

**O-237-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 3003118  
IN THE NAME OF CHRISTOPHER CAREW  
IN RESPECT OF THE FOLLOWING SERIES OF MARKS IN CLASSES 5 & 29:**

**Omega V  
&  
Omega-V**

**AND**

**AN APPLICATION FOR INVALIDATION (No. 500705) BY  
MARKANT HANDEL- UND SERVICE GMBH**

## **Background and pleadings**

1. Mr Carew filed the trade marks **Omega V** and **Omega-V** on 23 April 2013. They were published for opposition purposes on 4 October 2013. No opposition was received and, so, they were subsequently registered on 13 December 2013. The marks are registered in respect of the following goods:

**Class 5:** Vegetarian health food supplements for humans and for animals.

**Class 29:** Edible oils and edible fats

2. In terms of the matters that need to be determined by this tribunal, there is no material difference as between either of Mr Carew's marks. I will, therefore, refer to the marks in the singular, focusing on **Omega V**.

3. Markant Handel- und Service GmbH ("the applicant") seeks the invalidation of Mr Carew's mark. It relies on grounds under sections 5(2)(b), 5(4)(a), 3(1)(b) & 3(1)(c) of the Trade Marks Act 1994 ("the Act"). The first two grounds were pleaded when the application for invalidation was filed on 12 December 2014. The second two grounds were added later in the proceedings when it came to the applicant's attention that Mr Carew's mark, for reasons that will become apparent, may be descriptive/non distinctive. Mr Carew made some comments in writing as to why he thought the request to amend should be rejected, however, I allowed the request and Mr Carew did not ask to be heard on that matter. He was, though, given an opportunity to file further evidence directed at the new grounds, an opportunity he availed himself of.

4. In terms of the ground pleaded under section 5(2)(b), the applicant claims that there is a likelihood of confusion with its mark detailed below:

European Union Trade Mark ("EUTM") registration 6685614 for the mark **OMEGA** which was filed on 21 February 2008 and registered on 5 July 2010. The mark is registered for the following goods:

- Class 29:** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, edible oils and fats.
- Class 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, except bread mixes and prepared baking mixes (not included in other classes), for making bread; pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
- Class 32:** Beers; non-alcoholic drinks except for waters and lemonades; fruit drinks and fruit juices; syrups and other preparations for making beverages

5. The applicant's earlier mark carries three separate UK seniority dates, but these are not pertinent given that the opponent's mark is earlier than Mr Carew's mark purely on the basis of its filing date. The other matter to note is that the applicant's earlier EUTM was registered less than five years before the date on which the applicant filed its claim in these proceedings. The consequence of this (in contrast to marks that have been registered for more than five years) is that the applicant is entitled to rely on its earlier mark for all of the goods for which it is registered without having to prove that it has been used. Section 47(2A) of the Act refers.

6. Under section 5(4)(a), the applicant pleaded its case on the basis of its use of the sign **OMEGA** since 1959 in relation to "...a range of food and drink products". However, the applicant filed no use of its mark during the evidence rounds and, as indicated in its written submissions, no longer pursues the ground. Consequently, I will say no more about this pleading.

7. The claims under sections 3(1)(b) & (c) are similar. It is claimed that the word OMEGA is widely used in relation to goods which contain omega fatty acids. It is claimed that the addition of V to the mark will be seen as a reference to either vegetarian/vegan products (i.e. as an abbreviation of those words), or that the product

is/contains omega 5 fatty acid (i.e. that V will be seen as the Roman numeral for the number 5). The applicant considers the mark to be descriptive and/or non-distinctive for these reasons.

8. Mr Carew filed a (amended) counterstatement defending his registration. He put the applicant to proof of use of its earlier EUTM in the last five years. However, as I have already explained, the proof of use provisions are not applicable to the EUTM because it had not been registered for five years or more at the date on which the application for invalidation was made. In relation to the section 3(1)(b) and (c) grounds, the main points made by Mr Carew are that:

- i) The meaning of "V" is difficult to discern.
- ii) Roman numerals are never used when describing omega oils.
- iii) There is a lack of evidence showing that the mark is descriptive, or how it could be descriptive (Mr Carew had seen the opponent's evidence by the time he filed his amended counterstatement).
- iv) The mark would be seen as OMEGA VEE not OMEGA 5.

9. In relation to the ground under section 5(2)(b), Mr Carew's primary point is that there will be no confusion because the word OMEGA is wholly descriptive and, as such, consumers will not believe that the goods come from the same economic source simply because both marks contain/comprise a descriptive term. He adds that the V in his mark will, therefore, distinguish it from the applicant's mark.

10. Mr Carew has represented himself throughout the proceedings. The applicant is represented by Haseltine Lake. Both sides filed evidence. Neither side asked for a hearing, both filing written submissions instead.

## **The evidence**

### **The applicant's evidence**

11. This comes in the form of a witness statement from Ms Heather Orr, a trade mark attorney at Haseltine Lake. Her witness statement contains no real commentary (which would have been helpful), but simply provides exhibits which she says are the results of her research, ostensibly on the Internet. The exhibits are as follows:

- Exhibit HO2 – This contains Internet prints from the websites of Boots, Healthspan and Planet Organic. They show numerous products that contain omega 3. Sometimes they contain omega 3, and/or 6 and/or 9. There is nothing showing omega 5. One describes the product's content as "omega oil blend", another as "omega excellence organic flax oil". One is for the product "Lifestream V-Omega 3"; it is not clear from the packaging what the V is meant to represent, if anything.
- Exhibit HO3 – This contains articles and extracts from the websites of The Food Standards Agency, the Vegetarian Society, Newcastle University, Tesco, Sainsbury's, Health+Plus, and Boots. This shows that a number of undertakings use the letter V as an indication that the products in question are suitable for vegetarians. Some, but not all, also have the words vegetarian written underneath. The designations are presented in a circular or polygon shaped border. There is one use on a vitamin product; the trade mark on the product is Boots, the description is VITAMIN B COMPLEX, underneath which are three separate squares, one carries the words "60 TABLETS", the next "ONE A DAY" and the last "V".
- Exhibit HO4 – This contains extracts from the websites of optimumnutritionist, healthbay and stratfordrx. This shows three products that use the letter V in their name. V PURE Omega 3, a vegetarian/vegan alternative for omega 3 fish oil supplement; Lifestream V-Omega 3, the label of which shows that it is a vegetarian product and the website itself carries various designators, one of

which is a V in a circle; finally, there is Omega-V3, an omega 3 product for animals; this is not sold on the basis of being vegetarian, indeed, the ingredients suggest that it is not a vegetarian product on account of the inclusion of bovine gelatine.

- Exhibit HO5 – This consists of articles from the websites of the Biolab Medical Unit in London and the National Center for Biotechnology Information (NCBI) in the US and, also, articles and blogs from pomega5.com, naturalhealth365.com and eatingdisorderpro.com. The article published by Biolab dates to 2012 and reports on “Essential Fatty Acid”. Much of the article is about the success of the use of the omega 3 fatty acid, but notes that research has been ongoing in relation to others, including omega 5. The articles from NCBI date from 2010 and relate to the omega 5 fatty acid found in pomegranate seed oil. The report suggests that omega 5 fatty acid has particular properties that may inhibit breast cancer. The extract from Pomega5 is from a US website. It is, again, about the health properties of omega 5 found in pomegranate seed oil, which is suggested to be a good antioxidant. Natural Health 365 is not obviously a UK website, but, again, it discusses omega 5 (and omega 7) and its positive health effects (in this article, the benefit appears to be an anti-aging effect). The eatingdisorderpro website appears to be a US website. It discusses omega 5, 7 and 9 fatty acids, the health benefits and sources of the product.
- Exhibit HO6 - This consists of extracts from the websites of gourmetastic.com, purtianpride.co.uk, solgar.co.uk, nutrition valley.co.uk and tesco.com. The first (priced in pounds) is for an omega 5 product (described as organic pomegranate seed oil) sold in capsule form, the next is an all in one omega 3, 5, 6, 7 & 9 capsule, the next is for a spectrum of omega fatty acids (the ingredients show that omega 5 is included), the next is another full spectrum product described as a full spectrum omega 3-5-6-7-9 supplement, and, finally, a hair restoring treatment which contains pomegranate seed oil rich in omega-5.

- Exhibit HO7 – This contains an extract from the website of gridhealthliving.co.uk including “Formula IV, multivitamin and mineral capsules” and a print from uk.shop.com for “Heart Health Essential Omega III Fish Oil with vitamin E”.
- Exhibit HO8 – This consist of extracts from 10 UK websites in the nutritional/supplement field. It is not altogether clear what is intended to be taken from this exhibit beyond the fact that supplements can be added to a variety of foods such as food in bar form. I will return to the exhibit later if it becomes necessary to do so.
- Exhibit HO9 – This consists of an extract from the website webmb.boots.com about the use of flax seed as an alternative to omega 3 which can be mixed with liquid or food for ingestion. There is also an extract from the website thenaturalhealthmarket.co.uk about the benefits of chia seed which contains omega 3, 6, 5, 7 & 9 and which can be used in items such as smoothies and cake mixes.
- Exhibit HO10 & HO11 – This consists of product listings from the websites of GoodnessDirect and Planet Organic (Exhibit HO10) and Holland & Barrett and Boots (Exhibit HO11), products which are listed in pounds. Again, it is not altogether clear what the tribunal is asked to take from this, so I will return to it later if necessary.
- Exhibit HO12 – This contains website prints relating to the general business of Holland & Barrett and Boots – there is nothing pertinent to record in relation to this.

12. Ms Orr’s witness statement also contained Exhibit HO12, but this was struck out because it comprised without prejudice correspondence.

### **Mr Carew’s first witness statement**

13. Like the evidence of Ms Orr, Mr Carew’s evidence contains a number of exhibits:

- Exhibit CC1 – This consists of a self-standing statement containing Mr Carew’s comments on the applicant’s evidence, a commentary of his own, and

submissions as to why his defence should succeed. I will not detail this here, but will bear the submissions in mind.

- Exhibit CC2 – This consists of a decision of the opposition division of the EUIPO (previously OHIM) in relation to a dispute between the applicant and an unrelated (to these proceedings) party with regard to the marks OMEGA v OPTI OMEGA. Mr Carew highlights that the opposition division held, based on the “current practice of the office”, that goods in class 29 were different to goods in class 5 (which included dietary supplements). Mr Carew suggests that as the applicant’s mark is a EUTM, such an approach should be adopted throughout all Member States.
- Exhibit CC3 - This consists of the details of a UK trade mark registration (no. 1486829) in the name of the applicant for the mark OMEGA which dates from 1991 and was registered in 1995. Mr Carew suggests that because the mark has been registered for so long, proof of use should be provided. I will deal with this submission now. The proof of use requirements relate to the mark relied upon, which, as observed earlier, had been registered for less than five years. Consequently, there is no need for the applicant’s earlier mark to face the proof of use burden.
- Exhibit CC4 – This contains documents to show that the applicant has no presence in the UK. This is not relevant due to the point made above (even then, proof of use of an EUTM does not necessarily require use in the UK) and, also, because of the applicant no longer pursuing its section 5(4)(a) claim (which I accept would have required customers in the UK).
- Exhibit CC6– This contains a copy of the EU regulations concerning food labelling and health claims made on food products. Mr Carew’s point is that it would be illegal to have the word OMEGA on a food product that did not contain any omega oils and that this also applies in the context of trade marks. In his accompanying statement, Mr Carew states that “further consideration to be placed onto the lack of distinctive character of the applicant’s registered OMEGA trade mark within classes 5 and 29”. As I will explain later, in the



absence of Mr Carew filing a claim to invalidate the applicant's earlier EUTM, it must be assumed to be a validly registered mark.

- Exhibit CC7 – This consists of a large number of prints of other EU and UK marks which, in some form or another, include a V. Even without making too much of the fact that this is just state of the register evidence (which is largely not relevant), none of these marks appear to be on all fours with the subject mark. There is nothing to show that it is the V element that makes them distinctive in totality. I place little weight on this evidence.
- Exhibit CC8 – This consists of more state of the register evidence, this time in relation to marks which contain the word OMEGA (in the relevant classes, albeit mainly in class 5) (which I accept is a fairly large number). Mr Carew highlights the other aspects of the marks which he states shows how the brands differentiate themselves from each other. For example, the marks include OMEGA SMART, FEMME OMEGA, OPTI-OMEGA and OMEGA LIFE.
- Exhibit CC9 – This consists of a large number of prints of products (mainly supplements) which contain omega of one type or another and use that word as part of the branding, albeit with additional elements, including get-up.
- Exhibit CC10 – This consists of searches Mr Carew has undertaken on the websites of Boots, Holland & Barrett and Amazon (UK). There is a Boots search for the term “omega 3” which brings up a number of supplements which contain omega 3, a search for “omega iii” which brings up no results, a search for omega 5, the first 6 results provided (out of 111) make no reference to omega 5, and a search for “omega v”, with the first 6 results (of 22) making no mention of omega 5 or omega v. The Holland & Barrett searches bring up a number of products for the omega 3 search, but nothing for omega iii, omega 5 or omega v. The Amazon searches bring up a number of products for the omega 3 search, the omega iii search also brings up a number of results but for omega 3, not iii (other than an import CD), and the omega 5/V search brings up nothing relevant.

- Exhibit CC11 – This contains prints from Amazon, Tesco and one unidentified source aimed at showing that V can have multiple meanings and can provide distinctive character. Some of the goods listed are not relevant. Given the size of print, it is not possible in respect of most of them to work out whether the use of the V as part of the name is meant to mean something. Two drink products (V Energy Drink and V Kat Schnapps) make no reference to V standing for anything.
- Exhibit CC12 – This includes extracts from a database provided by the EU Register on Nutrition and Health Claims. It is not altogether clear what search terms were input to extract the results, but Mr Carew provides a number of extracts which show that certain omega 3 ingredients have been authorised as having some health benefits. Mr Carew states that nothing has been approved for omega 5. The extracts he provides are for conjugated linoleic acid which make no mention of omega 5. It is not clear whether this is a source, or only source, of omega 5.
- Exhibit CC13 – This contains a print of the OMEGA III product provided in Ms Orr's Exhibit HO7. Mr Carew highlights that it is a US product and, further, the website from which Ms Orr obtained her print is a market type website (such as Ebay or Amazon) where anyone can put products up for sale.
- Exhibit CC14 – This contains an extract from the Food Standards Agency concerning vegetarian and vegan labelling. It stresses that there is no legal definition of the terms and that the industry uses the expressions vegetarian or vegan voluntarily, and that if such terms are not present then consumers rely on the ingredients list. There is no information regarding symbols which may or may not be used. Mr Carew states that if something is vegetarian or vegan then the industry will use the whole word.
- Exhibit CC16 – This consists of a print of the OMEGA-V3 product which shows that it is a US product.
- Exhibit CC17 – This consist of an earlier decision issued by this tribunal between the applicant and an unconnected (to these proceedings) party

involving the marks OMEGA v OMEGASMART/OMEGAMAYO/OMEGABEE. The result was that the opposition succeeded in relation to OMEGAMAYO but failed in relation to the other two opposed marks.

- Exhibit CC18 – This consists of another decision issued by this tribunal in connection with the distinctiveness of the marks PAYM and PAYR, which were held to be distinctive. The point being made is that a letter can provide distinctive character.
- Exhibit CC19 – This consists of information about a product called V+Cola which Mr Carew believes to show how the addition of a distinctive element can create an overall distinctive brand identity.

### **Mr Carew's further evidence**

14. Mr Carew's second witness statement was filed subsequent to the addition of the grounds under section 3(1)(b) and (c):

- Exhibit CC20 – This consist of a series of email exchanges Mr Carew had with persons working for various Trading Standards authorities. The essence of his questions are i) would the V in Omega V be enough to indicate to a consumer that the product is vegetarian? ii) how common is it for Roman numerals to be used to signify whether something is omega 3, 6 or 9? and, iii) if omega 5 existed, would Omega V be expected to an omega 5 product? Ms Harris from Solihull Trading standards replied to this email on 20 November 2015, she answered question i) (but not the others) by saying that she “personally” would not perceive the product as vegetarian. Another response was received from Ms Vaudrey (who had spoken to a colleague) at Oldham County Council; she does not believe that the mark will signify a vegetarian product, that omega 3 is usually written in number form rather than Roman numerals (she suggests not using the V to avoid any confusion) and, finally, as far as she knows, omega 5 is not a known name. Mr Milligan from the London Borough of Tower Hamlets responded stating that V would not be enough to signify vegetarian as the word and/or the vegetarian tick would also be used. A Mr Blacklock responded from

North Yorkshire County Council, he states that a producer needs to give a true name for the product, which omega v does not, and that one does not have to say whether the product is vegetarian, but this may be desirable. Finally, Mr Brew from Staffordshire County Council states that the name alone would not be sufficient to indicate that the product is vegetarian, nor should the Roman numeral be used to indicate what omega product it is because this would be confusing.

- Exhibit CC21 – This is an extract from literature issued by the Department of Health relating to nutritional legislation setting out which authorities have particular roles with regard to food standards and labelling.
- Exhibit CC22 – This consists of around 15 email responses Mr Carew received from a variety of retailers in the UK who sell, amongst other items, supplements. The email being responded to is not always given, but from the content of what I have seen, the question posed is “Do you stock Omega V”. All bar one responded stating that they did not. The one that did was apparently asked an erroneous question “Do you stock Omega”. Some of the respondents simply apologised for not having the product, others pointed Mr Carew in the direction of other omega based products.
- Exhibit CC23 – This consists of website prints showing a large number of products which contain omega (most often omega 3), none of which use Roman numerals.
- Exhibit CC24 – This consists of European Regulations concerning food supplements. Mr Carew highlights paragraph 9 of the recitals which indicate that only vitamins and minerals normally found in and consumed as part of the diet should be allowed to be present in food supplements. Mr Carew states that omega 5 would not fit this criteria as it does not describe the goods of his registration (including edible oils and fats).
- Exhibit CC25 – This consists of extracts from NHS literature about food supplements. Mr Carew highlights a flow chart which is to assist the reader identify whether something is a food supplement. One of the questions to get

to that answer is whether the product has a nutritional or physiological effect. Mr Carew states that omega 5 does not, so is not a food supplement.

- Exhibit CC26 – This consists of various documents about “novel food”. Essentially, novel (new) foods must have their safety for human consumption assessed before being approved for use on the marketplace. The documents include the relevant EU Regulations. In this respect, Mr Carew sent an email to the Food Standards Agency questioning whether Omega 5 had novel food approval, and, also, whether omega v would be sufficient to indicate that the product is an omega 5 one. A response was received from Ms Roberts who advised that there has been no novel food approval to date, nor is she aware of omega 5 extract having a history of consumption in the EU prior to 1997. The second of Mr Carew’s questions is not answered.
- Exhibit CC27 – This consists of Internet searches and prints for omega 5 which revealed non-relevant hits such as a pumping product. There are also a number of articles about omega oils, none of which mention omega 5, with comparisons being made between omega 3, 6, 7 and 9.
- Exhibit CC28 – This consists of a print out and trade mark details for an OMEGA 7 product, but it is not clear why this is pertinent. There are then printouts from the website of eatingdisorderpro, Puritan’s Pride, Natural Health 365 and Pomga5 showing that these are US sources (the sources are those referred to by Ms Orr in her exhibits HO4/5). Finally, there is an extract from vitagrana.com, but, again, its relevance is not clear.

### **Sections 3(1)(b) and (c) of the Act**

15. These two provisions prevent, respectively, registration of trade marks which are “..devoid of any distinctive character” or “..consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”.

16. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that registration shall not be refused if the trade mark has acquired a distinctive character through use. However, as no use has been made of the applied for mark (or at least none filed), the proviso is not pertinent in these proceedings.

17. It must be borne in mind that the two grounds under discussion are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

18. In terms of section 3(1)(c), this is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 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 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C- 191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.



49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

19. In terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as *OHIM* points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the

same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

20. In terms of distinctiveness and descriptiveness, this must be assessed via the perception of the relevant public – as well as average consumers of the goods, this also includes those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I- 1725, paragraph 50).”

21. The ground pleaded under section 3(1)(b) suggests that the mark is devoid of distinctive character because it is descriptive. I will, therefore, consider the descriptiveness objection under section 3(1)(c) in the first instance. There are two separate claims. First, that the mark describes a product which consists of, or contains, an omega oil that is vegetarian (or vegan). Secondly, that the mark describes a product which consists of, or contains, omega 5 oil. That there are two potential descriptive meanings as the basis for the objection does not render the mark acceptable. As indicated at paragraph 92 of the *Starbucks* case, double descriptiveness does not matter; so long as one possible meaning is descriptive, that is the end of the matter:

“92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

### **The vegetarian descriptive meaning**

22. As a starting point, it is worth observing that Mr Carew accepts that the word OMEGA is a wholly descriptive word in relation to the goods for which his mark is registered. The question is whether the mark as a whole, with the addition of V, is also descriptive.

23. I accept that V, in some contexts, is used by undertakings in the food industry to indicate that food is suitable for vegetarians. However, the evidence shows that it is most often used as a self-standing designation and/or used together with wording to indicate its suitability for vegetarians. I also accept that the goods of the registration can be vegetarian. The edible oils and fats could be vegetarian, as could the supplements. Indeed, Mr Carew’s specification in class 5 specifically states that the health food supplements are vegetarian.

24. Ms Orr’s evidence shows some products that have the letter V in their name, but there are only three, and then, only two are for vegetarian products. Therefore, this does not establish that relevant consumers have become accustomed to seeing the letter V, as an abbreviation for vegetarian, used in brand names. The question, though, is still whether the mark will be perceived as a description. In my view, if a trader wished to describe that its goods were an omega product suitable for vegetarians, I consider it highly improbable that it would use a description comprised of OMEGA V. The resulting description would simply not be precise enough to communicate that intended descriptive meaning. Whilst there may be a need to keep the word OMEGA free for descriptive use, and, also, there may be a need to keep the letter V free for descriptive use, there is no need to keep the combination OMEGA V free for descriptive use. I dismiss the section 3(1)(c) objection to the extent that it is based on the goods being vegetarian, the same applies to vegan.

25. Under section 3(1)(b), the pleading is made on the basis that the mark is devoid of distinctiveness on account of its descriptiveness. If that is the case then it follows that the ground under section 3(1)(b) must also be dismissed given my finding that the mark is not descriptive. However, for sake of completeness, I observe that I can see no other reason why the ground under section 3(1)(b) should succeed independent of the ground under section 3(1)(c).

### **The omega 5 descriptive meaning**

26. The applicant's case is that Omega V is descriptive of goods comprising or containing omega 5, the V being seen as the Roman numeral for the number 5. As a starting point, it is clear that omega is the name given to types of fatty acid. To differentiate the different types, a codifying number is added. Omega 3 is the most well-known, this is borne out by the evidence. There is also evidence that omega 6 and 9 are also known (albeit I am sure to a lesser extent). The evidence is less convincing with regard to omega 5. Whilst it may, as a matter of fact, exist, much (although not all) of the evidence about its properties is from overseas (the US). Even then, its significance does not appear to be overwhelming. This may be down to omega 5 being a more recent discovery and/or its beneficial properties having been less established. I accept that there is evidence of a small number of supplement products that contain omega 5 being sold in the UK. Two of the four supplements shown in evidence (the fifth document in HO6 is a hair care product) use omega 5 on the packaging in a fairly clear manner. The third and fourth uses are less noticeable, unless one were to look at the ingredients list and/or promotional blurb. However, the extent to which such products have been sold or stocked is not known. There is nothing to suggest that omega 5 has been promoted in the UK in press articles or the television. I suspect that Ms Orr has trawled the Internet for supporting evidence (as is her job) and what has been filed represents the totality of potentially relevant evidence. This appears to be supported by the fact that Mr Carew's searches on websites that sell nutritional supplements led to him finding no results.

27. What I have said above leads me to conclude that omega 5 is known by an insignificant number of people in the UK. That being said, there will be more people who, if they encountered the word/numeral combination omega 5, would assume,

based on their knowledge of omega 3 and the use of codifying numbers, that omega 5 is something similar. There is, of course, no requirement for a mark to be in current use for it to fall foul of section 3(1)(c). For that reason, together with the fact that omega 5 does exist, means that had the mark been Omega 5, I would likely have held that there was a need to keep this free for future use of traders in this field, at least in respect of the field of supplements. The need to keep free for future use therefore undermines Mr Carew's point about novel food status, put simply, even if what Mr Carew states is correct (although I have reservations that the simple question he put to one representative at the Food Standards Agency is sufficient to establish the point), this would not matter. Mr Carew also argues that omega 5 cannot be a supplement, therefore omega V cannot possibly describe his goods. Whilst noted, I am not satisfied that omega 5, as an extract of pomegranate seed oil, does not, or could not, fall within the definition of food supplements.

28. Regardless of what is said above about omega 5, the question is whether Omega V is descriptive. The applicant's evidence on the use of Roman numerals for the goods at issue is weak. I cannot find that this it is usual for Roman numerals to replace numbers in this field. Indeed, the evidence paints a picture that it is (virtually) always the case that numbers are used. I do not place much weight on Mr Carew's evidence from the Trading Standards Officers. Some did not answer the question relating to the use of Roman numerals and, for those that did, it is clear that some of them did not really understand the context of what they were being asked.

29. The applicant highlights that in his original counterstatement, Mr Carew stated that the V in his mark was used due to the business being founded by 5 friends. Thus, Mr Carew has accepted that the V will be perceived as a Roman numeral (although, I note that this did not make its way into Mr Carew's amended counterstatement filed when the section 3(1) grounds were added). I do not consider that this equates to an acceptance that the mark will read as OMEGA 5.

30. I accept that most people will know what Roman numerals are. V may not, though, be the most obvious Roman numeral. I come to the view that the combination of the lack of knowledge of omega 5 in the UK, together with the unusualness of interchanging numbers and Roman numerals in this field, means that the mark will not

be perceived by the relevant consumer as a description. Again, the message is simply to imprecise. This imprecision also means that the need to keep free argument fails. I dismiss the section 3(1)(c) objection to the extent that it is based on the goods being omega 5. As with the objection based on vegetarian omega products, the applicant is no better off under section 3(1)(b).

### **Section 5(2)(b)**

31. Section 5(2)(b) of the Act states that:

“5.-(2) A trade mark shall not be registered if because – ..

(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.”

32. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;



(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

33. When making a comparison, all relevant factors relating to the goods in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (CJEU) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

34. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

35. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

36. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

37. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

38. The position with regard to the applied for goods in class 29 “Edible oils and edible fats” is straightforward. This is because the earlier EUTM contains in its class 29 specification the term “edible oils and fats”. The goods are identical.

39. The position of the applied for goods in class 5 requires more analysis. The goods concerned are:

**Class 5:** Vegetarian health food supplements for humans and for animals.

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

The goods of the earlier EUTM read:

- Class 29:** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, edible oils and fats.
- Class 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, except bread mixes and prepared baking mixes (not included in other classes), for making bread; pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
- Class 32:** Beers; non-alcoholic drinks except for waters and lemonades; fruit drinks and fruit juices; syrups and other preparations for making beverages

40. The only potential I can see in terms of establishing similarity is that certain food products (for example, edible oils and fats) may be enriched with the type of ingredients contained in food supplements. To illustrate the point, a vegetable oil spread (an edible fat) may contain omega 3 as an added ingredient. However, the nature of a food supplement is very different to an edible oil/fat, as is the method of use. The purpose only partially overlaps, in that both could be consumed for added health benefits, but the primary purpose of an edible oil/fat is not for this. The users will be the same, but this is not really pertinent because they are general consumer goods. Whilst the goods could be sold in the same stores (such as supermarkets), there is nothing to suggest that they are sold in close proximity. Whilst I have borne in mind the decision of the EUIPO referred to by Mr Carew (which referred to such goods being dissimilar), I do not go that far (and I am not bound to follow it anyway); nevertheless, I consider any similarity to be of only a low degree based on the factors I have assessed.

## **Average consumer and the purchasing act**

41. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

42. Be it the class 5 or class 29 goods, the goods are purchased by members of the general public. Edible oils and fats are fairly frequent purchases and are relatively low cost items. They will be purchased in a casual manner. Supplements are less frequent purchases, but are still fairly low cost. The packaging will be subject to closer scrutiny to ensure that the supplement is fit for the desired purpose. I consider that an average level of consideration will be adopted when they are selected. Both sets of goods will most likely be chosen through self-selection, be it in store or through a website. This suggests that the selection is more of a visual act, however, I will not ignore the aural impact of the marks completely.

## **Distinctive character of the earlier mark**

43. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma*

AG, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

44. Part of Mr Carew’s evidence and submissions is based upon a claim that the applicant’s mark is not distinctive. However, as I alluded to earlier, there is a presumption of validity in relation to a registered trade mark. Section 72 of the Act reads:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

45. Furthermore, the judgment of the CJEU in *Formula One Licensing BV v OHIM* specifically indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character; the CJEU stated:

“42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).

45. Such a finding would be detrimental to national trade marks identical to a sign considered as being devoid of distinctive character, as the registration of such a Community trade mark would bring about a situation likely to eliminate the national protection of those marks. Hence, such a finding would not respect the system established by Regulation No 40/94, which is based on the coexistence of Community trade marks and national trade marks as stated by the fifth recital in the preamble to that regulation, given that the validity of an international or national trade mark may be called into question for lack of distinctive character only in cancellation proceedings brought in the Member State concerned by virtue of Article 3(1)(b) of Directives 89/104 and 2008/95.

46. It should be noted that Article 8(2)(a)(ii) of Regulation No 40/94 expressly provides, in opposition proceedings, for trade marks registered in a Member State to be taken into consideration as earlier trade marks.

47. It follows that, in order to avoid infringing Article 8(1)(b) of Regulation No 40/94, it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based.”

46. In view of the above, the applicant’s OMEGA mark must be considered as a distinctive trade mark, capable of indicating trade origin, in relation to the goods for which it is registered. However, given the nature of the mark and the significance that omega fatty acids such as omega 3 has (even in relation to edible oils and fats), such distinctiveness is low.

### **Comparison of marks**

47. 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. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

48. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:



## **OMEGA v Omega V**

49. In terms of the overall impression of the applicant's mark, it comprises just the word OMEGA which, therefore, is the only element which contributes to its overall impression.

50. In terms of the overall impression of Mr Carew's mark, neither the word Omega nor V is given any form of prominence above the other, nor does it hang together as an obvious unit. However, Omega is at the beginning of the mark and makes up a much greater proportion of the mark as a whole.

51. Conceptually speaking, both marks make reference to omega, as in the Greek letter or a type of the fatty acid (such as omega 3). Mr Carew's mark has the added concept of the letter V. Overall, there is a reasonably high degree of conceptual similarity

52. Visually, the common presence of the word Omega/OMEGA creates an obvious point of similarity. The difference in casing does not create a difference because the earlier mark may be used in both upper and lower case script. The addition of the V creates a difference, but being at the end of the mark and only a small part of it as a whole means that the difference is not stark. I consider there to be a high degree of visual similarity.

53. From an aural perspective, the marks will be articulated as OM-E-GA against OM-E-GA-VEE. There is, in my view, slightly less aural similarity than there is visual similarity, but there is still a reasonably high level of aural similarity.

### **Likelihood of confusion**

54. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) but a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). 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.

55. I will consider the matter in relation to the applied for “Edible oils and edible fats”. Here the goods are identical, goods which are purchased in a fairly casual manner. The earlier mark is low in distinctive character in relation to such goods. However, the fact remains that the earlier mark must be regarded as indicating trade origin for the goods under discussion. That puts pay to most of Mr Carew’s arguments, arguments which are based upon the absence of distinctiveness and that consumers will readily distinguish between marks which have the word OMEGA in them. My finding is that there is a likelihood of confusion. The average consumer may overlook the letter V or may simply assume (because OMEGA is distinctive) that the Omega V product is just some form of sub-brand.

56. The position is different in relation to the supplements in class 5. Here, there is only a low degree of similarity between the goods. Further, whilst the earlier mark is to be regarded as distinctive in relation to the goods for which it is registered, the word OMEGA does not need to be regarded as distinctive for supplements. It clearly is not. Further, greater care will be used when selecting the goods compared to those assessed above, albeit, to an average level. Therefore, despite the similarity between the marks as assessed earlier, there is no likelihood of confusion. The common use of the word OMEGA, even though it may be distinctive for the earlier mark’s goods, will still be put down to co-incidence not economic connection. The use of that word in relation to supplements will be put down to a descriptive use, thus, the addition of V in such circumstances is enough to distinguish.

## **Conclusion**

57. The outcomes are as follows:

- The opposition fails in relation to class 5 under section 5(2)(b).
- The opposition succeeds in relation to class 29 under section 5(2)(b).

- The opposition fails for both classes under sections 3(1)(b) and (c)
- Mr Carew's registration is deemed never to have been made in respect of:
  - **Class 29:** Edible oils and edible fats
- Mr Carew's registration may remain registered in respect of:
  - **Class 5:** Vegetarian health food supplements for humans and for animals.

### **Costs**

58. The partial success/failure of the application means that I would ordinarily not have favoured either side with an award of costs. However, given the late addition of grounds, grounds which failed, and grounds which led to further evidence being filed by Mr Carew, I consider it appropriate to make a small award of £250 to reflect the additional time and effort that resulted.

59. I therefore order Markant Handel- und Service GmbH to pay Mr Christopher Carew the sum of £250. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>TH</sup> day of May 2016**

**Oliver Morris**  
**For the Registrar,**  
**The Comptroller-General**