

O-646-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3328433
BY VIVATINELL LIMITED TO REGISTER THE TRADE MARK**

NUTRITEA

IN CLASSES 5 AND 30

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 414189 BY N.V.
NUTRICIA**

BACKGROUND AND PLEADINGS

1) Vivatinell Limited (hereafter “the applicant”) applied to register the mark NUTRITEA on 31 August 2018. It was published, for opposition purposes, in the Trade Marks Journal on 3 August 2018 in respect of the following list of goods:

Class 5: *Powdered fruit-flavored dietary supplement drink mix; Powdered milk foods for infants; Powdered milk for babies; Powdered nutritional supplement drink mix; Powdered nutritional supplement energy drink mix; Prebiotic supplements; Preparations for treating colds; Preparations of vitamins; Probiotic bacterial formulations for medical use; Probiotic preparations for medical use; Probiotic supplements; Protein supplements; Medical infusions; Medicinal beverages; Medicinal drinks; Medicinal herb infusions; Medicinal infusions; Medicinal tea; Nutraceutical preparations for humans; Nutraceutical preparations for therapeutic or medical purposes; Nutraceuticals for use as a dietary supplement; Nutritional supplements; Slimming tea for medical purposes.*

Class 30: *Beverages based on chocolate; Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea; Beverages (Cocoa-based -); Beverages made of tea; Beverages (Tea-based -); Beverages with a tea base; Beverages with tea base; Black tea; Black tea [English tea]; Chamomile tea; Drinking chocolate; Drinks based on chocolate; Drinks containing cocoa; Drinks prepared from cocoa; Earl Grey tea; Ginseng tea; Green tea; Herbal infusions; Herbal preparations for making beverages; Herbal tea; Herbal teas; Herbal teas [infusions]; Iced tea; Iced tea mix powders; Iced teas; Instant tea; Linden tea; Packaged tea [other than for medicinal use]; Peppermint tea; Preparations for making beverages [tea based]; Prepared coffee and coffee-based beverages; Prepared coffee beverages; Red ginseng tea; Tea; Tea bags; Tea bags for making non-medicated tea; Tea beverages; Tea extracts; Tea for infusions; Tea (Iced -); Tea leaves; Tea mix powders; Tea mixtures; Tea-based beverages; Teas.*

2) N.V. Nutricia (hereafter “the opponent”) opposes the application in respect of all the goods listed. The opposition is based upon section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the first two grounds, the opponent relies upon the following European Union Trade Mark (“EUTM”):

EUTM 7198914

NUTRICIA

Filing date: 28 August 2008

Date of entry in register: 21 October 2014

Class 5: *Pharmaceutical products; dietetic substances adapted for medical use, fortifying foodstuffs adapted for medical use, including food for babies, including for infants with specific dietary needs and invalids; dietary nutritional supplements for medical use; a combination of active nutrients for medical use; ingredients, in particular a combination of ingredients, for the use of or for pharmaceutical preparations and food products, preparations and substances for medical purposes, yeast, and trace additives for medical use; vitamin preparations.*

Class 29: *[...] milk powder, milk products, [...], fermented milk and milk products, milk-based desserts, milk-based pudding, flavoured milk-based drinks, and milk products.*

Class 30: *[...] preparations made from cereals, preparations made from cereals for young children.*

Class 32: *[...] fruit or vegetable juices, fruit or vegetable drinks, preparations for making beverages, syrups for making beverages and fruit or vegetable extracts including drinks based on dairy products included in this class; fermented preparations and other preparations for making beverages.*

3) The opponent's EUTM is an earlier mark within the meaning of section 6(1) of the Trade Marks Act 1994 ("the Act") because it has a filing date earlier than the filing date of the contested application. It completed its registration procedures less than five years before the publication date of the contested application and, as a result, it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods listed in its EUTM.

4) The opponent asserts that registration of the contested application would be contrary to section 5(2)(b) of the Act because the respective marks are similar and the goods are identical, similar or complimentary, use of the applicant's mark will lead to initial interest confusion, confusion at the point of sale and also post sale.

5) In respect of the grounds based upon section 5(3) of the Act, the opponent asserts that:

- Use of the applicant's mark will take unfair advantage of all the functions of the opponent's mark including, but not limited to, the advertising and investment functions and the applicant will obtain a commercial advantage as a result of being incorrectly linked with the opponent;
- Use of the applicant's mark would result in detriment to the reputation of its mark because the miss-association of the two brands will result in tarnishment of, and detriment to the opponent's reputation. It gives the example of where association between the marks would occur where the two brands were advertised alongside each other in a newspaper or magazine;
- There would be detriment to the distinctive character of the opponent's mark if the applicant's marks are of inferior quality and miss-association with the opponent's mark will result in loss of sales for the opponent.

6) In respect of the ground based upon section 5(4)(a), the opponent relies upon its claimed goodwill, throughout the UK since 1905, in respect of its sign NUTRICIA for the following list of goods:

Class 5: *Pharmaceutical products; dietetic substances adapted for medical use, fortifying foodstuffs adapted for medical use, including food for babies, including for infants with specific dietary needs and invalids; dietary nutritional supplements for medical use; a combination of active nutrients for medical use; ingredients, in particular a combination of ingredients, for the use of or for pharmaceutical preparations and food products, preparations and substances for medical purposes, yeast, and trace additives for medical use; vitamin preparations.*

Class 29: *Milk powder, milk products, fermented milk and milk products, milk-based desserts, milk-based pudding, flavoured milk-based drinks, and milk products.*

Class 30: *Preparations made from cereals, preparations made from cereals for young children.*

Class 32: *Fruit or vegetable juices, fruit or vegetable drinks, preparations for making beverages, syrups for making beverages and fruit or vegetable extracts including drinks based on dairy products included in this class; fermented preparations and other preparations for making beverages.*

7) The opponent asserts that use of the applicant's mark would lead to a misrepresentation of the opponent's sign and result in damage to its goodwill. It submits that there will be initial interest confusion created by the use of the applicant's mark and that it does not matter if that misrepresentation becomes apparent at a later stage.

8) The applicant filed a counterstatement denying the claims made and highlighting the differences between the marks and asserting that NUTRI- is a common prefix used in many other marks.

9) Only the opponent filed evidence. I will refer to this to the extent that I consider it necessary. The opponent also filed written submissions that I will keep in mind. No

hearing has been requested and I give my decision after careful consideration of all the papers.

10) The opponent is represented, in these proceedings, by Nucleus IP Ltd. The applicant is not represented.

Opponent's Evidence

11) This takes the form of two witness statements by Andrew John Murch, Chartered Trade Mark Attorney and representative of the opponent. These can be summarised as follows:

- The opponent operates from 28 sites around the world, including the UK and evidence is in the form of extracts printed on 5 April 2019 (7 months after the relevant date) from the opponent's website www.nutricia.com¹. No other date indication is visible;
- These web extracts illustrate the opponent's mark in use in respect of what is described as "advanced medical nutrition" and "early life nutrition". There is a health aspect to all of the opponent's goods with it proclaiming its purpose as being "to pioneer nutritional discoveries that help people of every age live longer, healthier lives"²;
- Products shown include protein substitutes for children ("with inborn errors of metabolism"), protein milkshake-style drinks, baby feed (for "infants with faltering growth") and other drink-style food for various medical dietary management purposes³;
- Whilst these web extracts are in English it is a dot com web address. Whilst the final page is headed "Nutricia in the UK", there is no other indication that they are aimed at the UK;
- Extracts from the opponent's parent company, Danone, make specific references to the opponent and its role in developing nutrition for infants and children, those with digestive dis-function and advanced nutrition for people

¹ Mr Murch's 1st witness statement, para 2 and Exhibit AJM1

² Exhibit AJM1, page 6

³ Exhibit AJM1

with medical conditions⁴. One page⁵ shows the opponent's mark in use on packaging of infant formula powder and a "grape raisin" drink that are part of a range of nutrition products for infants, children and teens with cow's milk allergy. The narrative that accompanies these images states that the former was launched in 2016 (in the US) and the latter launched in the US in 2017;

- A decision of the opposition division of the Office for Harmonization in the Internal Market (now the EU Intellectual Property Office or EUIPO) involving the opponent's mark and a mark identical to the contested application in the current proceedings. In that case, the EUIPO found for the opponent⁶;
- The opponent claims to have a family of NUTRI marks on sale in the UK and extracts from the website of the online retailer www.amazon.co.uk (printed on 7 May 2019) illustrate nutritional products bearing the marks NUTRILON, NUTRISON and NUTRINI⁷;
- Mr Murch has "been advised and does "readily believe" that the opponent's sale of NUTRI prefixed products in the UK prior to the filing date of the contested application was in excess of £30 million⁸.

DECISION

Section 5(2)(b)

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

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

⁴ Mr Murch's 1st witness statement, para 3 and Exhibit AJM2

⁵ Exhibit AJM2, page 34

⁶ Exhibit AJM3

⁷ Mr Murch's 2nd witness statement, para 3 and Exhibit AJM4

⁸ Ditto, para 4

Comparison of goods and services

13) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, 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 *Gerard Meric v Office for Harmonisation in the Internal Market (MERIC)*, Case T-133/05, the General Court (“the GC”) 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) I also keep in mind *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.”

Class 5

Preparations of vitamins

17) The opponent’s Class 5 specification includes the term *vitamin preparations*. It is self-evident that these terms cover identical goods.

Powdered milk foods for infants; Powdered milk for babies

18) The opponent submits that these goods are similar to its *fortifying foodstuffs adapted for medical use, including food for babies, including for infants with specific dietary needs*. The opponent’s terms are broad in nature and includes fortifying

foodstuffs in the form of powdered milk, therefore, applying the guidance in *MERIC*, I find that there is more than just similarity and the respective goods are identical.

19) The opponent also submits that these goods are similar and complimentary to its *milk powder, milk products, fermented milk and milk products, flavoured milk-based drinks, and milk products* in Class 29. It is not clear to me why it claims the respective goods are complimentary and it provides no explanation, but I agree that there is a good deal of similarity because these terms may include milk products marketed as being suitable for babies and infants. Their nature, intended purpose and method of use are very similar and they may be sold through the same trade channels and be in competition. I conclude that there is a high level of similarity.

Probiotic bacterial formulations for medical use; Probiotic preparations for medical use; Medical infusions; Medicinal beverages; Medicinal drinks; Medicinal herb infusions; Medicinal infusions; Medicinal tea; Nutraceutical preparations for humans; Nutraceutical preparations for therapeutic or medical purposes; Nutraceuticals for use as a dietary supplement; Nutritional supplements; Slimming tea for medical purposes.

20) The opponent submits that all these goods are identical or highly similar to all its Class 5 goods, but it has not made any submissions as to why. Certainly, the following of the applicant's goods are covered by the opponent's broad terms *dietetic substances adapted for medical use, fortifying foodstuffs adapted for medical use*:

Probiotic bacterial formulations for medical use; Probiotic preparations for medical use; Medical infusions; Medicinal beverages; Medicinal drinks; Medicinal herb infusions; Medicinal infusions; Medicinal tea; Nutraceutical preparations for therapeutic or medical purposes; Slimming tea for medical purposes.

21) These goods are all indicated as being medicinal or for medical purposes and are, therefore, covered by the opponent's terms (when applying the guidance in *MERIC*) and are identical.

22) In respect of the applicant's *Neutraceutical preparations for humans and Nutraceuticals for use as a dietary supplement*, the word "nutraceutical" describes "functional food"⁹ that, in turn, means "a food containing health-giving additives"¹⁰. Firstly, I note the different spelling neutraceutical/nutraceutical, but my approach is to treat the meaning of these two words as being the same. Such goods may be used for medicinal reasons and consequently these terms include goods that are also included under the opponent's terms. Consequently, I agree that they are identical.

23) The applicant's *Nutritional supplements* is not specifically limited to being for medical purposes, but the term will include supplements that are used for such purposes and, consequently, will also be covered by the opponent's *fortifying foodstuffs adapted for medical use*. I find that these are also identical.

Powdered nutritional supplement drink mix; Powdered nutritional supplement energy drink mix

24) The opponent submits that these goods are similar/complementary to its *milk powder, milk products, fermented milk and milk products, flavoured milk-based drinks, and milk products* in Class 29. Once again, it is not clear to me why it claims the respective goods are complimentary, but I agree that there is a good deal of similarity (for the same reasons set out at paragraph 19, above. I conclude that there is a high level of similarity.

Probiotic supplements; Prebiotic supplements; Powdered fruit-flavored dietary supplement drink mix; Protein supplements

25) The opponent makes no specific submissions in respect of these goods. They are all dietary supplements and the terms include such goods for medical use and, therefore, applying the *MERIC* guidance they cover identical goods to the opponent's *dietary nutritional supplements for medical use*. The respective goods are identical.

⁹ <https://www.lexico.com/en/definition/nutraceutical>

¹⁰ https://www.lexico.com/en/definition/functional_food

Preparations for treating colds

26) These goods are self-evidently covered by the opponent's broad term *pharmaceutical products*. Consequently, the respective terms cover identical goods.

Class 30

27) The opponent submits that because "the main purpose of tea is the quenching of thirst and because all non-alcoholic based beverages in Class 32 can serve as a tea substitute...all of the applicant's goods in class 30 are highly similar...". I observe that a number of terms in the applicant's specification do not cover tea, however, I do not believe that this is material to my findings because they can also all be said to be beverages that quench the thirst. Therefore, the opponent's submission could equally apply to these goods and I proceed on the basis that the considerations for these non-tea goods are the same as for the tea goods. I note the submissions of the opponent, but it is necessary to consider the issue in more detail and consider the factors as set out in *Canon* and *Treat*.

28) I find it convenient to separate the applicant's goods into two groups.

Beverages based on chocolate; Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea; Beverages (Cocoa-based -); Beverages made of tea; Beverages (Tea-based -); Beverages with a tea base; Beverages with tea base; Black tea; Black tea [English tea]; Chamomile tea; Drinking chocolate; Drinks based on chocolate; Drinks containing cocoa; Drinks prepared from cocoa; Earl Grey tea; Ginseng tea; Green tea; Herbal infusions; Herbal tea; Herbal teas; Herbal teas [infusions]; Iced tea; Iced teas; Linden tea; Peppermint tea; Prepared coffee and coffee-based beverages; Prepared coffee beverages; Red ginseng tea; Tea; Tea beverages; Tea (Iced -); Tea mixtures; Tea-based beverages; Teas.

29) These are all terms that include drinks and, consequently, as the opponent submits, they share the same purpose of quenching the thirst as its *fruit or vegetable juices, fruit or vegetable drinks* in Class 32. Their nature and methods of use are also the same, all being beverages that are consumed by mouth. The channels of trade

do not obviously coincide because the raw materials are different and normally produced using different methods and by different traders. When being retailed, they will normally be placed on different shelves in different parts of the store. However, there is an element of competition between them in that the consumer may choose one over the other to quench their thirst, however, I do not consider this competitive relationship to be particularly strong, unlike for example between tea and coffee beverages or between apple juice and orange juice. Taking all of this into account, there is clearly similarity between the respective goods, but I would place this at no more than a medium level rather than being highly similar as the opponent contends.

Herbal preparations for making beverages; Iced tea mix powders; Instant tea; Packaged tea [other than for medicinal use]; Preparations for making beverages [tea based]; Tea bags; Tea bags for making non-medicated tea; Tea extracts; Tea for infusions; Tea leaves; Tea mix powders.

30) This second group of terms describe preparations or ingredients for making beverages rather than the beverage itself. The opponent makes no specific submissions in respect of these goods. The opponent's Class 32 specification also includes terms describing preparations for making beverages. Similar considerations exist to the beverages themselves, but with some slight differences. Firstly, their nature is less similar because the type of preparations covered in by Class 32 are quite different to the preparations covered by Class 30. However, they will share some purpose because they are both used for making beverages and may be used in a similar way (for example, mixed with a liquid such as water). It is not obvious that there is much by way of overlap of trade channels but I recognise that they may be sold in the same store but are likely to be on different shelves. Again, there is an element of competition in that the consumer may be faced with a choice of which preparation to choose and is likely to depend on the preference at that time. Taking all of this into account, I conclude that there is some similarity, but it is no more than low.

Comparison of marks

31) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, 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.”

32) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of 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.

33) The respective marks are:

Opponent's EUTM	Applicant's mark
NUTRICIA	NUTRITEA

34) The marks of both parties consist of a single word comprising of the prefix NUTRI and an additional three-letters. The opponent's EUTM is likely to be perceived as a single word. The applicant's mark is likely to be perceived as the two parts NUTRI and TEA conjoined and the mark's distinctiveness lies with the conjoined combination with no one dominating.

35) As I have already noted, the respective marks share the same letters NUTRI at the beginning and both have an additional three letters. They differ in that the first two of these additional three letters are different in each case. Visually, the opponent's EUTM presents as a single word. In respect of the applicant's mark, the conjoining of the prefix NUTRI and the word TEA also creates a single word but with the two parts retaining their visual identity within. Taking all of this into account, I conclude that they share a reasonably high level of visual similarity.

36) Aurally, the opponent submits that the applicant's mark will be pronounced as either NU-TRI-TEA or NU-TRI-TEE-AH. I consider that because the TEA part of the mark is an everyday word in the English language, that the second of these pronunciations is unlikely. The first pronunciation is very likely to be how the UK consumer will refer to it. It is likely that the UK consumer will express it in the first way suggested by the opponent. As I have already commented it is likely to be perceived as the prefix NUTRI and the word TEA conjoined. This is likely to influence how the mark will be expressed and it will be aurally referred to as NU-TRI-TEE. The opponent also submits that its mark will be pronounced as NU-TRI-SHA or NU-TRI-SEE-AH. I agree. Taking all of this into account, aurally the marks coincide in the NU-TRI parts but differ after the first two syllables. I conclude that they share a medium level of aural similarity.

37) Conceptually, the opponent submits that NUTRI is an abbreviation of "nutrition". Whilst there is no corroboratory evidence to support this, I accept that it has this meaning and, consequently, its use in both marks is allusive of this meaning, or a similar meaning. I keep in mind the following guidance of the GC in *Ontex NV v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-353/04:

"91 ... the evocative force of the earlier mark cannot be altered by the fact that it is supposedly 'made up'. Even a made-up word may carry conceptual weight."

38) Therefore, this message will be communicated by this part of both the opponent's mark and the applicant's mark, creating a point of conceptual similarity. In the applicant's mark the NUTRI part is combined with the word TEA and imparts an allusive message of a nutritious or nourishing tea. When the opponent's EUTM is considered as a whole, it has no obvious meaning beyond the allusion of "nutrition" or similar. Taking all of this into account, I conclude that the respective marks share a low to medium level of conceptual similarity.

Average consumer and the purchasing act

39) 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*.

40) 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."

41) The relevant average consumer of the respective goods will be either ordinary members of the public or, in respect of the various Class 5 goods, ordinary members of the public with specific dietary requirements.

42) In respect of the level of care and attention paid during the purchasing act, this is likely to be average in respect of beverages but slightly higher in respect of

foodstuffs adapted for specific dietary requirements because the consumer is likely to have a heightened awareness of the characteristics he/she requires in a product and will be more attentive in order to ensure the products have these characteristics. In both cases, visual impressions are likely to be important, but I do not ignore that aural considerations may play a part in the purchasing process where the consumer may aurally request the goods or where they have been recommended aurally.

Distinctive character of the earlier trade marks

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

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

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

44) The opponent’s EUTM consists of the word NUTRICIA. It is an invented word, but as I noted earlier, one that alludes to “nutrition” or similar. Consequently, its

inherent level of distinctive character is not as high as some invented words and I find that it is endowed with a medium level.

45) The opponent makes no specific claims or submissions regarding the issue of enhanced distinctive character. It does provide extracts from its website, but it is from a dot com address, with little indication that it is targeted at the UK consumer other than one page that is entitled "Nuticia in the UK". However, the extracts were printed over 7 months after the relevant date of these proceedings. It also claims to have a family of NUTRI marks in the UK and goods sold under these marks amount to over £30 million as of the relevant date. The problem with this evidence, is that it fails to illustrate what proportion, if any, of these sales relate to the opponent's NUTRICIA mark. Consequently, I am unable to conclude that the opponent's mark benefits from an enhanced level of distinctive character at the relevant date.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

46) The following principles are obtained from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

47) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

48) The opponent relies upon a claim to a family of NUTRI- prefixed marks in the UK. I dismiss this claim because it relies on only the one earlier registered mark, namely NUTRICIA. The other marks relied upon as forming part of the family of marks are not relied upon as earlier marks by the opponent and therefore cannot be taken into account for the purposes of section 5(2).

49) In respect of my considerations in the current case, I have found that:

- the applicant's Class 5 goods are all identical or highly similar to the opponent's goods;
- its Class 30 goods share similarity to the opponent's goods that range from no more than low to a medium level;
- The parties' marks both present as a single word, with the opponent's mark perceived as an invented word and the applicant's mark perceived as being a combination of the prefix NUTRI and the commonly known word TEA;
- The respective marks share a reasonably high level of visual similarity, a medium level of aural similarity and a low to medium level of conceptual similarity;
- The average consumer will be general members of the public who will pay an average degree of care during the purchasing act in respect of beverages but slightly higher in respect of foodstuffs adapted for specific dietary requirements. The purchasing process is likely to be visual, but I recognised that aural considerations may play a part;

- The opponent's mark has a medium level of inherent distinctive character and that this is not enhanced through use.

50) These findings create a reasonable balanced landscape with some findings pointing towards a finding of a likelihood of confusion whilst others point away.

51) The conceptual difference is the presence of TEA in the applicant's mark. It creates a concept that is absent in the opponent's EUTM. Does this difference neutralise the visual and aural similarities? Whilst both marks share the same NUTRI element, because of its allusive character, it is unlikely to endow either mark with any great distinctiveness. Rather this arises from the combination of NUTRI with additional letters. In the case of the opponent's EUTM, these are the letters CIA. In combination with NUTRI these create a fanciful word with no different or greater concept than NUTRI alone. The applicant's mark, on the other hand, has the additional letters TEA added to NUTRI. The word TEA is well understood by the average UK consumer and retains its own identity within the mark. Taking account of this conceptual difference and the low level of distinctive character of the NUTRI part common to both marks, it is likely that the visual or aural similarity will be neutralised by the presence of the TEA part of the applicant's mark. It is likely to be perceived as consisting of the component parts NUTRI TEA despite the two parts being conjoined. Consequently, the average consumer is likely to be able to distinguish the marks in a way that they will not confuse one for the other and I find that there is no likelihood of direct confusion. Further, because of the low level of distinctive character of NUTRI and its highly allusive message, it is not likely that its common presence at the beginning of both marks will result in the consumer believing that the goods under both marks originate from the same or linked undertaking and, therefore, there is no likelihood of indirect confusion.

52) The opponent relies upon decision no. B 002493479 of the EUIPO Opposition Divisions where the opponent relied upon the same earlier mark as in the current proceedings to oppose the registration of a mark identical to that of the applicant's mark. I am not bound by the findings of an EUIPO decision, but I keep it in mind and I record here that its findings regarding the individual elements of the global consideration are largely consistent with my findings here. However, the EUIPO

found in favour of the opponent because of a likelihood of confusion in respect of the Bulgarian-speaking part of the public. The distinction was identified, earlier in the decision, between the Bulgarian-speaking public who will consider NUTRI as fanciful and the public who will associate NUTRI with the English word “nutrition”. Therefore, I do not consider this decision to conflict with my findings here.

53) In summary, having taken into account the reasonably balanced findings in the global analysis, including the fact that some of the goods are identical, I find that the section 5(2)(b) ground fails in its entirety. The fact that the common part of the respective marks (NUTRI) is of a low level of distinctive character and allusive of the goods in issue together with the fact that the word TEA retains its conceptual identity within the applicant’s mark are sufficient factors for the respective marks not being confused.

Section 5(3) and Section 5(4)(a)

54) The opponent has pleaded grounds based upon these sections of the Act but has not provided any submissions regarding either ground. I will deal with both grounds together, and briefly.

55) Section 5(3) requires that the earlier EUTM relied upon by the opponent has a reputation in the EU. Section 5(4)(a) requires that the opponent’s unregistered sign identifies its goodwill in the UK. In respect of both grounds, the opponent relies upon its NUTRICIA mark/sign. The evidence that may have supported a claim to a reputation and a goodwill is flawed for a number of reasons, namely:

- (i) the web extracts are obtained from the opponent’s dot com website and there is no indication that it is targeted at the UK, with the exception of one page that is entitled “Nutricia in the UK”;
- (ii) these were obtained some 7 months after the relevant date;
- (iii) whilst there is a statement that the opponent has a family of NUTRI-prefixed marks, evidence of use in the UK is limited to the six screen prints from the online retailer Amazon.co.uk were all obtained on 7 May 2019, being over 8 months after the relevant date. Further, they do not show use of the

mark relied upon. Therefore, they fail to support claim of a goodwill and reputation at the relevant date;

- (iv) whilst Mr Murch states that the opponent's sales of NUTRI- marks in the UK has been in excess of £30 million, he does not say how much, if any of this relates to sales under the NUTRICIA mark as opposed to other NUTRI- prefixed marks. The only corroboratory evidence takes the form of a graph entitled "NUTRICIA" covering the period March 2017 to February 2019 with a line fluctuating between "4,000,000" and "5,000,000". Nothing meaningful can be gleaned from this.

56) Taking all of the above into account, the evidence is wholly insufficient to demonstrate that the opponent's EUTM has the requisite reputation for the purposes of section 5(3), nor that the opponent has the requisite goodwill in the UK attached to its sign for the purposes of section 5(4)(a). In light of this, the opponent's grounds based upon these sections of the Act both fall at the first hurdle.

57) In summary, the opposition based upon section 5(3) and section 5(4)(a) fail in their entirety.

Summary

58) The opposition fails in its entirety.

Costs

59) The applicant has been successful and is entitled to a contribution towards its costs. However, as an unrepresented party, he was directed to complete a costs proforma by 5 September 2019. He did not comply with this direction and no completed costs proforma was filed. Therefore, I make no award of costs.

Dated this 24th day of October 2019

Mark Bryant

For the Registrar

The Comptroller-General