

O-366-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2389949
IN THE NAME OF A DIFFERENT LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 93939
BY MILES-BRAMWELL EXECUTIVE SERVICES LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2389949
in the name of A Different Limited and
in the matter of opposition thereto under No. 93939
by Miles-Bramwell Executive Services Limited**

Background

1. Application No. 2389949 was applied for on 20 April 2005 and stands in the name of A Different Limited. I will refer to the applicant as AD. The application is for registration of the following trade mark:



The trade mark consists of the words "Sin & Slim" in a bold, red, sans-serif font. To the right of the text is a red icon of a devil's face with horns and a halo.

in respect of the following goods and services.

Class 16:

Printed instructional material containing personal slimming plans.

Class 29:

Prepared meals and snacks whose main ingredients are proper to this class.

Class 30:

Prepared meals and snacks whose main ingredients are proper to this class.

Class 41:

Documents (electronic) viewed on a screen, being personal slimming plans.

2. Following publication of the application in the *Trade Marks Journal*, a Notice of Opposition was filed on behalf of Miles-Bramwell Executive Services Limited. I will refer to the opponent as MBES. The grounds of opposition are, in summary,

- Under section 5(1) of the Act on the basis that the mark applied for is identical to MBES' earlier marks and is for identical goods and services;
- Under section 5(2)(b) of the Act on the basis that the mark applied for is similar to MBES' earlier marks and is for identical or similar goods and services;
- Under 5(3) of the Act given the substantial reputation of MBES' earlier marks built up over 30 years use and:
- Under section 5(4)(a) based on use of the word SIN since at least 1975.

3. The objections under section 5(1), 5(2)(b) and 5(3) of the Act are based on the following trade marks:

UK registration No. 2237302

Mark: SIN

Date Filed: 27 June 2000

Date Registered: 8 March 2002

Class 16: Printed matter; photographs, stationery, books, directories, recipes, pamphlets, charts, greetings cards, magazines, periodical publications.

Class 29: Meat, fish, poultry and game; meat extracts; products containing meat, sausages, puddings, cooked meat, cooked meat products; preserved, dried and cooked fruits and vegetables; jellies; jams; eggs, milk and milk products; edible oils and fats; preserves; prepared meals and snacks, prepared and packages foods.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, snack foods, prepared and packaged meals and foods, pastry products, confectionery, ices, ice creams, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces, salad dressing, spices.

Class 32: Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 41: Education; providing of training; arranging and conducting of educational seminars.

Class 42: Advisory and counselling services relating to slimming, diet, exercise and health.

Community Trade Mark No. 1939479

Mark: SIN

Date Filed: 30 October 2001

Date Registered: 14 November 2001

Priority Claim Date: 27 June 2000 (From UK Reg No. 2237302)

Class 16: Printed matter; photographs, stationery, books, directories, recipes, pamphlets, charts, greeting cards, magazines, periodical publications.

Class 41: Education; providing of training; arranging and conducting of educational seminars.

Class 42: Advisory and counselling services; advisory and counselling services relating to slimming, diet, exercise.

4. AD filed a counter-statement essentially putting MBES to proof of its claims. Both parties filed evidence. The matter came to be heard before me on 21 November 2007. MBES were represented by Dr. Peter Colley instructed by Swindell & Pearson. AD was represented by Ms Alice Mastrovito of Mastrovito & Associates. On the same day, I also heard revocation and invalidation proceedings filed by AD against MBES'

UK trade mark registration. Those proceedings are subject to a separate decision but clearly, in the event of appeals, the cases should travel together.

Evidence of MBES.

5. This takes the form of a witness statement of David Rathbone dated 24 July 2006. Mr Rathbone is Financial Director of MBES a position he has held since 1996. Mr Rathbone says he has been associated with MBES and its predecessors in business for over fourteen years, has a good knowledge of the trade and records of MBES, has full and unrestricted access to those records and is authorised to make his statement on its behalf.

6. Mr Rathbone explains that MBES trades as Slimming World, one of the UK's leading independent weight control and dietary organisations with an approximate 40% share of the UK market. The company and its predecessors have traded continuously in the UK since 1969. MBES trades through a network of 2,500 (approx) trained consultants who between them hold around 5,500 weekly slimming and weight control meetings for Slimming World members. Mr Rathbone says that at least one million members attend the groups each year and over three million are influenced to eat and live more healthily through MBES' products and services. He does not explain how this later figure is reached. Mr Rathbone states that since 1996 MBES has had approximately 600,000 new members per year subscribe to its products and services.

7. Mr Rathbone states that MBES' core business has always been the development and provision of weight control/eating plans, consultation and guidance to assist members of the public in controlling their weight and to assist in weight loss whilst maintaining a healthy diet. This has involved the developments of plans, concepts and supporting material. He explains that each new member is given a pack of printed material which includes a diet book. He estimates that at least 5.6 million diet books and similar publications have been printed and distributed to members joining the meetings. He confirms that the mark SIN is used in a "generally consistent manner" throughout all the material produced by MBES. In 2004 MBES "re-worked" use of its mark to SYN which, he says is used in exactly the same way as SIN.

8. Mr Rathbone confirms that MBES' annual turnover has been in excess of £15m for each of the last eight years. Products and services are promoted through local and national newspapers and advertising and through its own national magazine.

9. Mr Rathbone explains that much of the publicity for MBES is generated through articles in national and local newspapers. He exhibits a selection of such articles at DR6. Of the twelve pages exhibited, ten make reference to Slimming World. As far as I can tell, the other two merely refer to weight loss in general terms. None of the articles make any reference to SIN.

10. Although he provides no examples, Mr Rathbone states that advertisements for MBES services have regularly appeared in the following newspapers and magazines:

Daily Mail	The Sun	Sunday People	Mail on Sunday
Daily Mirror	Daily Record	Real	Pregnancy Magazine

Marie Claire	Shape	Women's Health	Zest
Inside Soap	Home & Life	Total Style	Woman's Weekly
Top Sante	New Baby	Health & Fitness	Woman's Own
You & Your Baby			

11. Mr Rathbone provides the following details for MBES' annual promotional and publicity spend in the UK:

Year	Advertising and promotional spend £ (approximate annual)
Pre TV advertising	
1995	400,000
1996	400,000
1997	400,000
1998	400,000
1999	400,000
2000	400,000
2001	400,000
2002	400,000
2003	400,000
Including TV Advertising	
2004	1,000,000
2005	1,000,000

No explanation is given on how much of the 2005 relates to the period before the relevant date in these proceedings.

12. Mr Rathbone goes on to state that in addition to MBES' nationwide advertising, its consultants also advertise in their own areas, generally by way of local newspaper advertising and flyers. Whilst he states that "guidelines for consultants' advertising provides for an annual advertising spend by consultants to be in the order of £2.8million. This is in addition to the Company's spend..." he does not say specifically what the actual spend might have been nor are any examples of such advertising provided.

13. Mr Rathbone says that SIN has been used continuously for over thirty years. MBES is the proprietor of both of the trade marks it relies on in this opposition and, at DR1, Mr Rathbone exhibits copies of the registration certificates for both.

14. Mr Rathbone explains that SIN is a unique way of enabling customers to "identify the relative "healthiness" of foods in a simple and effective manner. The less healthy a foodstuff is considered to be, in accordance with the Company's eating plans, the greater the SIN value attributed to that foodstuff".

15. Mr Rathbone states that SIN has been used in written materials produced by MBES "and otherwise" and is used verbally within the slimming and weight control meetings. He attaches a number of exhibits to illustrate this material:

- DR2. Two booklets. He states that the first booklet dates back to 1986 and is a complete and accurate copy of a membership booklet issued by MBES. The

booklet sets out the principles behind the “SIN-A DAY diet, and explains that certain foods:

“will prevent a good weight loss if eaten to excess, so these must be counted. They will be found on the **Food Value Chart** and the amount of carbohydrate each item contains is written alongside in points.”

It goes on to say that the dieter should “choose your sins (points) each day from the **Food Value Chart**”.

The second booklet forming the exhibit bears no date but Mr Rathbone believes it to date back some fourteen years. It again refers to the SIN-A-DAY diet and gives various foodstuffs a SINS value.

- DR3A copy extracts of the third edition (1999) and fourth edition (2000)
- DR3B sample of sixth edition (2002)
- DR3C copy of eighth edition (2004)

of MBES’ Food Directory which has been produced annually since 1997 in similar form and with consistency of use of the word SIN. The directory is a reference book which gives various foodstuffs a SIN value. The foodstuffs are categorised by brand. Mr Rathbone states that most of MBES members purchase and use such a book although they are also available to the general public. He estimates that some 200,000 books have been sold each year.

- DR3D copies of two further booklets Free Branded Food 4 and 5. These are also annually produced directories and refer to foods which MBES has categorised as being healthy enough to be SIN FREE.
- DR3E Book entitled One Hundred Original Sin Free Recipes. Mr Rathbone says the book was first published in 1992 and is still for sale. In excess of 750,000 are said to have been distributed in UK since 1994.
- DR3F Green SIN-A-DAY Eating Plan and Original SIN-A-DAY eating plan. The latter dates to about 1994 the former is believed to date from an earlier period. Mr Rathbone believes that some 600,000 have been produced.
- DR3G Green and Original SIN-A-DAY Eating Plan booklet dating from approx 1999/2000.
- DR3H Copies of registration certificates
- DR3I A random selection of publications dating from 1997-2001
- DR3J 2001 Celebrity Cookbook
- DR3K 2000 Guide to Health and beauty produced with Avon Cosmetics
- DR3L 2001 Cookbook

16. Since January/February 1998 MBES has produced a magazine entitled Slimming World. Distribution has increased from around 195,000 to 260,000 copies. Mr Rathbone states that it has been the best selling diet magazine title in the UK over the last five years. It is published every two months. A selection of the magazines, one from each year between 1998 to 2004, are exhibited at DR4.

17. Mr Rathbone states that MBES has undertaken work with the major supermarkets to produce directories which include a rating of the supermarkets' products using SIN values. Copies are provided at DR5. He says that the above books and many others have been and continue to be sold throughout the UK both to members and the general public, through book clubs and via the Internet and other distribution channels.

18. Mr Rathbone explains that in 2004 MBES reworked SIN to SYN and uses the latter in exactly the same way it used the former. He states that MBES established a website in 1997 and that SIN/SYN has been used continuously on the site since it went live. At DR7 he exhibits pages downloaded from the website on 20 July 2006. A second website was developed (date unknown) which is intended for use by those in the Health Care profession and copies of pages from that site, also downloaded on 20 July 2006, are exhibited at DR8.

19. Mr Rathbone has also filed a further witness statement. In it, he describes a witness identification programme that was undertaken to identify individuals able to give evidence relating to the issues in these proceedings. His witness statement, dated 25 October 2006, sets out what was done. The starting point was the distribution of questionnaire forms for district managers at a gathering at the company's headquarters. The district managers manage self employed consultants either directly or through other Team Managers or Team Developers. The district managers were not themselves asked to complete the questionnaires but were responsible for getting the consultants and members to do so. The blank questionnaires are exhibited at DR9.

20. Mr Rathbone estimates that something in the order of 250 replies to the questionnaires were received. Those who were prepared to give a witness statement or attend to give evidence were identified. Of these, 5 were consultants and 33 were members. In view of the volume, the 5 consultants and 12 of the 33 members were approached to give evidence. The 12 were derived from an objective division of the 33 members according to their geographic origin and then for those regions where more than one member's form was present, one of that number was randomly selected. Mr Rathbone says that he believes the replies received provide a representative sample as the forms were distributed to 30 out of 2,200 consultants and 600 out of a total membership of approximately 250,000. Mr Rathbone refers to evidence from 17 people, however, only 14 witness statements are in the material before me. Dr Colley confirmed the reference to 17 people to be a typographical error.

21. The basic questionnaires were lengthy documents (19 were questions to members with 21 to consultants). I have not been shown the completed questionnaires. The resulting witness statements must, therefore, represent a condensed version of the views expressed. The Annex to this decision contains material extracted from the 14 witness statements recording the answers to certain key questions.

AD's evidence

22. This is a witness statement of Nicholas Wallis Mason and is dated 12 May 2007. Mr Mason is AD's Managing Director and has been in charge of that company since its inception in 2004.

23. Mr Mason explains that he has carried out research into the origins, meaning and usage of the word SIN and exhibits the results of that research. Some of the material is undated or dated after the relevant date in these proceedings. Some of it clearly originates from outside the UK. I do not intend to fully summarise this material, however the exhibits can be broadly categorised into four areas. I set these out below.

DICTIONARY REFERENCES

24. At OPPNWM 1 and 2 Mr Mason exhibits copies of extracts from a number of dictionaries to show the meaning of the word SIN. Naturally enough, the various extracts coincide greatly. The Ninth Edition of the Chambers Dictionary published in 2003, defines SIN as:

“moral offence or shortcoming, esp from the point of view of religion; the condition of offending in this way; an offence generally;.....”

SIN TAXES

25. At OPPNWM3-OPPNWM8 and OPPNWM17 Mr Mason exhibits copies of extracts from a variety of sources showing use of the term SIN TAX. At OPPNWM5, is an extract from the US Internal Revenue Services website (undated but downloaded on 22 September 2006) which defines SIN TAX as:

“ a significant tax on a product or service that is unhealthy. The tax is used to discourage the purchase and use of products that pose a risk to health, such as tobacco and alcohol.”

26. At OPPNWM8 is exhibited an article dated 6 March 2004 downloaded from the BBC News website. The article refers to a survey having been carried out in the UK to determine to which products or services respondents would like to see SIN TAXES applied. Fast food was listed at number 3 on the list.

DEADLY SINS

27. At OPPNWM9 and OPPNWM10 Mr Mason exhibits various website pages which relate to the seven deadly sins in general and gluttony in particular.

SINS IN CONJUNCTION WITH FOOD AND/OR DIETING

28. At OPPNWM11-28 Mr Mason exhibits extracts from various website pages to show the use of the word SIN in relation to food or dieting. I shall set these out in greater detail.

OPPNWM11:

Source: christianitymagazine.co.uk

Date: May 2004.

Article entitled Food, Glorious Food

Extract: "But Sin gets everywhere. That's what it does best so you're as likely to find evidence of it in the food chain as in the heart of a toddler."

OPPNWM12:

Source: Guardian.co.uk

Date: October 25, 2005

Article entitled The Onslaught

Extract: "It's reverse, sleight-of-hand advertising: you get all the credit for exalting virtue, when really you're still selling sin."

OPPNWM13:

Source: prnewswire.co.uk

Date: 1 January 2002

News release

Extract: "Don't feel bad if you sin occasionally. It doesn't mean you can't and won't lose weight."

OPPNWM14:

Source: Spiked-online.com

Date: 19 August 2003

Article entitled Fad panics

Extract: "Today's well-fed Western world increasingly views food as a sin or a toxin: something we should berate ourselves for eating because it is good, or hate ourselves for eating because it is bad."

OPPNWM15:

Source: oup.co.uk

Date: downloaded on 15 December 2005 but refers to a book with a publication date of 6 November 2003

Book entitled: Gluttony: The seven Deadly Sins

Extract: "Part of a series of highly entertaining books on the history of sinning. Eating too much is one of the Western world's greatest problems, but relatively few people would consider it a crime against God."

OPPNWM16:

Source: Superdrug.com press release

Date: Undated

Article entitled: Shape up to a new you

Extract: "Sweetener tablets & Sweetener granules. If the thought of tea and coffee without sugar gives you the shivers reach for these sin-free sweeteners."

OPPNWM17:

Source: Weber Shandwick Report

Date: February 2004

Article entitled: Obesity: Challenges and Implications for Europe

Extract: “In response to the obesity crisis, many governments around the world are taking their own actions, exploring options, including “sin” taxes, advertisement bans, educational campaigns, physical activity programmes and more.” And “53% of respondents were against such a ban-or additional “sin” taxes on certain foods...”

OPPNWM18:

Source: UK Parliament Select Committee on Health Minutes of Evidence

Date: 27 November 2003

Extract: “For example VAT has been levied on so-called “sin-food” for over 20 years”

OPPNWM19:

Source: The National Centre for Eating Disorders

Date: 1999

Article entitled: The psychology of Dieting

Extract: “After the milk shake, instead of doing penance for the calorific sin, the dieter persists in sinful indulgence, say the psychologists.”

OPPNWM20:

Source: Telegraph

Date: 4 January 2004

Article entitled: UK Food agonises over Atkins

Extract: “Potatoes are an Atkins cardinal sin”

OPPNWM21:

Source: The People

Date: 14 May 2006

Front Page Headline: Sin & Thin: Be Bad..But lose a stone in a month

Article entitled: Sin Yourself Slim

OPPNWM22:

Source: The diet detectives

Date: Undated but bears copyright date of 2006-2008

Extract: “Most of us tend to underreport what we eat, and it’s mostly those “sin” foods that are forgotten, such as cakes, candy, salty snacks, and other high-calorie and high-fat items.”

OPPNWM23:

Source: Veggiehealth magazine

Date: undated

Extract: “Eating fat is not the original sin; in fact, our bodies can’t function properly without it.”

OPPNWM24:

Source: Women’s health magazine

Date: March 2006

Extract: Sub-headings entitled: “The sin: the breakfast binge” “The sin: the all day graze” “The sin: the fast-food lunch”, “The sin-girls’ night out gluttony” and “The sin-Happy hour blues”

OPPNWM25:

Source: sirc.org

Date: Undated

Article entitled: Food and Eating: An anthropological Perspective

Extract: "The real modern descent into sin and wickedness is a dieter who goes on a junk food binge"

OPPNWM26:

Source: iccoventry.co.uk

Date: Undated but downloaded 12 September 2006

Article entitled: Chocs away

Extract: "Her aim, she says, is to stop people thinking of chocolate as a guilty sin"

OPPNWM27:

Source: ivillage.co.uk

Date: undated but downloaded 15 December 2005

Article entitled: Child Fare

Extract: "Ditch the "naughty but nice" attitude. Thanks to those old cream cake adverts a whole generation has grown up attaching guilt and sin to certain foods."

OPPNWM28:

Source: Wikipedia

Date: Undated but downloaded 27 October 2006

Article entitled: Weight Watchers

Extract: "in the UK, Weight Watchers advertises under the slogan "where no food is a sin": this is a reference to its chief competitor Slimming World's system of giving some food "sin" values."

29. Mr Mason concludes his evidence by stating his belief that MBES appears to understand that the word SIN is unable to function as a trade mark and has abandoned its use adopting instead the word SYN. At OPPNWM30 he exhibits material produced by MBES showing use of the word SYN. At OPPNWM31, he exhibits copies of extracts taken from the UK Trade Marks Registry websites showing details of MBES' applications for the latter mark.

MBES' Evidence in reply

30. This is a further witness statement of David Rathbone, dated 20 August 2007. Mr Rathbone's statement is largely commentary and I do not therefore intend to summarise it fully though I do take it into account. Mr Rathbone states his understanding that SIN is identified with and understood to be a trade mark of MBES by "the UK public, in particular by those providing services and products for the slimmers' market and those in the market to buy them". He confirms that he has received numerous approaches from third parties regarding the applicant's adoption of SIN, generally from members and consultants expressing concern. In response to AD's evidence, he confirms that MBES has not abandoned the trade mark SIN, has made no decision never to use it again and continues to protect, police and enforce its rights in the trade mark.

DECISION

31. The relevant part of the statute reads:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

Section 5(1)

32. The opponent’s case under Section 5(1) is dependent on my finding that the parties’ marks are identical.

The marks are:

Opponent’s

SIN

Applicant’s

Sin & Slim 

33. Dr Colley took as his starting point the ECJ’s judgment in *LTJ Diffusion SA and Sadas Vertbaudet SA*, Case C-291/00. That case involved a consideration of the provisions of Article 5(1)(a) (rights conferred by a trade mark). The Court noted that Article 5(1)(a) does not require evidence of a likelihood of confusion. The protection offered in circumstances where marks and goods/services are identical is absolute. The Court’s guidance was as follows:

“54. In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

34. The Court had, earlier in the judgment, explained the considerations behind this guidance:

“50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.”

35. Article 4(1)(a) and hence Section 5(1) contains an equivalent provision in relation to identity between marks in the context of grounds for refusal or invalidity.

36. Against that background Dr Colley submitted that Section 5(1) applied in this case because of the prominence given to the word SIN in the applicant’s mark (prominent because it is both the first word and is in a bolder typeface) and the insignificance and non-distinctiveness of the other features of the mark which would in his view go unnoticed by the average consumer. The device at the end of the mark served as little more than a piece of modern punctuation as he put it.

37. I am unable to accept that view of the matter. Consumers would recognise that the mark is composed of conjoined elements that interplay with one another. Thus, ‘SIN’ and ‘& SLIM’ creates an idea that is greater than SIN on its own. The device of an imp or devil’s head surmounted by a halo picks up on the idea implicit in the words, that is to say a mixed negative and positive message. I have little doubt that the mark was intended to be read as a whole and that that is how consumers would approach it. The differences are certainly not so insignificant that they may go unnoticed. The marks are not identical.

Section 5(2)

38. Turning to Section 5(2)(b), the matter must be approached from the perspective of the average consumer who has the qualities identified in *Lloyd Schuhfabrik & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77. As I have indicated in the related actions the relevant consumer group must include a broad swathe of the population who are, or may at some point be concerned with slimming, dietary, exercise and health related issues. The relevant group may be primarily the adult population but there is no reason to suppose that the potential audience for the goods and services should be restricted in this way. Children may also be part of the average consumer group. To the extent that the goods and services are restricted to or include items relating to slimming (the applicant’s goods and services in Classes 16 and 41 are so restricted) then consumers may be expected to exercise a reasonable degree of care in the process of selection and purchase consistent with the importance that is attached to the health and personal appearance issues associated with healthy eating and dietary matters.

39. To the extent that both sides' goods (in Classes 29 and 30) are not restricted in any way then, depending on the precise nature of the goods, a somewhat lesser degree of care might be exercised particularly if cheaper items are involved.

40. I anticipate that most purchases will be made on the basis of a visual selection or scrutiny of diet plans etc. Word of mouth recommendation may also play a part in the context of dietary regimes and slimming clubs where newcomers may well wish to benefit from the views and experiences of established members or dieters.

Similarity of goods and services

41. It is conceded on behalf of the applicant that the goods and services are similar taking No. 2237302 as the basis for comparison. In fact, it is clear that there is identity in certain respects. Goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category designated by the trade mark application or vice versa (*Gérard Meric v OHIM*, Case T-133/05 and *Galileo International Technology LLC v Galileo Brand Architecture Limited*, O-269-04). Taking the matter on a class by class basis having regard to MBES' UK registration and considering its most relevant goods and services only:

“Printed instructional material containing personal slimming plans” is contained within the broad term “printed matter” in the opponent's specification and must be identical.

“Prepared meals and snacks whose main ingredients are proper to this class” (Class 29) are identical to “prepared meals and snacks, prepared and packaged foods” in Class 29 of the opponent's UK registration.

“Prepared meals and snacks whose main ingredients are proper to this class” (Class 30) are identical to “snack goods, prepared and packaged meals and foods” in the opponent's Class 30 specification.

“Documents (electronic) viewed on a screen, being personal slimming plans” has no direct counterpart in the opponent's specification but would be the electronic equivalent of the opponent's Class 16 printed matter. As such the goods and services are closely similar but not identical.

Similarity of marks

42. It is well established that the average consumer perceives a mark as a whole and does not dissect, or engage in analysis of, marks. Accordingly, the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created bearing in mind their distinctive and dominant components. The average consumer rarely has the opportunity to make direct comparisons between marks and must often rely on imperfect recollection. These criteria are uncontroversial and derive from *Sabel BV v Puma, AG*, [1998] R.P.C. 199. I also bear in mind that the issue of similarity between two marks must be assessed as a separate matter from the distinctiveness of the earlier trade mark, *L'Oreal SA v OHIM*; Case C-235/05P.

43. The opponent's earlier trade mark consists of the word SIN. The applied for mark is a composite one that clearly includes the whole of the opponent's mark as its first element. The key principles in assessing the similarity of marks in these circumstances can be derived from the following judgments of the European Courts. In *Medion AG v Thomson Multimedia Sales Germany and Austria GmbH*, [2006] E.T.M.R. 13 the ECJ held:

“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).

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.

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.”

44. In Case C-334/05P, *OHIM v Shaker di L Laudato and C. Sas*, the ECJ reaffirmed the need to examine marks as wholes whilst acknowledging that individual elements may have a predominant influence:

“It is important to note that, according to the case-law of the Court, 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 order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).”

However,

“... it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant elements.”

45. For the reasons given earlier in considering Dr Colley's submission in relation to identity of marks, I find it improbable that consumers would extract the word SIN from the composite mark and disregard the other elements. The presence of the ampersand provides a clear and meaningful link between the word elements of the mark which invites the viewer to approach the mark on the basis of it being a composite expression. That notion is reinforced by the presence of the small but not negligible device at the end of the mark which serves as a visual shorthand picking up on the theme of the words themselves and creating a pictorial oxymoron. The mark is also in the colour red but it has not been put to me that this makes a material difference.

46. It is reasonable to suppose that, within the context of the goods and services applied for, the element SLIM will scarcely be seen as a distinctive and dominant component in its own right. On the other hand I do not accept that, simply because a word (in this case SLIM) has a clear descriptive meaning in the context of the goods and services, it necessarily follows that its contribution to the totality of the mark must be wholly or largely discounted. The example I put to Dr Colley at the hearing was 'Wash & Go' ® for shampoos. Clearly, the first element of that mark can have no independent distinctive character in relation to shampoos. But it contributes to the overall construction and character of the mark. I accept that one can only proceed so far by analogy. There is, for instance, an obvious difference in the mark SIN & SLIM (and device) because the more distinctive component (SIN) is at the front of the mark and emboldened in terms of its presentation. I remain of the view that the analogy serves the limited purpose of demonstrating the capacity of a non-distinctive element to make a difference to the overall character of a mark. SIN & SLIM is just such a case where the totality has a significance as an expression. The consequence is that the presence of the (in itself) non-distinctive element SLIM cannot be ignored.

47. In short the overall impression created by the mark rests on the message conveyed by the juxtaposition of SIN & SLIM supported in small measure at least by the device. But within the totality of the mark I consider there is some weighting towards the unconventional use of SIN, this being neither a natural nor a particularly apposite word to use in relation to the goods and services in question. The latter point is somewhat reinforced by the fact that the word SIN and ampersand are picked out in bolder typeface. The word SIN thus retains some independent distinctive character notwithstanding the fact that the overall character of the mark involves reading it as a composite expression.

48. In terms of how the respective marks work, the word SIN may be either a noun or a verb. Used on its own, as is the case with the opponent's mark, it is perhaps more likely to be seen as a noun rather than an exhortation to sin. By contrast in the expression SIN & SLIM the first element is more likely to be seen as a verb. I say this because, whilst SLIM may be either a verb or an adjective, the expression SIN & SLIM really requires both elements to be verbs. That is how I anticipate consumers would react to the combination albeit that they would not pause to analyse their thoughts in this way.

49. With those general considerations in mind I turn to the visual, aural and conceptual similarities and differences between the marks. As a matter of visual impression the applied for mark is longer but has as its first, and a prominent, element

the word SIN. This word is more memorable within the expression SIN & SLIM and has some independent distinctive character notwithstanding that both elements of the mark need to be present for it to work. The device is small and makes a marginal visual contribution to the character of the mark. The overall effect is a degree, but not a high degree, of visual similarity between the competing marks.

50. Aurally, the opponent's position is if anything slightly stronger because the small device is unlikely to feature in oral references to the mark.

51. Conceptually, the marks work in different ways, one being a single word that is most likely to be treated as a noun, the other producing a message or expression through the use of two verbs. Marks must be considered from the perspective of the average consumer and in relation to the relevant goods and services. For the reasons I have already given I am not prepared to discount the effect of use of the admittedly descriptive word SLIM on the mark as a whole. Nevertheless, in the context of the goods and services of particular interest to the parties the notion of 'sin' or 'sinning' is mildly unusual, so there is considerable conceptual common ground between the marks in the sense that both rely on the same idea (SIN) to make their impact despite the fact that compositionally the marks work in different ways.

Distinctive character of SIN

52. There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use made of it (*Sabel v Puma*, Paragraph 24). Ms Mastrovito in her skeleton argument suggested that SIN is of limited inherent distinctive character for the reasons advanced and dealt with in the related actions. Dr Colley's submission was that, through significant use, the SIN mark enjoys a peculiarly distinctive character. In the related action I have held that the word SIN should not be declared invalid on any of the grounds under Section 3(1)(b)(c) or (d) or revoked under Section 46(1)(c) or (d). That finding in itself does not, of course, answer the question as to the level of distinctive character accruing to the mark either as a result of its inherent or acquired qualities.

53. AD's evidence, shows some journalistic use of SIN in relation to food and dieting but only at a high level of generality. At most, it suggests that overindulgence in certain types of food may be undesirable. But the underlying message is that the SIN rests with the behaviour of the consumer rather than the foods themselves (let alone the Class 16 goods and Classes 41 and 42 services). On the basis of the inherent merits of the word, SIN is a well known dictionary word but one which is mildly unexpected in the context of the majority of the goods and services of MBES' registration and hence possessed of a reasonable degree of distinctiveness. It may be of slightly diminished distinctiveness in relation to foodstuffs that might be said to fall into the 'naughty but nice' category (to use the common parlance), that is to say certain confectionery items, ice creams and such like but even here the evidence is far from establishing that it is customary in the language to use the word in this way.

54. From MBES' perspective it is said that the word has been used for over thirty years and is entitled to claim an enhanced level of distinctiveness and hence protection. In considering issues of use it is now well established that the use must be as a trade mark. The point arose in relation to evidence of use to overcome an

absolute ground objection in *Philips Electronics NV v Remington Consumer Products Ltd*, Case C-299/99 – see paragraphs 64 to 66 of the judgment. The same point can be found in the ECJ's judgment in *Ansul BV v Ajax Brandbeveiliging BV*, [2003] R.P.C. 40 where, in the context of establishing genuine use, the Court held (paragraph 36) that the “use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user ...”. Use intended to establish an enhanced level of distinctiveness must also be use as a trade mark.

55. For the reasons I have given in the related action I consider that the nature of MBES' use is more likely to be seen as part of the company's own internal jargon. That is to say terminology that is used (along with other terms such as Healthy Extras and Free Food) in the context of the dietary schemes and, as such, is associated with MBES but would not necessarily be relied on by consumers or potential consumers as an indication of trade source. That is not to deny its capacity to serve a trade mark function. I accept too that it is perfectly possible for a sign to serve more than one purpose (see, for instance, the Court of Appeal's recognition that Arsenal could both designate origin and serve as a badge of allegiance in *Arsenal Football Club v Reed* [2003] R.P.C. 39 and the CFI's judgment in *KWS Saat AG v OHIM*, Case T-173/00 acknowledging that colours or colour combinations may have a number of functions including technical or decorative as well as indicating the commercial origin of goods or services). It is merely that on the basis of the evidence before me, the pattern of use does not persuade me that it has in fact performed the function of a trade mark.

56. Dr Colley, nevertheless, placed reliance on the witness statements from consultants and members of the Slimming World diet groups. There was some discussion before me as to whether the exercise undertaken by MBES that resulted in the witness statements, amounted to a survey or was simply a witness gathering process. I accept that it is the latter. It would have been better in my view if, in addition to the blank questionnaires that have been exhibited, the opponent had filed the completed questionnaires of those witnesses who have given evidence. That would have enabled a comparison to be made between their spontaneous responses to the questions and the inevitably more considered comments in the resulting witness statements. Ms Mastrovito expressed some concern about this part of the opponent's case but no request for disclosure of supporting documentation or for cross-examination of the witnesses was made. In those circumstances I am entitled to give some weight to the witnesses' views.

57. The witnesses' reaction to the word SIN is recorded in the Annex to this decision. A reasonably consistent picture emerges. The witnesses associate the word with Slimming World and understand that it forms part of the jargon that is used in connection with eating plans. I commented to Dr Colley at the hearing that none of the witnesses referred to or said that they regarded it as a trade mark. His response was that people simply do not think in those terms and that, in any case, it had been necessary to avoid leading questions. There is some force to that submission but it still leaves me in considerable doubt about what the witnesses' underlying understanding of the word amounts to.

58. I accept that the witnesses associate SIN with Slimming World. Further, the fact that Slimming World may be the headline brand for them does not mean that SIN

cannot also function as a trade mark, albeit a sub-brand. Given the ambivalent nature of the usage shown in the evidence as a whole and my uncertainty about the witnesses' underlying beliefs and understanding I find it difficult to draw firm conclusions from their evidence. The responses suggest that the witnesses recognise the word as MBES/Slimming World's internal usage to denote the value system associated with the dietary plans. The plain wording of the responses does not satisfy me that the word has acquired, or is seen as having acquired a deeper and more entrenched meaning, to signify trade origin.

59. There may, after all, be many aspects of the presentation of goods (such as packaging, colour, cataloguing references etc.) that may be unique to the provider and associated by consumers with that particular supplier but which do not and/or are not necessarily intended to function as trade marks. Making the best I can of the evidence before me, including the witness statements referred to above, I am not persuaded that the opponent is entitled to claim any enhanced degree of distinctive character as a result of use of SIN.

Likelihood of confusion

60. This is a matter of global appreciation taking into account the interdependency principle whereby 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-Mayer Inc* [1999] R.P.C. 117). The distinctive character of the mark must also be taken into account as must the nature of the average consumer and the circumstances in which the goods and services are supplied/purchased.

61. I also bear in mind that mere association in the sense that the later mark brings the earlier mark to mind is not sufficient (*Sabel v Puma*, paragraph 26). On the other hand if the association between the marks causes the public wrongly to believe that the respective goods (or services) came from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon v MGM*, paragraph 29).

62. This is not a case where the later mark would be mistaken for the earlier trade mark. There is simply too much additional matter for that to happen. I, therefore, discount direct confusion. However, it remains the case that SIN is a somewhat unusual and memorable word to use in relation to the goods and services in question. That is the case even within the context of the parties' actual or intended businesses involving the goods and services in issue. It is, *a fortiori*, the case to the extent that the applicant's goods in Classes 29 and 30 (and those of the opponent) are unrestricted in scope. I have found that the positioning, prominence and impact of SIN within the overall context of the applicant's mark is such that it has some independent character within the composite mark. In these circumstances I consider that there is a real likelihood that consumers encountering the applied for mark will take it to be a derivative form of the earlier trade mark or that it is simply another way of expressing the context (slimming) in which the earlier trade mark is being used. Given also the complete overlap in goods and services, that is sufficient to establish a likelihood of confusion. The opposition succeeds under Section 5(2)(b).

63. For the sake of completeness I have recorded in the Annex the reaction of the witnesses to SIN and SLIM. A number of the witnesses indicate that they would be confused (see the comments of Tracey Hedges, Christine Blackmore, Jean Rowland, Michelle Cardall, Sarah Fox, Eirwen Thomas, Alison Adams and Jennifer Parker). Although this evidence may be said to be supportive of the conclusion I have reached I have not placed reliance on it because of the uncertainty surrounding the witnesses' understanding of the word SIN (which has not been tested in cross-examination) and the consequential difficulty in extrapolating to issues of confusion.

64. There remain the opponent's objections under Section 5(3) and 5(4)(a). These grounds were the subject of brief submissions only at the hearing and I did not understand Dr Colley to press them to any appreciable extent (though I should record that they were not given up). In the circumstances I see no need to consider these grounds. If, on appeal, I am found to be wrong in relation to Section 5(2) I cannot see how the opponent can be in a materially better position under either of its alternative grounds.

COSTS

65. The opponent has succeeded and is entitled to a contribution towards its costs. The three cases that were heard on 21 November 2007, although involving different issues of law, have been decided on the basis of substantially the same evidence. I propose to apportion the costs relating to the evidence between the revocation and invalidity actions on the one hand and the opposition on the other. Accordingly, I order the applicant to pay the opponent the sum of £1950. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of December 2007

M REYNOLDS
For the Registrar
The Comptroller-General

Annex

NAME	STATUS	YEARS' KNOWLEDGE OF SLIMMING WORLD	UNDERSTANDING OF SIN	REACTION TO SIN & SLIM
Tracey Hedges	Member	8 years plus	“The term SIN is used as part of the backbone of Slimming World’s diet plans. SIN is used to refer the energy value in relation to calories, fat etc for certain foods in Slimming worlds FOOD OPTIMISING plan.”	Not come across it in relation to diet plans, but would consider it misleading and a rip off of Slimming World.
Christine Blackmore	Consultant	11 years plus	“SIN or SINS is a term used in relation to the Slimming World diet for different types of food. The number of SINS or the SIN value given to different foods is worked out for us by a nutritionist.”	Not come across it but would automatically think it referred to Slimming World.
Nikki Randall	Member	Over 10 years	“SIN is used in the context of Slimming World’s eating plans to relate to foods that are not “free” and that you have to count as part of the eating plan. These foods are given a SIN value to assist someone on the diet plan to count the intake of such goods.”	No comment.
Jean Rowland	Member	20 years	“SIN is used in the Slimming World diet plans in the context of “extra foods” you can enjoy and count as part of your diet.”	Not come across it but would be confused.
Helen Ogundele	Member	3½ years	“SIN is used in relation to foods which are not FREE or are not deemed a	No comment.

			HEALTHY EXTRA, but must be counted as part of the Slimming World “diet”.	
Michelle Cardall	Member	13 years	“SIN or SINS is used in relation to treats you can have on a daily basis as part of the Slimming World eating plan. Foods like chocolate, crisps, cake, certain breads, meat pasta and basically anything that is not classed as a HEALTHY EXTRA or FREE FOOD under the Slimming World diet, are referred to as SINS”.	Has come across it being used in relation to diet plans and understood it to be part of Slimming World.
Chris Condon	Member	18 months	“ it is used in relation to certain types of foods you eat in the diet plan. Slimming World give certain goods a SIN value in the Slimming World eating plan, which is generally higher the more fattening the food.”	No comment.
Sarah Fox	Member	11 years	“SIN is used to refer to food items not FREE or HEALTHY EXTRAS that must be counted to a maximum amount daily. SIN can relate to food or drink (or supplement medication ie evening primrose oil) or cooking supplements (ie oil or butter) not FREE or a HEALTHY EXTRA A or B.”	Not come across it but reaction would be that this is part of Slimming World.
Eirwen Thomas	Member	Several years	“SIN is used as part of the Slimming World	Not come across it but would assume

			diet in relation to foods that you have to count and that cannot be eaten freely. You used to watch how much of such goods you eat and limit them as part of the diet.”	they have copied Slimming World.
Carol Welsh	Member	“For years”	“The term SIN is used as part of the Slimming World diet to relate to goods that are not on the A or B list and that are not designated FREE FOODS under the Slimming World eating plans.”	No comment.
Alison Adams	Member	‘since about the year 2000’	“SIN has, as far as I am aware, always been used by Slimming World in relation to its products and services in the UK and I consider it of vital importance in connection with the Slimming World diet plan.	Not come across it but reaction would be one of confusion and that someone was jumping on Slimming World’s bandwagon.
Christine Warren	Consultant	15 years	“SINS –or SYNS- are foods that members of Slimming World enjoy yet we are still in control of the diet plan. All goods that are “free” have a SIN (SYN) value.”	No comment.
June Patterson	Consultant	2½ years	“SIN is used as part of Slimming World eating plan to refer to foods that can be eaten as treats as part of the eating plan.”	No comment.
Jennifer Parker	Consultant	7 years	“SIN (now spelt SYN) is a means of fitting certain foods into Slimming World’s diet plans, including their FOOD OPTIMISING plan.	Has become aware of another company’s use of SIN AND SLIM in relation to diet plans. Reaction is that another

			Certain/most foods are given SIN values (now SYN) to help members within our groups to make choices about what foods to eat.”	company is trying to use Slimming World’s success to line their own pockets.
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