

**O-260-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3110533  
BY PRO GAINS LIMITED TO REGISTER THE TRADE MARKS**



**IN CLASS 29**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 405091  
BY GLAXOSMITHKLINE CONSUMER HEALTHCARE (UK) IP LIMITED**

## Background and pleadings

1) Pro Gains Limited (“the applicant”) applied to register the following trade mark in the UK on 27 May 2015:



2) It was accepted and published in the Trade Marks Journal on 19 June 2015 in respect of the following Class 29 goods:

*Prepared dishes consisting principally of meat; Prepared meals containing [principally] chicken; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes.*

3) GlaxoSmithKline Consumer Healthcare (UK) IP Limited (“the opponent”) oppose the mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK mark no. 2029053 in respect of the mark PROGAIN. The following Class 5 goods are relied upon in this opposition:

*Nutritional products, protein/carbohydrate preparations; all adapted to increase body-weight, as a meal replacement or for the provision of energy/calories.*

4) The earlier mark completed its registration procedure on 3 April 1998. This is more than five years before the publication date of the applicant’s mark. The significance of this is that the opponent’s mark is subject to the proof of use provisions contained in Section 6A of the Act.

5) The opponent claims that the respective goods are similar and that the marks are similar. It claims that “Pro Gains” is the dominant feature of the applicant’s mark and this word element is identical or near identical to its mark. As a result of these similarities, it claims that there is a likelihood of confusion.

6) The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier mark.

7) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate or necessary.

8) The opponent filed written submissions which will not be summarised but will be taken into account where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## Opponent's Evidence

9) This takes the form of a witness statement by Charles M. Atkinson, Vice President, Consumer Healthcare Trade Marks of GlaxoSmithKline Services Unlimited that is, together with the opponent, part of the GSK group of companies. He has responsibility for the mark PROGRAIN, owned by the opponent.

10) Mr Atkinson states that the opponent's predecessor as proprietor of the earlier mark, Maxinutrition Limited, commenced use of the mark in 1996 and that it has been used continuously since. He provides a number of invoices at Exhibit CMA2 from March 2011 to May 2012. These are to six different customers, three in the north of England, one in the Midlands, one in Wales and one in the south of England. The invoices relate to numerous brands of goods, but the goods identified as being branded PROGRAIN are shown below, together with the approximate value of the sale and the date of the invoice in which they appear:

- flapjacks (£14) (invoice date 15 March 2011);
- items identified as "Progain (choc)" (£4240), "Progain Extreme (Choc)" (£2854) and "Progain (Straw)" (£8325) and "Progain Extreme (Straw)" (£6658) (15 March 2012);
- flapjack (£538), "Progain (Straw)" (£6159), "Progain Extreme (Straw)" (£6369), "Progain Extreme (Choc)" (£6369), "Progain (Choc)" (£4839), "Progain (Vanilla)" (£2419), "Progain (Banana)" (£3226), "Progain (Choc)" (£3412) and "Progain (Straw)" (£1137) (29 February 2012);
- "Mini Progain (Strawberry)" (£4679) (28 March 2012);
- "Progain (Banana)" (£426), "Progain Extreme (Straw)" (£18,050), "Progain Extreme (Choc)" (£7413), "Mini Progain (Strawberry)" (£364), flapjack (£374), "Progain Extreme (Banana)" (£1195), "Progain Extreme (Vanilla)" (£1195) (13 April 2012);
- "Mini Progain (Chocolate)" (£550), "Progain Extreme (Straw)" (£1690), "Progain Extreme (Choc)" (£1126), "Progain (Choc)" (£501) (10 May 2012);
- "Progain (Straw)" (£90), "Progain (Choc)" (£45) and flapjack (£48) (2 March 2012);
- "Progain (Straw)" (£68) and flapjack (£24) (29 May 2012);

11) Mr Atkinson refers to the "Progain" products that appear in these invoices as "powder" or "powder for shakes". He also provided "invoiced sales" figures for the years 2012 to 2015. He states that they are in excess of £2.1 million, £1.4 million, £2.2 million and £1.4 million respectively. The invoices are addressed to businesses such as *Holland & Barratt*, *Health & Beauty*, *Amazon EU Sarl*, *Tesco* and *L.A. Fitness*.

12) At Exhibit CMA3, Mr Atkinson provides a copy of the opponent's first catalogue dated "Spring 1997". He states that additional catalogue extracts are also included from the years 1998 to 2011 and advertising material from before 2010. These show use of its mark, as follows:

- In the "1998 Trade Price List", under the heading of "Meal Replacement Sachets" various flavours of PROGRAIN are listed;

- Pages from what appear to be its catalogue from “Summer 2004” includes a page discussing its various products. Under the heading “Weight Gain” a tub of PROGAIN is illustrated. PROGAIN is described as “specially formulated to contain fast digesting, high quality, nutrient dense ingredients”;
- Another page, but it is unclear whether this is from the same catalogue refers to PROGAIN and identifies its beneficial characteristics that includes: “the ultimate ‘hard gainer’ solution. Add a daily serving to a good diet and quickly pack in more mass”;
- A further page illustrates the mark PROGAIN in use in respect of flapjack, described as “22g of high quality protein, CLA and the purest creatine into a bar that fits easily into your pocket. It is accompanied by a photograph of a muscular man weight training. It is undated.

13) Mr Atkinson states that in 2011 the opponent’s catalogues were distributed to 70,000 customers.

14) At Exhibit CMA4, Mr Atkinson provides extracts from the opponent’s UK website <http://shop.maxinutrition.com/uses>. These extracts were printed on 4 December 2015 and show PROGAIN used as a secondary mark to “MaxiNutrition” in respect to protein powder for muscle gain and flapjack formulated to “aid high-intensity performance”.

15) Mr Atkinson provides figures showing the number of visits to the opponent’s UK website and submits that because the average time a customer spends on the site is 5 minutes then they will be exposed to its PROGAIN mark. The figures are provided for 2006 through to 2010 and illustrate a trend of increased numbers of visits rising from 161,913 in the fourth quarter of 2006 to 403,223 in the fourth quarter of 2010.

16) Mr Atkinson states that a review of the applicant’s website ([www.progainsmeals.com](http://www.progainsmeals.com)) shows that it is involved in the sports nutrition business. Copies of pages from the applicant’s website are provided at Exhibit CMA5. These contain photographs promoting the applicant’s “top quality meals” and “tailor made nutrition management” that feature physically fit and muscular looking men in gym vests. The applicant’s mission statement appears and states:

“The mission of Pro Gains is to promote healthy products by providing a range of quality healthy meals, prepared and produced to a high standard by our professional, trained chef, to health conscious gym members and the general public on a calorie controlled diet....”

17) Exhibit CMA6 consists of copies of pages from third party retailers advertising PROGAIN products. They are undated, unless otherwise indicated:

- *Tesco* advertising “Maximuscle Progain Berry flapjack”;
- *Holland & Barrett* promoting various flavours of Progain powder;
- *Amazon* promoting “MaxiNutrition Progain Mass and Strength Flapjack Bars”;
- A *YouTube* video review of Progain described as a “powerful, high protein weight-gain shake to support rapid gains in muscle mass”. It contains a publication date of 15 December 2014;

- A second *YouTube* review of what appears to be the same or very similar product contains the text “uploaded on 9 Apr 2010”

### **Applicant’s Evidence**

18) This takes the form of a witness statement by Marco Hajikypry, Director of the applicant. He states that the applicant’s mark was first used in the UK in April 2015 and it has been used in respect to freshly prepared foods.

### **DECISION**

#### **Proof of use**

19) The relevant part of the Act is Section 6A, which reads as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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.

(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.”

20) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

21) Section 100 of the Act states that:

“100. 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.”

22) The application was published on 19 June 2015 and, therefore, the five year period in which the opponent must demonstrate use of its mark is between 20 June 2010 and 19 June 2015.

23) Mr Atkinson has provided numerous invoices, within this period, to third party retailers such as *Tesco*, *Holland & Barratt* and *Amazon*. In addition, he provides material relating to both the time before and after the relevant period. This material is not directly relevant for demonstrating use in the relevant period, but it does support his statement that PROGAIN products have been sold continuously since 1996.

24) What this evidence illustrates in use of the mark PROGAIN in respect of *flapjack* marketed as a high protein bar for those wishing to increase muscle mass and various powders than can be made up into a *high protein shake* to aid weight-gain. Such products are aimed at individuals who undertake weight training and also other sports competitors. There is no evidence of PROGAIN being used in respect of other goods.

25) Having found genuine use in respect of these goods, I go on to consider what would be a fair specification to reflect this use.

### ***Fair specification***

26) 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:

“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.”

27) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”



64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

28) I keep this guidance in mind. The term *nutritional products*, whilst being broad in meaning, it is limited by the additional description *all adapted to increase body-weight, as a meal replacement or for the provision of energy/calories*. To my mind, this description, when considered in its entirety identifies a sub-category of goods that is consistent with the guidance and one that the opponent may retain based on the use shown.

29) In summary, the use demonstrated by the opponent permits it to retain its original specification of goods in Class 5.

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

30) Sections 5(2)(b) of the Act is as follows:

“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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### Comparison of goods

31) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

32) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity also included consideration of the respective trade channels through which the goods or services reach the market.

33) For ease of reference, the respective goods are:

Opponent’s goods	Applicant’s goods
<b>Class 5:</b> <i>Nutritional products, protein/carbohydrate preparations; all adapted to increase body-weight, as a meal replacement or for the provision of energy/calories.</i>	<b>Class 29:</b> <i>Prepared dishes consisting principally of meat; Prepared meals containing [principally] chicken; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes.</i>

34) In its written submissions, the opponent submits that the respective goods are highly similar. It relies upon a decision of the OHIM (now known as the EUIPO) Board of Appeal, Reference R0683 2010, *Compagnie Gervais Danone v Nutrichem Ciat + Pharma*. The opponent refers to a passage from the decision of the EUIPO Opposition Division that was upheld by the Board of Appeal. This passage reads as follows:

*“the CTM applied for covers nutrient preparations, not for medical purposes, for daily food supplements (including fitness preparations) being prepared foodstuffs ... in Class 29. They can be used as a general substitute for meals. However their main function and aim is to help athletes and bodybuilders to refill on proteins, vitamins and trace elements. Additionally; the contested goods are usually manufactured by specialized undertakings active in the field of food supplements and nutrition for bodybuilders, sportsmen etc. They are available is specialized body-builder and fitness shops ... they are directed at specialized consumers, i.e. sportsmen, body-builders, athletes etc. However, the earlier mark covers – among others – vitamin preparations in Class 5... Thus the goods under comparison can be used in combination with each other. Additionally, they have the same general purposes, i.e. to support the development of muscles and body shape [my emphasis].”*

35) This passage does not appear to support the opponent. It can be seen from the underlined text that the similarity found by the Board of Appeal was in respect of vitamin preparations in Class 5 with nutrient preparations and daily food supplements. The considerations are different to those in the current proceedings. Further, even if I am wrong, I am not bound by decisions of the EUIPO Board of Appeal. In any event, in other cases, the Board of Appeal has also found that goods very similar to those in issue in the current case were considered to have only a superficial level of similarity. For example, in its judgment in *Eyva B.V. v McDonald's International Property Company, Ltd.*, R2477 2014-2 it found that the mere fact that various Class 5 goods including *nutritional supplements; nutritional supplements; dietetic foodstuffs or food supplements for non-medical purposes, food supplements with a protein base and nutritional supplement drinks with a base of proteins* may qualify as “nutrition”, it was of the view that any similarity with Class 29 goods, including *Foods prepared from meat, ... and poultry products*, ended there.

36) I would ordinarily share the views of the Board of Appeal expressed in that decision. However, as Mr Atkinson has shown in his Exhibit CMA5, the applicant's prepared meals are targeted, at least in part, at gym members. This is reinforced by the images of muscular men wearing gym vests that appear on the applicant's website. This illustrates to me that there is closer similarity between the respective parties' goods than one may first assume. It is clear that the applicant's goods are targeted at the same average consumer, namely sportsmen and gym users. The applicant's “tailor made nutrition management” is likely to provide the same high protein or high carbohydrate content sought by such consumers and the same as the goods of the opponent. They respective goods are therefore in competition with each other.

37) Having concluded that the applicant's Class 29 goods include goods that are in competition with the opponent's goods, I also consider it likely that they will be displayed in the same part of the store and may appear on adjacent shelves to the opponent's goods. I conclude that the respective goods may share trade channels.

38) The goods share some similarity in methods of use, in that they are all consumed as part of the consumers' desired diet.

39) Taking all of the above into account, I find that the respective goods share a medium level of similarity between the respective goods.


### **Comparison of marks**

40) 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.”

41) 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.

42) The respective marks are shown below:

Opponent's mark	Applicant's mark
<p style="text-align: center;">PROGAIN</p>	

43) The opponent's mark consists of the conjoined suffix PRO and the word GAIN creating a mark consisting of a single word. Naturally, this is the dominant, distinctive and only component of the mark. The applicant's mark contains various components with a device appearing over the "O" of "PRO" and the "GA" of GAINS and bridges the two words. In much smaller letters, the non-distinctive words "Nutrition Made Simple" appear below the PRO GAINS components. By virtue of its relative size within the mark and its position within the mark, the words PRO and GAINS are the dominant and distinctive components. The device component is also distinctive and I keep this in mind.

44) Having identified the dominant and distinctive component of the applicant's mark is the words PRO GAINS, I now go on to compare the respective marks.

45) Visually, the applicant's mark has a device of, what appears to be either a barbell standing on a concave line appearing at the top of the mark or a representation of wheels and an axle. In addition, the words "Nutrition Made Simple" appear in small letters at the bottom of the mark. These are all absent in the opponent's mark and are therefore differences between them. The applicant's mark also contains the stylised words PRO and GAINS. This component shares similarities with the opponent's mark in that the opponent's mark consists of the word PRO and the word GAIN conjoined. Taking all of this into account, I conclude that the marks share a medium level of similarity.

46) Aurally, the applicant's mark will be articulated as "pro gains". The consumer is not likely to refer to the other components of the mark. The opponent's mark will be

articulated as "pro gain". The only difference between the two marks is the sound created by the letter "s" at the end of the opponent's mark. Therefore, they share a very high level of aural similarity.

47) Conceptually, the both of the respective marks are likely to be perceived as alluding to the goods providing some gain or benefit that is at a professional level. In the case of the applicant's mark, the addition of the words "Nutrition Made Simple" points towards such gains being obtained from nutritional products. The addition of the device, insofar as it is perceived as a barbell creates an allusion of a link to fitness and weight lifting. Where it is perceived as a representation of wheels and an axle, it is likely to be seen as alluding to the delivery method of the goods. Taking all of this into account, I find that the the respective marks share a good deal of conceptual similarity.

### **Average consumer and the purchasing act**

48) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

49) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

50) The opponent submits that the respective goods are of a low to moderate cost and that the consumer's level of attention would not be enhanced beyond an average or normal level. It also submits that the respective goods are directed at the public at large. I agree insofar as the applicant's specification of goods ordinary prepared meals. However, in respect of the opponent's goods that I have found to be in competition with the applicant's goods, the level of attention is likely to be greater. This is because the consumer is looking for specific benefits from using the goods and the precise composition is likely to be analysed in order to identify if the goods meet their requirements. Consequently, the level of care and attention will be raised in respect of purchases of the opponent's goods.

51) The purchasing act in respect to both parties' goods is likely to be the same, namely self-selection from the shelf of a shop or from an online equivalent. The purchase will therefore, predominantly be visual in nature, but aural considerations may play a role in placing telephone orders or where verbal recommendations are made.

## **Distinctive character of the earlier trade mark**

52) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

53) The opponent’s mark consists of the suffix PRO and the word GAIN. As I have stated earlier, this creates the allusion of goods that provide some gain or benefit that is at a professional level. Because of this allusive quality, the mark’s inherent level of distinctive character is not the highest level. Nevertheless, it is no more than allusive and is endowed with a moderate level of inherent distinctiveness.

54) In his evidence, Mr Atkinson has stated that the mark has been used continuously since 1996 and in the years 2012 to 2015, the sale of goods bearing the mark amounted to £1.4 to £2.4 million a year. He has also shown that the opponent’s goods are supplied to a number of large retailers such as *Tesco, Holland & Barrett* and *Amazon*. Set against this is the fact that Mr Atkinson has not supplied any information regarding the market share the goods sold under the mark enjoy, but he does state that 70,000 customers received its catalogue containing PROGAIN goods in 2011. This level of use, whilst not set in the context of market share, suggests that its distinctive character is enhanced through use, but not to any materially significant extent.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

55) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

56) The Applicant's website illustrates that its prepared meals are targeted at gym users and other consumers with specific dietary requirements. As a result, I have found that the applicant's specification of goods includes goods that share a medium

level of similarity with the applicant's goods and that they are in competition with each other. I have also found that the respective marks share a medium level of visual similarity, a very high level of aural similarity and a good deal of conceptual similarity, that the respective goods will have the same average consumer who will pay a raised level of attention when purchasing the respective goods. The purchasing act will be mainly visual in nature.

57) Factoring all of this into the global appreciation assessment, taking account of imperfect recollection and the fact that marks are normally perceived as a whole, I conclude that there is a likelihood of confusion. The device of a barbell/wheels and axle and the presentation of the words PRO and GAINS, in the applicant's mark, is not likely to go unnoticed by the average consumer and, therefore, the consumer is not likely to confuse one mark for the other (known as direct confusion). However, it is likely that the similarities in the marks will lead the consumer to believe that the respective goods originate from the same or linked undertaking (so called "indirect confusion"). I find that there is a likelihood of confusion.

### **Final Remarks**

58) The opposition is successful in its entirety and the application is refused.

### **COSTS**

59) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of (INSERT) as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the counterstatement	£300
Application fee	£200
Evidence	£600
Written submissions	£300
<b>Total:</b>	<b>£1400</b>

60) I order Pro Gains Limited to pay Glaxosmithkline Consumer Healthcare (UK) IP Limited the sum of £1400 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

**Dated this 24<sup>th</sup> day of May 2016**

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