

O-342-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2655136
BY ALKA9 LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 32:**



AND

**OPPOSITION THERETO (NO. 400607)
BY WP IP & DEVELOPMENT BV**

The background and the pleadings

1) Trade mark application 2655136 was filed by Alka9 Ltd (“the applicant”) on 5 March 2013. It was published in the Trade Marks Journal on 26 April 2013. The mark and the goods for which registration is sought are set out below:



Class 32: Mineral and aerated waters, non-alcoholic drinks, fruit drinks, fruit juices

2) WP IP & Development BV (“the opponent”) opposes the registration of the mark. The opponent is the proprietor of the following earlier mark¹:

International Registration (“IR”) 1129392

ALKAVITAE

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; nutritional beverages for medical use; vitamins and vitamin supplements; minerals and mineral products; homeopathic products and preparations; natural medicines; medicinal herbs and herbal preparations for medical purposes; food supplements and food additives for non-medical use, with the addition of vitamins, minerals and/or herbs, not for medical use, included in this class; dietetic food and supplements not for medical use and not included in other classes; non-medicated food supplements, plant and herb extracts for medicinal purposes, medicinal herb extracts; non-medicated food and nutritional supplements in liquid or powder form included in this class.

Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-medicated supplements for drinks; sports drinks and energy drinks and multivitamin drinks not included in other classes; health drinks for non-medical use included in this class; mineral waters containing mineral supplements.

¹ The opposition was initially based on two earlier marks, but one of them (IR 1077103 – AlkaLife) was under opposition at the time and was subsequently transferred to another party. The opponent withdrew its reliance on that mark and no request for the new owner of it to be joined to the proceedings was made.

which designated the EU for protection on 20 March 2012 with protection being granted on 6 August 2013.

3) The opponent relies on the above mark as the basis for a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The applicant filed a counterstatement denying the ground of opposition. Both sides filed evidence and written submissions. Neither side requested a hearing. The applicant filed written submissions in lieu of attending a hearing, the opponent did not.

Section 5(2)(b)

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

“5.-(2) 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.”

5) The CJEU has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these casesⁱ:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

6) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods can vary depending on what is involved. The goods involved are various forms of non-alcoholic beverage. These are low cost items purchased fairly frequently by members of the general public. They are not specialist products. This suggests a fairly casual approach in terms of selection. The goods will most often be self-selected from supermarket (etc) shelves or online equivalents, so suggesting that the visual impact of the marks is most important. The aural impact will not, though, be completely ignored because the goods could be ordered (in bars or restaurants) although, the marks will also likely be seen in this environment too. I should add that even though some of the goods may be enriched with mineral food supplements (as per the opponent's mark) this does not materially change the purchasing process.

The comparison of goods

7) I will go through the applicant's specification term by term:

Mineral and aerated waters

8) The goods of the ALKAVITAE mark include "mineral and aerated waters". The goods are, therefore, identical.

Non-alcoholic drinks

9) The goods of the ALKAVITAE mark include "other non-alcoholic drinks". The goods are, therefore, identical.

Fruit drinks, fruit juices

10) The goods of the ALKAVITAE mark include "fruit drinks and fruit juices". The goods are, therefore, identical.

The meaning/significance of ALKA

11) Part of the applicant's argument is based on a claim that the word ALKA is a commonly used/descriptive prefix in the drinks (and related) field. It is argued that because of this, the average consumer's capacity to distinguish between the marks is even greater. The applicant's evidence comes from Mr David Crouch, a trade mark attorney at Bromhead Johnson. Attached to his witness statement are a number of exhibits which show:

- The case details for the mark ALKA-SELTZER for class 5 goods which consist of a tablet for making seltzer water for the treatment of acidity. Mr Crouch describes this as a well-known mark. Mr Crouch also provides an extract from Wikipedia about the product, although it does little to explain the extent of use of this mark in the UK.
- Case details of 3 marks (ALKA, ALKA REVIVE & ALKA RESCUE) which are all owned by the company responsible for ALKA-SELTZER and which cover drinks in class 32 as well as class 5 goods. There is nothing to show that these marks are being used.
- Case details of 4 marks (ALKALONE, ALKAZEN, ALKAGEN & ALKASTREAM) owned by three separate proprietors, all of which cover drinks in class 32 as well as other goods in other classes.
- A website print regarding the ALKASTEAM product. The product depicted is a replacement filter for some sort of system which reduces fluoride and calcium in tap water. There is no use of ALKA (or alkaline) in a descriptive

sense in the information given on the website about the product. However, a second print from eBay shows another replacement filter for “AlkaStream Water **Alkaline** ioni...” (my emphasis).

- Case details for the mark AlkaPod for goods in class 11, namely a portable water filter and ionizer with “integral alkalising ionising minerals”. This registration is owned by a separate company to all the others. Also provided is a website print about the AlkaPod product which, apparently, turns ordinary water into “Alkaline water”, something which has been used by people in Japan and Korea for many years. A further website print containing similar information is also provided.
- Case details for the mark Alkaherb for goods in class 30 for tea beverages and flavouring for beverages. This registration is owned by a separate company to all the others. Website prints are provided about the product. There is no use of ALKA (or alkaline) in a descriptive sense in the information given on the website about the product.
- Case details for the mark AlkaBath for goods in class 3 (bath salt) and beauty services in class 44. This registration is owned by a separate company to all the others. A website print showing the product is provided which uses the word ALKALINE in a descriptive sense a number of times.
- A website print from www.water-for-health.co.uk which promotes the benefits of drinking alkaline water and promotes a number of products (filters, cartridges, drops etc) to make alkaline water.
- A website print from DetoxifyNow.com. It also promotes the benefits on alkaline water. It is not clear if this is a UK centric website. I think it more probable that it is US centric. I note on page 10 of 28 that “This page is a good comparison of the various models available in the US, though in the UK/EU the choice is more limited at the moment”. In the same page a price is given in \$.
- A product safety sheet for ALKAZYME (produced by ALKAPHARM) which is a “pre-disinfectant for re-usable surgical/medical/dental instruments”. There is no use of ALKA (or alkaline) in a descriptive sense in the information given on the website about the product.
- A website print for a product called “Alka Alfes Cocoa Cream Wafers”. There is no use of ALKA (or alkaline) in a descriptive sense in the information given on the website about the product.

12) In response, a witness statement was filed on behalf of the opponent by Ms Katherine Cameron, a trade mark attorney at RGC Jenkins & Co. Her evidence is that the word ALKA has no meaning. She provides a print from the relevant parts

of the Collins English Dictionary and the British National Corpus with a negative result for this word. She adds that an “alkali” is a basic, ionic salt of an alkaline metal; it is something that has a base which dissolves in water. She states that the word “alkaline” does not describe an ingredient or substance - it merely describes a form of a substance when it has a high PH level (greater than 7). In the accompanying submissions it is highlighted that the majority of the applicant’s evidence is state of the register rather than state of the market so does not assist.

13) The significance of the word ALKA must be appraised in relation to the goods of the application. The goods are non-alcoholic beverages. From that perspective, there is not a single piece of evidence to show that there is a trade in the UK for alkaline water or any other beverage that has had some form of alkaline treatment. The closest one gets are some trade mark registrations with the word ALKA as a suffix (or in one case ALKA per se), but there is no evidence that they are used in relation to class 32 goods. There is evidence showing that alkaline water has some perceived health benefits (although one of the web pages provided is possibly US centric) and that products exist to make such water. However, whilst this is noted, the evidence does not persuade me that this is a particularly well-known phenomenon. Whilst a small number of people may be familiar with this, this will not have had a great impact on the average consumer. Submissions are made on the basis that use in similar fields is also relevant. Whilst in some cases such an argument may work, the applicant’s evidence here is weak. The degree of impact is not known. In some of the examples provided no mention is made of alkaline in a descriptive sense so as to educate the average consumer that ALKA is being used to suggest alkaline properties. Neither does the existence of ALKA-SELTZER help. Firstly, there is no real evidence of use in the UK of this mark. Furthermore, I am not prepared to infer that the average consumer of the ALKA-SELTZER product will have analysed the mark to the point where ALKA is given a descriptive or suggestive meaning. In any event, whilst the product is added to water, it will firmly be regarded as a medicinal product so does not heavily influence the meaning of ALKA in respect of class 32 goods.

14) I come to the view that the evidence fails to establish that ALKA, in relation to beverages in class 32, will be perceived by the average consumer as being descriptive/suggestive of alkaline. Nor does the evidence establish common use of this abbreviation in the relevant field.

Comparison of marks

15) The comparison is between:



and

ALKAVITAE

16) In terms of dominant and distinctive elements, in ALKAVITAE, which naturally breaks down into its two component parts, both the words ALKA and VITAE are equally distinctive and play a roughly equal contribution to the mark. In terms of the applicant's mark, the visual impact of the three coloured overlapping shapes is quite striking. The numeral 9 is not particularly distinctive. The A (PERSON) KA element is also distinctive and dominant, but the visual impact created as whole is significant. In terms of how this mark will be perceived, I accept that there is room for more than one view. Some will see the mark as A-KA-9 with a human being placed between A and KA and will see nothing more than that. On the other hand, some will see the human being intended to represent the letter I. There is more argument for a likelihood of confusion on the part of the latter than the former, so I will focus on this average consumer from this point on.

17) From a conceptual perspective, the finding I have already made (that ALKA has no descriptive or suggestive connotation in the drinks field) means that no conceptual similarity is created due to the common presence of ALKA or the element in the applicant's mark that will be perceived as this word. Any concepts are likely to be based more on the other aspects of the marks which are not similar. This could equate to a conceptual difference, however, I come to the view that the position is more of a neutral one given that neither mark possesses a clear conceptual meaning in totality.

18) Aurally, ALKAVITAE will be articulated as AL-KU-VIE-TIGH or AL-KU-VEE-TIGH, and the applicant's mark, because the human being will be seen as representing the letter I, as AL-KU-NINE. The beginnings are the same, the endings quite different. There is a moderate degree of aural similarity between the marks.

19) Visually, the marks share the letters A and KA, they have an L (in the case of the earlier marks) or a human that is intended to represent that letter. However there are differences in terms of the number 9 in the applicant's mark compared to the word VITAE in the earlier marks. There is also the visually striking device element in the applicant's mark. Overall, any visual similarity is low.

The distinctiveness of the earlier mark

20) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been presented so only the inherent qualities of the mark need to be considered. From that perspective, the combination of a word (ALKA) which I have said does not give a descriptive or suggestive nod to the goods, with the word VITAE creates a mark with a reasonably high level of distinctiveness.

Likelihood of confusion

21) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

22) I think the very clear differences between the marks that I have already outlined mean that there is no likelihood of the marks being confused directly for one another. The differences are so striking to put paid to that. The better argument relates to what is known as indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10) Mr Purvis QC, sitting as the Appointed Person, explained the difference between direct confusion and indirect confusion in the following way:

“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.

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

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

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

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

23) I bear in mind that the goods are identical and the earlier mark reasonably high in distinctiveness. However, the similarity between the marks is not one where the applied for mark looks like a natural extension of ALKAVITAE, there is nothing natural in the word VITAE being replaced by 9. Nor is the applied for mark simply taking the earlier mark and adding a non-distinctive element, there is much more to it than that. However, ALKA is a distinctive element (reasonably high in distinctiveness), so it could be argued (along the lines that the opponent has) that no one else other than the brand owner would include that in another mark. However, it is not as though the applicant’s mark has just taken that word. The letter L is missing and a device of a human being is in its place, it has a numeral 9, and it has an extremely strong visual impact. I come to the view that those elements combined create a mark that looks so visually striking and striking in elements that are not in common with the earlier mark, which means that the average consumer will not consider the point of similarity to indicate a same stable product. To come to the opposite view would require, in my view, far too analytical an approach, an approach that the average consumer is most unlikely to adopt for the goods at issue here. **There is no likelihood of confusion.**

Costs

24) The applicant has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side's statement - £300

Considering and filing evidence - £500

Written submissions (filed with its evidence) £400

Total - £1200

25) I hereby order WP IP & Development BV to pay Alka9 Ltd the sum of £1200 within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 4th day of August 2014

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

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).