

O/0590/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001683785

DESIGNATING THE UK

IN THE NAME OF BIOGENA GMBH & CO KG

FOR THE FOLLOWING TRADE MARK:

Retlron

IN CLASSES 5, 29 AND 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 439333 BY

URSAPHARM ARZNEIMITTEL GMBH

BACKGROUND AND PLEADINGS

1. International registration no. 1683785 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Biogena GmbH & Co KG. The IR is registered with effect from 9 June 2022. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder claims a priority date of 8 April 2022 and seeks protection for the goods set out in paragraph 29 below.

2. On 22 February 2023, Ursapharm Arzneimittel GmbH (“the opponent”) opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UKTM no. 801290011 for the mark **Retaron** which was filed on 28 January 2016 and registered on 28 December 2016.¹ A priority date is claimed from 31 July 2015. The opponent relies upon some goods for which the mark is registered, namely:

Class 5 Dietary supplements for humans and animals.²

3. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. The holder filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of the earlier mark.

5. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of all the papers on file.

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing International Registration designating the EU (“IREU”). As a result of the opponent having an IREU protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

² Although the opponent stated in its Form TM7 that it wished to rely upon the term “dietary supplements”, that term does not appear in its specification. The only term that appears in the specification and which relates specifically to dietary supplements is the one listed here. Consequently, I will proceed on that basis.

REPRESENTATION

6. The holder is represented by Stevens, Hewlett & Perkins.

7. The opponent is represented by D Young & Co LLP.

EVIDENCE AND SUBMISSIONS

8. The opponent's evidence in chief consists of:

- a. The witness statement of Barbara Sold, dated 30 August 2023, which is accompanied by 8 exhibits (AB1 to AB8). Ms Sold is the Head of International Marketing for the opponent.
- b. The witness statement of Thorsten Dohmen, dated 1 September 2023. Mr Dohmen is an attorney-at-law and explains that he provided the translations contained within the exhibits to Ms Sold's statement.

9. The holder elected not to file evidence.

10. The opponent's written submissions in lieu are dated 2 January 2024.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

12. Section 5(2)(b) of the Act 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.”

13. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As it was registered more than 5 years prior to the designation date for the IR, it is subject to the use provisions of section 6A of the Act.

Proof of use

15. The relevant statutory provisions are as follows:

“6(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. The relevant period for assessing genuine use is the five-year period ending with the priority date for the mark in issue i.e. 9 April 2017 to 8 April 2022. As the earlier mark is a comparable mark, use within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (i.e. 31 December 2020).³ Only use in the UK will be relevant after that date.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

³ See paragraph 7 of Part 1, Schedule 2A of the Act.

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale

of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

20. As noted above, parts of the opponent’s evidence have been translated by Mr Dohmen. Whilst he states that he has provided these translations based upon his own knowledge of the French language, and with the assistance of dictionaries/translation tools where the Dutch language is used, these do not appear to me to be “certified” translations, as required by the Tribunal. Nonetheless, I note that their accuracy has not been called into question by the holder, who has remained silent throughout these proceedings. I am not, therefore, convinced that I should discount the translations entirely, but rather should approach them with a degree of caution. In any event, for reasons that will become clear, I consider that the evidence before me is sufficiently self-explanatory in all material ways that nothing will turn on the definitions provided.

21. Ms Sold’s unchallenged evidence is that the earlier mark has been used in relation to dietary supplements; she has provided examples of product packaging which show use of the earlier mark.⁴ Whilst I note that these examples are undated, the same packaging appears on the opponent’s website during the relevant period (and prior to IP Completion Day).⁵ It appears that the opponent’s product is a dietary supplement used for the purposes of maintaining good vision.⁶

22. Ms Sold has provided a selection of invoices dated between 2019 and 2020 which, she confirms, are addressed to customers located in Germany and the Netherlands.⁷ These display products sold under the earlier mark alongside a series of numbers, which are plainly units sold. Whilst I note that this is confirmed by Mr Dohmen’s translation, it is self-evident, in my view, from the face of the document; it is difficult to see what else this number could be referring to. In total, these invoices show sales of

⁴ Exhibit AB1

⁵ Exhibit AB2

⁶ See, for example, Exhibit AB8

⁷ Exhibit AB5

over 5,000 units. Whilst I note that there is no product description provided, Ms Sold's evidence is clear that the opponent uses the mark in relation to dietary supplements. There is no suggestion of the mark being used in relation to any other goods/services, and this is supported by the evidence which only refers to one type of dietary supplement.

23. Taking all of this into account, in particular the repeated sales evidenced by the invoices provided and the fact that sales have been made in at least two EU countries prior to IP Completion Day, I am satisfied that there has been genuine use of the earlier mark for the purposes of dietary supplements, for use in humans, for the purposes of maintaining normal vision.

24. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

25. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

26. The only evidence of use is in relation to dietary supplements intended for human consumption. Consequently, I do not consider that the opponent should be entitled to rely upon the part of its specification which relates to dietary supplements for animals. Further, I have considered whether the opponent should be entitled to retain the broad term "dietary supplements for humans" at large, or whether use should be narrowed

further due to only one type of dietary supplement being offered. In my view, the latter is the correct approach; I consider that the average consumer would view the opponent's use as use in relation to dietary supplements for maintaining normal vision.

27. With that in mind, I consider a fair specification to be:

Class 5 Dietary supplements for humans for the purpose of maintaining normal vision.

Section 5(2)(b) – case law

28. 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 greater 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 to mind the earlier mark, 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

29. In light of my findings above, the competing goods are as follows:

Opponent's goods	Holder's goods
<p data-bbox="183 253 300 286"><u>Class 5</u></p> <p data-bbox="183 309 788 398">Dietary supplements for humans for the purpose of maintaining normal vision.</p>	<p data-bbox="810 253 927 286"><u>Class 5</u></p> <p data-bbox="810 309 1393 1279">Nutritional additives, especially antioxidants for medical purposes; dietetic products and nutritional supplements for medical purposes; preparations for the production of beverages for medical purposes; dietetic products for special medical purposes (balanced diets); foods for babies especially milk powder for babies; dietary and nutritional supplements for sports and increased performance for medical purposes; mineral nutritional additives; starch for dietetic and pharmaceutical purposes; nutritional additives, primarily composed of vitamins, amino acids, minerals and trace elements for medical purposes; herbal teas for medical purposes.</p> <p data-bbox="810 1352 943 1386"><u>Class 29</u></p> <p data-bbox="810 1408 1393 1610">Preserved, dried and cooked fruits and vegetables; vegetable extracts and concentrates (purees) for culinary purposes (except essential oils).</p> <p data-bbox="810 1684 943 1718"><u>Class 30</u></p> <p data-bbox="810 1740 1393 1942">Dried kitchen herbs; preserved herbs and spices; herbal teas not for medical purposes; black teas; tea essences; tea extracts; instant teas; tea mixes.</p>

30. When making the comparison, all relevant factors relating to the goods 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.”

31. Guidance on this issue has also 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.

32. In *Gérard Meric v OHIM*, Case T-133/05, the General Court stated that:

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

33. I bear in mind that it is permissible to group goods together for the purposes of assessment.⁸

Class 5

Dietetic products and nutritional supplements for medical purposes; dietetic products for special medical purposes (balanced diets).

34. In my view, the opponent's goods are identical to these terms on the principle outlined in *Merici*. If I am wrong in that finding, they will overlap in nature, method of use, purpose and trade channels and will be highly similar.

Nutritional additives, especially antioxidants for medical purposes; dietary and nutritional supplements for sports and increased performance for medical purposes; mineral nutritional additives; starch for dietetic and pharmaceutical purposes; nutritional additives, primarily composed of vitamins, amino acids, minerals and trace elements for medical purposes.

35. These are all types of food additive/supplement. Whilst they may have different purposes to the opponent's goods, which are specifically for maintaining normal vision, they may overlap in nature, method of use and trade channels. In large retailers, they are likely to be sold in close proximity to each other. I also consider that the user of the goods is likely to be the same. The goods may, in some case, be in competition,

⁸ *Separode Trade Mark* BL O-399-10

although this is unlikely where the specific purposes are different. There is no complementarity, as one is neither important nor indispensable for the other. In my view, the goods are similar to at least a medium degree.

Preparations for the production of beverages for medical purposes.

36. In my view, this term could include dietary supplements provided in liquid form. Consequently, this term is identical to the opponent's goods on the principle outlined in *Meric*. If I am wrong in that finding, then the goods overlap in trade channels, user, method of use and purpose. There is also competition. Consequently, they are highly similar.

Herbal teas for medical purposes.

37. In my view, these are not goods that can be considered dietary supplements. However, I recognise that herbal teas for medical purposes have certain qualities for which they are consumed (such as improving digestive health, assisting sleep etc.). Consequently, there may be some overlap in purpose with the opponent's dietary supplements. The user may also overlap. The goods may be sold through the same trade channels and may be in reasonable proximity to each other (due to the holder's goods being specifically for medical purposes). The nature of the goods will differ. Given the overlapping purpose, there may be an element of competition. In my view, the goods are similar to a medium degree.

Foods for babies especially milk powder for babies.

38. The opponent claims that these goods are identical to those for which it has protection. I disagree. The above term relates to food itself, rather than dietary supplements. Whilst I recognise that baby food is often fortified with various vitamins, the goods are still different in nature and method of use. Any overlap in purpose is at a very general level. The user of the goods might overlap, but again, this will be at a very general level. Whilst I recognise that the goods may be sold through the same retailers (such as pharmacies or supermarkets), they are unlikely to be sold in

proximity to each other. There is no competition or complementarity. Taking all of this into account, I consider the goods to be dissimilar.

Class 29

Preserved, dried and cooked fruits and vegetables; vegetable extracts and concentrates (purees) for culinary purposes (except essential oils).

39. In relation to these goods, the opponent submits:

“These goods are similar to dietary supplements as they are complementary and share an intended purpose. Dietary supplements can be characterised as food supplements and so they share the same intended purpose as food goods. Moreover, dietary supplements are sometimes made up of goods such as vegetable extracts and herbs.”

40. The user of the goods may clearly overlap. I have no evidence before me to suggest that the producer of the goods is likely to be the same, and I consider it extremely unlikely. The goods may be sold through the same trade channels (such as supermarkets), but they would not be sold in proximity to each other. The purpose of the goods may be the same at a very general level (in terms of both being for the nutritional benefit of the consumer), but the specific purposes are different; the holder's goods are foodstuffs, whereas the opponent's goods are dietary supplements intended to be consumed alongside food (not instead of). For this reason, there is no competition. The nature of the goods is plainly different. The method of use may be the same to the extent that they may all be consumed, but that is too general a level of overlap to carry weight in my assessment. There is no complementarity, as one would not expect the same undertaking to be responsible for both, nor are they important or indispensable for each other. I consider the goods to be dissimilar.

Class 30

Dried kitchen herbs; preserved herbs and spices; herbal teas not for medical purposes; black teas; tea essences; tea extracts; instant teas; tea mixes.

41. In my view, these goods can be distinguished from the herbal teas in class 5 by virtue of the fact that they do not have a medical purpose. They are, therefore, unlikely to share the same purpose as the opponent's goods (with the holder's consumed for enjoyment/to quench thirst/flavour food) and the opponent's goods to improve the user's nutritional intake. The method of use and nature of the goods plainly differ. The user may be the same, but I have no evidence before me to suggest an overlap in producer. As these are not medical goods, they are likely to be sold alongside other spice/herb products or alongside coffee/tea products, not in the pharmaceutical section of large retailers. Consequently, they will not be sold in proximity to each other. There is no competition (given the differing purposes) and no complementarity (as one is not important or indispensable for the other). I consider the goods to be dissimilar.

42. As some degree of similarity between the goods is required for there to be a successful opposition under section 5(2)(b) of the Act, the opposition under this ground must fail in respect of those goods that I have found to be dissimilar.⁹ For the avoidance of doubt, even if I had found that the opponent could rely upon the broader term "dietary supplements for humans", I would still have found the same goods to be dissimilar for the reasons given above.

The average consumer and the nature of the purchasing act

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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

⁹ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

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.”

44. The goods are likely to be used by members of the general public or professional users who are prescribing the goods to their patients. The opponent submits that the average consumer is likely to pay a low to medium degree of attention when purchasing the goods; I disagree. The goods that I have found to be similar are all medicinal in nature and/or are intended for improving the nutritional wellbeing of the user. Consequently, members of the general public are likely to be paying a higher-than-average degree of attention when purchasing the goods (although, in my view, not the highest). Medical professionals may pay a high degree of attention when they are prescribing/recommending these goods to patients.

45. The goods are likely to be self-selected from the shelves of a retail outlet, or online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component given that advice may be sought from medical professionals prescribing the product or retail assistants.

Comparison of trade marks

46. It is clear from *Sabel* 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.”

47. 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.

48. I recognise that the IR may be interpreted in two different ways. The first is as an invented word – RETLRON. The second is as two conjoined words (RET and IRON). In my view, the former is more likely. In any event, I consider that a significant proportion of average consumers would view the mark as the invented word, RETLRON. I will carry out my assessment on that basis.

49. The respective trade marks are shown below:

Opponent's trade mark	The IR
Retaron	RetIron

50. Both marks consist of a single word, in which the overall impression resides.

51. Visually, the marks coincide in the letters RET- at the beginning of the mark and the letters -RON at the end. They differ in the middle letter, being A in the opponent's mark and L in the IR. The impact of this different letter is reduced by virtue of it being in the middle of the mark. In my view, the marks are visually highly similar.

52. Aurally, the opponent's mark is likely to be pronounced RET-AHH-RON. The IR is likely to be pronounced as RET-LLL-RON. Overall, the marks are aurally highly similar.

53. Conceptually, both marks are invented words. I consider it unlikely that either will convey a conceptual message to the consumer. Consequently, the conceptual position is neutral.

Distinctive character of the earlier trade mark

54. 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-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 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).”

55. 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

56. I have summarised the opponent's evidence of use above. There is no evidence of use in relation to the UK market, which is the relevant market for assessing enhanced distinctiveness. Consequently, I have only the inherent position to consider. The earlier mark is an invented word. In my view, it is inherently highly distinctive.

57. In reaching this finding, I have borne in mind the fact that the opponent's mark is used on eye-related products, and that RETINA is part of the eye. The first three letters of the earlier mark share the same first three letters as this word. However, neither party argued that either mark should be seen as allusive; in my view, even if they had, such an allusion would not be immediately graspable by the average consumer and, for this reason, it would simply be viewed as an invented word with no meaning.

Likelihood of confusion

58. 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 them and the goods being down to the responsible undertaking 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 marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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.

59. I have found as follows:

- a) The goods vary from being identical to similar to a medium degree (except where I have found them to be dissimilar).

- b) The average consumer for the goods is a member of the general public or a medical professional, who will pay at least a higher-than-average degree of attention during the purchasing process (although for medical professionals, the level of attention may be high).
- c) The purchasing process for the goods is predominantly visual, although I do not discount an aural component.
- d) The marks are visually and aurally highly similar. The conceptual position is neutral.
- e) The earlier mark is inherently distinctive to a high degree.

60. I recognise that the high degree of attention paid is a factor in favour of the holder. However, in my view, it is counteracted by the degree of similarity between the marks. In my view, the visual and aural similarities between the marks are likely to result in one being mistakenly recalled for the other, particularly when factoring in the principle of imperfect recollection. Whilst I bear in mind that some of the goods are similar to only a medium degree, I consider that the effect of the interdependency principle is such that there will still be confusion for these goods. In my view, there is a likelihood of direct confusion for all goods that I have found to be similar.

CONCLUSION

61. The opposition is successful in relation to the following goods for which, subject to any successful appeal, the application is refused:

Class 5 Nutritional additives, especially antioxidants for medical purposes; dietetic products and nutritional supplements for medical purposes; preparations for the production of beverages for medical purposes; dietetic products for special medical purposes (balanced diets); dietary and nutritional supplements for sports and increased performance for medical purposes; mineral nutritional additives; starch for dietetic and

pharmaceutical purposes; nutritional additives, primarily composed of vitamins, amino acids, minerals and trace elements for medical purposes; herbal teas for medical purposes.

62. The opposition is unsuccessful in relation to the following goods for which the application may proceed to registration:

Class 5 Foods for babies especially milk powder for babies.

Class 29 Preserved, dried and cooked fruits and vegetables; vegetable extracts and concentrates (purees) for culinary purposes (except essential oils).

Class 30 Dried kitchen herbs; preserved herbs and spices; herbal teas not for medical purposes; black teas; tea essences; tea extracts; instant teas; tea mixes.

COSTS

63. As both parties have enjoyed a roughly equal degree of success, I direct that each bear their own costs.

Dated this 24th day of June 2024

S WILSON

For the Registrar