

O/0297/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03720653 BY
VITAE HEALTH LTD
TO REGISTER AS A TRADE MARK:**



IN CLASS 5

AND

**OPPOSITION THERETO
UNDER NO. OP600002176 BY
VITAE HEALTH INNOVATION, S.L.**

Background & Pleadings

1. Vitae Health LTD (“**the applicant**”) applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed on 11 November 2021 and was published on 26 November 2021 in respect of the following goods:

Class 5: Food supplements; Mineral food supplements; Dietary food supplements; Vitamin and mineral food supplements; Food supplements consisting of amino acids; Health-aid foods supplements containing ginseng; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Health-aid foods supplement containing red ginseng; Mineral supplements; Nutritional supplements; Dietary supplements; Protein supplements; Calcium supplements; Herbal supplements; Vitamin preparations in the nature of food supplements; Vitamin supplements; Mineral nutritional supplements; Enzyme dietary supplements; Zinc dietary supplements; Zinc supplement lozenges; Vitamin and mineral supplements; Dietary supplements for humans; Flaxseed oil dietary supplements; Linseed oil dietary supplements; Activated charcoal dietary supplements.

2. VITAE HEALTH INNOVATION, S.L. (“**the opponent**”) opposes (using the Fast Track provisions) the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been

applied for and registered under UK law, and the original filing dates remain the same.

4. The opponent is the proprietor of a comparable mark, UK registration number 917883532 which stands as follows:

VITAE HEALTH INNOVATION

5. The opponent's mark was filed on 4 April 2018 and registered on 14 September 2018 for various goods and services in Classes 3, 5, and 39 respectively.
6. For the purposes of this opposition, the opponent relies only on the following Class 5 goods as covered by its earlier mark:

Class 5: Pharmaceuticals (other than goods for dental purposes);
Dietetic substances adapted for medical use; Nutritional supplements.

7. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's earlier mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings, as per Section 6A of the Act.
8. In its notice of opposition, the opponent claims that the marks are highly similar from a visual, phonetic, and conceptual perspective. Also, the opponent claims that the contested goods in Class 5 are identical or similar to a high degree to the opponent's.
9. The applicant filed a defence and counterstatement in which it denied the opponent's claims in the following terms:

"Vitae Health LTD, whilst taking into account the points made in the opposition's (Vitae Health Innovation S.L.) statement of grounds,

disagrees with the primary argument that the public is likely to confuse Vitae Health LTD and Vitae Health Innovation S.L. with each other due to what has been described as two trademarks that are "similar to a very high degree".

1. Vitae Health International S.L. is unlikely to become confused with Vitae Health LTD as a result of both trademarks existing due to a very different brand identity. Vitae Health Innovation may be the registered name of the opposition (minus 'S.L. '), however, it is not the public facing brand identity. In the vast majority of instances where the public would be able to form perception of Vitae Health Innovation S.L., the opposition is simply referred to as 'Vitae', and in some cases as 'Vitae Natural Nutrition'. One such place that 'Vitae Health Innovation' is consistently written is in the footer of each page of 'vitaeinternational.com', however it is the belief of the applicant that this is not sufficient enough to create a brand identity that the customer will remember the company by. Another example of such a practice, is the popular sports nutrition brand that is 'MYPROTEIN'. Included in the footer of each page of 'myprotein.com' is the logo for 'The Hut Group Limited', however the public does not refer to MYPROTEIN as The Hut Group when referring to the sports nutrition brand.

2. Whilst both companies are operating in the same market sector, the product identity of each company is very different. Vitae Health Innovation S.L. produces their own innovative products in their lab, the vast majority of which have their own name, rather than that of the primary ingredient. Vitae Health LTD, on the other hand, sells basic supplements, named according to the primary ingredient. In addition to this, the packaging of each company's products is very different, and therefore unlikely to be confused."

10. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade

Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

11. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. Although the opponent filed evidence with its TM7F, this was erroneously admitted into these fast-track proceedings as no prior leave was sought to file such evidence. On that basis, the evidence will not be considered in reaching my decision.
12. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
13. A hearing was neither requested nor was it considered necessary. This decision has been taken following a careful consideration of the papers.
14. In these proceedings, the opponent is represented by attorney-at-law Lara Grant and the applicant is a litigant in person.
15. 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 Trade Marks 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.

Decision

Section 5(2)(b)

16. 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”.

17. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

18. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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 für 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”.

19. The competing goods to be compared are shown in the following table:

Opponent’s Goods	Applicant’s Goods
<p>Class 5: Pharmaceuticals (other than goods for dental purposes); Dietetic substances adapted for medical use; Nutritional supplements.</p>	<p>Class 5: Food supplements; Mineral food supplements; Dietary food supplements; Vitamin and mineral food supplements; Food supplements consisting of amino acids; Health-aid foods supplements containing ginseng; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Health-aid foods supplement containing red ginseng; Mineral supplements; Nutritional supplements; Dietary supplements; Protein supplements; Calcium supplements; Herbal supplements; Vitamin preparations in the nature of food supplements;</p>

	Vitamin supplements; Mineral nutritional supplements; Enzyme dietary supplements; Zinc dietary supplements; Zinc supplement lozenges; Vitamin and mineral supplements; Dietary supplements for humans; Flaxseed oil dietary supplements; Linseed oil dietary supplements; Activated charcoal dietary supplements.
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20. In its statement of grounds, the opponent contends the following:

“34. All the goods covered in the Opposed application in class 5 consist of nutritional supplements and as such are identical to the earlier covered 'nutritional supplements' of the Earlier Mark and fall within that broad category.

35. Also, they are identical or similar to a high degree to pharmaceuticals (other than goods for dental purposes) and dietetic substances adapted for medical use protected by the Earlier Mark as having the same nature, intended purpose, identical consumers, distribution channels and same producers/manufacturers.

36. Thus, the goods in the Opposed application are identical to the Earlier Mark's goods.”

21. As quoted at the beginning of this decision, the applicant refers to the marketing of the products and the primary ingredients of the competing goods. In particular, the applicant claims that:

“Vitae Health Innovation S.L. produces their own innovative products in their lab, the vast majority of which have their own name, rather than that of the primary ingredient. Vitae Health LTD, on the other hand, sells basic supplements, named according to the primary ingredient. In addition to this, the packaging of each company's products is very different, and therefore unlikely to be confused.”

22. Whilst the applicant states that the goods in which the parties actually trade are different, this has no bearing on my decision. This is because I must consider the matter notionally based on the terms the parties have registered or seek to register. In addition, the applicant has five years in which to use its trade marks for the goods for which registration is sought, and the opponent's earlier mark has not been registered for five years (at the relevant date), and they, too, have more time in which to use their mark across the full range of their specification. Thus, without putting forward a blanket denial for the competing specifications, the applicant is deemed to have accepted the opponent's contentions in relation to the competing terms.¹ However, I should highlight that the contested goods clearly fall within the ambit of the broad term "*Nutritional supplements*", covered by the opponent's mark. Thus, I agree that they are identical as per *Meric*. If I am wrong in this finding, there will be overlap in use because both goods will be intended to improve a person's wellbeing by ensuring that their regular diet is supplemented with the appropriate nutrients. There will be overlap in user, method of use, nature and trade channels. I consider the goods to be highly similar.

Average Consumer and the Purchasing Act

23. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch),

¹ Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

"The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted."

at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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.”

24. The goods at issue cover a range of nutritional and dietary supplements, which I consider to be relatively low-cost (but not the lowest) purchases. The average consumer will be a member of the general public or professionals dealing in nutrition or a health-related business. The consumers will encounter the goods via websites, advertisements, brochures, and newspapers. The purchase of the goods will be primarily visual, such as in retail or online stores, where they will be viewed and self-selected by the consumers. However, I do not discount an aural element where word of mouth plays a part, such as verbal recommendation. The level of attention the average consumer will display when selecting the goods at issue will normally be average as the goods, whilst relatively low-cost items which may be purchased reasonably frequently, they are still consumed for a particular health purpose and the average consumer will likely take some care to consider the ingredients and benefits of the products. This is the case even for goods that may be less frequently purchased and more expensive. However, there may be some circumstances when the goods are purchased for very particular dietary or nutritional requirements, and here the average consumer might pay a slightly higher level of attention to ensure that they are fit for that particular purpose. Lastly, for health care professionals, the level of attention will be slightly higher than average when prescribing or recommending the given goods.

Comparison of Trade Marks

25. 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.”

26. 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.

27. The marks to be compared are:

Opponent's Mark
VITAE HEALTH INNOVATION
Applicant's Mark


Overall Impression

28. The applicant's mark consists of the verbal elements "VITAE HEALTH". The first word element, "VITAE", appears emboldened at the top of the mark, greater in size than the second word element (HEALTH), with a stylised 'A' letter, which the average consumer would see as a capital letter A with the crossbar missing. The second word element is placed underneath the first word element, smaller and in regular font. Both word elements appear in a green typeface, in upper case, against a black background. The first word element, "VITAE", will be more dominant owing to its size and position in the mark, having the most relative weight in the overall impression, and the word element "HEALTH", which is highly descriptive of the goods, has some, albeit lesser, relative weight.
29. The earlier mark consists of the words "VITAE HEALTH INNOVATION" in a standard font and upper case. Registration of a word mark protects the words themselves.² I consider that the word "VITAE" will be more dominant, with the words "HEALTH INNOVATION" having an allusive quality, albeit a mild one, to the goods which relate to the boosting/enhancement of a person's health. The word element "VITAE" will have greater weight in the overall impression. Due to their allusiveness, the words "HEALTH INNOVATION" will play a lesser role in the overall impression of the earlier mark.

Visual Comparison

30. The earlier mark comprises the words "VITAE HEALTH INNOVATION", while the contested mark incorporates the first two word elements "VITAE HEALTH" of the earlier mark. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,³ the common word elements, "VITAE HEALTH", positioned at the beginnings of the

² See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

competing marks, create a strong point of visual similarity. However, the endings of the marks differ due to the presence/absence of the word element “INNOVATION”. Nevertheless, I do not consider the difference created by the use of the green font and the black background in the contested mark to be significant since normal and fair use allows word-only marks to be presented in any standard font or case in standard colours.⁴ That said, I note that it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white, as this goes beyond normal and fair use of the word mark.⁵ I find, therefore, that the combination of colours used by the applicant is not a complex one where the earlier word mark could notionally be used in a similar green colour font against a black background. Considering all the factors, including the overall impression of the marks, I find that the degree of visual similarity falls between medium and high.

Aural Comparison

31. The average consumer would pronounce the earlier mark as “VEE-TAY HELTH IN-UH-VAY-SHUHN” and the contested mark as “VEE-TAY HELTH”. The marks differ in length and syllables. The earlier mark is seven syllables long, whereas the contested mark is three. However, I note that the competing marks share the identical first three-syllable word elements “VEE-TAY HELTH”, with the only phonetic difference emanating from the third word element “IN-UH-VAY-SHUHN”. I also note that the average consumer will naturally replace the stylised letter in the contested mark with the letter ‘A’. Taking into account the above factors and the overall impressions, I consider that the marks are aurally similar to a medium degree.

⁴ *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19.

⁵ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

Conceptual Comparison

32. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁶
33. The opponent contends that *“the marks share the same meaning -health for life. VITAE being a Latin term is generally understood by the British consumers as it is vastly known in its employment as an alternative for a ‘resume’ or Curriculum Vitae.”*
34. In the absence of evidence, I am unwilling to conclude that the entirety of the relevant public in the UK will be aware and readily grasp the meaning of the word “VITAE”. It is my view that some consumers will understand the word to mean ‘life’, and some will see it as an invented word with no discernible meaning. As mentioned earlier in this decision, the word elements “HEALTH INNOVATION” in the earlier mark will have an allusive connotation pertaining to the development of goods for the maintenance or boosting/enhancement of a person’s health.
35. The competing marks share the common word elements “VITAE HEALTH”. Thus, as explained in the preceding paragraph, for those consumers who recognise the word “VITAE”, the competing marks will share the concept of life and health. The additional word “INNOVATION” in the earlier mark will be seen as a mark relating to innovation in that field. Overall, taking into account the above factors and the overall impressions, there is a medium degree of conceptual similarity. In the case where the consumers treat the element “VITAE” as an invented word, the competing marks will share the concept emanating from the common word element “HEALTH”, albeit one being slightly more innovative than the other. In such a case, I find that the marks will still have a medium degree of conceptual similarity.

⁶ *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R. 29.

Distinctive Character of the Earlier Trade Mark

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

37. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

38. I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of the words “VITAE HEALTH INNOVATION”. As explained earlier in this decision, a group of consumers will consider the word element “VITAE” as an invented word, affording a high degree of inherent distinctiveness, and another group will recognise its meaning. That said, as shown above, the word mark contains the commonplace words “HEALTH INNOVATION” which will be allusive to the Class 5 goods. I consider that the mark as a whole is inherently distinctive to a medium degree, and slightly less for the group of consumers who know the meaning of the first word element “VITAE”.

Likelihood of Confusion

39. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁷ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁸

40. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

⁷ See *Canon Kabushiki Kaisha*, paragraph 17.

⁸ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

41. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., (as he then was) sitting 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.”

17. 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).”

42. I note that the categories identified above are not exhaustive.⁹
43. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., (as he then was) 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.
44. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. (as he then was) 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.”

45. Earlier in this decision I have concluded that:

- the goods at issue are identical;
- the average consumer of the parties' goods is a member of the general public or a health care professional, who will select the

⁹ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

goods by predominantly visual means, but without dismissing the aural means. The attention will normally be average but higher than average for health care professionals or for particular dietary requirements;

- the competing marks are visually similar to between a medium to high degree, aurally similar to a medium degree, and conceptually similar to a low degree;
- the earlier mark as a whole has a medium degree of inherent distinctiveness, and slightly less for the group of consumers who know the meaning of the first word element “VITAE”.

46. Taking into account the above, I am satisfied that the marks will be directly confused. The differences, based on the additional word “INNOVATION” in the earlier mark and stylisation of the contested mark, are not sufficient to allow the average consumer to distinguish between the respective marks. I note that the average consumer will imperfectly recall the marks as the element “VITAE” will dominate the overall impression. The similarities coupled with the identity of the goods between the marks are such that they will be mistakenly recalled as each other, even when a higher than average degree of attention will be paid during the purchasing process. I, therefore, consider there to be a likelihood of direct confusion.

47. If I am wrong on direct confusion, I find that there is a likelihood of indirect confusion for the respective identical goods. It is my view that the contested mark would be likely perceived as a variation of the earlier word mark, “VITAE HEALTH INNOVATION”, such as a co- or sub-brand. In particular, while the average consumer will identify the differences between the marks, they will identify the identical word elements in the respective marks. Given the identity of the goods in question, it is likely to create the impression that the goods sold under the contested mark originate from the same or a linked undertaking as those provided under the earlier mark and vice versa. Therefore, I find that the average consumer would assume a commercial association between the parties, believing that the respective goods come from the same or economically

linked undertakings. As a result, I find there is a likelihood of indirect confusion.

Outcome

48. The opposition under Section 5(2)(b) of the Act is **successful in its entirety**. Therefore, subject to appeal, the application will be refused.

Costs

49. The opponent has been successful and is entitled to a contribution towards his costs. Awards of costs in fast-track opposition proceedings are governed by Tribunal Practice Notice 2 of 2015. I award costs to the opponent on the following basis:

Filing a notice of opposition	£200
Opposition fee	£100
Total	£300

50. I, therefore, order Vitae Health LTD to pay VITAE HEALTH INNOVATION, S.L. the sum of £300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of March 2023

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General