

O-304-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3090775
BY SPYRIDON LAPPAS**

TO REGISTER:

Kidney-Kind

AS A TRADE MARK IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404364 BY KIND LLC**

BACKGROUND

1. On 23 January 2015, Spyridon Lappas (“the applicant”) applied to register the trade mark **Kidney-Kind** in class 5. Following examination, the application was published for the following goods:

Dietetic food; dietetic supplements; natural food based supplements designed specifically for Chronic Kidney Disease Patients.

The application was published for opposition purposes on 20 February 2015.

2. The application is opposed by Kind LLC (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the goods (shown below) in the following United Kingdom and European Union Trade Marks (“EUTM”):

UK no. 2631544 for the trade mark: **KIND** applied for on 13 August 2012 and which was entered in the register on 16 November 2012:

Class 29 - Healthy snacks, namely nut and seed based snack bars; processed fruit and nut-based food bars, nut based snack food bars, fruit based snack food bars also containing nuts, grains, cereals, dried fruits and other ingredients; Dairy based snack foods; yogurt; cheese; vegetable based snack foods; potato based snack foods; fruit based snack foods; nut and seed based snack foods.

Class 30 - Rice based snack foods; wheat based snack foods; cereal based snack foods and cereal derived clusters consisting of nuts, fruits, seeds, whole grains and other ingredients.

EUTM no. 11001807 for the trade mark: **BE-KIND** applied for on 28 June 2012 and which was entered in the register on 12 March 2013:

Class 29 - Healthy snacks, namely nut and seed based snack bars, processed fruit and nut-based food bars, nut based snack food bars, fruit based snack food bar also containing nuts, grains, cereals, dried fruits, Dairy based snack foods, yogurt, cheese; vegetable based snack foods; potato based snack foods; fruit based snack foods; nut and seed based snack foods.

Class 30 - Granola mixes; whole grain-based snack foods, namely rice based snack foods, wheat based snack foods, cereal based snack foods and predominantly cereal based clusters containing nuts, fruits, seeds and whole grains.

3. The applicant filed a counterstatement in which he denies the basis of the opposition. The applicant concludes:

“in summary, the fact that: a) we are in a different product class, b) we are addressing a different market and, c) we share one common word only, lead us to believe that our trade mark and goods are sufficiently different and do not risk causing any confusion.”

4. Both parties filed evidence; the opponent also filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, below.

The evidence

5. The opponent’s evidence consists of a witness statement and two exhibits from Timothy Pendered, a trade mark attorney and partner at RGC Jenkins & Co, the opponent’s professional representatives. Exhibit TGP1 consists of pages from a range of websites filed in support of the following statement:

“2. Food products to suit a wide variety of tastes and/or special needs are readily available on the open market...This includes products to cater for intolerances, such as gluten-free foods, or certain classes of individual, such as infant/baby foods, or people with medical conditions, such as diabetics...”

Exhibit TGP2 consists of pages from a range of websites filed in support of the following statement:

“3. Public awareness of food products and their implications for health have grown at an ever increasing rate in recent years, as has legislation to deal with such areas as production methods and labelling...It is now common practice for members of the public to shop specifically for certain food types. Where once there might have been some distinction between normal or regular foods and say, dietary foods, now there is essentially none. Part of the change in habit is no doubt due to the plethora of media output relating to foods, including numerous regular shows on television....”

6. The applicant’s evidence consists of a witness statement and six exhibits from Mr Lappas. Mr Lappas explains that the trade mark the subject of the application has not been used on any goods and services but, if permitted, he intends to use it upon:

“2. Dietetic food, dietetic supplements, natural food based supplements designed specifically for Chronic Kidney Disease Patients.”

He states that:

“4...the mark Kidney-Kind is solely developed as an oral food supplement product for CHRONIC KIDNEY DISEASE patients undergoing Dialysis...”

Mr Lappas goes on to explain:

“4. Kidney-Kind is addressing a completely different target consumer than the opposition’s audience. Kidney-Kind’s audience is not driven from “typical food based media output” but rather from dietetic advice and recommendations by their renal consultants and dieticians.”

7. Exhibits SL1 and SL2 consist of examples of such advice issued by an American Organisation, the National Institute of Diabetes and Digestive and Kidney Diseases (SL1) and in the second edition of a United Kingdom publication entitled “Kidney Failure Explained” (SL2). Exhibits SL3, 4 and 5 consist of screen prints obtained from the opponent’s website accompanied by guidance issued by the National Kidney Foundation (which also appears to be an American organisation) (SL3), a letter dated 17 March 2015 to the opponent from the U.S. Food and Drug Administration (“FDA”) in which the latter takes issue with the manner in which a number of the opponent’s products are described (SL4) and an article which appeared in the MailOnline on 15 April 2015 which reports on the FDA’s investigations. Based on this evidence, Mr Lappas states:

“4...Kidney-Kind differs in every dimension and parameter from the opposition’s products because their products contain ingredients which are PROHIBITED for CHRONIC KIDNEY DISEASE patients...”

Finally, Mr Lappas states:

“6. The applicant’s competitors are the likes of Abbot (with Nepro), KoRa (with Renapro) and Nestle (with Novasource Renal & Renacal)...”

8. Exhibit 6 consists of literature relating to the products to which Mr Lappas refers which, I note, are described in the following terms: Nepro “Therapeutic Nutrition for People on Dialysis”, Renapro “Nutritional supplement for biochemically proven hypoproteinaemia and patients undergoing dialysis”, Novasource “designed to help meet the unique nutritional needs of people with chronic renal disease” and Renacal “provides nutritional support for people with acute renal failure.”

DECISION

9. The opposition is based upon section 5(2)(b) of the Act which reads 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,

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

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community 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.”

11. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As the trade marks upon which the opponent relies had not been registered for more than five years at the date on which the application for registration was published, they are not subject to proof of use, as per section 6A of the Act. The opponent is, as a consequence, entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

12. The following principles are gleaned from the decisions of the EU 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 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.

The principles:

(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 greater 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

13. Although the specifications of the opponent's earlier trade marks vary slightly, in my view, it is not to the extent that one specification materially improves the opponent's position over the other. Given the approach I intend to adopt in relation to the competing trade marks (paragraph 32 refers), I shall compare the applicant's goods with those in earlier trade mark no. 2631544.

14. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 29 - Healthy snacks, namely nut	Class 5 - Dietetic food; dietetic

<p>and seed based snack bars; processed fruit and nut-based food bars, nut based snack food bars, fruit based snack food bars also containing nuts, grains, cereals, dried fruits and other ingredients; Dairy based snack foods; yogurt; cheese; vegetable based snack foods; potato based snack foods; fruit based snack foods; nut and seed based snack foods.</p> <p>Class 30 - Rice based snack foods; wheat based snack foods; cereal based snack foods and cereal derived clusters consisting of nuts, fruits, seeds, whole grains and other ingredients.</p>	<p>supplements; natural food based supplements designed specifically for Chronic Kidney Disease Patients.</p>
---	---

How should the competing specifications be approached?

15. As the opponent’s specification in class 29 contains the word “namely”, the following guidance in the Trade Marks Registry’s classification guide is relevant:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

16. Mr Lappas has filed evidence showing how the opponent’s use their earlier KIND trade mark and draws various conclusions on the basis of this use. That, however, is not the correct approach. As neither of the opponent’s earlier trade marks are subject to the proof of use requirements, what I must do is consider the matter on a fair and notional basis, comparing the goods in the opponent’s earlier trade mark with the goods for which Mr Lappas’ trade mark has been published.

17. Turning to the applicant’s specification, in his counterstatement, Mr Lappas states:

“Kidney-Kind is a range of oral nutritional supplements strictly to support the clinical needs of renal patients that are on dialysis (blood clearance)...

The exact explanation of goods in the text on our application is: Dietetic food, Dietetic Supplements, Therapeutic Nutrition, natural food based-supplements designed specifically for Chronic Kidney Disease.”

In his witness statement, Mr Lappas explains that he intends to use his trade mark upon:

“2...Dietetic food, dietetic supplements, natural food based supplements designed specifically for CHRONIC KIDNEY DISEASE Patients.”

And:

“4...the mark Kidney-Kind is solely developed as an oral food supplement product for CHRONIC KIDNEY DISEASE patients undergoing Dialysis...”

18. Taking into account Mr Lappas’ various comments mentioned above together with the evidence he has provided, it appears to indicate that it was his intention to limit all of the goods in his application to being: “designed specifically for Chronic Kidney Disease Patients.” However, the manner in which his specification is drafted does not, if indeed that was his intention, achieve that objective. Although the explanation which follows may appear pedantic, the manner in which a trade mark specification is punctuated is an extremely important matter as it defines the scope of the monopoly sought.

19. In the specification published, the use of semi colons after the words “Dietetic food” and “dietetic supplements” means that those goods are unlimited and the limitation to “designed specifically for chronic kidney disease patients” only applies to the “natural food based supplements...”. Contrast this with the specification mentioned by Mr Lappas in his witness statement i.e. “Dietetic food, dietetic supplements, natural food based supplements designed specifically for Chronic Kidney Disease Patients”. In this specification, the use of commas after the words “dietetic food” and “dietetic supplements” means that the various items would be treated as a list and the limitation would apply to all of the goods in the specification rather than just to the “natural food based supplements”. When comparing the competing goods, I must, however, proceed on the basis of the specification published for opposition purposes.

20. In the judgment of the Court of Justice of the European Union (“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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. In its submissions, the opponent states:

“The nature and purpose of the goods applied for overlap with the opponent’s goods, in the sense that they are all for human consumption, as part of a balanced diet. There may well be differences in their composition. However, foodstuffs of different compositions already exist in abundance, so this is not a distinguishing factor. Also, many existing foodstuffs are aimed at different and specific target consumers, so this is not a distinguishing factor either. [The opponent’s evidence] shows a number of well-known food and dietary supplement suppliers who list various ranges of food products to cater for a whole variety of different dietary conditions, such as intolerances, allergies and even diseases. Consequently, the goods applied for do not differ fundamentally in their nature and purpose from the opponent’s goods, even if their composition and target end user might not be the same.

In terms of channels of trade, the goods applied for are of a sort that are likely to be produced and marketed by the same sort of undertakings as for the opponent’s goods, and to pass through similar routes to market. The respective goods are likely to be presented to the average consumer in ways that overlap. For example, via medical advisers and dieticians, through specialist retail outlets that supply health foods products and supplements, from special sections in chemist shops, pharmacies and department stores and via on-line shopping. On-line shopping in particular has become an increasingly popular way for the general public to purchase goods. As the evidence demonstrates, food products of all different kinds and for all kinds of consumer are readily available for purchase on-line.

The goods for which the opponent’s marks are registered are wide enough to cover products that could at least complement the goods applied for, if not compete against them.”

22. Broadly speaking, the opponent’s specification consists of a range of snack foods in classes 29 and 30, whereas the applicant’s specification consists of dietetic food and dietetic and natural food based supplements in class 5.

23. Turning first to the applicant’s “dietetic food”, the users of these goods and those of the opponent may be the same, for example, members of the general public, as may be the physical nature of the goods, how they are used and to some extent their intended purpose e.g. to relieve hunger. As the evidence shows (exhibit TGP 1), the competing goods may be produced and marketed by the same undertakings and may reach the market through the same trade channels. In addition, the evidence shows that the competing goods will be sold in bricks and mortar retail outlets and on-line by the same

undertakings for example, supermarkets, pharmacies and specialist retailers. My own experience tells me that even if the competing goods may not be found on the same shelves of, for example, a supermarket, they may be sold in relatively close proximity. However, as the applicant's "dietetic food" will be selected to deal with a particular dietary or medical condition, I am unable, despite the opponent's submissions mentioned earlier, to identify any meaningful degree of complementarity (in the sense outlined in the case law) or competition between the goods at issue. Weighing the above factors, in my view, results in at least a medium degree of similarity between the applicant's "dietetic food" and the opponent's goods.

24. That leaves the applicant's "dietetic supplements" and "natural food based supplements..." to consider. Once again the users of the competing goods may be the same as may the method of use. However, the physical nature of the competing goods is likely to differ from the opponent's goods as, in my view, will their intended purpose; the intended purpose of the opponent's goods being to relieve hunger whereas the primary intended purpose of the applicant's goods is as a dietary top-up or to assist in the management of the dietary aspect of a medical condition. While such goods may be sold by the same undertakings mentioned above, I think they are less likely to be found on the same shelves or even in close proximity. Once again, in my view, there is no meaningful degree of complementarity or competition between the goods at issue. Considered overall, I find that there is only a low degree of similarity between the opponent's goods and the applicant's "dietetic supplements" and "natural food based supplements..."

25. Although I have concluded that the opponent's goods are similar to the applicant's goods to at least a medium and low degree of similarity respectively, I shall revisit the significance of these findings when I consider the likelihood of confusion.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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."

27. In its submissions, the opponent states:

“Dietetic foods and supplements are intended for human consumption, so the average consumer for such goods includes the general public. It also includes clinicians such as medics and dieticians. The intended end user of [natural food based supplements designed specifically for chronic kidney disease patients] is clearly people with chronic kidney disease. However, the average consumer for such goods also includes clinicians such as medics and dieticians who advise patients with this condition, and it could also include the general public. Consequently, all of the goods applied for could come before the same average consumer as the opponent’s goods, which includes the general public.”

In relation to the nature of the purchasing decision, the opponent states:

“The level of attention of the average consumer for [the applicant’s goods] can be expected to be reasonably high, given that a purchase will require some thought into selecting the right product. At the same time, however, with the main focus being on the composition of the foodstuff, the average consumer might be expected to devote less attention to its particular branding...”

28. The average consumer of the opponent’s goods is a member of the general public. As the average consumer, typically, will self-select such goods from the shelves of, for example, a bricks and mortar retail outlet such as a supermarket or from the pages of a website, visual considerations are likely to dominate the selection process; although aural considerations cannot be ignored, in my view, they will be a much less significant part of the selection process. Given what is likely to be the low cost of the goods at issue and the likely frequency with which such goods may be purchased, I would expect the average consumer to pay a fairly low degree of attention to their selection.

29. The average consumer for the applicant’s goods is either a member of the general public with special dietary needs or, as the opponent submits, professional users such as “medics and dieticians” who advise those with such needs. Insofar as a member of the general public is concerned, as all of the goods at issue may be self-selected from, for example, the shelf of a chemist or retail outlet specialising in such goods or from the websites of such undertakings, visual considerations are likely to play an important part in the selection process. However, as such goods may also (in my experience) be the subject of, for example, enquiries to sales staff in a bricks and mortar retail setting, aural considerations will also play their part. I have no evidence as to how a professional user would select such goods but a review of trade-specific documentation (in both printed and electronic form) and face-to-face discussions with those representing undertakings trading in such goods would seem likely, and point to a mixture of visual and aural considerations being involved.

30. As to the degree of care that these such average consumers will display, keeping in mind that all of the goods at issue are likely to be selected to cater for specific dietary

needs (albeit of varying degrees of severity) and the potentially serious adverse consequences of selecting an unsuitable product, I am led to conclude that both sets of average consumers are likely to pay a high degree of attention to their selection.

Comparison of trade marks

31. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

32. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. When comparing the competing specifications, I did so on the basis of the goods in UK no. 2631544. As that registration consists exclusively of the word **KIND**, in my view, it is this trade mark which offers the opponent the best prospect of success in these proceedings. If the opponent does not succeed in relation to this trade mark, in my view, it will be in no better position in relation to the other trade mark upon which it relies i.e. **BE-KIND**. Having reached that conclusion, the trade marks to be compared are as follows:

opponent's trade mark	applicant's trade mark
KIND	Kidney-Kind

33. As the opponents' trade mark consists exclusively of the well-known English language word KIND presented in upper case (which collinsdictionary.com defines as, inter alia, “beneficial or not harmful”) and as no part of the word is emphasised or highlighted in any way, the overall impression it will convey and its distinctive lies in the word itself.

34. The applicant's trade mark consists of two words presented in title case and linked by a hyphen. The word “Kidney” is so well-known as to require no further explanation and, as the opponent submits: “is likely to be seen as descriptive.” The use of the hyphen as a linking feature, reinforces my own view that the two words “hang-together” to form a “unit”; a unit which alludes to the beneficial (or at least not harmful) nature of

the applicant's goods on one's kidneys. This, in my view, is the overall impression the applicant's trade mark will convey and it is in the totality the distinctiveness lies.

Visual and aural comparison

35. The fact that both trade marks contain the word "KIND/Kind" as a separate component, in my view, inevitably results in at least a medium degree of visual and aural similarity between them.

Conceptual comparison

36. In its submissions, the opponent states:

"The mark applied for is similar in conceptual terms to the opponent's marks, in that it is apt to evoke a sense of reassurance in the products."

The opponent's trade mark, in my view, will be understood as alluding to food products which are beneficial (or at least not harmful) to the average consumer and, as I mentioned above, the applicant's trade mark as alluding to products which are beneficial (or at least not harmful) to the average consumer's kidneys. There is, as a consequence, a fairly high degree of conceptual similarity between them, albeit any conceptual similarity which exists stems from the use of a word which is itself highly allusive.

Distinctive character of the KIND trade mark

37. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. In its submissions, the opponent states:

"The opponent's marks have at least an average level of distinctiveness in relation to the goods."

As the opponent has filed no evidence of the use it has made of its earlier trade mark, I have only its inherent characteristics to consider. I have provided a definition of the word KIND above. As a word which strongly alludes to, but does not describe food products which are beneficial (or at least not harmful) to the user, in my view, the word

KIND is possessed of a fairly low degree of inherent distinctive character (rather than the “at least average level” the opponent suggests).

Likelihood of confusion

39. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

40. Earlier in this decision, I concluded that:

- the average consumer of the goods at issue is a member of the general public (the opponent’s goods) and a member of the general public or a professional user (the applicant’s goods);
- the average consumer will select the opponent’s goods by predominantly visual means and the applicant’s goods using a mixture of visual and aural means;
- when selecting the goods the average consumer will pay a degree of attention varying between low (the opponent’s goods) and high (the applicant’s goods);
- the competing goods are similar to between a low and at least a medium degree;
- the competing trade marks are visually and aurally similar to a medium degree and conceptually similar to a fairly high degree;
- the opponent’s earlier trade mark is possessed of a fairly low degree of inherent distinctive character.

41. Although I have concluded that there is a fairly high degree of conceptual similarity, I explained that this conceptual similarity arose from the presence in the competing trade marks of the word “KIND”/“Kind”, which I later held strongly alluded to food products which are beneficial (or at least not harmful) to the user. In this regard, I remind myself of the CJEU’s guidance in *Formula One Licensing BV v OHIM*, Case C-196/11P, where it found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No

40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii)".

42. Although I have found that the earlier trade mark has a fairly low degree of inherent distinctive character, that does not, of itself, preclude a finding of likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders".

43. However, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

44. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

45. The only similarity between the competing trade marks stems from a shared component i.e. the word “KIND”/“Kind” which is both fairly low in inherent distinctive character and which, in my view, does not play an independent and distinctive role in the applicant trade mark. Notwithstanding my earlier findings, I shall approach the likelihood of confusion on the basis most favourable to the opponent i.e. that the competing goods are similar to a high degree, the average consumer is a member of the general public paying a low degree of attention during the selection process (thus making them more prone to the effects of imperfect recollection) and the earlier trade mark is, as the opponent submits, possessed of “at least an average level of distinctiveness”. However, even approaching the matter on that basis, I am satisfied that as the only similarity between the competing trade marks stems from a word i.e. “KIND”/“Kind”, the highly allusive meaning of which will be well-known to the average consumer, combined with the fact that the applicant’s trade mark creates a totality/unit in which the word “Kind” does not play an independent and distinctive role, this is sufficient to militate against either direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the similarity between the competing trade marks leads the average consumer to assume the goods at issue come from the same or economically linked undertakings).

46. I have, of course, reached the above conclusion on the basis of the specification of the application published. However, given the applicant’s evidence and submissions, this may not be the specification he actually intended. That being the case, the applicant may wish to consider (I put it no higher than that) limiting his specification to reflect the goods upon which he actually intends to trade i.e. that all of the goods are “designed specifically for Chronic Kidney Disease Patients”.

Conclusion

47. The opposition has failed and, subject to any successful appeal, the application may proceed to registration.

Costs

48. As the applicant has been successful, he is entitled to an award of costs in his favour. Awards of costs are governed by Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide but bearing in mind that the applicant has not been professionally represented and making no award to him in respect of his evidence (which did nothing to further his position), I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement: £100

Considering and commenting upon the opponent's evidence: £150

Total: £250

49. I order Kind LLC to pay to Spyridon Lappas the sum of **£250**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of June 2016

**C J BOWEN
For the Registrar
The Comptroller-General**