

O-420-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 2 619 857
IN THE NAME OF PHARM MED LIMITED
TO REGISTER IN CLASSES 05,35 AND 42 THE TRADE MARK:**



AND

**OPPOSITION THERETO UNDER NO 103776
BY MERCK CONSUMER HEALTHCARE**

Background and pleadings



1. Pharm Med Limited applied to register the trade mark On 4th May 2012. The application was accepted and published in the Trade Marks Journal on 8th June 2012 in respect of the following goods and services:

Class 5

Mineral food supplements; food supplements; vitamins and minerals; vitamin preparations; mineral preparations; naturopathic and homeopathic preparations and substances; vitamin, mineral and protein preparations and substances; plant compounds and extracts for use as dietary supplements; herbal supplements and herbal extracts.

Class 35

Intermediary business services relating to mineral food supplements, food supplements, vitamins and minerals, vitamin preparations, mineral preparations, naturopathic and homeopathic preparations and substances, vitamin, mineral and protein preparations and substances, plant compounds and extracts for use as dietary supplements, herbal supplements and herbal extracts; wholesale services, retail services and electronic shopping retail services connected with the sale of mineral food supplements, food supplements, vitamins and minerals, vitamin preparations, mineral preparations, naturopathic and homeopathic preparations and substances, vitamin, mineral and protein preparations and substances, plant compounds and extracts for use as dietary supplements, herbal supplements and herbal extracts.

Class 42

Research and development into mineral food supplements, food supplements, vitamins and minerals, vitamin preparations, mineral preparations, naturopathic and homeopathic preparations and substances, vitamin, mineral and protein preparations and substances, plant compounds and extracts for use as dietary supplements, herbal supplements and herbal extracts.

2. Merck Consumer Healthcare oppose the registration on the basis of Section 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") in respect of its earlier United Kingdom registration No 2 005 958 for NATURE'S BEST, filed on 19th December 1994 and registered on 13th December 1996 in respect of the following goods:

Class 3

Essential oils; cosmetics including vitamin and herbal preparations, hair and skin lotions, soaps for personal use, health and beauty requisites.

Class 5

Food supplements, being pharmaceutical preparations and substances, herbal products, food and dietary supplements, vitamins, minerals, amino-acids; nutritional preparations including evening primrose oils, fish oils, marine products, digestive aids, fibre and enzyme products and combinations of the aforesaid goods; tonic preparations and substances.

3. Merck also oppose under Section 5(4) (a) in respect of its claimed common law rights in NATURE'S BEST. It claims that this sign has been used in the UK since 1981 in respect of the same goods as detailed above in classes 3 and 5.
4. Under Section 5(2) (b), Merck claim that the dominant element in the contested trade mark is "Nature's Best Sellers", the remaining elements being devoid of distinctive character. As such the marks are similar. As the goods and services are identical and/or similar, there is a likelihood of confusion. Under Section 5(3), Merck claim that its earlier trade mark has been in continuous use since 1981 with a substantial sum spent on nurturing and promoting the brand. As such, unfair advantage would be taken by the contested trade mark as a result of being linked with the opponent. Further, this would lead to tarnishment and dilution of the opponent's reputation. Finally, should the applicant's goods be of inferior quality, there will be a loss of sales for the opponent which will be irreparably detrimental. Under Section 5(4) (a), Merck claim that it has a substantial reputation and goodwill. It is inevitable that there will be misrepresentation and damage.
5. Pharm Med Limited filed a counterstatement denying the grounds of opposition. It also requested that the opponent's provide proof of use of its earlier trade mark.
6. The opponent filed evidence in these proceedings, which will be summarised below. Neither party requested a hearing, nor were written submissions filed in lieu. This decision is therefore given following a careful consideration of the papers.

Proof of use provisions

7. In opposition proceedings, earlier marks for which the registration procedure was completed before the five year period ending with the date of publication of the contested mark may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)¹. The contested mark was published on 8th June 2012. The earlier trade mark relied upon completed its registration procedure on 13th December 1996, therefore the proof of use provisions apply.

Opponent's evidence

8. This is a witness statement from Nicholas Guy Fraser, the company secretary of Lamberts Healthcare Limited (LHL), a wholly owned subsidiary of the opponent. The following relevant points are contained therein:

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

O-420-13

- The opponent has traded under NATURE'S BEST in the UK since 1981. It has been registered as a trade mark since 1996 when the application was supported with evidence of acquired distinctiveness through use.
- Annual sales of Nature's Best products are as follows:

• Year	• Annual sales in GBP
• 2005	• 8,655,000
• 2006	• 8,863,000
• 2007	• 8,504,000
• 2008	• 8,123,000
• 2009	• 8,929,000
• 2010	• 8,821,000
• 2011	• 9,015,000
• 2012	• 10,086,000
• Total	• 70,996,000

- The following amounts have been spent on advertising and promotion of the Nature's best brand in the UK:

Years	Amount in GBP
2005	2,216,000
2006	2,355,000
2007	2,643,000
2008	2,455,000
2009	2,385,000
2010	2,100,000
2011	2,253,000
2012	2,401,000
Total	18,808,000

- Exhibit NGF1 is a printout from the opponent's website, describing the history of the company and confirming that they have traded since 1981.
- Exhibit NGF2 are copies of brochures illustrating use of Nature's Best in the UK between 2005-2012. It is noted that use of Nature's best is shown on a range of food supplements, vitamins and nutritional supplements. It is also shown on a limited range of toiletry products such as shampoos, body washes and lotions/body creams.
- Exhibit NGF3 are copies of advertisements for Nature's Best products placed in a variety of national newspapers between the years 2005 and 2012.
- Exhibit NGF5 are copies of dictionaries, reference texts and newspapers which define or otherwise discuss the term "Superfoods". This was discussed in one national newspaper as early as 2005. Exhibit NGF6 is the result of an internet search which returned over 5million hits in respect of the term. Mr Fraser also points out that the term superfoods has become so widespread that the European Union banned its use via legislation unless it was accompanied by a specific authorised health claim that explained to customers why the product in question was good for their health. Exhibit NGF7 is an article from the BBC News website, dated 29 June 2007, referring to the EU's desire to regulate use of the term SUPERFOODS.

The remainder of the evidence is comprised of submissions which will not be summarised here, but will be referred to, where appropriate, during this decision.

Conclusions on proof of use

9. It is clear from the evidence filed, in particular the brochures, that the earlier trade mark has been used in respect of a wide range of goods. Certainly, the Tribunal is satisfied that use has been shown across all of its earlier goods for which its mark is registered.

Class 3

Essential oils; cosmetics including vitamin and herbal preparations, hair and skin lotions, soaps for personal use, health and beauty requisites.

Class 5

Food supplements, being pharmaceutical preparations and substances, herbal products, food and dietary supplements, vitamins, minerals, amino-acids; nutritional preparations including evening primrose oils, fish oils, marine products, digestive aids, fibre and enzyme products and combinations of the aforesaid goods; tonic preparations and substances.

DECISION

10. The relevant parts of section 5 of the Act read as follows:

(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.

11. The leading authorities which guide me in this ground are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc* [1999] RPC 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* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C- 334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

O-420-13

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*
- f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

The average consumer

12. 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 goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).

13. In respect of the class 5 goods, it is noted that these are purchased for the purpose of improving and/or maintaining health. They are likely therefore to be considered purchases, with a customer taking time to ensure the correct product is purchased, containing the correct ingredients in the required amount. It is considered therefore that a high degree of attention will be displayed during the purchasing process. Likewise in respect of the services, they are likely to represent a significant monetary outlay and will be chosen carefully and so again a high degree of attention will be expected. In respect of the class 3 goods, these will contain quite a range with some items being quite cheap and purchased frequently and others being more expensive and purchased less frequently. Bearing in mind this range, it is concluded that the average position is that such purchases are likely to be at least reasonably considered.


Comparison of goods.

14. It is noted that some of the class 5 goods are identical as they are expressed in identical terms, for example vitamins. These goods clearly represent the high point of the opponent’s case and if they cannot succeed here in respect of confusion, they cannot succeed anywhere. As such, the identical goods will be the focus of the decision as to likelihood of confusion.

Comparison of marks

15. 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.

The respective trade marks are shown below:

<p>Nature’s Best</p>	
<p>Earlier trade mark</p>	<p>Contested trade mark</p>

16. It is noted that the earlier trade mark is a word only mark whereas the contested trade mark is a complex mark comprised of a number of elements. Visually, they coincide in respect of the elements “Nature’s Best”, which appear in each. They differ in respect of the numerous additional elements present in the contested trade mark, not least the shield device containing the letter “S”, the word “Superfoods” and the additional word “sellers!”. These all have a significant visual impact. Bearing in mind all of the aforesaid, it is considered that the degree of visual similarity, is very low.
17. Aurally, the point of coincidence corresponds with the visual analysis. It is considered unlikely that all of the verbal elements of the contested trade mark will be articulated. The most likely scenario is that it will be referred to as “S Superfoods”, thus leading to no aural similarity. However, even in the event that all elements are articulated, the degree of aural similarity is in any case, considered to be very low.
18. Conceptually, the earlier trade mark will be understood as referring to the best that nature has to offer, a strong allusion of its nutritional credentials. The contested trade mark follows a not dissimilar theme, as it includes “superfoods”. The opponent has filed evidence on the meaning of superfoods and it is considered that this term is indeed understood to mean a food that is exceptionally nutritious and beneficial to health. However, the contested trade mark also introduces the idea of popularity in respect of “best sellers” which is likely to be seen as a discrete term with a meaning divergent from “nature’s best”. It is considered that this constitutes at least to some extent, a conceptual gap. However, this gap is not so great that an entirely different meaning is instantly grasped and understood as the presence of superfoods will inevitably be understood as pertaining to good nutrition. Bearing in mind all of the aforesaid, the marks are considered to be conceptually similar, at least to a low degree.

Distinctive and dominant components

19. It is considered that the earlier trade mark does not have separate distinctive and dominant components. Rather, it will be appreciated instantly as a whole.
20. In respect of the contested trade mark, the opponent argues that the shield device and the element “superfoods” are non-distinctive and that the dominant and distinctive element is therefore Nature’s Best Sellers! Unsurprisingly, the applicant disagrees. On viewing the contested trade mark, it is considered that the shield device together with superfoods is visually dominant. This is supported by its relative larger size to the remaining elements, its position on top of the remaining elements and the fact that it appears in a mustard yellow colour. It is accepted that “superfoods” has a meaning in respect of, at least the goods applied for. However, in combination with the shield device, it catches the eye first. Further, the shield is perfectly distinctive. It is considered therefore that this element is the dominant and distinctive element of the contested trade mark.
21. Bearing in mind all of the aforesaid, it is considered that the respective trade marks are similar, only to a very low degree.

Distinctiveness of the earlier trade mark

22. The degree of distinctiveness to be accorded to the earlier trade mark is important because the more distinctive the earlier marks (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

23. The distinctiveness of a trade mark is to be assessed on the basis of the goods and services to which it is applied, from the perspective of the consumers of those goods and services. Prima facie and bearing in mind the goods to which it is applied, the earlier trade mark has relatively weak distinctive character. Indeed it was registered on the basis of distinctiveness having been acquired through use. However it is a registered trade mark and so has a presumption of distinctiveness. Its weak starting point means that it is considered to be no more than averagely distinctive as a result of the use made of it.

Global Assessment – conclusion on likelihood of confusion

24. In considering the likelihood of confusion therefore, it is clear that the factors assessed 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.

25. Some of the goods are identical and these represent the high point of the opponent's case. The respective trade marks have a number of features which distinguish them from one another with only a very low degree of visual similarity, a low degree of conceptual similarity and (at best) a very low degree of aural similarity. Further, the earlier trade mark is, at best, only averagely distinctive. It is true that the relevant public rarely have the opportunity to view trade marks side by side and so rely on an imperfect picture of them. However, it is likely that these purchases will be considered, perhaps highly so. In addition and as already stated, the trade marks have only a very low degree of similarity with a number of distinguishing features. These factors negate against imperfect recollection. There is considered to be no likelihood of confusion, even in respect of the goods which are clearly identical.

26. The opposition based upon Section 5(2) (b) of the Act therefore fails.

Section 5(3) – Reputation

27. Section 5(3)² of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair

² Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01)).

O-420-13

advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

28. In order to succeed under this ground the earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU stated:

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

29. The opponent has provided, in its evidence, details of sales together with examples of advertisements placed in national newspapers over a period of seven years from 2005 to 2012. The sales figures appear to be not insignificant, though there is no information on the number of units sold. Further, no information is provided as regards the size of the particular market as a whole, nor is there any information as to what these figures actually equate to in respect of market share. It is therefore impossible to place them into any meaningful context. It is noted that adverts have appeared in national newspapers. However, it is unclear as to their impact. Bearing in mind the nature of the goods here, the relevant public is the public at large. There is nothing in the evidence that leads to the conclusion that the earlier mark is known to a significant part of the public at large. It is therefore considered that the evidence filed is unpersuasive as regards reputation. Furthermore, even if there were a reputation, the differences in the trade marks mean that no link would be made. As such, this ground of opposition necessarily fails.

Section 5(4)(a) – Passing Off

30. The basis of the claim under Section 5(4)(a) is identical to that already rejected under Section 5(2)(b). If there is no confusion in respect of identical goods, it is difficult to see how there can be a misrepresentation. This ground of opposition therefore also fails.

31. The sum of all this is that the opposition fails in its entirety.

COSTS

32. The applicant has been successful and is entitled to a contribution towards its costs. The applicant is therefore awarded the amount of £850. This is made up as follows:

Considering opposition - £200
Statement of Case in Reply - £300
Considering Evidence - £350

O-420-13

33. I order Merck Consumer Healthcare to pay Pharm Med Limited the sum of £850.

This sum is to 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 28th of October 2013

Louise White

**For the Registrar,
The Comptroller-General**