

o/978/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003603064

BY ZIPONGO, INC.

TO REGISTER THE TRADE MARK:

FOODSMART

IN CLASSES 9, 42 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427821

BY SMARTRETAIL CVBA

BACKGROUND AND PLEADINGS

1. On 2 March 2021, Zipongo, Inc. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 30 July 2021. The applicant seeks registration for the following goods and services:

Class 9 Computer software; downloadable software in the nature of a mobile application; mobile application software for wireless devices that provides users with recipes, personalized meal planning services and information about health, wellness and nutrition.

Class 42 Platform as a service (PAAS) featuring computer software platforms for health care providers, namely, dieticians and medical personnel to communicate with patients regarding health, wellness and nutrition; software as a service (SAAS) services featuring software for providing participants online access in the field of digital health to gain insight, tools, and the support in the fields of health, wellness and nutrition; providing a web hosting digital therapeutic platform for the management and care of clinical conditions; providing a website featuring interactive health, wellness and nutrition assessments; providing a website featuring technology that enables users to create grocery lists and assists users in online grocery choices and ordering.

Class 44 Providing healthcare information; providing nutrition assessments and consultation to help individuals make health, wellness and nutritional changes to improve health; health care services, namely, nutrition and wellness services, telenutrition, health coaching and online nutrition education and support.

2. The application was opposed by SmartRetail CVBA (“the opponent”) on 29 October 2021. The opposition was originally based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). However, the opponent withdrew the section 5(3) ground in writing on 30 March 2022. The opponent relies upon the following trade mark:



UK registration no. UK00801331092

Filing date 28 June 2016.

Registration date 18 July 2017.

3. The opponent relies upon all of the goods and services for which the earlier mark is registered, as set out in the Annex to this decision.

4. The opponent claims that the marks are closely similar in terms of visual, aural and conceptual considerations, and the goods and services are identical or similar.

5. The applicant filed a counterstatement denying the claims made.

6. The applicant filed evidence in chief. A hearing took place before me on 27 September 2022, by video conference. The applicant was represented by Mr Robert Snell of Lane IP. Albeit not present at the hearing, the opponent provided submissions in lieu of attendance, and is represented by Albright IP limited.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

8. The applicant's evidence consists of the witness statement of Robert Snell dated 13 June 2022. Mr Snell is a Chartered Trade Mark Attorney and Senior Associate at

Lane IP who are the applicant's representatives in this matter. Mr Snell's statement was accompanied by 3 exhibits (RS1-RS3).

9. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to it where necessary below.

DECISION

10. Section 5(2)(b) reads as follows:

“5(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.”

11. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6(1)(a) and 6(1)(ab) of the Act do not apply. The opponent may rely on all of the goods and services it has identified without demonstrating that it has used its mark.

Section 5(2)(b) case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

Matratzen Concord GmbH v OHIM, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in Canon, Case C-39/97, the court stated at paragraph 23 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. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary

and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

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

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

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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 GC stated that "complementary" means:

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

19. In *Sanco SA v OHIM*, Case T-249/11, the GC 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. (as he then was) noted, as the Appointed Person, in *Sandra Amalia 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.”

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.”

20. At the hearing the applicant confirmed that they do not dispute that the parties’ goods and services are similar to at least some degree. However, the applicant has not specified what degree of similarity the goods and services share. Therefore, I shall carry out a full comparison of the specifications.

Class 9

Computer software.

21. I consider that the opponent’s “software in the field of nutrition, lifestyle and health care” and “software for the collection, storage, analysis, scoring, evaluating and reporting of research on information and data in the field of health and wellbeing” falls within the applicant’s broader category of “computer software”. I consider them identical on the principle outlined in *Meric*.

Mobile application software for wireless devices that provides users with recipes, personalized meal planning services and information about health, wellness and nutrition.

22. I consider that the applicant's above goods fall within the opponent's broader category of "downloadable electronic application software in the field of nutrition, lifestyle and health care". I consider them identical on the principle outlined in *Meric*.

Downloadable software in the nature of a mobile application.

23. I consider that the applicant's above goods overlaps with the opponent's "downloadable electronic application software in the field of nutrition, lifestyle and health care". I consider that the goods overlap in nature and method of use as they are all types of software, however, I appreciate that the applicant's goods are specifically software used on a mobile device, and that the opponent's goods are specifically used in the field of nutrition, lifestyle and health care. I also consider that the goods would overlap in user and trade channels because the same software undertaking would provide all of the goods. I do not consider that they are complementary, however, they may to some extent be in competition. Taking the above into account, I consider that the goods are similar to a high degree.

Class 42

Platform as a service (PAAS) featuring computer software platforms for health care providers, namely, dieticians and medical personnel to communicate with patients regarding health, wellness and nutrition.

24. I consider that the applicant's above services overlap with the opponent's "establishment and development of an internet platform for purchasing advice for the benefit of advice on health, food, nutrition, wellness, lifestyle, lifestyle products and digital health (digital health programs such as apps and ebooks)". I consider that there will be an overlap in trade channels and user because a health care provider may wish to seek the services of establishing and developing their own platform, and also have it hosted via PAAS. Therefore, as the same company would establish, develop and host a platform, I consider that the goods would be important or indispensable to one another. Consequently, the services are complementary. Therefore, taking the above into account, I consider that the services are similar to a medium degree.

Software as a service (SAAS) services featuring software for providing participants online access in the field of digital health to gain insight, tools, and the support in the fields of health, wellness and nutrition.

25. SAAS is a model for the distribution of software where customers access software over the internet. The software could be hosted by its producers or made available to clients on the internet and licenced on a subscription basis. In this instance, the applicant's software is in the field of digital health. I consider that the same comparison applies as above in paragraph 24. I consider that there will be an overlap in trade channels and user with the opponent's "establishment and development of an internet platform for purchasing advice for the benefit of advice on health, food, nutrition, wellness, lifestyle, lifestyle products and digital health (digital health programs such as apps and ebooks)" because a health care provider may wish to seek the services of establishing and developing their own platform, and also have it hosted via SAAS instead. Therefore, as the same company would establish, develop and host a platform, I consider that the goods would be important or indispensable to one another. The services therefore have a strong complementary relationship. Consequently, I consider that the services are similar to a medium degree.

Providing a website featuring interactive health, wellness and nutrition assessments; providing a website featuring technology that enables users to create grocery lists and assists users in online grocery choices and ordering; providing a web hosting digital therapeutic platform for the management and care of clinical conditions.

26. I do not consider that the above services overlap with the opponent's class 42 services which establish, create, develop and design internet platforms, some of which specifically have the purpose of providing advice on health, food, nutrition, wellness, lifestyle, lifestyle products and digital health. I do not consider that the services would overlap in nature, method of use or purpose because the opponent's services create a platform for businesses/business users, whereas the applicant's services are the provision of providing a website to the end consumer. Consequently, I also do not consider there is an overlap in trade channels and user. The services are not complementary nor in competition. Taking the above into account, I consider that the services are dissimilar.

27. I also note that “quality control consultancy in the field of food hygiene” in the opponent’s specification is also dissimilar to the applicant’s above services. They do not overlap in user or trade channels as the opponent’s services would be provided by a quality control consultancy firm. The services also do not overlap in nature, method of use or purpose. The services are not complementary nor in competition. Therefore, the services are dissimilar.

Class 44

Providing healthcare information.

28. I consider that the opponent’s “provision of information relating to health, food, nutrition” would fall within the applicant’s above broader category. I consider them identical on the principle outlined in *Meric*.

Providing nutrition assessments and consultation to help individuals make health, wellness and nutritional changes to improve health.

29. I consider that the applicant’s above services are self-evidently identical to the “provision of information relating to health, food, nutrition” and “providing information relating to nutrition” in the opponent’s specification.

Health care for people.

30. I consider that the opponent’s “health care services, namely, nutrition and wellness services, telenutrition, health coaching and online nutrition education and support” fall within the applicant’s above broader category. I consider them identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then

determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

32. The average consumer for the goods and services will be members of the general public, health care professionals and health-based businesses. The cost of purchase is likely to vary. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of the purchase is low, various factors will be taken into consideration such as suitability for the user’s particular health and medical needs, ease of use and reliability. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process.

33. The goods are likely to be purchased from software undertakings, healthcare specialists, health-based businesses, and their online equivalent. The services are likely to be purchased from healthcare specialists, healthcare advice centres or their online equivalent. Alternatively, the goods and services may be purchased following perusal of advertisements. Consequently, visual considerations are likely to dominate the selection process.

34. However, I do not discount that there may be an aural component to the purchase of the goods and services given that advice may be sought from a sales assistant/health consultant, or a recommendation may have been given through word-of-mouth.


Comparison of the trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

37. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	FOODSMART

38. The opponent's mark consists of the words SMART WITH FOOD, which is highly allusive of the opponent's health, nutrition, diet and wellness goods and services. The

wording is presented below a simple hollow circle device, with the left hand side presented in the colour green and the right hand side presented in blue. At the bottom of the circle is a yellow dot. The words SMART and FOOD are also presented in the colour blue, and the word WITH in the colour green. I consider that the overall impression of the mark lies in the combination of all these weak elements (highly allusive wording and banal circle device), however, I appreciate that the words will marginally have more of an impact because “the average consumer will more easily refer to the goods [and services] in question by quoting their name than by describing the figurative element of the trade mark”.¹

39. The applicant’s mark consists of the word FOODSMART. I note that the word ‘FOODSMART’ is comprised of two ordinary dictionary words; food and smart. I note that this is also highly allusive of the applicant’s health, wellness and nutrition goods and services. There are no other elements to contribute to the overall impression which lies in the word itself.

40. The applicant submitted at the hearing that the marks have the words FOOD and SMART in common, however, the marks have “no visual similarity”. However, I simply cannot agree with this assertion. Visually, the marks clearly coincide in the presence of the words SMART and FOOD, and therefore these act as visual points of similarity. However, the opponent’s mark starts with the word SMART, ends with the word FOOD and is joined with the word WITH, whereas the applicant’s mark starts with the word FOOD and ends with the word SMART, all presented as one word. The opponent’s mark also includes a green and blue colour scheme, and the hollow circle device. I bear in mind that registration a word only mark covers use in any standard typeface, and registration of a mark in black and white covers use in any colour. However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white, including contrived colour splits, which appears in the opponent’s mark. Therefore, these act as visual points of difference. Taking the above into account, I consider that the marks are visually similar to a medium degree.

¹ *Wassen International v OHIM* Case T-312/03.

41. Aurally, the marks overlap in the pronunciation of the words SMART and FOOD. However, the opponent's mark starts with the word SMART and ends in FOOD, whereas the applicant's mark starts with the word FOOD and ends in SMART. Consequently, the beginnings of the marks differ aurally. Furthermore, the opponent's mark also contains the word WITH which will also be articulated in the middle of the mark. However, the hollow circle device will not be pronounced. Consequently, I consider that the marks are aurally similar to a medium degree.

42. Conceptually, albeit the words are inverted, I consider that the marks SMART WITH FOOD and FOOD SMART evoke the same meaning. To be "food smart" you will be "smart with food" and vice versa. I consider that this would include eating healthily, calorie counting or tracking your food intake. I do not consider that the hollow circle device and the blue and green colour scheme adds to the conceptual message of the opponent's mark. Therefore, I consider that the marks are conceptually identical.

Distinctive character of the earlier trade mark

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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

45. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

46. Firstly, I note that the applicant made various submissions at the hearing, as well as within its evidence (**exhibits RS1 and RS2**) that “if EU Designation IR No.1331092 did not include a device element and a blue and green colour scheme, it would not have been deemed inherently registrable”. I understand that the opposition is based on the UK equivalent of an EU mark which was created at the end of the Brexit Transition Period, however, this Tribunal is not bound by decisions of the EUIPO. In accordance with *Formula One*,² the mark will be considered to have at least some distinctive character.

47. The opponent’s mark is composed of the words SMART WITH FOOD, which is presented in blue and green writing underneath a blue/green hollow circle device. Albeit the applicant submitted at the hearing that it is uncontroversial to state that the existence of the colour and the device makes the opponent’s mark distinctive, I do not consider that the wording SMART WITH FOOD can be totally ignored. However, it is clear that the wording SMART WITH FOOD by itself is highly allusive of the opponent’s goods and services which are based on health, food, and nutrition.

² *Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 to 44

48. As highlighted above, in *Wassen International v OHIM* Case T-312/03, and in *Migros-Genossenschafts-Bund v EUIPO*, T-68/17 it was stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”³

49. Taking the above into account, I consider that the wording SMART WITH FOOD, albeit highly allusive, is slightly more dominant than the hollow circle device, which is simple in nature and therefore banal. Consequently, I consider that the colour and device only plays a slightly lesser role. However, it is clear that the opponent’s mark, as a whole, is only inherently distinctive to a low degree.

Likelihood of confusion

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

³ Paragraph 52

51. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually and aurally similar to a medium degree.
- I have found the marks to be conceptually identical.
- I have found the opponent's mark to be inherently distinctive to a low degree.
- I have identified the average consumer to be members of the general public, medical professionals and health based businesses who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods and services to be identical to similar between a low and medium degree.

52. I take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

53. Therefore, taking all of the above case law into account, I consider that it is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

54. As established above, the average consumer does not dissect the mark. The marks will be viewed as a whole. The opponent's mark, as a whole, is composed of a banal hollow circle device, a blue and green colour scheme, and the wording SMART WITH FOOD, which although is only slightly more dominant than the other elements, it is highly allusive of the opponent's goods and services. I bear in mind that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

55. In this instance, the common elements between the marks, in combination, is low in distinctiveness. SMART and FOOD and vice versa, is highly allusive of the parties' goods and services in relation to health, food, and nutrition. Therefore, even bearing in mind the principle of imperfect recollection, the differences between the two marks will take on a greater significance for the average consumer than they might have otherwise.⁴ The stylisation, including the blue and green colour scheme, the word WITH and the hollow circular device in the opponent's mark, may not be very remarkable, however, but they are visual points of difference. The marks aural similarity is higher than its visual, and its conceptual similarity is identical. However, again, this is because the marks share common elements which are low in distinctiveness. It is clear that the marks are not identical. As highlighted above, the marks have distinguishing features between them which become more significant due to both of the marks being lower in distinctiveness. Therefore, taking all of the above into account, I do not consider that there is a likelihood of direct confusion.

56. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

⁴ *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

57. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

58. Mr Purvis KC in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion ‘tends’ to fall in one of them.⁵ I note that the opponent hasn’t provided any submissions as to what category this case would fall within. I also bear in mind that the examples set out by Mr Purvis are not exhaustive. However, having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Even though the marks share the common words SMART and FOOD, as highlighted above, I consider that these elements are highly allusive of the opponent’s and applicant’s applied for/registered goods and services. Therefore, I do not think that the common elements are of such a level of distinctiveness that the average consumer would believe that only one undertaking would use them in relation to health, food, and nutrition goods and services. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole. Consequently, I do not consider that the average consumer would think that the applicant’s trade mark was connected with the opponent, and vice versa. Even if the opponent’s mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

57. The opposition is unsuccessful, and the application may proceed to registration.

⁵ Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10

COSTS

58. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filling evidence	£500
Preparation for and attendance of hearing	£700
Total	£1,400

59. I therefore order SmartRetail CVBA to pay Zipongo, Inc. the sum of £1,400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of November 2022

L FAYTER

For the Registrar

ANNEX

The opponent's mark

Class 9

Downloadable electronic application software in the field of nutrition, lifestyle and health care; software in the field of nutrition, lifestyle and health care, management of databases on nutrition, lifestyle and health care, cost management of nutrition, lifestyle and health care, processing of data on nutrition, lifestyle and health care, management of data on nutrition, lifestyle and health care, storage of health data; electronic databases in the field of health insurance underwriting and nutrition, lifestyle and health care; customized electronic databases with data and information on nutrition; software for managing the transmission of data between different software systems; apparatus for data input, namely electronic pens or scanners for use by providers of nutrition, lifestyle and health care for the electronic data entry; software for the collection, storage, analysis, scoring, evaluating and reporting of research on information and data in the field of health and wellbeing; downloadable mobile applications for research on nutrition and health.

Class 35

Advertising, marketing and promotional services; advertising, marketing, sales promotion and consultancy for products and services in the areas of health, food, nutrition, wellness, lifestyle and digital health (digital health programs such as apps and ebooks); public relations services; e-commerce (services in the field of -), namely, providing information on products via telecommunication networks for advertising and sales purposes; advertising the goods of other vendors; demonstration and display of products; commercial trade and trade information for consumers; on-line trading services in which sellers offer products to be auctioned and where the offer takes place electronically via the internet; business information and advice for consumers; retail and wholesale services relating to foods, food additives, kitchen and cooking appliances; administrative services of a mail order company (including via the internet and other communication networks) relating to foods, food additives, kitchen and cooking appliances and lifestyle products; advice and information about administrative management of customer service and administration of products and prices on internet sites in relation to purchases made over the internet; acquiring third party contracts;

business mediation in drawing up contracts for buying and selling of goods (including via the internet and other communications networks); organization of collective buying; import and export agencies; administrative processing of orders as part of mail order services for third parties; price comparison services; auction services; commercial-business assistance, commercial business management and administrative services; business consultancy and advisory services; commercial intermediation services; organization of company presentations for commercial purposes; advisory, consultancy and information in the business area; business analysis, business research and business information services; provision of information and advice to consumers on the purchase choice of products and articles; business project management; collecting information for business; compilation of business information; the collection and systematization of business data; business information provided online from a global computer network or the internet; advice and information relating to the aforementioned services, as far as included in this class.

Class 41

Publishing and reporting; services of a publishing house (including electronic publishing); publication of printed matter; publication (online) of electronic books and periodicals; providing online non-downloadable electronic publications; education, recreation and sport; teaching; training related to health, food, nutrition, wellness, lifestyle, lifestyle products and digital health (digital health programs such as apps and ebooks); training in the field of nutrition, lifestyle and health care; provision of educational information regarding wellness, lifestyle, lifestyle products and digital health programs such as apps and e-books; educational information related to lifestyle; advice and information relating to the aforementioned services, as far as included in this class.

Class 42

Establishment and development of an internet platform for purchasing advice for the benefit of advice on health, food, nutrition, wellness, lifestyle, lifestyle products and digital health (digital health programs such as apps and ebooks); developing and designing websites for the purpose of purchasing advice and for advice on health, food, nutrition, wellness, lifestyle, lifestyle products and digital health (digital health programs such as apps and ebooks); creation of platforms on the internet for e-

commerce; quality control consultancy in the field of food hygiene; advice and information relating to the aforementioned services, as far as included in this class.

Class 44

Dietary advice for people; health care for people; services in the field of hygiene and beauty care for people; health (consultancy in the field of -); medical services; consultancy services relating to health, food, nutrition; provision of information relating to health, food, nutrition; providing information relating to nutrition; guidance on nutrition and diet; health consultancy with regard to wellness, lifestyle and with regard to the choice and use of digital lifestyle products and health (digital health) programs such as apps and e-books; medical analysis in connection with nutrition counseling; advice and information relating to the aforementioned services, as far as included in this class.