

BL O/371/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3289325

BY

NICHOLAS CROWE and MATTHEW CROWE

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 05 and 35:

Lifes Nutrients

AND

OPPOSITION THERETO (NO. 412846)

BY

DSM IP ASSETS B.V.

Background and pleadings

1. Nicholas Crowe and Matthew Crowe (the applicants) applied to register the trade mark:

Lifes Nutrients

in the UK on 11 February 2018. It was accepted and published in the Trade Marks Journal on 23 March 2018 for:

Class 05: Health food supplements for persons with special dietary requirements; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Herbal supplements; Probiotic supplements; Protein dietary supplements; Protein powder dietary supplements; Protein supplements; Vitamin and mineral food supplements; Vitamin and mineral supplements; Diet capsules; Dietary and nutritional supplements; Dietary fiber to aid digestion; Dietary fibre; Dietary food supplements; Dietary supplement drink mixes; Dietary supplement drinks; Dietary supplemental drinks; Dietary supplements; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Dietary supplements with a cosmetic effect; Mineral dietary supplements for humans; Nutritional supplement meal replacement bars for boosting energy; Nutritional supplements; Herbal dietary supplements for persons special dietary requirements.

Class 35: Online retail services in relation to dietary and nutritional supplements; Mail order retail services in relation to dietary and nutritional supplements; Retail services in relation to dietary and nutritional supplements; Online retail store services relating to cosmetic and beauty products; Wholesale services in relation to dietary supplements.

2. DSM IP Assets B.V. (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is raised against all of the goods and services of the application.
3. The opposition is based on earlier International Registration designating the EU WE00001203013, with a date of designation in the EU of 20 January 2014, for the mark:



4. Given the date of designation, the opponents mark qualifies as an earlier mark in accordance with section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to the proof of use provisions contained in s. 6A of the Act. The opponent may therefore rely upon all of the goods they have identified, without showing that they have used the mark.
5. The earlier mark is registered for goods in classes 01, 05, 29, 30 and 32, however the opponent relies only on the goods it has protected in classes 01 and 05, namely:

Class 01: Chemical and biochemical products for industrial use for the production of food, beverages and dietary products; cultures and fermented preparations of microorganisms for industrial use for the production of food, beverages and dietary products; microbiologically produced products for industrial use for the production of food, beverages and dietary products; chemical and biochemical products for preserving foodstuffs; fatty acids; omega-3 fatty acids.

Class 05: Food supplements; dietary supplements; dietetic substances for medical use; ingredients for (dietetic) foods for medical use, namely food additives for use as nutritional supplements; food for babies; infant formula; milk for babies; food for the sick, for medical use; vitamins and vitamin preparations; medicinal oil; vitamin oil for human consumption.

6. In its statement of grounds, the opponent claims that:
 - the distinctive element in both marks is the word element 'Lifes';
 - the second element of the later mark, the word 'Nutrients', serves no more than a descriptive function;
 - the marks are visually, phonetically and conceptually very similar;
 - the goods and services applied for must be considered to be identical in part and, where not identical, similar;
 - the average consumer and channels of trade are the same;
 - there is a very strong likelihood of confusion.
7. In its counterstatement the applicant claims that 'Life's Nutrients' has been trading since 2016 and the words have never been used separately. As the mark is always used in totality there would be no confusion as the whole mark 'Life's Nutrients' is not similar to the earlier mark 'Lifes'.
8. Both parties filed evidence and written submissions. I will not summarise that information here, but will refer to it when necessary, throughout my decision.
9. As no hearing was requested, this decision is taken following a careful perusal of the papers.
10. Throughout the proceedings the applicant has represented itself whilst the opponent has been professionally represented by Oakleigh IP Services Limited.

Decision

Section 5(2)(b) of the Act

11. Section 5(2)(b) of the Act is as follows:

“(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

12. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“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.

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 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.

Comparison of goods and services

13. In the judgment of the Court of Justice of the European Union 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”.

14. 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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. The parties’ respective specifications are:

Earlier mark	Application
<p>Class 01: Chemical and biochemical products for industrial use for the production of food, beverages and dietary products; cultures and fermented preparations of microorganisms for industrial use for the production of food, beverages and dietary products; microbiologically produced products for industrial use for the production of food, beverages and</p>	<p>Class 05: Health food supplements for persons with special dietary requirements; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Herbal supplements; Probiotic supplements; Protein dietary supplements; Protein powder dietary supplements; Protein supplements; Vitamin and mineral food supplements;</p>

<p>dietary products; chemical and biochemical products for preserving foodstuffs; fatty acids; omega-3 fatty acids.</p> <p>Class 05: Food supplements; dietary supplements; dietetic substances for medical use; ingredients for (dietetic) foods for medical use, namely food additives for use as nutritional supplements; food for babies; infant formula; milk for babies; food for the sick, for medical use; vitamins and vitamin preparations; medicinal oil; vitamin oil for human consumption.</p>	<p>Vitamin and mineral supplements; Diet capsules; Dietary and nutritional supplements; Dietary fiber to aid digestion; Dietary fibre; Dietary food supplements; Dietary supplement drink mixes; Dietary supplement drinks; Dietary supplemental drinks; Dietary supplements; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Dietary supplements with a cosmetic effect; Mineral dietary supplements for humans; Nutritional supplement meal replacement bars for boosting energy; Nutritional supplements; Herbal dietary supplements for persons special dietary requirements.</p> <p>Class 35: Online retail services in relation to dietary and nutritional supplements; Mail order retail services in relation to dietary and nutritional supplements; Retail services in relation to dietary and nutritional supplements; Online retail store services relating to cosmetic and beauty products; Wholesale services in relation to dietary supplements.</p>
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17. The applied for goods in class 05 are all intended to be ingested by the consumer, in food, beverage and capsule form, and are consumed to provide the user with a dietary supplement. These goods may vary in their ingredients and form, but they are all health, dietary or nutritional products containing vitamins, minerals, herbs, protein or fibre.
18. Applying the *Meric* principle set out above, the earlier goods ‘food supplements; dietary supplements; dietetic substances for medical use; ingredients for (dietetic) foods for medical use, namely food additives for use as nutritional supplements; vitamins and vitamin preparations’, are broad terms that wholly encompass the applied for goods. These goods are identical.
19. The applied for ‘Online retail services in relation to dietary and nutritional supplements; Mail order retail services in relation to dietary and nutritional supplements; Retail services in relation to dietary and nutritional supplements’ and ‘Wholesale services in relation to dietary supplements’ in class 35, are services intended to provide consumers with the opportunity to purchase dietary and nutritional supplements through a wide range of retail and wholesale environments.
20. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.
21. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for

registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

22. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

23. In this instance, it is clear as to the nature and extent of the retail activities to which the applicant engages, or intends to engage in, namely those services applied specifically to the sale of dietary and nutritional supplements.
24. In respect of the applied for wholesale services; wholesale is defined as “the selling of goods in large quantities to be retailed by others”⁴. In this regard, the relevant public will be in the trade, acting as a middle man between the manufacturer of the goods and the general public. There will, though, still be that close connection between the goods and services in such a way that the relevant public may believe that the responsibility for those goods/services lies with the same undertaking.
25. The applicant's services are all intended to provide the average consumer of dietary and nutritional supplements with a choice of retail and wholesale environments in which to purchase those goods. The opponent's goods are dietary and nutritional supplements. These goods and services coincide in respect of intended purpose. They can also coincide in respect of end consumers and trade channels, as the earlier goods are provided by way of the contested services.
26. I must also consider complementarity. 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 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”.

⁴ Oxford English Dictionaries.com

27. Further in *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0/255/13;

"It may well be the case that wine glasses are almost always used with wine - and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand;

"..... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

28. The applied for 'online retail services in relation to dietary and nutritional supplements; mail order retail services in relation to dietary and nutritional supplements; retail services in relation to dietary and nutritional supplements; wholesale services in relation to dietary supplements' are therefore found to be similar to a medium degree to the opponent's earlier goods in class 05.

29. The applied for 'online retail store services relating to cosmetic and beauty products' are services offering a retail environment in which the consumer of cosmetic and beauty products may choose from a range of products and then purchase those goods. These services have no connection with the opponent's earlier goods in classes 01 or 05, which have no link to cosmetic or beauty products. These services are therefore dissimilar to the earlier goods.

30. In conclusion I find the applicant's class 05 goods to be identical to the class 05 goods of the opponent's earlier mark. I find a part of the applicant's services in class

35 to be similar to a medium degree to the opponent's goods in class 05, and a part of the applied for services to be dissimilar.

31. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

32. Having found the applicant's 'online retail store services relating to cosmetic and beauty products' services to be dissimilar to the opponent's earlier goods, I conclude that, for those services, there can be no possibility of a likelihood of confusion.

Average consumer and the purchasing act

33. 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*.

34. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

35. The goods and services found to be identical or similar are day to day products and services, being dietary, nutritional and health food supplements on the one hand, and the retail and wholesale of those goods on the other. I find that the average consumer of both the goods and the services will be a member of the general public. The average consumer of the wholesale services of the applicant may also be a professional in the relevant sphere of business.

36. The average consumer of the goods at issue would generally pay at least a medium level of attention when selecting them. Dietary and nutritional supplements can be quite basic, e.g. a multi-vitamin tablet, however some are more complex in their nature and, for a consumer with particular dietary requirements or medical issues, a greater degree of care may be required during the selection process. The choice of retailer of such goods is unlikely to be subject to the same level of scrutiny as the goods themselves, but the level of attention being paid by a professional consumer of wholesale services will be at least medium.

37. The goods and services at issue are both likely to be selected by visual means, from websites, advertisements, brochures, newspapers, magazines, etc. Word of mouth recommendation may also play some part in the selection process, so aural consideration is also important, however the visual aspect of selection will play the more important role.

Comparison of marks

38. 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.”

39. It would be wrong, therefore, to dissect the trade marks artificially, 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.

40. In submissions and evidence, the applicant has shown that to a large extent, it uses its mark ‘Lifes Nutrients’ in combination with a figurative ‘heart’ shaped logo. Much of the applicant’s evidence points to this combined use rather than use of the mark as applied for. It is however the case that the comparison to be made between the opponent’s earlier mark and the applicants later mark, will not include an assessment of the figurative element that the applicant has shown use of.

41. The marks to be compared are:

Earlier mark	Contested mark
	Lifes Nutrients

42. The earlier mark is a figurative mark comprised of the word ‘life’s’, where the apostrophe in the word is replaced with an oval design, and the word is placed within a black and white geometric figurative design. As the figurative elements in the mark

are quite basic, the word 'life's' can be said to be the dominant, eye-catching element, and therefore the overall impression of the earlier mark lies in that word.

43. The contested mark is comprised of the plain words 'Lifes Nutrients'. The word 'Nutrients' is defined as 'substances that help plants and animals to grow'.⁵ This is a definition that I am familiar with and one that I believe the relevant public in this regard would also be familiar with. This element will therefore be perceived to be descriptive and non-distinctive within the context of the goods and services at issue. Whilst the mark will be read as a single expression, the word 'Lifes' can be said to play a greater role in the later mark and as such, the overall impression of the later mark lies in that word.

Visual similarity

44. The marks are visually similar inasmuch as they both contain the word 'lifes'. They differ in the figurative elements of the earlier mark, and in the word 'Nutrients' of the later mark which has no counterpart in the earlier mark.

45. Weighing up the similarities and differences and taking account of my conclusions regarding the overall impression of the marks, I find them to be visually similar to an average degree.

Aural similarity

46. The opponent's earlier mark will be enunciated as *LYFS*. The applicant's contested mark will be articulated as *LYFS/NEW/TREE/UNTS*. Whilst the majority of the later mark is different to the earlier mark, both marks share the same first word identically. The marks are therefore found to be phonetically similar to an average degree.

Conceptual similarity

47. The figurative elements in the earlier mark are likely to be considered as simply decorative in nature. In the alternative, the figurative elements in the earlier mark

⁵ <https://www.collinsdictionary.com/dictionary/english/nutrient>

may possibly be perceived to allude to the leaf of a plant. The word element 'Life's' in the earlier mark derives from the word 'Life' and will be understood to refer to the quality a plant or animal has when it is alive.

48. The later mark is comprised of the plain words 'Lifes Nutrients'. As with the earlier mark, the word 'Lifes' derives from the word 'Life' and will be readily understood. The word 'Nutrients' will be understood to refer to substances that are needed to help plants and animals to grow.
49. Both marks convey a message that relates to the concept of 'Life'. The word 'Nutrients' in the later mark will be perceived to be descriptive and non-distinctive within the context of the relevant goods and services and will be given little or no weight. Where the figurative elements of the earlier mark are perceived to represent a leaf shape, the average consumer will understand this as a reference to the notion of plant life, which will likely reinforce the impact that the word 'life's' will have on that consumer. I therefore find the marks to be conceptually identical.
50. In conclusion, the marks have been found to be visually and phonetically similar to an average degree and conceptually identical.

Distinctive character of the earlier trade mark

51. 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 *WindsurfingChiemsee 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).”

52. The opponent has not claimed that its earlier mark has an enhanced distinctive character through use. I therefore have only the inherent position to consider.

53. 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 said:

“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.”

54. The opponent’s mark is comprised of figurative elements that may or may not be perceived as a leaf design and the word ‘Life’s’. For the average consumer of health food supplements and dietary supplements, there may be an association between

the opponent's goods and the use of the word 'Life's' combined with a figurative shape that may be seen as a reference to a leaf. Whether that connection is made or not, I find the earlier mark to be inherently distinctive to no more than an average degree.

Likelihood of Confusion

55. I now draw together my earlier findings into a global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 12 above).

56. 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 marks may be offset by a greater degree of similarity between the respective goods and services 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 it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks side by side but must instead rely upon the imperfect picture of them he has retained in his mind.

57. The applicant has claimed that the average consumer of the goods and services at issue will perceive the later mark as a whole. Whilst this may be the case, it has been found that the element 'Nutrients' in that mark will be perceived to be entirely descriptive and non-distinctive when taken within the context of the goods and services on offer. As such, it is the element 'Lifes' in the later mark which will carry more weight and be seen to play a greater role in that mark.

58. In this respect, I note that the applicant also states in its submissions that the use of the word 'Lifes' is an arbitrary one, as the word has no direct link to the goods.⁶ This

⁶ Submissions of applicant, 14/01/2019. Page 9, Section 8.7. Comparison of goods and services.

statement supports my finding that it is that element of the later mark which will be found to dominate the mark.

59. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods/services down to the responsible undertakings being the same or related.

60. I have already found that:

- the goods and services are identical, similar to a medium degree or dissimilar;
- the marks are visually and phonetically similar to an average degree and conceptually identical;
- the average consumer will be a member of the general public or a professional;
- the consumer can be expected to be paying a medium level of attention when selecting the services at issue, and a medium to higher than average level of attention during selection of the goods at issue;
- during the selection process, the visual and aural considerations will both be important, however the visual impression will play the greater role;
- the earlier mark has no more than an average level of inherent distinctiveness;

61. Having weighed up all of the factors, I conclude that there is no likelihood of direct confusion between the marks. The average consumer will be paying at least average attention during the purchasing act and will not mistake one mark for the other. The figurative elements in the opponent's mark, and the additional verbal element 'Nutrients' in the applicant's mark will not go unnoticed.

62. I must therefore go on to consider the potential for indirect confusion between the marks.

63. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

64. Taking into account the earlier finding that the figurative elements in the earlier mark are quite basic in nature and the word 'Nutrients' in the later mark will be considered to be descriptive and non-distinctive, I find that the second category set out above, bites here. The average consumer of the opponent's earlier goods in class 05 will, when faced with the applicant's goods, and the applicant's retail and wholesale services of those goods, believe that that use represents a brand extension or sub-brand of the opponent, and expect that the goods and services are economically linked and share the same origin.
65. The applicant has stated in submissions that an internet search of the terms 'Lifes' and 'Lifes Nutrients' separately, fails to bring back a hit for the other term. It argues that this result should show that, where a consumer searches e.g. 'Lifes' and is not exposed to the term 'Lifes Nutrients' or vice-versa, confusion between the two terms could not arise. I am not persuaded by this line of argument. The fact that the word 'Nutrients' is descriptive and non-distinctive has been established previously. My assessment is made therefore on the basis of the perception or impact that the later mark, as a whole, would have on the average consumer of goods and services where the intention is to purchase and consume products that are marketed specifically for their nutritional values. In that context, that consumer will pay little or no regard to the element 'Nutrients' in the applicants mark and will consequently be drawn to the 'Lifes' element. Where this is the case, an internet search of the applicant's mark may be reduced to a search for 'Lifes' products, which would bring into play the opponent's activity in the same field of interest.
66. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
67. In this respect, as the applicant has stated that the word 'Lifes' "has no direct link to the goods at issue and can be said to be an arbitrary choice when considering the nature of the goods", and as 'Nutrients' is a descriptive term, I conclude that the

average consumer will indirectly confuse the marks and believe that the goods and services found to be identical or similar, originate from the opponent.

Conclusion

68. The opposition is partially successful. Subject to appeal, the application is refused for all of the applied for goods in class 05 and the following services:

Class 35: Online retail services in relation to dietary and nutritional supplements; Mail order retail services in relation to dietary and nutritional supplements; Retail services in relation to dietary and nutritional supplements' and 'Wholesale services in relation to dietary supplements.

69. The application may proceed to registration for the following:

Class 35: Online retail store services relating to cosmetic and beauty products

Costs

70. The opponent has been largely successful and is entitled to a contribution towards its costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). Allowing for the partial success of the applicant, I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for opposition	£100
Preparing the statement of case and considering the counterstatement	£200
Preparing written submissions and evidence and considering the applicant's written submissions and evidence	£500

Total

£800

71. I therefore order Nicholas Crowe and Matthew Crowe jointly to pay DSM IP Assets B.V. the sum of £800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated 3 July 2019

Andrew Feldon

For the Registrar

The Comptroller-General