

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATIONS Nos 3252092 AND 3261142
IN THE NAME OF CARL JENKINS**

**AND IN THE MATTER OF
OPPOSITIONS Nos 410962 AND 410968 THERETO
BY BIOSTIME HONG KONG LIMITED**

**AND IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MR MARK BRYANT
DATED 20 DECEMBER 2018**

DECISION

Introduction

1. This is an appeal from a decision of Mr Mark Bryant, acting for the Registrar, dated 20 December 2018, BL O/819/18 in which he dismissed oppositions brought by Biostime Hong Kong Limited (“the Opponent”) against Applications numbers 3252092 and 3261142 standing in the name of Carl Jenkins (“the Applicant”).

Application No. 3252092

2. On 23 August 2017, the Applicant applied under number 3252092 for registration of the designation represented below for use as a trade mark in the UK:



3. The goods in respect of which registration was sought were:

Class 5

Vitamin and mineral supplements; Herbs (Medicinal -)

Application No. 3261142

4. Subsequently, on 4 October 2017, the Applicant applied for registration of a series of 2 x designations Time Health and TIME HEALTH for use as trade marks in the UK in relation to the same goods in Class 5 as above.

Oppositions Nos. 410962 and 410968


5. Application numbers 3252092 and 3261142 were published in the Trade Marks Journal on 8 September 2017 and 20 October 2017 respectively.
6. On 5 December 2017 and 6 December 2017 respectively the Opponent filed Notices of oppositions and statements of grounds against the Applications.
7. The grounds of opposition were under Section 5(2)(b) which provides 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.”
8. The oppositions were based on earlier trade mark Registration number 3249707 standing in the name of the Opponent:

Mark	Filing/registration date	Goods relied on
	11.08.17/03.11.17	<u>Class 5</u> Vitamin preparations; cod liver oil; mineral food supplements; nutritional supplements



9. The Applicant took issue with the grounds of oppositions in Notices of defence and counterstatement dated 16 February 2018, whereupon the oppositions were consolidated by the UKIPO.
10. Both sides filed written submissions but only the Applicant filed evidence. The consolidated oppositions came to be heard by the Hearing Officer on 18 December 2018, when the Applicant was represented by Mr Max Stacey of Baron Warren

Redfern and the Opponent by Mr Lewis Hands of Handsome IP Limited. Those same representations continued on appeal.

The Hearing Officer’s decision

11. The Hearing Officer held as follows:

- 1) Registration number 3249707 was an earlier trade mark within the meaning of Section 6(1) of the Act (para. 13).
- 2) The Hearing Officer would be guided by the Registrar’s usual summary of principles applicable under Section 5(2)(b) gleaned from the case law of the Court of Justice of the European Union (para. 14).
- 3) The respective goods were identical (para. 18).
- 4) The overall impression on the relevant consumer was paramount in the comparison of the marks (para. 19).
- 5) The marks for comparison were:

Opponent’s earlier trade mark	Applicant’s trade marks
	

6) Analysing the Opponent’s mark:

“22) The opponent submits that the dominant elements of its mark are the words “Healthy” and “Times”. It is my view that the two words form a unit by creating the phrase “healthy times” that will be readily understood by the consumer and it is this phrase that is the dominant and distinctive element and not the individual words. I also recognise that the distinctiveness of the mark is influenced by the hand-written style of the text, the reversed final letter “s” and the rectangular shaped border.”

7) On the other hand:

“23) In respect of the applicant’s marks, the dominant features are the words “TIME” and “HEALTH”. This is self-evidently so in respect of the applicant’s series of word marks. In respect of its word and device mark, Mr Hands submitted that the other visual elements such as the

small clock do not add any distinctiveness to the mark. I do not agree. The presence of the clock sitting in the middle depression of the letter “M”, the contrast in colour between the two words and the fact that the word “TIME” appears larger and above the word “HEALTH” all contribute to the distinctive character of the mark. Further, the larger appearance of the word “TIME” and the fact that it appears above the smaller word “HEALTH” further enhances its role as the dominant and distinctive element of the mark. That said, I recognise that the word “HEALTH” contributes to the impression created by the mark despite it being a word of low distinctive character in respect of health supplements.”

- 8) The stylisation, border and reversal of the words in the Opponent’s mark created indisputable differences with the Applicant’s series of 2 x word marks resulting in a medium level of visual similarity between them (para. 24).
- 9) The additional elements in the Applicant’s device mark (position of word elements appearing one above the other, larger appearance of the word TIME and its different colour, and the clock device) moved Application number 3252092 further away from the Opponent’s mark, which meant that there was a low to medium degree of visual similarity between the marks (para. 25).
- 10) Aurally, the marks shared a medium level of similarity:

“26) Aurally, the applicant’s marks are all the same, being expressed as the two syllables “TIME-HEALTH”. The opponent’s mark will be expressed as the three syllables “HEALTH-E-TIMES”. Mr Hands claimed that these differences have little impact. I do not agree. Firstly, the comparison is between two syllable marks and a three syllable mark. Secondly, the respective first syllables are different, the opponent’s second syllable is absent from applicant’s mark and the respective last syllables are different. I acknowledge that the first syllable of the opponent’s mark occurs as the last syllable of the applicants mark and vice-versa. Factoring all of this into my considerations, I conclude that they share a medium level of similarity.”

- 11) The respective marks were conceptually different:

“27) Mr Hands submitted that the opponent’s mark brings to mind the concept of “time to be healthy” or similar as does the applicant’s marks and asserts that there is no conceptual difference. Whilst I agree that the concept created by the opponent’s mark is something akin to a time to be healthy, I do not agree that the concept conveyed by the applicant’s marks is the same. The concept of all three of its marks is less clear and, as Mr Stacey submitted, certainly not the same as the concept present in the opponent’s mark. Mr Stacey asserted that the opponent’s mark gave a meaningful marketing message (namely, a time to be healthy) whereas all of the applicant’s marks will be perceived as TIME marks with the “Health” element indicating that the

goods are “health products”. I agree with this analysis. It is a natural construction of a phrase for the first word to qualify the second, therefore, in the opponent’s mark, the word “Healthy” qualifies the second word “Times” so that the phrase, as a whole, is likely to be perceived as a phrase that will be understood as “a time that is healthy” or, as the opponent submits “a time to be healthy”. By reversing the natural position of the words and removing the last letter “s” from the word “Times” and the “y” from the word “healthy”, this has the effect of making the phrase present in the applicant’s mark more impenetrable. The consumer is unlikely to see any direct meaning in the phrase “Time Health”. Therefore, these two words do not form a unit, unlike the words in the opponent’s mark. Each word retains a separate identity and meaning within the marks. In respect of the applicant’s word and device mark, this perception would not be offset by the get-up of the mark that includes the small clock device. Rather, with the word “TIME” being the dominant element, will reinforce such a perception and, as Mr Stacey submitted, it will also be perceived as a “TIME” mark.

28) Taking all of this into account, I conclude that the applicant’s marks are conceptually different from the opponent’s mark.”

- 12) The average consumer was the general public or businesses buying the goods for wholesale/retail. The lower level of attention of the general public was relevant. Sales were likely to be visual although aural considerations could play a part. The desire to select the correct and preferred nutritional supplement that is perceived to match the required benefit, meant that the level of attention of the consumer was “slightly more considered than normal”. The Hearing Officer rejected the argument that trade origin was insignificant when choosing supplements (paras. 31 - 32).
- 13) The distinctive character of the earlier trade mark was low to medium. Although its stylisation added some distinctive character, the words communicated a message to the consumer that the goods sold under the mark would lead to healthy times. The Opponent had not relied on enhanced distinctiveness through use (para. 34).
- 14) Assessed globally in view of the above findings and taking into account the principle of interdependence, there was no likelihood of confusion:

“38) I dismiss Mr Hands’ submission that the removal of the last letters from each of the words present in the opponent’s mark and reversing the order of the words amounts to an insignificant difference. Rather, I find that the differences in the opponent’s mark and the applicant’s series of word marks their different concepts, are sufficient to overcome the fact that the respective goods are identical and that the purchasing act will have a slightly more considered purchasing act than normal. It is insufficient that the respective marks will be perceived as all relating to health. The common occurrence of the HEALTH and TIME elements in both marks may result in one mark bringing the

other to mind, but I remain unconvinced of even this. Nevertheless, even if one mark did bring the other to mind, it is insufficient for a finding of a likelihood of confusion. Therefore, when taking account of all the relevant factors, I find that it is not likely that the parties' marks will be confused (so called "direct confusion"), nor that it is likely that the average consumer will expect goods sold under the respective marks to originate from the same or linked undertaking (so called "indirect confusion"). I find there is no likelihood of confusion.

39) The applicant's word and device mark has its own visual impact that it markedly different from the opponent's mark, and such a visual impact makes this mark even less likely to be confused with the opponent's mark. I find that there is no likelihood of confusion in respect of this mark too."

- 15) The oppositions failed and costs in the sum of £1,000 would be awarded to the Applicant.

The appeal

12. On 19 January 2019, the Opponent filed Notice of appeal to the Appointed Person under Section 76 of the Act.
13. The grounds of appeal were that the Hearing Officer misapplied the usual principles for:
- (1) the assessment of conceptual similarity of the marks and wrongly concluded that there was no conceptual similarity between the marks;
 - (2) the global assessment of the similarity in the marks and wrongly concluded that there was no overall similarity between the marks;
 - (3) the level of attention paid by the average consumer to the marks and wrongly concluded that there was an increased level of attention applied.
14. The Applicant filed a Respondent's notice on 4 February 2019 denying that any grounds of appeal existed and stating that the Hearing Officer's decision should be upheld.

Standard of review

15. The parties were agreed that the correct approach was as stated by Mr Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd*, BL O/017/17 at paragraph 52 (applied by Arnold J in *Apple Inc. v. Arcadia Trading Limited* [2017] EWHC 440 (Ch) at para. 11):

“(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others)."

16. The Opponent particularly relied on principle (v):

“(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong ...”.

17. The Applicant additionally referred me to a comment by Mr Iain Purvis QC sitting as the Appointed Person in *ROCHESTER Trade Mark*, BL O/049/17 that:

“... the reluctance of the Appointed Person to interfere with the decision of Hearing Officer on a likelihood of confusion is quite high ...” (para. 33).

Ground 1

18. The Opponent alleged that the Hearing Officer was misled into finding that there was conceptual dissimilarity between the marks through his putting to the parties at the hearing “Newcastle United” and “Village Green” as examples of word combinations that produce different meanings when their order is reversed. Mr Hands for the Opponent said that he could not think of couplings of words that did not produce this effect when asked by the Hearing Officer for suggestions. However, since the hearing he wished to put forward the examples of “Knights errant” and “Brave Indian”.
19. Mr Stacey for the Applicant objected that this was seeking to introduce new evidence and argued that in any event “Knights errant” and “Brave Indian” when reversed conjured up different concepts.
20. I did not find any of this helpful. First, I had no means of checking what had/had not been said at the hearing and/or in what context since as the parties confirmed to me there was no transcript.
21. Second, the Hearing Officer in his decision quite properly detailed his consideration of the conceptual aspects of the marks TIME HEALTH (a. words, b. words and device) and HEALTHY TIMES figurative. This was the relevant comparison before him. He decided contrary to the Opponent’s arguments that the parties’ respective marks conveyed different concepts. The fact that he may have alluded to other words that when reversed had dissimilar meanings was neither here nor there. In any case as he recognised this was not merely a reversal of the same words since the words in the Applicant’s marks were TIME HEALTH and in the Opponent’s mark HEALTHY TIMES. Moreover, in the case of the Applicant’s figurative mark, the Hearing Officer noted that the clock device emphasised the concept conveyed by the word element TIME.
22. I have not been directed to any error in the Hearing Officer’s reasoning merely disagreement by the Opponent with his conclusions.
23. In my judgment the Hearing Officer was entitled to find that the marks conveyed different concepts – the Applicant’s marks on the one hand, TIME designations; the Opponent’s mark on the other hand, healthy times. In fact I agree.
24. I reject the Opponent’s further suggestion that the fact that the clock was set at 4 pm meant that the Applicant’s figurative mark should have been found by the Hearing Officer to convey to the public a time (i.e., 4 pm) to be healthy, in which case the concepts of the marks were the same.

Ground 2

25. It was said here that the Hearing Officer misapplied the test for the comparison of the marks set out by the CJEU in Case C-251/91, *Sabel BV v. Puma AG* [1997] ECR I-6191:
“23. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components ...”.
26. It was unclear to me what if any error the Opponent was purporting to identify in the Hearing Officer’s global appreciation of the marks other than as a continuation of the Opponent’s previous argument that it disagreed with the Hearing Officer’s findings on the conceptual aspects.
27. Moreover, Ground 2 appeared to be based on a misreading of the decision as to the visual and aural aspects of the marks. As stated above, the Hearing Officer found that there was a medium degree of visual similarity between the Applicant’s word marks and the Opponent’s mark, and a low to medium degree of visual similarity between the figurative marks of the Applicant and the Opponent, and aurally all the marks shared a medium degree of similarity (not simply that the marks were visually and aurally similar as contended for by the Applicant). The converse of those findings is that there were visual and aural differences in the marks which needed to be taken into account in their global appreciation by the consumer.
28. Mr Stacey for the Applicant drew my attention by reference to the CJEU decisions in *Ruiz Picasso v. OHIM*¹ to the well-established principle that a conceptual dissonance in marks can counteract any visual and aural similarities between them.
29. Mr Hands for the Opponent queried the appropriateness of the Applicant relying on *Picasso* since these authorities were not mentioned in the Applicant’s skeleton argument. I was satisfied that I could take notice of these well-known authorities having provided Mr Hands with the option of a short adjournment to consider them which he declined.

Ground 3

30. Ground 3 in so far as I understood it sought to repeat the same argument put to the Hearing Officer, namely that the average consumer pays an increased level of attention to selecting the correct supplement but not to the particular trade mark under which the supplement is sold. In my view, this betrays a misunderstanding of the relevance of the level of attention paid to the purchase act by the average consumer in the global assessment of the likelihood of confusion, and, as noted by the Hearing Officer, the very role of trade marks in guaranteeing the origin of goods to the consumer. The point is that when due to the nature of the goods a purchaser pays a higher level of attention to their selection then the scope for imperfect recollection of the marks may (but not always) consequently be reduced and vice versa.

¹ Case C-361/04 P, CJEU [2006] ECR I-0643, Case T- 185/02, GC [2004] ECR II-1739

31. I reject the Opponent's submission that the Hearing Officer wrongly concluded that the applicable level of attention that would be paid by the average consumer of vitamins and health supplements was "slightly more than normal".
32. It seemed to me that the Opponent's reliance on Case T-250/15, *Speciality Drinks Ltd v. EUIPO*, EU:T:2016:678 was misplaced in that regard. The specification applied for in that case included Scotch whisky. The Board of Appeal considered that the average consumer of Scotch whisky was the general public who were reasonably well informed and reasonably observant and circumspect and who would pay an average level of attention to the purchase act. The applicant sought to argue that the Board of Appeal failed to take into account that Scotch whisky was bought also by connoisseurs who would pay a high level of attention to the purchase act. The General Court pointed out that this argument was based on a misreading of the decision; the Board of Appeal had taken this into account but noted that Scotch whisky was also available to less knowledgeable consumers, so that the finding that the average consumer paid an average level of attention could not be called into question. It is well established that when the average consumer comprises groups of persons who pay differing levels of attention to the purchase of the goods/services in question then it is the lower level of attention that is relevant in the global appreciation of the marks and the global assessment of likelihood of confusion. Indeed, this argument was put forward by Mr Hands on behalf of the Opponent and accepted by the Hearing Officer in the present case (i.e., that the relevant level of attention was that of the general public and not businesses buying the goods for wholesale retail; see para. 11, sub para.12) above).

Conclusion

33. For the above reasons, in the result the appeal has failed.
34. I will order that, in addition to the costs in the sum of £1,000 awarded by the Hearing Officer, the Opponent pays to the Applicant the sum of £600 as a contribution towards the Applicant's costs of this appeal. The total sum of £1,600 is to be paid by the Opponent to the Applicant within 28 days of the date of this decision.

Professor Ruth Annand, 28 May 2019

Mr Lewis Hands of Handsome IP Limited appeared on behalf of the Opponent/Appellant

Mr Max Stacey of Baron Warren Redfern appeared on behalf of the Applicant/Respondent