

O-233-16

TRADE MARKS ACT 1994
IN THE MATTER OF TRADE MARK APPLICATION NO 2 619 857
IN THE NAME OF PHARM MED LIMITED
TO REGISTER A LOGO TRADE MARK IN CLASSES 05, 35 AND 42
AND OPPOSITION THERETO UNDER NO 103776 BY MERCK CONSUMER
HEALTHCARE

DECISION

INTRODUCION AND PROCEDURAL ISSUES

1. This is an appeal from the decision of the Hearing Officer, Ms Louise White, whereby she dismissed the opposition filed by Merck Consumer Healthcare (“the opponent”) to registration of the mark:



2. The application was accepted and published in the Trade Marks Journal on 8th June 2012 in respect of the following goods and services:

Class 5 Mineral food supplements; food supplements; vitamins and minerals; vitamin preparations; mineral preparations; naturopathic and homeopathic preparations and substances; vitamin, mineral and protein preparations and substances; plant compounds and extracts for use as dietary supplements; herbal supplements and herbal extracts.

Class 35 Intermediary business services relating to mineral food supplements, food supplements, vitamins and minerals, vitamin preparations, mineral preparations, naturopathic and homeopathic preparations and substances, vitamin, mineral and protein preparations and substances, plant compounds and extracts for use as dietary supplements, herbal supplements and herbal extracts; wholesale services, retail services and electronic shopping retail services connected with the sale of mineral food supplements, food supplements, vitamins and minerals, vitamin preparations, mineral preparations, naturopathic and homeopathic preparations and substances, vitamin, mineral and protein preparations and substances, plant compounds and extracts for use as dietary supplements, herbal supplements and herbal extracts.

Class 42 Research and development into mineral food supplements, food supplements, vitamins and minerals, vitamin preparations, mineral preparations, naturopathic and homeopathic preparations and substances, vitamin, mineral and protein preparations and substances, plant compounds and extracts for use as dietary supplements, herbal supplements and herbal extracts.

3. The principal ground for opposition was the opponent's prior registration and widespread use of the mark **NATURE'S BEST** for a range of goods, a number of which are identical or similar to those covered by the mark applied for. In particular, it relied on its earlier United Kingdom registration No 2 005 958 for NATURE'S BEST, filed on 19th December 1994 and registered on 13th December 1996 in respect of the following goods:

Class 3 Essential oils; cosmetics including vitamin and herbal preparations, hair and skin lotions, soaps for personal use, health and beauty requisites.

Class 5 Food supplements, being pharmaceutical preparations and substances, herbal products, food and dietary supplements, vitamins, minerals, amino-acids; nutritional preparations including evening primrose oils, fish oils, marine products, digestive aids, fibre and enzyme products and combinations of the aforesaid goods; tonic preparations and substances.

4. The opponent's case was that "NATURE'S BEST" was a widely known mark for food supplements, vitamins and other nutritional supplements (as well as some other goods). The opponent's prior registration was, when it was applied for, regarded as prima facie descriptive but was registered on the basis of proof of use.

The opposition

5. The opposition was advanced on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). As to sections 5(2)(b) and section 5(4), the Hearing Officer held that there was a very low similarity of the respective marks and, although there were identical or similar goods, there was no likelihood of confusion. As to section 5(3), the Hearing Officer found that the evidence as to the reputation of the earlier marks was unpersuasive and that even if there was a reputation, the differences in the marks were such that no link would be made in the manner required by the leading authorities.
6. The case was therefore a straightforward one where, for all of the grounds of opposition, the Hearing Officer considered that the marks were sufficiently different not to give rise to a risk of confusion or any link between the respective marks.

Procedural matters

7. The respondent to this appeal, Pharm Med Limited, did not respond to the notification of the hearing nor indicated any intention to attend. It may have been wound up or otherwise no longer active.
8. The opponent indicated that it was content to have the appeal determined on the papers. Although it is true that not “all” parties have indicated that they were content for this course to be taken (cf. Trade Mark Rules 2008 rule 73(3)), since the respondent did not respond at all, in my judgment, it is appropriate to determine the appeal in this way. Moreover, sufficient time has passed since the originally fixed hearing for any objection to that course to have been taken and none has.
9. I did not receive a skeleton argument from either side and I indicated in an earlier notification to the parties that it was possible that substantive consideration of this appeal would be unnecessary (and would therefore save the parties costs) if the appellant was not seriously resisting it or no longer existed or traded.
10. I previously directed, inter alia, that the hearing date be vacated and unless a further request for a hearing was made, the appeal would be determined on the papers. I also directed that the parties should file skeletons including, if desired, reasons why the appeal should be allowed if there remained no active opposition to the appeal on the part of the respondent. I should say that the absence of skeletons has not materially affected consideration of the appeal as will be apparent from the reasoning below.
11. I did not receive any further communication save for the indication mentioned that the appellant was content for the appeal to be determined on the papers and, later, that this remained the case.
12. In those circumstances, the fairest approach is for me to consider the grounds of appeal in full and, if any appear prima facie to be sound to allow the appeal but not simply to permit the appeal to be allowed by default on the basis that no substantive opposition has been advanced to it. In so doing I apply the well-known “*Reef*” principles and bear

in mind that this appeal involves a review not a re-hearing with the cautious approach to appellate interference that this requires (see e.g. *Galileo International Technology LLC v European Union* [\[2011\] ETMR 22](#) at [11]-[14]).

GROUND OF APPEAL

13. The opponent advances five grounds of appeal and contends that the Hearing Officer:
- a. Failed correctly to apply *Medion v. Thompson*;
 - b. Failed to apply the interdependency principle;
 - c. Failed correctly to assess the distinctiveness of the opponent's mark;
 - d. Failed to properly assess the opponent's reputation and goodwill when addressing the section 5(3) and 5(4) grounds;
 - e. Incorrectly assessed the level of attention likely to be paid by the relevant public when purchasing the goods in question.

14. I shall deal with these in turn.

(i) *Medion v. Thompson*

15. The Hearing Officer referred to the principles in the *Medion* case at para. [11] of the decision in conventional terms:

“...e) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*.”

16. The Hearing Officer applied this approach later on in her decision where she said at para. [15]:

“15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.”

17. She continued at paras. [16]-21]:

“16. It is noted that the earlier trade mark is a word only mark whereas the contested trade mark is a complex mark comprised of a number of elements. Visually, they coincide in respect of the elements “Nature’s Best”, which appear in each. They differ in respect of the numerous additional elements present in the contested trade mark, not least the shield device containing the letter “S”, the word “Superfoods” and the additional word “sellers!”. These all have a significant visual impact. Bearing in mind all of the aforesaid, it is considered that the degree of visual similarity, is very low.

17. Aurally, the point of coincidence corresponds with the visual analysis. It is considered unlikely that all of the verbal elements of the contested trade mark will be articulated. The most likely scenario is that it will be referred to as “S Superfoods”, thus leading to no aural similarity. However, even in the event that all elements are articulated, the degree of aural similarity is in any case, considered to be very low.

18. Conceptually, the earlier trade mark will be understood as referring to the best that nature has to offer, a strong allusion of its nutritional credentials. The contested trade mark follows a not dissimilar theme, as it includes “superfoods”. The opponent has filed evidence on the meaning of superfoods and it is considered that this term is indeed understood to mean a food that is exceptionally nutritious and beneficial to health. However, the contested trade mark also introduces the idea of popularity in respect of “best sellers” which is likely to be seen as a discrete term with a meaning divergent from “nature’s best”. It is considered that this constitutes at least to some extent, a conceptual gap. However, this gap is not so great that an entirely different meaning is instantly grasped and understood as the presence of superfoods will inevitably be understood as pertaining to good nutrition. Bearing in mind all of the aforesaid, the marks are considered to be conceptually similar, at least to a low degree.

Distinctive and dominant components

19. It is considered that the earlier trade mark does not have separate distinctive and dominant components. Rather, it will be appreciated instantly as a whole.

20. In respect of the contested trade mark, the opponent argues that the shield device and the element “superfoods” are non-distinctive and that the dominant and distinctive element is therefore Nature’s Best Sellers! Unsurprisingly, the applicant disagrees. On viewing the contested trade mark, it is considered that the shield device together with superfoods is visually dominant. This is supported by its relative larger size to the remaining elements, its position on top of the remaining elements and the fact that it appears in a mustard yellow colour. It is accepted that “superfoods” has a meaning in respect of, at least the goods applied for. However, in combination with the shield device, it catches the eye first. Further, the shield is perfectly distinctive. It is considered therefore that this element is the dominant and distinctive element of the contested trade mark.

21. Bearing in mind all of the aforesaid, it is considered that the respective trade marks are similar, only to a very low degree.”

18. This evaluation does not appear to contain any error of principle or in application of the *Medion* approach. The Hearing Officer took proper account of the need to consider the

overall impression, the need to avoid artificially dissection of the trade and the importance of identifying any distinctive and dominant components. The Hearing Officer also took into account the extent to which parts of the mark could be regarded as descriptive. I am not therefore persuaded by this ground of appeal.

(ii) *Interdependency principle*

19. Next it is said that the Hearing Officer failed properly to apply the interdependency principle. Again, she correctly set out the requirements of the law in this regard in para. [11] as follows:

“(g) 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,”

20. As to the similarity of the marks, she expressly applied this approach when she came to make her overall evaluation. She said:

“Global Assessment – conclusion on likelihood of confusion

24. In considering the likelihood of confusion therefore, it is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. MetroGoldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

25. Some of the goods are identical and these represent the high point of the opponent’s case. The respective trade marks have a number of features which distinguish them from one another with only a very low degree of visual similarity, a low degree of conceptual similarity and (at best) a very low degree of aural similarity. Further, the earlier trade mark is, at best, only averagely distinctive. It is true that the relevant public rarely have the opportunity to view trade marks side by side and so rely on an imperfect picture of them. However, it is likely that these purchases will be considered, perhaps highly so. In addition and as already stated, the trade marks have only a very low degree of similarity with a number of distinguishing features. These factors negate against imperfect recollection. There is considered to be no likelihood of confusion, even in respect of the goods which are clearly identical.”

21. I am unable to detect any error of principle or approach in this evaluation and the Hearing Officer was not clearly wrong.

(iii) *Distinctiveness of opponent’s mark and its good will*

22. The opponent criticises the hearing officer for failing adequately to evaluate the distinctiveness of the opponent's mark and its goodwill (I treat these two grounds together). Again, this is not a well-founded criticism. The Hearing Officer said at para. [23]:

“...The distinctiveness of a trade mark is to be assessed on the basis of the goods and services to which it is applied, from the perspective of the consumers of those goods and services. Prima facie and bearing in mind the goods to which it is applied, the earlier trade mark has relatively weak distinctive character. Indeed it was registered on the basis of distinctiveness having been acquired through use. However it is a registered trade mark and so has a presumption of distinctiveness. Its weak starting point means that it is considered to be no more than averagely distinctive as a result of the use made of it.”

23. That passage must be read together with the evaluation she made of the reputation of the mark for the purpose of the assessment under section 5(3) of the Act at para. [29] of the decision:

“29. The opponent has provided, in its evidence, details of sales together with examples of advertisements placed in national newspapers over a period of seven years from 2005 to 2012. The sales figures appear to be not insignificant, though there is no information on the number of units sold. Further, no information is provided as regards the size of the particular market as a whole, nor is there any information as to what these figures actually equate to in respect of market share. It is therefore impossible to place them into any meaningful context. It is noted that adverts have appeared in national newspapers. However, it is unclear as to their impact. Bearing in mind the nature of the goods here, the relevant public is the public at large. There is nothing in the evidence that leads to the conclusion that the earlier mark is known to a significant part of the public at large.”

24. She therefore held that the evidence provided in the case did not persuade her that the opponent's mark had a significant reputation. In those circumstances, she was justified in concluding that the mark was only averagely distinctive. Prima facie it would be reasonable to treat the term “NATURE'S BEST” as being descriptive of the goods in question and, it is unsurprising that proof of acquired distinctiveness was required before that mark could be registered. In that context, treating the mark as having average distinctiveness was, in the light of the evidence, a sensible assessment.

(iv) Level of attention of average consumer

25. On this issue, the Hearing Officer said the following:

“13. In respect of the class 5 goods, it is noted that these are purchased for the purpose of improving and/or maintaining health. They are likely therefore to be considered purchases, with a customer taking time to ensure the correct product is purchased, containing the correct ingredients in the required amount. It is considered therefore that a high degree of attention will be displayed during the purchasing process. Likewise in respect of the services, they are likely to represent a significant monetary outlay and will be chosen carefully and so again a high degree of attention will be expected. In respect of the class 3 goods, these will contain quite a range with some items being quite cheap and purchased frequently and others being more expensive and purchased less frequently. Bearing in mind this range, it is concluded that the average position is that such purchases are likely to be at least reasonably considered.”

26. Although I am not persuaded that this passage contains an erroneous evaluation, it would have been preferable to avoid reference to an “average” position. If there are goods within a class for which there would be a particularly high or low level of attention, that should be taken specifically into account for those particular goods. Nonetheless, it is important to bear in mind that the goods for which the mark is applied are food supplements and I consider that it is likely that more care is likely to be applied in selecting and purchasing those than for certain fast moving ordinary food items. The Hearing Officer was accordingly right in saying that such purchases were likely to be at least reasonably considered.

27. I do not therefore think that she made any error of substance in this aspect of her decision. That assessment of the average consumer properly fed into the assessment she made of the likelihood of confusion in the manner set out above.

CONCLUSION

28. For the reasons given, I am not persuaded that any of the grounds of appeal have been made out.

29. I would, however, say this. It struck me in considering the case that the mark applied for was slightly odd in that the term “NATURE’S BEST SELLERS” seemed like a somewhat artificial designation which may have been chosen to make a subtle association albeit falling short of a link of the kind required by section 5(3) of the Act but nonetheless some kind of subtle reference to the way in which the opponent’s products were marketed. Doubtless, if the applicant is trading at all, it would be well advised to ensure that its actual use and context of the mark registered was scrupulously fair and avoided any implication of connection with the opponent.

30. The appeal will be dismissed.

COSTS

31. In the circumstances, given the absence of significant engagement on the part of either side in this appeal, I propose to make no order as to costs.

DANIEL ALEXANDER QC

Appointed Person

10 May 2016

Representation: opponent/appellant: Nucleus IP Limited