ‘b’, the word “Vitacor” is directly followed by the word “Plus” in use. Despite the

presence of the word “Plus”, the word retains its independent use as an indicator of origin.[3]

Sufficient Use

40. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

41. The relevant period is between 16 October 2014 and 15 October 2019. I have noted above that Dr Rath’s witness statement provides an unchallenged annual breakdown of the turnover figures covering the EU and the UK. The UK turnover figures for the relevant period, the total of which is in excess of £157,000, solely cover the sales of goods under both earlier marks. Although the figures do not differentiate between the first and the second earlier mark, they begin at over £25,000 in 2014, fluctuating slightly over the years to approximately £26,900 in 2019. Whilst the 2014 and 2019 figures include turnover falling outside (pre-dating or post-dating) the relevant timeframe, it is reasonable to assume from the previous annual figures that at least a portion of the turnover, and sales of the goods in that respect, will fall within the relevant time period. Further, the annual breakdown of the turnover figures in Germany, Spain, and Poland are produced. In detail, the total of the turnover for the sales of:

    a. Vitacor Plus in Germany from 2016 to 2019 is over 12 million Euros;

    b. Vitacor Junior in Germany from 2018 to 2019 is over 56,000 Euros;

[3] Pertaining to the *Colloseum* principles.

c. Vitacor Plus in Spain from 2016 to 2019 period is over 232,000 Euros; and

d. Vitacor Junior in Poland from 2016 to 2019 is over 72,000 Euros.

Again, the 2019 figures in 'a' – 'd' above include turnover post-dating the relevant timeframe, i.e. 15 October 2019. However, as explained above, it is reasonable to accept from the previous annual figures that a reasonable amount of the turnover will fall inside the relevant period. In addition to the above figures, the exhibited invoices show sales of various quantities of the relevant goods of the earlier marks to various EU countries (Germany, Spain, and Poland) and the UK. However, I identified that the UK invoices, which are greater in number than the EU ones, relate only to sales of Vitacor Plus (although I have accepted that this constitutes use of the Vitacor mark per se), and a small number within the five-year period demonstrates not very significant sales of the given goods. Admittedly, the UK and EU supplements market is a significant one, and even though the opponent did not provide any evidence as to the market share it possesses, I am satisfied that this evidence supports that the opponent has operated in a way aimed at real commercial exploitation and has done so for a number of years.

42. Further to the sales figures, there are examples in the opponent's evidence that show sufficient use with the forms that I have already identified in the previous section on his licensee's website selling the respective goods[4] and in the listings of the order forms[5]. All of these show the relevant products targeting UK and/or EU consumers. While there is a lack of evidence in relation to marketing expenditure, the opponent gives

[4] See Exhibit MR3.

[5] See Exhibits MR9, MR11 and MR12.

evidence of adverts, such as the leaflet,[6] advert[7], and brochure[8], where the earlier marks were clearly referenced and displayed in the description of the above evidence and for which I am satisfied that they relate to customers based in the UK. Further, the opponent produced annual figures in relation to the online traffic that his online shop received from the UK and EU countries.

43. Although the evidence could have been better and more comprehensive in parts, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.[9] Bearing in mind the two different marks and the forms of the marks I have said may be considered, I am satisfied that the evidence supports use of the marks in the EU during the relevant period. As such, the opponent can rely upon the registered marks for the purpose of these proceedings. Even if not all the forms of use of Vitacor per se are supportive, and in the event that I should only have considered c) and d) (as depicted earlier) as appropriate forms of use, I still consider there have been genuine use of the mark on account of such use, particularly bearing in mind the unchallenged evidence of sales.

Fair specification

44. I must now consider what a fair specification would be for the use shown.

45. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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[6] See Exhibit MR8.

[7] See Exhibit MR10.

[8] See Exhibit MR13.

[9] See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

> “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.”

In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

> “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."

46. The goods relied upon are *"food supplements, dietetic supplements, vitamins, minerals"* in Class 5, and these are the goods for which the opponent made a statement of use. Neither the opponent nor the applicant has commented upon the specific goods they believe the earlier mark has, or has not, been used, nor what a fair specification should be.

47. I recognise that the goods for which the mark has been used are dietary supplements for youngsters and adults. For example, "Vitacor Plus" is described in the opponent's evidence and witness statement as a "daily dietary supplement" consisting of micronutrients such as various vitamins, magnesium, selenium, and copper, while "Vitacor" is of the same composition as "Vitacor Plus" differing in dosage. The goods can be defined as dietary/food supplements. However, there is no evidence in relation to "*vitamins"* and *"minerals"* sold as such under the registered marks. These could be regarded as a distinct narrower sub-category of goods that relate to the provision of specific vitamins or minerals instead of the opponent's products comprised of a multi-formula of nutrients. I consider that the average consumer would describe the use made either

as "*dietetic supplements*" or *"food supplements"*. Whilst these are relatively broad terms, the breadth of use justifies this, and it would not be the case that the average consumer would attempt to sub-categorise the goods further. Consequently, I consider a fair specification to be:

**Class 5:** food supplements; dietetic supplements.

**Section 5(2)(b)**

48. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

"A trade mark shall not be registered if because-

[…]

(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."

49. The principles, considered in this opposition, stem from the decisions of the European Courts 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, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

k) if the association between the marks creates a risk that the public 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**

50. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

51. Taking into account the fair specifications I indicated earlier, the competing goods to be compared are shown in the following table:

| **Opponent's Goods Earlier Marks '018 & '565** | **Applicant's Goods** |
|---|---|
| **Class 5:** Food supplements; Dietary supplements. | **Class 5:** Nutritional supplements. |

52. In the notice of opposition, the opponent claims that the applicant's goods are identical to goods covered by the earlier marks, although this was before the application of the above fair specification.

53. The applicant in its notice of defence, denies any identity between the respective goods.

54. The contested goods are intended to be used to supplement a normal diet or because they are considered beneficial to health. It is clear that the contested terms are either literally identical or they are encompassed by the opponent's broad terms *"food supplements; dietetic supplements".* As such, they are considered identical based on the *Meric* principle or else highly similar, sharing the same nature, purpose, method of use, users, and trade channels.

**Average Consumer and the Purchasing Act**

55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J 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."

56. The goods at issue cover products, i.e. nutritional supplements, considered relatively low-cost (but not the lowest) purchases. The average consumer will be a member of the general public or a health care professional. The purchase of the goods will be primarily visual, such as in retail or online stores, websites, advertisements, brochures, and newspapers. However, I do not discount an aural element where word of mouth plays a part, such as verbal recommendation.

57. The level of attention the average consumer will display when selecting the goods at issue will normally be average as the goods, whilst relatively low-cost items which may be purchased reasonably frequently, they are still consumed for a particular health purpose and the average consumer will likely take some care to consider the content and benefits of the product. This is the case even for goods that may be less frequently purchased and more expensive. However, there may be some circumstances when the goods are purchased for very particular dietary or nutritional requirements, and here the average consumer might pay a slightly higher level of attention to ensure that they are fit for that particular purpose. Last, for health care professionals, the level of attention will be slightly higher than average when prescribing or recommending the given goods.

**Comparison of Trade Marks**

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

60. The marks to be compared are:

| Opponent's Marks | Applicant's Marks |
|---|---|
| First Earlier Mark '018<br>Vitacor<br><br>Second Earlier Mark '565<br>Vitacor Plus |  <br><br>  <br> |

Overall Impression

61. The earlier word marks '018 and '565 consist of the words "Vitacor" and "Vitacor Plus", respectively, presented in title case and standard font. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation.[10] I recognise the second word element "Plus" in the second earlier mark may be seen as a descriptor referring to an advantage or benefit or as something additional. However, it will still contribute to the overall impression. Therefore, the overall impression of the marks lies in the words themselves.

62. The applicant's figurative marks consist of a combination of word and figurative elements. The word/verbal element "VITAFOR" in a capital case and standard font sits in the centre of the mark against a swirl device enclosed in a circle border. The contested marks appear in red and grey, while the word element is in white font in both versions. The word element

[10] See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

has the greatest weight in the overall impression, whereas the devices have some but slightly less weight in the overall impression.

Visual Comparison

*First Earlier Mark '018*

63. The contested mark incorporates all the first four and the last two letters of the single-worded earlier mark except for the letter in position five (VITAFOR/Vitacor). I bear in mind that the beginnings of words tend to have more impact than the ends, although this is just a rule of thumb.[11] The font and colour divergence of these word elements will play no material role due to the notional and fair use of the earlier word mark in any standard font, case, and colour. The device elements present in the contested mark are absent in the earlier mark, introducing a further visual difference. Taking into account the overall impression of the marks and the similarities and differences, I find there is a medium to high degree of visual similarity.

*Second Earlier Mark '565*

64. The earlier mark is a two-word mark (Vitacor Plus), whereas the contested mark is single-worded. Following the analysis in the preceding paragraph, the contested mark incorporates all the letters of the first word component (Vitacor) of the earlier mark apart from the letter in the fifth position. Also, the notional and fair use of the earlier mark applies here, thereby creating no visual difference as to font case and colour among the competing marks. A notable divergence is that the earlier mark contains the word "Plus", which is not present in the contested mark. As shown previously, another point of difference is the presence of the device element in the contested mark. I consider there to be a low to medium degree of similarity.

[11] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Aural Comparison

*First Earlier Mark '018*

65. The first earlier mark '018 will be articulated as "VI-TA-KOR" and the word element of the contested mark "VI-TA-FOR". The contested marks overlap to a great extent sharing the same beginning, middle syllable, and endings (VI-TA-KOR/ VI-TA-FOR). A point of aural difference is created due to the first letter of the last syllable (VI-TA-KOR/ VI-TA-FOR). In addition, I do not consider that the average consumer will attempt to articulate the device elements in the applicant's marks. Taking into account the overall impressions, I consider that the marks are aurally similar to a reasonably high degree.

*Second Earlier Mark '565*

66. The second earlier mark '565 will be verbalised as "VI-TA-KOR-PLUS". The findings demonstrated in the previous paragraph apply here as to the first word component of the second earlier mark and the contested mark (VI-TA-KOR/VI-TA-FOR). As for the second word component "PLUS", there is no phonetic counterpart in the contested mark, creating a further aural divergence between the competing marks. I have already indicated that the consumers will not verbalise the device elements found in the contested mark. In this case, the respective marks are similar to a medium degree.

Conceptual Comparison

67. In his submissions in lieu, the opponent claims that "both marks include the term "VITA" which suggests a link with vitamins and health and well-being."

68. I accept, to a degree, the opponent's submissions that the average consumer will perceive VITA- as a reference to life/vitality or vitamins, thereby discerning a common meaning from the word elements

Vitacor/VITAFOR. I note that this will be more apparent for the health care professional. As for the second word component “Plus” of the second earlier mark ‘565, it is a common dictionary word and will be perceived as offering something extra. Although the words Vitacor/VITAFOR in their totality are invented words, in my view, the conceptual commonality created by ‘VITA-’ will result in some, although not high overall, conceptual similarity.[12] Whilst accepting this point, I also consider it likely that some, albeit a lesser proportion, of average consumers will not see the VITA- meaning.

**Distinctive Character of the Earlier Trade Mark**

69. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

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

[12] See *Mundipharma v OHMI - Altana Pharma (RESPICUR),* Case T-256/04.

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

70. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

*First Earlier Mark '018*

71. As delineated above in this decision, the "Vita-" component may allude to the goods at issue, but the totality of the word "Vitacor" shows a measure of inventiveness. Therefore, I recognise that Vitacor as a whole is an invented word but cannot ignore that the mark includes an allusive element. Thus, the first earlier mark is inherently distinctive to a medium degree as a whole. For those (lesser proportion) that do not see the allusiveness, the mark is highly distinctive.

*Second Earlier Mark '565*

72. As in the first earlier mark, the distinctiveness lies with the word Vitacor, and, as noted above, I consider it possesses a medium degree of distinctive character. Although the second earlier mark contains the word Plus, a dictionary word suggesting that the goods offer something extra, this will not add any further distinctiveness to the mark. For those that don't see the allusiveness, the mark is still reasonably high in distinctiveness, notwithstanding the inclusion of the word Plus.

73. The level of distinctiveness of a mark may be enhanced through use. The opponent has provided evidence of use of the earlier marks. I should stress here that, whilst the marks are EUTMs, it is the position in the UK that must be considered because the question is whether the average consumer in the UK will be confused. Thus, more focus needs to be placed on the use

made to UK consumers. I find the evidence insufficient to demonstrate that the marks have acquired an enhanced degree of distinctive character through use in the UK for the goods that the opponent has genuinely used the marks. The sales which have been evidenced, including in the UK, do not strike me as particularly significant in what must be a fairly large market. There is no indication of the market share held by the marks and no marketing expenditure figures as to the amount invested by the opponent in promoting the given marks. Overall, whilst the marks have been genuinely used, the evidence is insufficient to demonstrate enhanced distinctiveness.

**Likelihood of Confusion**

74. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[13] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[14]

75. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

[13] See *Canon Kabushiki Kaisha*, paragraph 17.

[14] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

76. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

77. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

78. Earlier in this decision I have concluded that:

- the goods at issue are identical or else highly similar;
- the average consumer of the parties' goods is a member of the general public or a health care professional, who will select the goods by predominantly visual means, but without dismissing the aural means. The attention will normally be average but higher than average for some goods for particular dietary requirements;

- the contested mark and the earlier mark ‘018 are visually similar to a medium to high degree; aurally similar to a reasonably high degree and conceptually similar;

- the contested mark and the earlier mark ‘565 are visually similar to a low to medium degree; aurally similar to a medium degree and conceptually similar;

- the earlier marks have a medium degree of distinctive character, whilst for those who do not see the allusiveness of the ‘Vita-’ component, the marks have a highly distinctive character. The use is not sufficient to establish enhanced distinctiveness of the marks.

79. As the earlier marks differ in one or more points, I will evaluate them separately.

*First Earlier Mark ‘018*

80. Taking into account the above factors and considering the identical goods in play, I find that the visual and aural similarities between the verbal elements of the respective marks (having the greatest weight in the overall impressions) would, in my view, cause the marks to be misremembered or mistakenly recalled, especially because of the shared structure, length and letters, i.e. identical first four and last two letters, and the identity of the goods. It is my view that the different letter (Vitacor/VITAFOR) is in a much less impactful positioning than if it were at the beginning of the word. The device elements in the contested mark, playing a less prominent role, may well be lost due to the principle of imperfect recollection.

81. Whilst for the group of consumers that may perceive the identical component ‘Vita-/VITA-’, placed at the beginning of the competing marks, as allusive to vitality/vitamins, and that this could potentially reduce the likelihood of confusion, in this present case, it is the whole and not part of the verbal elements of the applicant’s marks (VITAFOR) that will be mistaken for the opponent’s earlier mark (Vitacor) or vice versa leading to

a likelihood of direct confusion. This finding applies to both types of average consumers for the reasons advanced above, despite the slightly higher than average degree of attention for some, which might potentially affect to an extent imperfect recollection.

82. Even if the average consumer recalls that one mark consists of device elements and the other not, I still consider that the marks would be indirectly confused for identical goods, with Vitacor/VITAFOR being imperfectly recalled as each other and with the difference in device elements put down to the use of a brand variant.

*Second Earlier Mark '565*

83. Considering first direct confusion, despite the imperfect recollection and the identity of the goods in question, the differences between the marks on a visual and aural basis, mainly emanating from the additional word "Plus" in the earlier mark, are sufficient to inhibit the average consumer from misremembering or mistakenly recalling one mark as the other.

84. In terms of indirect confusion, the average consumer, having identified that the marks are different (additional word and device elements), will, though, assume that the identical goods are offered by the same or economically linked undertaking. The imperfect recollection of the Vitacor/Vitafor element, the similarities between the first word element, the structure of the letters, and the conceptual similarity will aid the average consumer to perceive the marks as coming from the same or related undertaking. Against this background, it is my view that the average consumer would believe that the marks are indicative of a sub-brand and there is some economic connection between them. As a result, I find there is a likelihood of indirect confusion.

85. Last, I have considered the opponent's submissions in lieu referring to the EUIPO opposition with No. B003069100, involving the same applicant but different opponent, with the former withdrawing the contested mark; and the original decision in Spanish of the Spanish Trademark Office refusing

the applicant's mark. Whilst bearing these cases in mind, they have had little influence on my decision. First, the fact that in one territory the contested mark was withdrawn is neither here nor there, in terms of assessing, the merits of the present case. Second, the fact that the applicant's mark was refused by the Spanish Office is similarly not significant (notwithstanding that my decision is also to refuse the application) as I am duty bound to consider the matter on the basis of the evidence and facts before me.

**OUTCOME**

86. Given that the first earlier mark '018 and second earlier mark '565 succeed in full, the opposition under Section 5(2)(b) of the Act is successful in its entirety. Therefore, subject to appeal, the application will be refused.

**COSTS**

87. The opponent has been successful and is entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £1,500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

| | |
|---|---|
| **£100** | Official opposition fee |
| **£250** | Filing a notice of opposition and considering the counterstatement |
| **£650** | Filing evidence |
| **£500** | Filing written submissions in lieu |
| **£1,500** | Total |

88. I, therefore, order VIDA FORTE NUTRIENTES INDÚSTRIA E COMÉRCIO DE PRODUTOS NATURAIS LTDA. to pay Matthias Rath the sum of £1,500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 1st day of October 2021**

**Dr Stylianos Alexandridis**
**For the Registrar,**
**The Comptroller General**