O/0969/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004076082
BY DS NATURAL SAGLIK URUNLERI TICARET LIMITED SIRKETI
TO REGISTER THE TRADE MARK:

VITALOTICS

IN CLASSES 5, 35 AND 39

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 449568
BY VITABIOTICS LTD

BACKGROUND AND PLEADINGS

1. On 16 July 2024, DS NATURAL SAGLIK URUNLERI TICARET LIMITED SIRKETI ("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 9 August 2024. The applicant seeks registration for the class 5, 35 and 39 goods and services contained in Annex 1 to this decision.

2. The application was opposed in full by Vitabiotics LTD ("the opponent") on 10 September 2024 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act ("the Act"). Under section 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

VITABIOTICS

Comparable UK trade mark (EU) registration no. UK00906104038[1]
Filing date 6 July 2007; Registration date 21 April 2008.
Seniority date 22 May 1990.
("The First Earlier Mark")



UK registration no. UK00001426301
Filing date 22 May 1990; Registration date 8 November 1991.
(the Second Earlier Mark)[2]

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority or seniority date (if applicable) and registration date of the EUTM from which it derives.
[2] There is a disclaimer on this mark which states that registration of this mark shall give no right to the exclusive use of the Greek letter "W".

VITABIOTICS

UK registration no. UK00003094322

Filing date 12 February 2015; Registration date 8 May 2015.

(the Third Earlier Mark)

3. Under section 5(2)(b), the opponent relies upon its First and Second Earlier Mark's to oppose the applicant's class 5 goods, and its Third Earlier Mark to oppose the applicant's class 35 and 39 services. The opponent's goods and services are contained in Annex 2 to this decision. The opponent claims that there is a likelihood of confusion because of the high degree of similarity between the marks and the identity and/or similarity of the goods and services.

4. Under section 5(3), the opponent relies upon its First and Second Earlier Mark's class 5 goods, and Third Earlier Mark's class 35 services, contained in Annex 2 to this decision. The opponent claims that its marks' "enjoy a significant reputation in relation to its services",[3] and that use of all the applicant's goods and services would take unfair advantage of its First, Second and Third Earlier Marks. The opponent also claims that the parties' marks are highly similar, and the goods and services are identical or similar, but "even for those goods and services that may be considered dissimilar, the average consumer would make a link" between them, believing that they are part of the same undertaking or economically connected. The opponent also claims that the opposed mark will be called to mind by the opponent's marks, "such that the average consumer may create a link" between them, which would allow the applicant to free-ride on the opponent's reputation to "achieve greater sales without committing to the time and expense of marketing or quality control testing of their goods" which would amount to an unfair advantage. The opponent also claims that if the applicant's goods and services were of inferior quality that this would cause "detriment by association", and that registration of the applicant's mark would "be without due cause and may be detrimental to the distinctive characters and/or repute of the opponent's earlier marks by way of tarnishment or dilution" as their marks will

[3] Under the First and Second Earlier Marks the opponent only relies upon its class 3 goods and therefore I acknowledge that this must be typographical error.

no long be able to identify goods and services originating only from the opponent, which would result in a loss of sales.

5. Under section 5(4)(a), the opponent relies upon its **VITABIOTICS** sign which it claims to have used throughout the UK since at least 1971 for "vitamin and mineral based supplements and related retail and wholesale services". The opponent claims that use of the applicant's mark on all of its goods and services would be contrary to the law of passing off.

6. On 18 November 2024, the applicant filed a Form TM21b restricting its class 5 and 35 specifications. On 19 November 2024, the Registry issued an official letter confirming the amended specifications and asked the opponent whether this would allow the opposition to be withdrawn. On the 29 November 2024, the opponent confirmed that they maintain their position notwithstanding the amendments. Therefore, the applicant filed a counterstatement denying the claims made.

7. The opponent is represented by Kilburn & Strode LLP and the applicant is represented by MON IP LTD.

8. The opponent filed evidence in chief. Neither party requested a hearing, however, the opponent filed submissions in lieu. I make this decision having taken full account of all the papers and evidence, and I will refer to them where necessary below.

9. 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.

EVIDENCE

10. The opponent's evidence includes the witness statement of Robert Peter Taylor dated 13 February 2025. Mr Taylor is the Director, Company Secretary and Senior

Vice President of the opponent. Mr Taylor has held his position of Director since 1 January 1994, and his statement is accompanied by 15 exhibits (RPT1-RPT15).

11. The opponent's evidence also includes the witness statement of Caroline Ruvimbo Nyahasha dated 17 February 2025. Ms Nyahasha is a Chartered Trade Mark Attorney and Trade Mark Counsel at Kilburn & Strode LLP, the opponent's representatives. Ms Nyahasha's statement is accompanied by 1 exhibit (CN1).

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

DECISION

Section 5(2)(b)

13. 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."

14. The opponent's marks qualify as earlier marks in accordance with section 6 of the Act as their filing and seniority dates are earlier than the filing date of the applicant's mark. The opponent's First, Second and Third Earlier Marks had also completed their registration process more than five years before the relevant date (the filing date of the applicant's mark). Accordingly, the use provisions at section 6A apply. However,

as the applicant did not request that the opponent prove use of its earlier marks, the opponent is entitled to rely upon all of its goods and services (contained in Annex 2 to this decision) without demonstrating that it has used its First, Second and Third Earlier Marks.

Section 5(2)(b) - case law

15. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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;[4]

(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; and

(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

16. 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 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

[4] That being the interdependency principle.

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."

17. 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.

18. In *Gérard Meric v OHIM*, 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 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. For the purposes of considering the issue of similarity of the parties' goods and services (contained in Annex 1 and 2), it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. 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 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."

21. 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 O/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."

22. As noted above, the opponent relies upon its First and Second Earlier Mark's to oppose the applicant's class 5 goods, and its Third Earlier Mark to oppose the applicant's class 35 and 39 services. I shall, therefore, deal with these comparisons separately.

Class 5

23. I note that the parties' competing class 5 goods are as follows:

Opponent's goods	**Applicant's goods**
The First Earlier Mark Class 5 Vitamin and mineral preparations. **The Second Earlier Mark** Class 5 Vitamin and mineral preparations.	Class 5 Veterinary preparations for medical purposes; chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; medicated cosmetics; Dietary supplements for veterinary purposes; medical preparations for slimming purposes; food for babies; Dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; Sanitary preparations for medical use: hygienic pads, hygienic tampons; plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets; Preparations for destroying vermin; herbicides, fungicides, preparations for destroying rodents; Deodorants, other

	than for human beings or for animals; air purifying preparations; air deodorising preparations; Disinfectants; antiseptics; detergents for medical purposes; medicated soaps; disinfectant soaps; antibacterial hand lotions.

Dietary supplements for veterinary purposes.

24. I bear in mind that the opponent's "vitamin and mineral preparations" in class 5 is not limited via user, and therefore this broad term would encompass vitamin and mineral preparations for veterinary purposes. I also note that at paragraph 21 of its submissions in lieu, the opponent claims that the applicant's above goods would fall within the broader category of "vitamin and mineral preparations" in its First and Second Earlier Mark's specifications.

25. The applicant's dietary supplements can provide the user with nutrients such as vitamins and minerals. The opponent's goods also provide the user, that being animals, with vitamins and minerals, and therefore, I find that the applicant's goods could fall within the opponent's broader category, making them identical on the principle outlined in *Meric.*

26. However, if I am wrong in this finding, and the above goods are not identical, I nonetheless consider them to be highly similar. The parties' goods overlap in method of use and purpose as they both would be consumed to give the animal vitamins and minerals (or other substances) to improve their health and diet. While the specific chemical nature and composition of the goods may vary, they are all supplements which have the overall purpose of enhancing nutritional intake. The goods will overlap in trade channels, as the same veterinary undertaking would produce the supplement goods, and they would be sold next to each other in the same aisle of pet shops or general retail outlets. There will also be an overlap in user, being veterinary professionals and the general public seeking to purchase supplements for their animals or pets. I bear in mind that there may be a degree of competition between the

goods, with the average consumer choosing one over the other to give their animal their vitamins and minerals. However, I do not consider them to be complementary. Therefore, overall, I consider the goods to be similar to a high degree.

Veterinary preparations for medical purposes.

27. I find that the applicant's above "veterinary preparations for medical purposes" encompasses preparations intended to prevent, diagnose and treat medical conditions in animals. As noted above, the opponent's "vitamin and mineral preparations" includes vitamin and mineral preparations for veterinary purposes, and these goods could be used to treat medical conditions in animals. On this basis, I find that the opponent's goods could fall within the applicant's above broader category, making them identical on the principle outlined in *Meric.* However, if I am wrong in this finding, the goods overlap in trade channels, nature, purpose, method of use and user, making them similar to a high degree.

Medical preparations for slimming purposes.

28. At paragraph 21 of its submissions in lieu, the opponent submits that the applicant's above goods are identical to its "vitamin and mineral preparations". However, the opponent has not provided any reasoning as to why.

29. Nevertheless, I consider that the applicant's above goods would encompass nutritional shakes which include a variety of ingredients, including vitamins and minerals, formulated to assist with weight loss, weight management or appetite control. The opponent's goods are also taken to provide vitamins and/or minerals to supplement nutrition and maintain health. On the basis that they all provide the user with essential vitamins and minerals, and they are all taken orally, the goods are likely to overlap in method of use and purpose. There may also be an overlap in trade channels, with the goods being sold in pharmacies or supermarkets, in close proximity. The goods will also overlap in user, however, are unlikely to be in competition or complementary. I therefore find that the parties' goods are similar, but only to between a low and medium degree.

Medicated cosmetics.

30. Again, at paragraph 22 of its submissions in lieu, the opponent submits that the above goods are similar to the opponent's goods "as they may contain vitamins and minerals, and will be aimed at the same consumers within the health and supplement industry". I bear in mind that *Les Éditions Albert René v OHIM*[5] sets out that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

31. Whilst I note that the same users will purchase the parties' goods, that being members of the general public, the goods clearly do not overlap in nature. I note that medicated cosmetics will contain active ingredients used to treat, for example, eczema or acne, and vitamins and minerals are not typically used to treat such ailments. However, the purpose of the applicant's medicated cosmetics is to improve the user's skin, and that the opponent's "vitamin and mineral preparations" can also be ingested to improve the appearance of the users skin, hair and nails. Nevertheless, the goods do not overlap in method of use on the basis that medicated cosmetics will be applied externally to the skin (typically on the face), whereas the opponent's goods will be ingested orally. Whilst the goods may all be sold in pharmacies or supermarkets, I do not consider that they would be sold in the same aisle, but they may be sold in close proximity. The goods are also clearly not complementary, however, they may be in competition to the extent that the goods overlap in purpose. I therefore find that the parties' goods are similar to a low degree.

Chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes.

32. At paragraph 22 of its submissions in lieu, the opponent submits that the above goods are similar to the opponent's goods "as they may contain vitamins and minerals, and will be aimed at the same consumers within the health and supplement industry".

[5] Case T-336/03

Once again I bear in mind the case of *Les Éditions Albert René v OHIM*, and whether there is similarity between the parties' goods based on the factors identified in *Treat*. Without any further submissions or evidence before me, I consider that the applicant's chemical preparation goods would cover, for instance, antiseptic and antibacterial preparations for veterinary purposes and chemical diagnostic preparations for veterinary purposes. These goods would be used only by professionals, that being veterinarian's, when, for example, operating on and diagnosing an animal in their practice. The applicant's chemical regents will be used in the research, testing, development and manufacture of pharmaceutical and veterinary products, and the user of these goods will be those who work in a laboratory researching and developing pharmaceutical and veterinary products. I find that the parties' preparations clearly do not overlap in nature (chemicals vs vitamin and minerals), method of use or purpose. Without any evidence before me, I do not consider that the goods would overlap in trade channels, nor are they in competition or complementary. Whilst the user of the opponent's goods are professionals such as veterinarian's (as well as members of the general public who own or care for an animal) this overlap in user with the applicant's chemical preparation goods is not enough on its own to establish similarity between them. Consequently, I find that the goods are dissimilar.

Food for babies.

33. At paragraph 22 of its submissions in lieu, the opponent claims that the above goods are similar to the opponent's goods "as they may contain vitamins and minerals, and will be aimed at the same consumers within the health and supplement industry". Whilst the applicant's goods, which would include formula or prepared food such as pureed fruit and vegetables, may indeed contain vitamins and minerals, the parties' goods clearly do not overlap in nature or purpose, as the applicant's goods are food which are used to feed babies whereas the opponent's supplements are used alongside food to provide the user with additional nutrients. Whilst the goods will be consumed by the same users, without any evidence before me, I find that the goods would not be produced by the same undertakings, nor would the goods be sold in the same aisle of a supermarket. The goods are neither in competition or complementary, and therefore, I find that they are dissimilar.

Dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; sanitary preparations for medical use: hygienic pads, hygienic tampons; plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets; preparations for destroying vermin; herbicides, fungicides, preparations for destroying rodents; deodorants, other than for human beings or for animals; air purifying preparations; air deodorising preparations; disinfectants; antiseptics; detergents for medical purposes; medicated soaps; disinfectant soaps; antibacterial hand lotions.

34. The applicant's above goods can be summarised as follows:

1) dental preparations
2) sanitary preparations
3) diapers
4) preparations for destroying vermin
5) air purifying and deodorising preparations
6) disinfectants, antiseptics, detergents, soaps and antibacterial goods

35. In the opponent's statement of grounds and submissions in lieu, they make no submissions in regard to any of these goods. Nevertheless, I find that they clearly differ in nature, method of use, purpose and trade channels with the opponent's "vitamin and mineral preparations". They are not in competition nor are they complementary. Whilst there may be an overlap in user, this is not enough on its own for a finding of similarity. On this basis, the goods are dissimilar.

Class 35 and 39

36. I note that the parties' competing class 35 and 39 services are as follows:

Opponent's services	**Applicant's services**
The Third Earlier Mark Class 35	Class 35 Advertising, marketing and public relations; organization of exhibitions and

Business management; business administration; office functions; advertising services provided via the Internet; provision of business information; wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals.	trade fairs for commercial or advertising purposes; design for advertising; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; Business management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services; Auctioneering; The bringing together, for the benefit of others, of a variety of goods, namely , veterinary preparations for medical purposes , chemical preparations for veterinary purposes , chemical reagents for pharmaceutical and veterinary purposes , dietary supplements for veterinary purposes , medical preparations for slimming purposes, food for babies, dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth, sanitary preparations for medical use: hygienic

	pads, hygienic tampons, plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets, preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents, deodorants, other than for human beings or for animals, air purifying preparations, air deodorising preparations, disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues. <u>Class 39</u> Land, water and air transport services; rental of land, water or air vehicles; arranging of tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); Car parking; garage rental; Boat storage; Transport by pipeline; Electricity distribution; Water supplying; Rescue services for vehicles; Storage, wrapping and packaging of goods; Transport and storage of trash; transport and storage of waste.

Class 35

Office functions.

37. The above term appears identically in both of the parties' specifications.

Business management, business administration and business consultancy.

38. The opponent's terms "business management" and "business administration" falls within the applicant's above broader category. The services are identical on the principle outlined in *Meric.*

Advertising, marketing and public relations.

39. The opponent's "advertising services provided via the internet" fall within the applicant's above broader category. The services are identical on the principle outlined in *Meric.* However, if I am wrong in this finding, the services overlap in trade channels, nature, purpose, method of use and user, making them similar to a high degree.

Design for advertising.

40. The applicant's above services encompass the creation, development and design of advertising materials and contents for others. The opponent's "advertising services provided via the internet" would encompass such services, and therefore, the parties' services are identical on the principle outlined in *Meric.*

Secretarial services.

41. While the opponent has not provided any submissions in regard to what its term "office functions" would cover, I consider that this phrase naturally includes any services which are core to the functions of an office. On this basis, I find that the applicant's "secretarial services" would be encompassed by "office functions", making them identical on the principle outlined in *Meric.*

Accounting; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services.

42. The opponent's "business management" and "business administration" services are intended to help companies manage their business and thus will be involved in activities associated with the running of a business. Consequently, I find that that the applicant's above services falls within the broader categories of "business management" and "business administration" in the opponent's specifications. The services are identical on the principle outlined in *Meric.*

43. However, if I am wrong in this finding, the parties' services will overlap in trade channels, users, method of use, nature, and purpose, making them highly similar.

The bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations for medical purposes, dietary supplements for veterinary purposes, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

44. I find that that the applicant's above services falls within the broader category of "wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals". The services are identical on the principle outlined in *Meric.* Even if I am wrong in this finding, the services will overlap in trade channels, users, method of use, nature, and purpose, making them highly similar.

Provision of an online marketplace for buyers and sellers of goods and services.

45. I find that the applicant's above services overlap with the opponent's "wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and

pharmaceuticals". I note that the opponent's services would encompass wholesale and retail services provided online and therefore the parties' services overlap in nature. They also overlap in purpose on the basis that they allow and facilitate a user to purchase goods online. The goods are also likely to overlap in trade channels. However, I appreciate that the applicant's services also allows the consumer to place its own goods and services for sale (as well as buying goods and services from others). I therefore find that they are similar to at least a medium degree.

The bringing together, for the benefit of others, of a variety of goods, namely, medical preparations for slimming purposes, food for babies, sanitary preparations for medical use: hygienic pads, hygienic tampons, plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets, air purifying preparations, deodorants, other than for human beings or for animals, air deodorising preparations, disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

46. While the applicant's above services overlap in nature and method of use with the opponent's "wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals", (as they are both types of wholesale and retail services), the goods sold clearly differ. I consider that the services would overlap in trade channels and user, with general retail stores selling all of the aforementioned goods to the general public. However, the services are not competition nor complementary. On this basis, the services are similar to between a low and medium degree.

The bringing together, for the benefit of others, of a variety of goods, namely, dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

47. While the applicant's above services overlap in nature and method of use with the opponent's "wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals", (as they are both types of wholesale and retail services), the goods sold clearly differ. I therefore find that the goods and services do not overlap in purpose or trade channels, as the applicant's services would likely be provided by dental specialists and practices, whereas the opponent's services would be provided by general retail stores. The services are neither in competition nor complementary, albeit there would be an overlap in user. I also do not consider an overlap in general nature and method of use is sufficient to find similarity between the parties' retail services. On this basis, I consider that they are dissimilar. However, if I was wrong in this finding, then the services would be similar to only a very low degree.

The bringing together, for the benefit of others, of a variety of goods, namely, preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

48. While the applicant's above services overlap in nature and method of use with the opponent's "wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals", (as they are both types of wholesale and retail services), the goods sold clearly differ, and thus, they differ in purpose. I also find that the goods and services do not overlap in trade channels, as the applicant's services would likely be provided by pest and vermin specialists, whereas the opponent's services would be provided by general retail stores. The services are neither in competition nor complementary, however, there would be an overlap in user. I therefore consider that the parties' services are dissimilar. However, if I was wrong in this finding, then the services would only be similar to a very low degree.

The bringing together, for the benefit of others, of a variety of goods, namely, chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, enabling customers to conveniently view and purchase those

goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

49. Whilst the applicant's above services overlap in general nature and method of use with the opponent's "wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals", (as they are both types of wholesale and retail services), the goods sold clearly differ. I therefore consider that they differ in purpose. I also do not consider that there would be an overlap in trade channels and user, as the applicant's goods are very specialist. The services are clearly not in competition nor complementary. I do not consider than an overlap in general nature, and method of use is sufficient to find similarity between the parties' services. On this basis, I consider that they are dissimilar. However, if I was wrong in this finding, then the services would only be similar to a very low degree.

Organization of exhibitions and trade fairs for commercial or advertising purposes.

50. Whilst at paragraph 22 of its submissions in lieu the opponent submits that the applicant's above services are identical to its "business management", "business administration" "office functions", "advertising services provided via the Internet and "provision of business information" services, the opponent does not state why. The applicant's above services clearly differ in nature to the opponent's "advertising services provided via the internet", albeit all of the services are provided for advertising purposes. There is likely to be an overlap in user, however, without any evidence before me, I do not consider that the services overlap in trade channels, especially as the opponent's services clearly state that they are services provided only via the internet. I do not consider that the services are complementary nor in competition. I therefore find that the services are dissimilar.

Auctioneering.

51. The applicant's above services is the practice of selling goods and services via competitive bids. The opponent submits that these services are identical to its "business management", "business administration" "office functions", "advertising

services provided via the Internet and “provision of business information" services, however, the opponent does not provide any explanation as to how or why they are identical.[6] There is no evidence before me to support this submission and therefore I disagree with the opponent. I find that the parties’ services clearly do not overlap in nature, method of use, trade channels or purpose. Nor are they in competition nor complementary. Whilst the services may overlap in user, this is not enough on its own to find similarity. I therefore find that the parties’ services are dissimilar.

Class 39

Land, water and air transport services; Storage, wrapping and packaging of goods.

52. At paragraph 26 of its submissions in lieu, the opponent states that:

> “The applicant's Class 39 services for "Land, water and air transport services; Storage, wrapping and packaging of goods" are similar to the opponent's wholesale retail services because the goods provided by the wholesale and retail services will be transported, stored, wrapped, and packaged as part of the wholesale and retail service.”

53. Whilst I appreciate that the goods provided via the opponent’s class 35 wholesale and retail services could be wrapped and transported after purchase, these services are not encompassed by the term “wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals”. They are, as indicated by class 39, separate services. I also note that the applicant’s class 39 services are those which provide third parties with wrapping and transportation services. Therefore, whilst a retail or wholesale store may offer such services to their customers, they do not offer them to third parties as they would only wrap and transport their own items. Consequently, I find that wrapping specialists and transport undertakings provide the applicant’s services, whereas the opponent’s services are provided by wholesale and retail stores. The services clearly do not overlap in nature, method of use and purpose,

[6] Paragraph 24 of its submissions in lieu.

nor are they in competition nor complementary. Whilst the user of the services may overlap, this is not enough on its own to establish similarity. I therefore find the parties' services are dissimilar.

Rental of land, water or air vehicles; arranging of tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); Car parking; garage rental; Boat storage; Transport by pipeline; Electricity distribution; Water supplying; Rescue services for vehicles; Transport and storage of trash; transport and storage of waste.

54. The only submissions I have before me in regard to the applicant's above goods are also contained in paragraph 26 of the opponent's submissions in lieu, which submits that:

> "On the whole, the applicant's class 35 and class 39 services are likely to be interpreted by consumers as being services related to the Earlier Marks, for example, marketing of the Earlier Marks or transportation of the goods under the Earlier Marks."

55. These are generic submissions which do not explain how, for example, the arranging of tours, boat storage, electricity distribution, water supplying or transport and storage of trash and waste are similar to the opponent's class 35 wholesale and retail services. I find that all of the applicant's above services clearly do not overlap in nature, method of use, purpose or trade channels with the opponent's services. They are also neither in competition or complementary. Whilst the user of the services may overlap, this is not enough on its own to establish similarity. I therefore find the parties' services to be dissimilar.

56. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the goods and services that I have found to be dissimilar.[7] The opposition under section 5(2)(b) fails for the following goods and services:

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

Class 5 Chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; food for babies; Dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; Sanitary preparations for medical use: hygienic pads, hygienic tampons; plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets; Preparations for destroying vermin; herbicides, fungicides, preparations for destroying rodents; Deodorants, other than for human beings or for animals; air purifying preparations; air deodorising preparations; Disinfectants; antiseptics; detergents for medical purposes; medicated soaps; disinfectant soaps; antibacterial hand lotions.

Class 35 Organization of exhibitions and trade fairs for commercial or advertising purposes; Auctioneering.

Class 39 Land, water and air transport services; rental of land, water or air vehicles; arranging of tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); Car parking; garage rental; Boat storage; Transport by pipeline; Electricity distribution; Water supplying; Rescue services for vehicles; Storage, wrapping and packaging of goods; Transport and storage of trash; transport and storage of waste.

The average consumer and the nature of the purchasing act

57. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

58. The average consumer for the veterinary goods and services will be members of the general public who own or care for an animal or pet. However, I do not discount professional users such as veterinarians who will stock the goods within their veterinary practices. The cost of the goods is likely to be low, and their frequency of purchase will vary. Nevertheless, the average consumer will take various factors into consideration, such as the cost, ingredients, administrative method, desired health or dietary benefits of the goods, and the location and reputational standing of the provider

for the services. Therefore, the level of attention paid during the purchasing process will be medium.

59. The average consumer for the class 35 office services will be members of the general public or business users. The cost of the services in question is likely to vary, and the majority of the services will be purchased relatively infrequently. The average consumer will take various factors into consideration such as the cost, type of services offered and the suitability of those services to the consumer's needs. Therefore, the level of attention paid during the purchasing process will be medium. The average consumer for the general retail and wholesale services in class 35 will be members of the general public, who will use the services relatively frequently. They will take into consideration the location of the services, what goods they offer and the reputational standing of the provider. I therefore find that the level of attention paid during the purchasing process will also be medium.

60. The veterinary goods and services are likely to be obtained from a veterinarian and their online equivalent. The office services are likely to be obtained from business management undertakings and their online equivalent. The retail and wholesale services will be obtained from retail and wholesale stores. The goods and services are also likely to be selected following the perusal of signage on physical premises. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods and services through advice sought from veterinarians or a sales assistant.

Comparison of the trade marks

61. 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."

62. 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.

63. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
VITABIOTICS **("The First and Third Earlier Mark")** Ω VITABIOTICS **(the Second Earlier Mark)**	***VITALOTICS***

Overall impression

64. The First and Third Earlier Marks consist of the invented word "VITABIOTICS". There are clearly no other elements to contribute to the overall impression which lies in the word itself. However, as I shall come to discuss in the conceptual comparison, I

find that the average consumer will see that the opponent's invented word marks are composed of the elements "VITA" and "BIOTICS".

65. The Second Earlier Mark consists of the invented word "VITABIOTICS" presented underneath a device, which consists of an upside-down "U" shape. I consider that the average consumer will recognise this device the Greek letter Omega. However, even if the consumer did not know it was specifically the letter "Omega", I find they will still recognise it as being a Greek letter. As I shall come to discuss in the conceptual comparison, I find that the average consumer will see that the invented word "VITABIOTICS" is composed of the elements "VITA" and "BIOTICS". I also consider that the word "VITABIOTICS" plays a greater role in the overall impression of the mark, with the Omega device playing a lesser role.

66. The applicant's mark consists of the invented word "VITALOTICS" presented in a standard italic capitalised typeface. I consider that the word "VITALOTICS" plays a greater role in the overall impression of the mark, with the minimal stylisation playing a lesser role. As I will come to discuss in the conceptual comparison, I find that the average consumer will see the ordinary dictionary word "VITAL" appears at the beginning of the applicant's mark.

Visual Comparison

The First and Third Earlier Mark and the applicant's mark

67. Visually, the parties' marks share the four letters which appear at the beginning of the marks, "VITA", a position to which the average consumer usually pays more attention.[8] The marks also share the last five letters "OTICS". These all act as visual points of similarity. However, the letters "BI" are contained in the middle of the opponent's First and Third Earlier Marks, and the letter "L" is contained in the middle of the applicant's mark. These act as visual points of difference. Therefore, taking all the above into account, I find that the parties' marks are visually similar to a high degree.

[8] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

The Second Earlier Mark and the applicant's mark

68. The same comparison applies above, however, I note that the Omega device appears above the word "VITABIOTICS". This element also acts as a visual point and difference and therefore, as a whole, the parties' marks are visually similar to between a medium and high degree.

Aural Comparison

The First and Third Earlier Mark and the applicant's mark

69. In the opponent's statement of grounds, they claim that "the only difference between the verbal elements of the respective marks is the letter L in the opposed mark". At paragraph 8 of its counterstatement, the applicant states that they believe that the endings of the parties' marks have "distinct phonetic differences". I remind myself that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

> "62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, **break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him** (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57). (my emphasis)

70. In this case, I consider that the average consumer will see that the opponent's word marks are composed of the elements "VITA" and "BIOTICS" (the meaning of which I shall discuss below). On this basis, the opponent's marks are likely to be pronounced as VYE-TAH-BYE-OT-ICKS.

71. I consider that the average consumer will see the ordinary dictionary word "VITAL" at the beginning of the applicant's mark. On this basis, the mark is likely to be

pronounced VYE-TAL-OT-ICKS. Therefore, the first syllable and the two ending syllables of the parties' marks are identical. However, they differ in length, with the opponent's marks being one syllable longer. Consequently, I find that, as a whole, the marks are aurally similar to between a medium and high degree.

The Second Earlier Mark and the applicant's mark

72. The Omega device will not be pronounced in the opponent's Second Earlier Mark. On this basis, the same aural comparison applies above. The Second Earlier Mark and the applicant's mark are aurally similar to between a medium and high degree.

Conceptual Comparison

The First and Third Earlier Mark and the applicant's mark

73. Conceptually, at paragraph 11 of its submissions in lieu, the opponent claims that "the marks are similar as they convey the message of being related to health and wellbeing due to the shared 'vita' element". In the applicant's counterstatement, they claim that:

a) the prefix "VITA" is weak in distinctiveness as it is derived from the Latin word for "life" and is commonly used in the health, wellness, and pharmaceutical industries.

b) the prefix "VITA" is descriptive in nature, as it suggests life, vitality, or health, which are characteristics of the goods offered (e.g., supplements, nutraceuticals).

c) The suffix "BIOTICS" relates to life sciences and biology. It is a commonly used term in the pharmaceutical and health industries and is descriptive of goods or services related to biological or biotechnological health solutions.

d) "BIOTICS" lacks strong inherent distinctiveness due to its descriptive character in the context of health-related goods.

e) The combination of "VITA" and "BIOTICS" is not highly distinctive on its own. It conveys a clear descriptive meaning: products associated with life and biological health. This reduces its inherent distinctiveness.

f) Additionally, "VITAL" is an independent and recognizable word, denoting life, energy, and vitality. It is descriptive but conceptually distinct from "VITA," which is more generic and tied to the Latin root for "life."

g) "OTICS" is a unique and fanciful suffix that does not overlap semantically with "BIOTICS".

h) "Otics" does not carry any inherent meaning in English or other languages. It is not a dictionary word or a term with defined significance.

i) The name "Vitalotics" is inspired by the universally positive and life-affirming associations of "Vital." The "Otics" is entirely meaningless, designed solely to enhance the aesthetic appeal of the word, ensuring that the mark retains a unique and original identity while being conceptually distinct from other trademarks.

74. As noted by *Unisor* above, the average consumer will break a sign down into verbal elements which suggest a concrete meaning or which resemble words known to them. In this instance, the opponent's invented word marks, "VITABIOTICS", appears to be composed of the elements "VITA" and "BIOTICS". Whilst the applicant states that the prefix "VITA" is derived from the Latin word for "life", I remind myself that my assessment must be made from the perspective of the UK consumer, and it is unlikely that they will know Latin, or a similarly derived language, such as Italian. However, I agree with applicant, and consider that the average consumer will likely understand it as a shortening of the word "vitality" which is highly allusive of the effect of taking the opponent's class 5 vitamin and mineral preparations (i.e. the preparations will give you energy or liveliness). I also note that this appears to be in line with the opponent's argument that the "VITA" element conveys the message of being related to health and wellbeing. This element is also allusive of the opponent's wholesale and retail services connected with the sale of vitamin supplements, nutritional products, and

pharmaceuticals. However, it is neither allusive nor descriptive of the Third Earlier Marks business, office, and advertising services.

75. I agree with the applicant that the "BIOTICS" element of the First and Third Earlier Marks relates to life sciences and biology. The average consumer would know, recognise and call to mind the words "antibiotics", "probiotics" and "prebiotics" which all end in the "BIOTICS" element, which is indicative of microorganisms (with antibiotics killing bad microorganisms and probiotics and prebiotics adding or helping grow good microorganisms in the gut). I therefore find that the average consumer would recognise that the word "BIOTICS" is commonly used within pharmaceutical and health industries, and that this element is allusive of the opponent's vitamin and mineral preparations promoting growth or activity that is beneficial to microorganisms and the user's gut health. Again, I find that this element is also allusive of the opponent's wholesale and retail services connected with the sale of vitamin supplements, nutritional products, and pharmaceuticals, but it is neither allusive nor descriptive of the Third Earlier Marks business, office, and advertising services.

76. In regard to the applicant's "VITALOTICS" mark, I find that encompassed at the beginning of this word is the word "VITAL". I find that in applying *Unisor,* the average consumer will see this ordinary dictionary at the beginning of the mark, which evokes the meaning of something being necessary or very important. I bear in mind that in *LIGHT VITAMIN* (word mark) BL O/1174/25, Mr Thomas Mitcheson KC sitting as the Appointed Person stated that the assessment of a conceptual meaning should take place with reference to the parties' goods and services where there is a potential link between the conceptual meaning of the mark and the goods and services to which it is affixed. I therefore find that the "VITAL" element at the beginning of the applicant's mark will be seen as allusive of its goods and services being essential to maintaining life. I agree with the applicant that the remaining "OTICS" element does not convey any particular meaning to the average consumer, and thus, as a whole, the applicant's "VITALOTICS" mark will be seen as an invented word which derives from, and encompasses, the word "VITAL".

77. On the basis that the parties' marks are composed of invented words, they are conceptually neutral. However, I appreciate that the "VITA" and "VITAL" elements both

evoke allusive meanings in regard to the users health, which acts as a point of conceptual similarity.

The Second Earlier Mark and the applicant's mark

78. The same comparison applies above, however, I note that the Second Earlier Mark contains the Omega device at the beginning of it.

79. Regardless of whether the average consumer knows it is the "Omega" letter or not, they will understand it as denoting a Greek letter, which acts as conceptual point of difference between the marks.

Distinctive character of the earlier trade mark

80. 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 1-2779, 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)."

81. 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 services, 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.

82. I will begin by assessing the inherent distinctive character of the opponent's First, Second and Third Earlier Marks. As noted above, the average consumer will see the elements "VITA" and "BIOTICS" in the word "VITABIOTICS". The "VITA" element will be understood as a shortening of the word "vitality", and the "BIOTICS" element will call to mind medicines and treatments such as antibiotics and probiotics which help promote growth or activity that is beneficial to microorganisms and the user's gut health. Therefore, as a whole, albeit the word is invented (as it is not dictionary-defined), the marks are allusive of the opponent's class 5 and 35 goods and services which pertain to vitamins. However, it is neither allusive or descriptive of the Third Earlier Mark's class 35 business, office and advertising services.

83. For the class 5 and 35 goods and services which pertain to vitamins, I find that all of the opponent's earlier marks are inherently distinctive to between a low and medium degree. For the class 35 business services, I find that the Third Earlier Mark is inherently distinctive to above a medium degree.

84. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

85. At paragraph 4 of his witness statement, Mr Taylor states that Vitabiotics' core operations include the manufacture, marketing, supply, distribution and retail sale of healthcare products including vitamin, mineral and supplements aimed at supporting a wide range of health needs. He also states that Vitabiotics "is the number one vitamin brand in the UK with 28% market share", which is confirmed by the Vitabiotics brand

report by Nielsen data, dated 7 September 2024. This is contained in **exhibit RPT1**, and the report includes a pie chat of 15 vitamin and mineral supplements manufacturers, (including the opponent) which shows that the opponent has the largest share of the market, with the second largest share held only amounting to 9.5%. I have also been provided with the following turnover figures for VITABIOTICS branded products, and the total sales turnover from Vitabiotics' top third-party UK retailers (being Boots, Superdrug, Amazon, Tesco, Holland & Barrett, Sainsburys and Asda), from 2016 to 2023:

Table 10.1 (in approx. GBP)

	2023	2022	2021	2020	2019	2018	2017	2016
Total sales turnover	196.4 million	174.2 million	193.4 million	168.8 million	139.4 million	126.9 million	120.7 million	120.4 million
Top UK Retail customer sales turnover	75.8 million	70 million	58.8 million	56 million	48 million	43.1 million	40.5 million	37.6 million

86. At paragraph 10 of his witness statement, Mr Taylor confirms that the above total turnover figures are a combination of online sales to UK customers via their e-commerce offering, export sales to international distributors and direct sales to major UK retail customers. I have also been provided with the current top five retail customers of Vitabiotics in the UK, as follows:

Retailer	Number of orders in 2024
Boots Company Plc	629
Amazon EU S.a.r.L	96
Holland and Barrett	117
Tesco	163
J Sainsbury Plc	154

87. To support this, I have been provided with a selection of 20 invoices contained at **exhibit PRT4**. I note the following from this exhibit:

a) The invoices are dated between 9 April 2014 to 20 November 2023.

b) They are addressed to the retailers Boots, Tesco, Holland & Barrett and Amazon based in Nottingham, Rugby and Burton on Trent.

c) The goods sold include “pregnacare original”, “wellman”, “wellwoman”, “cardioace”, “visonace”, “pregnacare max”, “perfectil platinum”, “wellkid chewable”, “pregnacare breastfeeding”, “feroglobin” “wellkid baby syrup”, “menopause plus”, “wellteen”, “menopace”, “jointace collagen”, “perfectil”, “osteocare original”, “cardioace plus”, “superdog joints and bones” and “jointcare original”.

d) The goods have predominantly been purchased in larger quantities, between 20 to 2,880 boxes in each invoice.

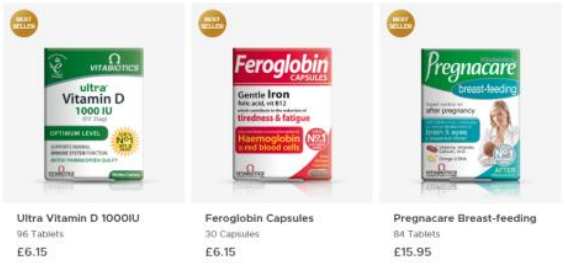
e) The bottom of the invoices state that the VITABIOTICS is “Britain’s No.1 supplements”.

f) All of the invoices contain the following mark on the top right-hand corner and bottom left-hand corner:

VITABIOTICS
SCIENCE OF HEALTHY LIVING

88. I note that the above mark is used at the top of the opponent’s website vitabiotics.com, (without the wording “SCIENCE OF HEALTHY LIVING”), as shown by the screenshots contained in **exhibit RPT3**. This exhibit contains screenshots dated 9 March 2020, 6 May 2021 and 17 April 2024, which shows the opponent’s goods for sale, as follows:





89. To support the above, **exhibit RPT10** contains a monthly breakdown of UK visitors to the opponent's website from December 2019 to July 2024.[9] I note that the amount of UK visitors per month ranges between 158,000 to over 600,000.

90. I have also been provided with the following approximate advertising spend for publicising VITABIOTICS products in the UK between 2014 and 2021, and for 2024:

Year	Advertising Spend
2014	£9.5 million
2015	£8.2 million
2016	£10.2 million
2017	£10.5 million
2018	£10.8 million
2019	£9.3 million
2020	£9.2 million
2021	£10.6 million
2024	£13.8 million

91. Mr Taylor states that the opponent's UK advertising includes, but is not limited to, digital advertising, social media advertisements, brand ambassadors, train station billboard/posters, bus billboards, store posters, TV and radio adverts, promotional articles and magazine advertisements. **Exhibit RPT6** contains examples of Vitabiotics advertising materials used over the years which includes:

[9] Visitors for the months August to December 2024 have also been provided by these fall after the relevant date.

a) A PowerPoint presentation which lists a David Gandy “Wellman” 30 second TV advert which was ran between 2016 to 2019, and a “Wellbaby” and “Wellkid” 30 second TV advert which was ran between 2015 and 2024, shown as follows:





b) The PowerPoint also shows the “native advertising” and Ad features on the Mail Online for Wellman, Wellwoman, Perfectil and Pregnacare which was used in October 2022, July 2023, April 2024 and September 2024.

c) Screenshots from “issuu” shows magazine adverts for Pregnacare were contained in “baby London” issues dated December 2015 and April 2017.

d) An article from campaignlive.co.uk dated 18 March 2013, which reports on Vitabiotics launching its first TV on Channel 5 “after signing a £2m 12-month partnership”. It states that the campaign was to focus on Vitabiotics main vitamin brand, Wellman and Wellwoman.

e) An article from healthfoodbusiness.co.uk dated 13 May 2024 which reports on Vitabiotics new TV advertising campaign for its Pregnacare brand, which was launched on 2 April 2024 on Channel 4, E4, ITVX and Sky. This is supported by the following depiction of the advert from the PowerPoint presentation:



92. I have also been provided with further third party articles in regard to the opponent's VITABIOTICS supplement goods, contained in **exhibit RPT7**. The Mail Online article dated 2 December 2011 refers and depicts the opponent's Vitabiotics Pregnacare-Conception, being a "30p multi-vitamin pill [that] could more than double a woman's chance of having a baby [whilst having IVF], according to a study" carried out at University College London. The yahoo!life article dated 11 July 2022 lists and depicts the best 12 multivitamins for women, which includes Vitabiotics Wellwoman, Vitabiotics Pregnacare conception tablets, and Vitabiotics perfectil plus hair.

93. Mr Taylor has provided the following table in regard to the awards won by Vitabiotics, including:

2003	Queen's Award for Enterprise for International Trade
2004	DTI (Department of Trade & Industry) Innovation Award, in recognition of the Immunace trial in HIV patients conducted by the London School of Tropical Medicine
2008	Queen's Award for Enterprise for International Trade
2009	Boots Supplier of the Year in recognition of 99.9% supply chain delivery record putting Vitabiotics ahead of all other suppliers, in all other categories at Boots
2013	Queen's Award for Innovation in vitamin research (Vitabiotics became the first British vitamin company to receive this award)
2013	Boots Overall Supplier of the Year in all categories
2018	Queen's Award for Innovation (Vitabiotics was the first vitamin company to receive the Innovation Award on two separate occasions)
2022	Superdrug Stars Awards

94. The above is supported with examples of independent write-ups about these awards, contained in **exhibit RPT8**. In paragraph 16 of his witness statement, Mr Taylor confirms that Vitabiotics is the only company to receive the Queen's award on 4 occasions, including twice for innovation. I note that the manufacturing chemist

article dated 21 April 2003 confirms that the Queen's awards is UK's highest honour for a business.[10] The first Queen's award for enterprise was awarded in 2013, and the press book for this award, contained in **exhibit RPT8**, states that it was awarded for Vitabiotics Pregnacare range of tablets, which is a "market-leader which increases fertility rates" and that the "range has been an outstanding commercial success with a UK market share of 70%". I also note that the Grocery Trader article dated 4 June 2018, which reports on Vitabiotics' second award for innovation, states that Vitabiotics is the "UK's number one vitamin company", and that the award was for its Perfectil beauty vitamins range, which is also "the UK's number one nutritional supplement for skin hair and nails". Furthermore, the opponent won the Beauty Vitamin and Best Gut Health awards at the Superdrug Stars Awards in 2022 for its Vitabiotics Perfectil Original and Vitabiotics Wellbio.[11]

95. The opponent has provided evidence that it has exhibited its Vitabiotics at exhibitions across the UK, including The Baby Show which has 2 shows per year in London, from 2010 to 2020 and 2022 to 2024. The opponent has also attended The Fertility Show in London from 2015 to 2019 and 2023 to 2024.[12] **Exhibit RPT9** contains photographs from articles and social media posts of the opponent's stands at these events, including:





96. However, I bear in mind that the opponent has not provided any further information, including how many UK attendees were present at these events.

[10] Page 2 of **exhibit RPT8**
[11] **Exhibit RPT8**
[12] The table contained in paragraph 17 of Mr Taylor's statement contains this information.

97. I have been provided with a breakdown of the amount of followers the opponent's "Vitabiotics" social media pages had from 2019 to 2024. Its Facebook page had 23,366 followers in 2019, which increased to 713,562 in 2022, and increased further to 892,542 in 2024. Its Instagram page had 14,155 followers in 2019, which increased to 59,952 in 2022 and increased further to 109,010 in 2024. I bear in mind that whilst this information clearly shows an increase in following, I am unable to determine how many of the opponent's followers were from the UK. Nevertheless, the screenshots of its social media pages contained in **exhibit RTP11** shows that its bios refer to themselves as the UK's number 1 vitamin company, and they clearly use the Second Earlier Mark in their profile pictures, as follows:



98. Mr Taylor confirms that the Vitabiotics brand has celebrity brand ambassadors who extensively promote their products on their social media platforms. Their brand ambassadors include Heidi Klum, Frankie Bridge, Gabby Logan (MBE), Roz Purcell, Tess Daily and David Gandy. **Exhibit PRT12** contains third party articles from Cosmetics Business, and announcements published on the opponent's website, reporting on the opponent's aforementioned brand ambassadors. These are dated June 2016, July 2019, October 2019, January 2020, October 2022 and November 2022.

99. **Exhibit PRT12** also includes a Mail Online article dated December 2018 which refers to the opponent's brand ambassador Nicole Scherzinger who "swears by taking a daily dose of perfectil skin, hair and nail supplements". A photograph of the perfectil packaging clearly shows the opponent's Second Earlier Mark presented in white, placed in the bottom left-hand corner of the packaging, with the bottom right-hand side of the packing stating that it's the "UK's NO 1 beauty supplement". While Mr Taylor has also provided its brand ambassadors social media following on Instagram, Facebook and Tik Tok, I note that I have no information as to when these numbers were obtained, and therefore whether they reflect the following the celebrities had at

the relevant date. Nor am I able to determine how many of the social media followers were from the UK.

100. **Exhibit RPT15**, contains a document prepared by Vitabiotics in 2021 to mark their 50 year anniversary.[13] The document contains a depiction of the Vitabiotics product portfolio from 2021, including:



[13] Paragraph 23 of Mr Taylor's statement.



101. All of the above packaging is clearly affixed with the Second Earlier Mark in the bottom left-hand corner. The Wellkid vitamin gummies have Marvel and Peppa Pig packaging as the opponent partnered with them in co-branding campaigns.[14] To support this, I have been provided with screenshots from the opponent's website in **exhibit RPT13**, dated 26 November 2020 and 7 December 2020, showing "Vitabiotics Wellkid" goods affixed with the Marvel and Peppa Pig branding.

[14] Paragraph 21 of Mr Taylor's witness statement.

102. The internal document from 2021, contained in **exhibit RPT15**, also contains the following examples of the opponent's outdoor advertisements:



Wellkid® Peppa Pig digital billboard



Perfectil® Hair Crush escalator digital poster



Wellwoman® tube station poster



Wellkid® Marvel digital billboard

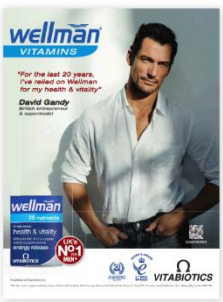


Ultra® Vitamin D tube poster



Wellman® airport digital billboard

103. **Exhibit RPT15** also contains the following examples of the opponent's "extensive press advertising" for its Wellman, Wellwoman, Wellbaby and Superdog supplement goods:



Wellman®



Wellman® Grooming



Wellwoman®



Wellbaby®



Superdog®

104. From the document, it appears that these posters were used in UK advertisements.[15] I also note that posters of all the opponent's goods from 2021 are included within this document, and that the above five posters are just representative examples from this exhibit.

105. Lastly, I bear in mind that Mr Taylor has provided a table of the charitable initiatives between 2013 to 2024 pursued by the opponent, at paragraph 22 of his witness statement. These initiatives have been reported in third party articles, which are contained in **exhibit RPT14**. This includes Vitabiotics sponsoring the Menopause Roadshow in Birmingham in 2019, and partnering with charities such as the Great Ormond Street Hospital, Mind, Shelter and Age UK in 2023 and 2024.

106. The total turnover provided in the table 10.1 contains sales made to UK customers and export sales to international distributors. These sales figures have not been broken down in order to determine the UK sales only. However, in the same table, the opponent has clearly provided turnover from Vitabiotics' top third-party UK retailers[16] from 2016 to 2023. The total value of these sales amount to £429.8 million, which is clearly significant. To support this I have been provided with VITABIOTCS invoice evidence from 2014 to 2023 showing the sale of the opponent's goods in large quantities to Boots, Tesco, Holland & Barrett and Amazon. All of these goods can be cross-referenced with the goods shown on the opponent's website, the 2021 portfolio and outdoor advertisements, the TV advertisements, as well as the goods reported in a variety of third party publications, all of which are dated within the relevant period. Moreover, the opponent has provided its websites monthly UK visitors which ranged between 158,000 to over 600,000 every month from December 2019 to July 2024.

107. The opponent has provided me with UK advertising spend which is also clearly significant, and it is clear that the opponent has won multiple awards for its multivitamin goods. The opponent also holds 28% of the vitamin and mineral supplements market.

[15] The opponent provides specific examples of advertising outside of the UK (around the world), and refers to its investment portfolio including "TV, radio, national and consumer press, London tube carriages and escalator panels, London and regional bus rears, roadside billboards and extensive digital and social media presence". Moreover, all of the above advertising contains the wording "the UK's No 1 vitamin company" which is not present in the "around the world" adverts.
[16] That being Boots, Superdrug, Amazon, Tesco, Holland & Barrett, Sainsburys and Asda.

Whilst I appreciate that this figure was obtained in September 2024, this is only 2 months after the relevant date. I therefore find that this figure can be used to cast a light backwards, and shows that the opponent did indeed have a large share of the vitamin and mineral supplements market during the relevant period. Whilst I bear in mind that the narrative and exhibited evidence does not confirm whether the aforementioned percentage pertains to the UK market (or wider), the Queen's Award press book evidence states that in 2013, the Vitabiotics Pregnacare range had a UK market share of 70%, and the third party article and social media evidence refers to VITABIOTICS as being the "UK's number one vitamin company". Moreover, the opponent's evidence shows that the Perfectil range is referred to as "UK's NO 1 beauty supplement" (on the product packaging) or "the UK's number one nutritional supplement for skin hair and nails".[17] Therefore, taking all of the above evidence into account, which clearly shows use of the First and Second Earlier Marks, I find that the distinctiveness of them has been enhanced to a high degree for its class 5 "vitamin and mineral preparations".[18]

108. In regard to the Third Earlier Mark, I find that none of the above evidence shows use of its class 35 services. I therefore find that the distinctiveness of this mark cannot be enhanced.

Likelihood of confusion

109. 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 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. Nevertheless, the standard summary of the principles applicable to the assessment of the likelihood of confusion was approved

[17] **Exhibit RPT8** Grocery Trader article 2018
[18] For the sake of completeness, I bear in mind that the most distinctive part of the Second Earlier Mark is the invented word "VITABIOTICS", as the Omega device has a recognisable meaning. Consequently, I find that the use of the Second Earlier Mark throughout the evidence constitutes as use of the First Earlier "VITABIOTICS" Mark.

by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25, as listed in paragraph 15 above.

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

The First and Third Earlier Mark

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally similar to between a medium and high degree.
- I have found that the "VITA" and "VITAL" elements within the parties' invented words both evoke allusive meanings in regard to the users' health, which acts as a point of conceptual similarity between them.
- I have found the First and Third Earlier Mark to be inherently distinctive to between a low and medium degree for the class 5 and 35 goods and services which pertain to vitamins.
- I have found the First and Third Earlier Mark to be inherently distinctive to above a medium degree for the opponent's class 35 business services.
- I have found that the distinctiveness of the First Earlier Mark has been enhanced to a high degree for its "vitamin and mineral preparations".
- I have identified the average consumer of the goods and services as members of the general public, including those who own or care for an animal or pet, and professionals such as veterinarians and business users. The average consumer will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that at a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods and services to range from being identical to similar to a very low degree.

111. Taking all of the above factors into account, bearing in mind that the average consumer rarely has a chance to make direct comparisons between trade marks and,

instead, will encounter them in different settings at different times, and therefore must rely upon the imperfect picture of them retained in its mind, I consider that there is a likelihood of direct confusion. As noted above, I have found that the parties' marks consist of the invented words "VITABIOTICS" and "VITALOTICS", which start with the same the first four letters and end with the same last five letters (resulting in the marks sharing 9 out of 11 letters). The only differing letters between these marks is the letters "BI" in the middle of the opponent's marks and the letters "AL" in the middle of the applicant's mark, which would be easily overlooked. I therefore consider that the parties' marks are likely to be mistakenly recalled or misremembered as each other, given the high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the between a medium and high degree of aural similarity between the parties' marks will have the same result. Consequently, I consider that there is a likelihood of direct confusion in regard to the goods and services which I have found to be identical, similar to a high degree, similar to at least a medium degree, and similar to between a low and medium degree, due to the effect of the interdependency principle.

112. However, where the parties' goods and services are similar to a low degree, or a very low degree, I consider that this will offset the similarity between the marks in accordance with the interdependency principle and will prevent there from being a likelihood of confusion.

The Second Earlier Mark

- I have found the marks to be visually and aurally similar to between a medium and high degree.
- I have found the "VITA" and "VITAL" elements within the parties' invented words evoke allusive meanings in regard to the users health, and the Omega device in the Second Earlier Mark acts as a conceptual point of difference.
- I have found the Second Earlier Mark to be inherently distinctive to between a low and medium degree for its class 5 goods.
- I have found that the distinctiveness of the Second Earlier Mark has been enhanced to a high degree for its class 5 goods.

- I have identified the average consumer of the goods as members of the general public including those who own or care for an animal or pet, and professionals such as veterinarians. The average consumer will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that at a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods range from being identical to similar to a low degree.

113. For the same reasoning provided in paragraph 111 above, I consider there to be a likelihood of direct confusion between the parties' marks. I find that the average consumer would easily overlook the Omega device in the Second Earlier Mark, which plays a lesser role in the overall impression. Therefore, on the basis that the invented words share 9 out of their 11 letters (that being the first 4 letters, which create a conceptual point of similarity between them, and the last 5 letters), the marks will be mistakenly recalled or misremembered as each other given the between a medium and high degree of visual and aural similarity between the marks. I consider that there is a likelihood of direct confusion in regard to the goods which I have found to be identical, similar to a high degree, and even where they are similar to between a low and medium degree, due to the effect of the interdependency principle.

114. However, where the parties' goods are similar to a low degree, this will offset the similarity between the marks in accordance with the interdependency principle and will consequently prevent there from being a likelihood of confusion.

115. 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.

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)”.

116. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (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.

117. Bearing in mind that the average consumer rarely has the chance to compare the marks side-by-side, will encounter them in different settings at different times, and therefore must rely upon the imperfect picture of them retained in its mind, I consider there to be a likelihood of indirect confusion, on the basis of imperfect recollection. I am of the view that although the average consumer could remember the Omega device used in the Second Earlier Mark, they are still likely to imperfectly recall the differences in spelling between the words “VITABIOTICS” and “VITALOTICS”, which share 9 out of their 11 letters (differing in 2 letters which appear within the middle of the invented words). It is my view that the average consumer will view the applicant’s mark as an alternative mark being used on identical and similar goods, by the same or economically linked undertakings, perhaps being an updated version of the same mark and therefore indicative of re-branding. It is not uncommon for undertakings re-brand themselves from time to time to accommodate changes in marketing considerations. I consider there to be a likelihood of indirect confusion for all of the goods which are identical, similar to a high degree, and similar to between a low and medium degree. As noted above, for those goods which are similar to a low degree, this will offset the similarity between the marks in accordance with the interdependency principle and will prevent there from being a likelihood of confusion.

118. The opposition under section 5(2)(b) partially succeeds.

Section 5(3)

119. Section 5(3) of the Act states:

> “5(3) A trade mark which –
>
> > (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of

the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

120. Section 5(3A) of the Act states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

121. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40.*

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora,* paragraph 74, and the court's answer to question 1 in *L'Oréal*.

122. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar, and I have discussed their level of similarity in paragraphs 67 to 79 above. Secondly, the opponent must show that its earlier marks has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's marks being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 16 July 2024.

Reputation

123. In *General Motors*, Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

124. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods and services.

125. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

126. I have found that the distinctive character of the opponent's First and Second Earlier Marks have been enhanced through use for its class 5 "vitamin and mineral preparations". I have also found that the that there was no enhanced distinctive character in regard to the Third Earlier Mark as there was no evidence of use in relation to its class 35 services. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.[19]

127. Nevertheless, I note that I have been provided with significant evidence to show that the opponent has been using its marks since at least 2016. As noted above, the turnover made from Vitabiotics' top third-party UK retailers[20] from 2016 to 2023

[19] *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39
[20] That being Boots, Superdrug, Amazon, Tesco, Holland & Barrett, Sainsburys and Asda.

amounted to £429.8 million. This is clearly a significant figure. To support this, I have been provided with a market share figure, which in September 2024, VITABIOTICS held 28% of the vitamin and mineral supplements market. Whilst it is unclear whether this percentage pertains to the UK market (or wider), throughout the evidence, VITABIOTICS is consistently described as "UK's number one vitamin company". Moreover, the Queen's Award press book evidence states that in 2013, the Vitabiotics Pregnacare range had a UK market share of 70%. I therefore find that in conjunction with the significant sales figures, it is reasonable to infer that the opponent clearly held a significant share of the vitamin and mineral supplements market in the UK at the relevant date. I have also been provided with significant UK advertising spend, supported by the opponent's outdoor advertisements, TV advertisements, and a variety of third party publications reporting on the opponent's goods. It is also clear that the opponent has won many awards and titles for its VITABIOTICS supplement goods. I am therefore satisfied that the First and Second Earlier Marks had a strong reputation for "vitamin and mineral preparations" at the relevant date.

128. In regard to the Third Earlier Mark, as I have found that there is no evidence of use in relation to its class 35 services, the opponent has failed to establish use of this mark. Therefore, UK00003094322 may not be relied upon under section 5(3).

Link

129. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

> The degree of similarity between the conflicting marks
>
> As noted above, I have found that the First Earlier Mark and the applicant's mark is visually similar to a high degree and aurally similar to between a medium and high degree. On the basis that the marks consist of invented words, they are conceptually neutral, although, the "VITA" and "VITAL" elements evoke allusive meanings in regard to the users health, which creates a conceptual point of similarity between them. The Second Earlier Mark and the

applicant's mark are visually and aurally similar to between a medium and high degree, and the "VITA" and "VITAL" elements within the parties' invented words evoke allusive meanings in regard to the users health. The Omega device in the Second Earlier Mark also acts as a conceptual point of difference.

The nature of the goods and services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods, and the relevant section of the public

The relevant section of the public purchasing the parties' goods and services will be members of the general public and professionals such as veterinarians.

As noted in paragraphs 24 to 35 above, I have found the First and Second Earlier Marks class 5 goods, and the applicant's class 5 goods to range from being identical to dissimilar.

In regard to the applicant's class 35 services, that being: *advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; design for advertising; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; Business management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services and Auctioneering*, I find that these services clearly do not overlap in nature, method of use, purpose or trade channels with the opponent's class 5 "vitamin and mineral preparations". The goods and services are neither in competition nor complementary. I therefore find them to be dissimilar.

In regard to the applicant's class 35 services, that being: *the bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations*

for medical purposes, dietary supplements for veterinary purposes, medical preparations for slimming purposes, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogue, I found that the goods sold by these services are identical or similar to the opponent's goods. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Consequently, I find there to be an overlap in trade channels between the opponent's class 5 goods and the applicant's class 35 services, which are also, therefore complementary. I consider that the goods and services are similar to a medium degree.

The opponent's "class 5 "vitamin and mineral preparations" may be sold in the same general retail store as the applicant's class 35 " *the bringing together, for the benefit of others, of a variety of goods, namely, food for babies, sanitary preparations for medical use: hygienic pads, hygienic tampons, plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets, deodorants, other than for human beings or for animals, air purifying preparations, air deodorising preparations, disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues*" services. However, this is a very general overlap. The goods and services clearly do not overlap in nature, method of use or purpose. Nor are they in competition nor complementary. I therefore find that they are dissimilar.

In regard to the applicant's remaining class 35 services, that being: *the bringing together, for the benefit of others, of a variety of goods, namely, chemical preparations for veterinary purposes chemical reagents for pharmaceutical and veterinary purposes, dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth,*

preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues, I do not consider there to be an overlap in nature, method of use, purpose or trade channels with the opponent's class 5 "vitamin and mineral preparations". The goods and services are neither in competition nor complementary. Consequently, I find them to be dissimilar.

In regard to all of the applicant's class 39 services, I find that they clearly differ in nature, purpose and method of use with the opponent's "vitamin and mineral preparations". Without any evidence before me, I do not consider there to be an overlap in trade channels as the applicant's class 39 services would likely be provided by transport, packaging and waste management undertakings, whereas the opponent's goods would likely be provided by vitamin and supplement specialists. The parties' goods and services are clearly neither in competition nor are they complementary. I find them to be dissimilar.

The strength of the earlier mark's reputation

As noted in paragraph 127 above, the First and Second Earlier Marks have a strong reputation for vitamin and mineral preparations.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I found the First and Second Earlier Marks to be inherently distinctive to between a low and medium degree for its vitamin and mineral preparations, which has been enhanced through use to a high degree.

Whether there is a likelihood of confusion

I found there to be a likelihood of direct and indirect confusion.

130. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's First and Second Earlier Marks to mind when confronted with the applicant's mark. That is, to make a link between them.

131. I recognise that a lesser degree of similarity between the marks than that required for a likelihood of confusion may be sufficient for a relevant section of the public to make a connection between those marks.[21] I also remind myself at this stage that finding similarity between the goods or services, or indeed a likelihood of confusion, is not required in order to find a link would be made between the marks. Moreover, I bear in mind that the closeness of the goods and services is a factor to be taken into account when considering if the use of the later mark would bring the earlier marks to mind.

132. Where I have found there to be a likelihood of confusion, there is automatically a link. I therefore find there to be a link between the First and Second Earlier Marks' and the applicant's mark being used on class 5 goods which I have found to be identical, similar to a high degree and similar to between a low and medium degree, that being:

Class 5	Veterinary preparations for medical purposes; Dietary supplements for veterinary purposes; medical preparations for slimming purposes.

133. In regard to the applicant's class 35 services that I have found to be similar to a medium degree to the opponent's "vitamin and mineral preparations", I consider that the reputation of the opponent's earlier marks is strong enough for the relevant public to make a link between them and the applicant's mark. I bear in mind that the opponent's strong reputation resides in the invented word "VITABIOTICS", and that the distinctiveness of the First and Second Earlier marks have been enhanced. The parties' goods and services are also similar to a medium degree. I therefore find that use of the applicant's "VITALOTICS" mark will bring the First and Second Earlier Marks to mind, that being "VITABIOTICS",[22] which shares 9 out of the 11 letters (including the first 4 letters and the last 5 letters, with the difference being 1/2 letters that occur in the middle of the marks). Consequently, I find that a significant part of the

[21] *Intra-Presse SAS v OHIM*, Joined cases C-581/13P & C-582/13P
[22] And the Omega device in the Second Earlier Mark.

UK relevant public would make a link between the First and Second Earlier Marks and the applicant's mark for the following services:

Class 35 The bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations for medical purposes, dietary supplements for veterinary purposes, medical preparations for slimming purposes, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

134. In regard to the applicant's class 5 "medicated cosmetics", I am of the view that when consumers are confronted with the applicant's mark being used on these goods, that they would consider the parties' marks to be linked. I say this because the relevant section of the public that selects the applicant's goods would be the same consumer who is aware of the reputation of the opponent's marks being used on the opponent's vitamin and mineral preparations. This is on the basis that all of the goods are used to improve the appearance of the users skin. Therefore, I consider that they fall within a similar field of interest. On this basis, I consider that upon seeing the goods (which I have found to be similar to a low degree), use of the applicant's "VITALOTICS" mark will bring the First and Second Earlier Marks to mind, that being "VITABIOTICS",[23] which shares 9 out of the 11 letters, causing them to wonder if the opponent had expanded its brand to sell other types of goods which help improve the appearance of the user. In my view, such an expansion is one that is not too far removed from what the opponent's reputation already vests in. As such, I am of the view that a link is made out in respect of these goods.

135. I have found that the applicant's class 5 "chemical preparations for veterinary purposes" and "chemical reagents for pharmaceutical and veterinary purposes" to be dissimilar to the opponent's vitamin and mineral preparations. As noted in paragraph 32 above, I did not find any overlap in the *Treat* factors, including users, and I do not consider that the user of the applicant's goods would be aware of the opponent's reputation for vitamin and mineral preparations. Taking all of the above into account, I

[23] And the Omega device in the Second Earlier Mark.

find that these goods are too far removed from what the opponent's reputation vests in. It is my view that there will be no link made in respect of these goods, and if a link was to be made, it would be so fleeting that it would not suffice to result in an unfair advantage or damage to the opponent or its marks.

136. The goods and services that remain are the applicant's class 5 goods (which can broadly be described as dental preparations, hygienic preparations, preparations to destroy vermin and rodents, and detergents), class 35 services (which can broadly be described as advertising and business services, as well as wholesale and retail services for the aforementioned class 5 goods), and its class 39 services (which can broadly be described as transport and travel, electricity and water supply, storage, and transportation of waste services). Notwithstanding the fact that the parties' services are likely to overlap in user (that being the general public), I still consider that the parties' goods and services are too removed from one another that the opponent's strong reputation is not enough to bridge the gap between them. I consider that the distance between the goods and services is sufficient to offset any similarity between the parties' marks. As I have found there to be no link between the marks in the minds of the relevant public in the UK, there can be no resulting damage caused to the opponent's earlier marks. Therefore, the opposition based upon section 5(3) fails for the following goods and services:

Class 5 Chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; food for babies; Dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; Sanitary preparations for medical use: hygienic pads, hygienic tampons; plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets; Preparations for destroying vermin; herbicides, fungicides, preparations for destroying rodents; Deodorants, other than for human beings or for animals; air purifying preparations; air deodorising preparations; Disinfectants; antiseptics; detergents for medical purposes; medicated soaps; disinfectant soaps; antibacterial hand lotions.

Class 35 Advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; design for advertising; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; Business management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services; Auctioneering; The bringing together, for the benefit of others, of a variety of goods, namely, chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, food for babies, dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth, sanitary preparations for medical use: hygienic pads, hygienic tampons, plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets, preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents, deodorants, other than for human beings or for animals, air purifying preparations, air deodorising preparations, disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

Class 39 Land, water and air transport services; rental of land, water or air vehicles; arranging of tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); Car parking; garage rental; Boat storage; Transport by pipeline; Electricity distribution; Water supplying; Rescue services for vehicles; Storage, wrapping and packaging of goods; Transport and storage of trash; transport and storage of waste.

Damage

137. Within its Form TM7, the opponent claims that the applicant free-riding on the opponent's reputation to "achieve greater sales without committing to the time and expense of marketing or quality control testing of their goods" would amount to an unfair advantage.

138. The opponent also claims that if the applicant's goods and services were of inferior quality that this would cause "detriment by association", and that registration of the applicant's mark would "be without due cause and may be detrimental to the distinctive characters and/or repute of the opponent's earlier marks by way of tarnishment or dilution" as their marks will no long be able to identify goods and services originating only from the opponent.

139. I note that in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

140. For there to be an unfair advantage, it means that consumers are more likely to buy the goods and services of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. Where there is a likelihood of confusion, the applicant will benefit from an unfair advantage. Consequently, I find that damage is made out in respect of the class 5 goods contained in paragraph 132.

141. Unfair advantage is usually the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods and services identified by the later mark. Taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods and services of the later mark than they otherwise would have been if they had not been reminded of the earlier marks. The later mark will get a marketing or commercial 'leg-up' because

the link with the earlier reputed mark means that the owner of the later mark does not have to put as much effort into making the later mark known because it already feels familiar or sends a message to consumers as to what they can expect.

142. The image of the opponent's earlier "VITABIOTICS" marks evoke an award winning, number 1 supplement brand in the UK, for both animals and humans. This is an attractive and potentially lucrative image from which the applicant's "VITALOTICS" mark will benefit in relation to its class 5 goods and class 35 services listed in paragraphs 133 and 134 above.

143. I have found the marks to be highly similar invented words which shares 9 out of the 11 letters (including the first 4 letters and the last 5 letters, with the difference being 1/2 letters that occur in the middle of the marks), and I have found the parties' goods to be similar to a low degree, and its goods and services to be similar to a medium degree. I therefore consider that the relevant public will be more likely to buy the applicant's goods and services because there will be familiarity with the repute and image of the earlier marks. This means that the applicant's mark will benefit from the opponent's significant marketing efforts and expenditure, without having to invest at all, or as much, which would normally be required for a new mark, in order to achieve the level of sales it will gain because of the link. The change in consumer behaviour will produce an objectively unfair result by giving the applicant an advantage in relation to its class 5 goods and class 35 services, because it is free-riding on the reputation of the First and Second Earlier Marks and the marketing efforts of the opponent.

144. As I have found there to be unfair advantage, I do not need to consider the other pleaded heads of damage. The opposition based upon section 5(3) of the Act succeeds for the following goods and services:

Class 5 Veterinary preparations for medical purposes; Medicated cosmetics; Dietary supplements for veterinary purposes; medical preparations for slimming purposes.

Class 35 The bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations for medical purposes, dietary

supplements for veterinary purposes, medical preparations for slimming purposes, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

Section 5(4)(a)

145. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b) …
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

146. Subsection (4A) of section 5 of the Act states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

147. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> “55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

148. Whether there has been passing off must be judged at a particular point (or points) in time.

149. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

> “43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

150. The applicant has filed no evidence of use of its mark, I have only the prima facie relevant date to consider i.e. 16 July 2024.

Goodwill

151. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

152. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application* (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

153. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

154. Goodwill arises as a result of trading activities, and it is clear from the top third-party UK retailer sales, that the opponent has been trading under the VITABIOTICS sign since at least 2016. From 2016 to 2023, the opponent generated a total of £429.8 million for its multivitamin supplements. I am therefore satisfied that the opponent has demonstrated a notable degree of goodwill prior to the relevant date in relation to "vitamin and mineral based supplements". I also note that the turnover figures are supported by screenshot evidence of the opponent's website before the relevant date and UK visitor rates between December 2019 to July 2024 which ranged between 158,000 to over 600,000 UK visitors a month. I have also been provided with portfolio evidence, third party article evidence, award evidence as well as significant advertising figures and examples of TV, trade shows and outdoor advertising. In light of this, I am also satisfied that VITABIOTICS sign was distinctive of the opponent's goodwill at the relevant date.

155. In terms of the "related retail and wholesale services" the opponent relies on, there is no evidence which pertains to such services. I note that in paragraph 9 of his witness statement, Mr Taylor states that:

> "In the UK, Vitabiotics sells its product to end consumers and business-to-business customers via (i) its website www.vitabiotics.com which features an integrated e-commerce site which was launched in 2000, (ii) third party retail stores, and (iii) wholesalers and distributors. Vitabiotics is proud of the fact that

by the 1990s, it had secured key UK retailers to stock its products, These included Boots, Superdrug, Tesco and Sainsburys."

156. This indeed confirms that, the opponent itself does not provide wholesale and retail services selling third party goods. Instead it sells its own goods on its website and it supplies and sells its own goods to retailer and wholesalers, in order for its goods to be purchased by the general public. Moreover, as noted above, VITABIOTICS is referred to as the "number 1 vitamin brand in the UK", and there is never any reference to its retail or wholesale services. The evidence, instead, clearly shows and focusses on its VITABIOTIC vitamin and mineral preparations, including the award, the third party article and advertising evidence. Consequently, I find that due to the lack of any evidence in regard to the opponent providing the wholesale and retail services in regard to selling third party goods, the opponent has not demonstrated goodwill for these services at the relevant date.

Misrepresentation and damage

157. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc*. [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

158. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer". However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

159. Under section 5(4)(a), the opponent relies upon its "VITABIOTICS" sign, which mirrors the opponent's First Earlier Mark that it relies upon under section 5(2)(b). The evidence that the opponent relies upon for section 5(4)(a) is also the same evidence as summarised in paragraphs 85 to 105 above.

160. The goods for which the opponent has shown goodwill are identical to the applicant's "dietary supplements for veterinary purposes" and "veterinary preparations for medical purposes". Taking the identity of the parties' fields of activity into account, as well as the invented word marks being similar (sharing 9 out of the 11 letters, including the first 4 letters and the last 5 letters, with the difference being 1/2 letters that occur in the middle of the marks), I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent. Damage through diversion of sales is easily foreseeable. However, if I am wrong to find that the applicant's above goods are identical to the goods for which the opponent has shown goodwill, I nevertheless consider that they are similar to a high degree. The goods will overlap in

user and trade channels, all of which will be sold in veterinary practices. I therefore consider that the parties' fields of activity in this case are very close, as all of the goods are used for health and wellness in animals and pets. Consequently, I find that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent, in which damage would arise through diversion of sales.

161. The goods for which the opponent has shown goodwill are also similar to between a low and medium degree to the applicant's "medical preparations for slimming purposes" and similar to a low degree to "medicated cosmetics". The goods will overlap in trade channels and user and I consider that the parties' fields of activity in this case are close, as the goods are used to improve the appearance of the user (either maintaining their health via weight management, or by improving the quality of their skin). Consequently, I find that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent, in which damage would arise through diversion of sales.

162. The applicant's class 35, "the bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations for medical purposes, dietary supplements for veterinary purposes, medical preparations for slimming purposes, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues" services will overlap in user and trade channels with the goods for which the opponent has shown goodwill (vitamin and mineral based supplements), all of which will be sold in veterinary practices. I consider that the parties' fields of activity in this case are close, as the goods and services are used for health and wellness (in humans and animals). Consequently, I find that a substantial number of members of the relevant public would be misled into using the applicant's services in the mistaken belief that they are the services of the opponent, in which damage would arise through diversion of sales.

163. In regard to the applicant's remaining class 5 goods and class 35 and 39 services, I consider that the differences between these goods and services, and the opponent's

goods, would be sufficient to avoid misrepresentation occurring. The parties' fields of activity are clearly not close enough, and therefore, I consider that these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the applicant's goods and services in the mistaken belief that they are provided by the opponent's business. As there is no misrepresentation, there can be no damage

164. The opposition based upon section 5(4)(a) is partially successful, and succeeds in respect of the following goods and services:

Class 5 Veterinary preparations for medical purposes; Medicated cosmetics; Dietary supplements for veterinary purposes; medical preparations for slimming purposes.

Class 35 The bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations for medical purposes, dietary supplements for veterinary purposes, medical preparations for slimming purposes, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

CONCLUSION

165. The opposition is partially successful under sections 5(2)(b), 5(3) and 5(4)(a). The application is therefore refused in respect of the following goods and services:

Class 5 Veterinary preparations for medical purposes; Medicated cosmetics; Dietary supplements for veterinary purposes; medical preparations for slimming purposes.

Class 35 Advertising, marketing and public relations; design for advertising; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office

machines; systemization of information into computer databases; telephone answering for unavailable subscribers; Business management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services; The bringing together, for the benefit of others, of a variety of goods, namely, veterinary preparations for medical purposes, dietary supplements for veterinary purposes, medical preparations for slimming purposes, food for babies, sanitary preparations for medical use: hygienic pads, hygienic tampons, plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets, deodorants, other than for human beings or for animals, air purifying preparations, air deodorising preparations, disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

166. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 5 Chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; food for babies; Dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; Sanitary preparations for medical use: hygienic pads, hygienic tampons; plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets; Preparations for destroying vermin; herbicides, fungicides, preparations for destroying rodents; Deodorants, other than for human beings or for animals; air purifying preparations; air deodorising preparations; Disinfectants; antiseptics; detergents for medical purposes; medicated soaps; disinfectant soaps; antibacterial hand lotions.

Class 35 Organization of exhibitions and trade fairs for commercial or advertising purposes; Auctioneering; The bringing together, for the benefit of others, of a variety of goods, namely, chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

Class 39 Land, water and air transport services; rental of land, water or air vehicles; arranging of tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); Car parking; garage rental; Boat storage; Transport by pipeline; Electricity distribution; Water supplying; Rescue services for vehicles; Storage, wrapping and packaging of goods; Transport and storage of trash; transport and storage of waste.

COSTS

167. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 27th day of October 2026

L FAYTER

For the Registrar

ANNEX 1

The applicant's specification which reflects the restrictions made via the Form TM21b filed on 18 November 2024:

Class 5

Veterinary preparations for medical purposes; chemical preparations for veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; medicated cosmetics; Dietary supplements for veterinary purposes; medical preparations for slimming purposes; food for babies; Dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth; Sanitary preparations for medical use: hygienic pads, hygienic tampons; plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets; Preparations for destroying vermin; herbicides, fungicides, preparations for destroying rodents; Deodorants, other than for human beings or for animals; air purifying preparations; air deodorising preparations; Disinfectants; antiseptics; detergents for medical purposes; medicated soaps; disinfectant soaps; antibacterial hand lotions.

Class 35

Advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; design for advertising; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; Business management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services; Auctioneering; The bringing together, for the benefit of others, of a variety of goods, namely , veterinary preparations for medical purposes, chemical preparations for veterinary purposes , chemical reagents for pharmaceutical and veterinary purposes , dietary supplements for veterinary purposes , medical preparations for slimming purposes, food for babies, dental preparations and articles: teeth filling material, dental impression material, dental adhesives and material for repairing teeth, sanitary preparations for medical

use: hygienic pads, hygienic tampons, plasters, materials for dressings, diapers made of paper and textiles for babies, adults and pets, preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents, deodorants, other than for human beings or for animals, air purifying preparations, air deodorising preparations, disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

Class 39

Land, water and air transport services; rental of land, water or air vehicles; arranging of tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); Car parking; garage rental; Boat storage; Transport by pipeline; Electricity distribution; Water supplying; Rescue services for vehicles; Storage, wrapping and packaging of goods; Transport and storage of trash; transport and storage of waste.

ANNEX 2

The First Earlier Mark

Class 5

Vitamin and mineral preparations.

The Second Earlier Mark

Class 5

Vitamin and mineral preparations.

The Third Earlier Mark

Class 35

Business management; business administration; office functions; advertising services provided via the Internet; provision of business information; wholesale and retail services connected with the sale of vitamin supplements, nutritional products, herbal remedies, food and drink, cosmetics grooming products and pharmaceuticals.