

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 93046**

**IN THE NAME OF ALTICOR INC**

**TO TRADE MARK APPLICATION No. 2366967**

**IN THE NAME OF NUTRIGREEN HEALTH PRODUCTS LTD**

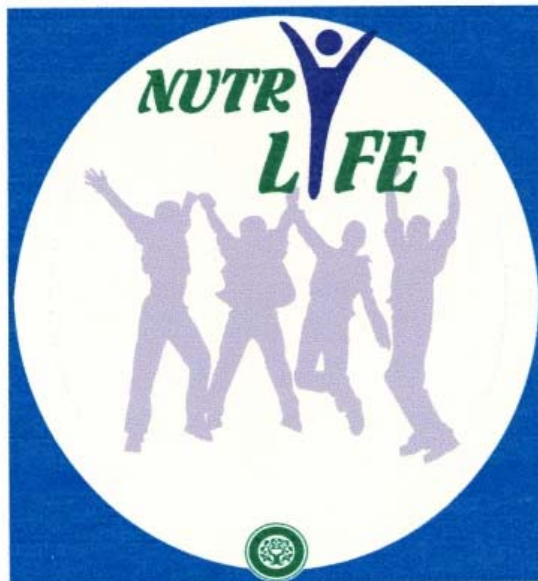
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**DECISION**

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Application No. 2366967

1. On 29 June 2004 Nutrigreen Health Products Ltd (**‘the Applicant’**) applied to register the following sign:



as a trade mark for use in relation to: 'Blend of plant extracts relating to health products, formulated into vitamins and minerals' in Class 5.

2. The sign was graphically represented in colour in the application for registration. The Applicant used the version of Form TM3 introduced in May 2004. This is reproduced at pp.1432 to 1437 of Morcom et al The Modern Law of Trade Marks 2<sup>nd</sup> Edition 2005. The Form took account of the changes made to Rule 5 of the Trade Marks Rules 2000 by the Trade Marks (Amendment) Rules 2004. In Box 4 and Guidance Note 4 the Applicant was notified that the colouring shown in the graphic representation would be recorded as a feature of the sign put forward for registration if no requirement to the contrary was stated in the Form. The Form contained no requirement to the contrary. The application was therefore an application for registration of the sign in colour as shown above.

#### Opposition No. 93046

3. On 20 January 2005 Alticor Inc. (**'the Opponent'**) filed a Notice and Grounds of Opposition objecting to the application for registration under Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 on the basis of prior registration and use of the trade mark **NUTRILITE** in relation to preparations in Class 5 consisting of minerals and/or vitamins for use as nutritive adjuncts to foodstuffs. The Opponent claimed to have been using the trade mark **NUTRILITE** in the United Kingdom in relation to such goods since 1983. This use was relied upon for the purpose of establishing the common law right asserted under Section 5(4)(a).

4. The objection under Section 5(4)(a) added nothing of substance to the objection under Section 5(2)(b).

5. The Applicant joined issue with the Opponent on its Grounds of Opposition. Each side filed evidence in support of its position. Neither side requested a hearing. The opposition was determined on the basis of the papers on file.

#### The Hearing Officer's Decision

6. The opposition was rejected in its entirety for the reasons given by Mr. M. Reynolds acting on behalf of the Registrar of Trade Marks in a written decision issued under reference BL O-237-06 on 18 August 2006. He ordered the Opponent to pay £1,100 to the Applicant as a contribution towards its costs of the Registry proceedings.

7. The Hearing Officer's findings (as summarised by me) were as follows:-

- (1) On considering the matter by reference to what it was notionally open to the parties to do within the boundaries of their respective trade mark specifications, it was clear that the goods in issue were either identical or closely similar.
- (2) Taken as a whole, the Opponent's trade mark **NUTRILITE** was a moderately distinctive mark. The evidence on file was not sufficient to establish that it had acquired an enhanced distinctive character through use.
- (3) Taken as a whole, the distinctive character of the Applicant's figurative mark was dominated by the visual impact of having verbal elements linked by a bridging element in the form of a symbolic representation of a human figure with arms outstretched.

- (4) When the totality of the Applicant's mark was taken into account, there was limited visual similarity between the marks in issue.
  - (5) In oral use the Applicant's mark was likely to be referred to as **NUTRILIFE**. Consumers were less likely to refer to the other elements that go to make up the composite mark.
  - (6) *'Conceptually, the marks may be said to allude to desirable characteristics of the underlying goods namely that they have a part to play in a healthy lifestyle. However, they do so in different ways. The ideas conveyed by – LITE and – LIFE are distinct. That independent identity is not lost when combined with the NUTRI prefix which is itself of low distinctive character'* (paragraph 40).
  - (7) The goods in issue were likely to be purchased by people with an interest in health issues or the need to correct a dietary deficiency of some kind and a reasonable, but not necessarily the highest, degree of care would be exercised in the purchasing process.
  - (8) Cumulatively, the differences between the marks, in issue were sufficient to enable them to co-exist peacefully in the market for vitamins and minerals in the form of food supplements.
8. His overall assessment of the likelihood of confusion was as follows:-

44. In reaching a view on likelihood of confusion regard must be had not just to the visual, aural and conceptual similarities and dissimilarities considered above but also the relative importance of each of these. In the absence of evidence to the contrary I consider that the goods at issue are most likely to be purchased on the basis of visual appraisal in

a retail environment or (on the basis of the opponent's trade) through catalogues where again the consumer will have the opportunity to see the product name, packaging and related information.

45. Oral usage cannot be ruled out. It may arise through word of mouth recommendation or in telephone ordering though, generally speaking, when the latter takes place the required source of the goods has already been identified as a result of visual acquaintance with the mark. Visual considerations, therefore, seem to me to be of rather greater importance than oral/aural ones.

46. The opponent's written submissions have rightly reminded me that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc [1999] R.P.C. 117). In this case identical and/or closely similar goods are involved. Because I attach importance to the fact that consumers are most likely to rely on visual acquaintance with the marks, the composite nature of the applied for mark suggests that there is a limited degree of similarity between the marks. Balanced against that is the need to allow for imperfect recollection in marks where the word elements, although made up of commonplace elements, are distinctive. In that respect the opponent can reasonably say that there is not much between NUTRILITE and NUTRILIFE. What would be the effect of sequential acquaintance with the marks particularly when allowance is made for imperfect recollection?

47. The effect of presenting NUTRI and LIFE on separate lines is to draw attention rather more than would otherwise be the case to the individual elements that make up the mark. Furthermore the authorities counsel against extracting components from composite marks and making the comparison solely on the basis of the allegedly conflicting elements. I bear in mind also that the average consumer is deemed to be reasonably well informed, circumspect and observant. It is not appropriate to assume that consumers will be too careless in their approach to the marks.

48. To find in the opponent's favour requires a likelihood of confusion amongst a significant number of people not just a risk or possibility that a few will be confused. Making the

best I can of it I favour the applicant's position. I have also considered whether, even if direct confusion between the marks is not likely, consumers might be led to think that the applied for mark is a variant of the opponent's mark or a brand from a related (economically linked) undertaking. Taking all the elements of the marks into account I can see no reason why the consumer who noted the similarities and differences and was not confused, should fall prey to the misconception that the opponent or a related undertaking was making itself responsible for the goods sold under the mark. The overall differences are too great for that. The opposition fails under Section 5(2)(b).

### The Appeal

9. On 18 September 2006 the Opponent gave notice of appeal to an Appointed Person under Section 76 of the Trade Marks Act 1994 contending, in substance, that the Hearing Officer's decision should be reversed on the basis that he had not given full effect to the established principle that words speak louder than the non-verbal elements in marks such as that put forward for registration by the Applicant. This contention was developed in argument at the hearing before me. The Hearing Officer's evaluation was challenged on the basis that '*it cannot be right for a word mark to be camouflaged in a logo like this*' (Transcript p.19).

10. The Applicant was not represented at the hearing. I understand that the Treasury Solicitor's Department was informed shortly before the appeal came on for hearing that the Applicant was not proposing to participate.

### Decision

11. The case for the Opponent rests essentially on two propositions. First, that the words **NUTRILITE** and **NUTRILIFE** are so closely similar that they would, if used

concurrently as trade marks for goods of the kind in issue, give rise to the existence of a likelihood of confusion. Second, that the Applicant's figurative mark would be perceived and remembered simply as the word **NUTRILIFE** with visual additions of a generally artistic and non-distinctive character, which should be regarded as insufficient to negate the potential for confusion created by the presence of that word.

12. I agree with the first of these propositions. However, the real issue on this appeal is whether the second proposition should be accepted as correct.

13. At this point I think it is necessary to refer to the basic principle affirmed by the ECJ in paragraph 29 of its Judgment in Case C-120/04 Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH [2006] ETMR 13, p.164:

29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see Matratzen Concord, paragraph 32).

14. In a case such as the present, the marks in issue must therefore be evaluated and compared without dismemberment or excision. When that is done, they might be found to have elements in common that the relevant average consumer may take to be performing 'an independent distinctive role'. They might then be regarded as distinctively similar marks, the concurrent use of which would be liable to give rise to the existence of a likelihood of confusion.

15. This was recognised in paragraphs 30 and 31 of the Judgment of the Court:

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

16. On any view of the matter, it is only if all the other components of a mark are negligible that the assessment of similarity can be carried out solely on the basis of its dominant element: Case C-334/05P OHIM v. Shaker di L. Laudato & C. Sas (12 June 2007) at paragraph 42. The all-inclusive nature of the required assessment was again emphasized by the ECJ in its judgment delivered on 20 September 2007 in Case C-193/06 P Société des Produits Nestlé SA v OHIM at paragraphs 42 to 48.

17. In keeping with that approach, the significance of aural similarity has to be evaluated in the manner indicated in paragraphs 32 to 35 of the Judgment of the ECJ in Case C-234/06P Il Ponte Finanziara SpA v. OHIM (13 September 2007):

32. Even though it is conceivable that aural similarity alone could create a likelihood of confusion, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue (see Case C-206/04 P Mülhens v. OHIM [2006] ECR I-2717, paragraph



21; see also, to that effect, Case C-334/05 P OHIM v. Shaker [2007] ECR I-0000, paragraphs 34 and 35).

33. Such a global assessment of the likelihood of confusion must be based on the overall impression created by those marks, bearing in mind, in particular, their distinctive and dominant components (see Mülhens v. OHIM, paragraph 19, and, in particular, in respect of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 50, 1) Case C-251/95 SABEL [1997] ECR I-6191, paragraph 23, and Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 25).

34. That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see Case C-361/04 P Ruiz-Picasso and Others v. OHIM [2006] ECR I-643, paragraph 20; Mülhens v. OHIM, paragraph 35; and Case C-171/06 P T.I.M.E ART v. OHIM [2007] ECR I-0000, paragraph 49).

35. In that regard, as the Advocate General observed at paragraph 56 of her Opinion, the assessment of any aural similarity is but one of the relevant factors for the purpose of the global assessment. Therefore, one cannot deduce that there is necessarily a likelihood of confusion where mere phonetic similarity between two signs is established (Mülhens v. OHIM, paragraphs 21 and 22).

18. I am satisfied that the Hearing Officer directed himself consistently with these considerations in his approach to assessment in the present case. It follows that his decision should stand if it was realistically open to him to make the determination he did on a proper application of the relevant principles to the case in hand.

19. The Hearing Office was correct, in my view, to recognise that perceptions and recollections of the Applicant's figurative mark were likely to owe more to the impact of the element:



than to the impact of the remainder of the mark. He was equally correct, in my view, to recognise that this would be likely to result in oral references to the mark as **NUTRILIFE**. And he was no less correct, in my view, to recognise that ‘there is not much between **NUTRILITE** and **NUTRILIFE**’. His appraisal thus envisaged that the Applicant’s mark would be perceived and remembered as a logo incorporating a visually unusual representation of a word (**NUTRILIFE**) which could not, in isolation, be used as a trade mark concurrently with the trade mark **NUTRILITE** for goods of the kind in issue without giving rise to the existence of a likelihood of confusion.

20. He none the less found that the differences between the marks outweighed the similarities with sufficient individualising effect to avoid the existence of a likelihood of confusion. That finding was based upon his evaluation of the impact that the visual and conceptual differences between the marks would have upon the relevant average consumer.

21. It can be seen that in the Applicant’s mark the word **NUTRILIFE** is inset in visual imagery designed to convey the concept of vitality and thereby reinforce the reference to **LIFE**. To describe the visual imagery as ‘camouflage’ is to focus attention, correctly, on the degree to which the imagery would influence perceptions and recollections of the inset word. Words do not always or necessarily speak louder than the non-verbal elements with which they may have been combined. Nor if they are combined

with such elements do they always or necessarily speak in the same way or to the same effect as they otherwise would. The Hearing Officer gave effect to those caveats in his assessment in the present case. I do not think it can be said either that it was not open to him to do so or that the result of doing so in the way that he did was clearly wrong.

22. It follows that his determination is not liable to be set aside and that the appeal should therefore be dismissed. In reaching that conclusion, I emphasise that I am not recognising any entitlement on the part of the Applicant to protect the designation **NUTRILIFE** simpliciter or any mark other than the one which was put forward for registration on 29 June 2004: see Case C-234/06 P Il Ponte Finanziaria SpA (above) at paragraph 61 and Case T-147/03 Devinlec Developpement Innovation Leclerc SA v. OHIM (12 January 2006) at paragraphs 66, 67 (unaffected on this point by the appeal to the ECJ in which Judgment was delivered under reference C-171/06 P on 15 March 2007).

23. The Applicant does not appear to have incurred costs in connection with the appeal. The appeal will therefore be dismissed with no order as to costs.

Geoffrey Hobbs QC

9 November 2007

Jennifer Maddox of Messrs WP Thompson & Co appeared on behalf of the Opponent

The Applicant was not represented.

The Registrar was not represented.