

**O-056-21**

**TRADE MARKS ACT 1994**

IN THE MATTER OF

APPLICATION No. 3404906 TO REGISTER

AS A UK TRADE MARK IN CLASS 5

**nakedbiotics**

IN THE NAME OF EFFICIENT MICROBES LTD

AND

OPPOSITION No: 417764 THERETO

BY NAKED WHEY INC. DBA NAKED NUTRITION

## BACKGROUND AND PLEADINGS

1. On 6 June 2019, Efficient Microbes Limited (“**the Applicant**”), applied to register as a UK trade mark the word mark “nakedbiotics” in respect of the following goods in Class 5:

*Nutritional supplements in drink form; Preparations and food additives for the strengthening [sic] of the intestinal flora and the stimulation [sic] of beneficial intestinal bacteria; Dietary and nutritional supplements*

2. On 20 September 2019, Naked Whey Inc. DBA Naked Nutrition (“**the Opponent**”) filed a notice of opposition against the application (having filed a notice of threatened opposition on 19 August 2019). The opposition is directed against all the goods of the application and the sole ground relied upon by the Opponent is section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”), which reads as follows:

“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”.*

3. The earlier trade marks relied on by the Opponent were all filed on 13 October 2017 (and registered on 18 April 2018) as EU trade marks for goods in Class 5 (collectively “**the EUTMs**”).

EU017323321: NAKED NUTRITION

EU017323403: LESS NAKED

EU017323379: NAKED MASS

4. The Opponent relies in these proceedings on the following goods under its registrations:

*Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Dietary supplements and dietetic preparations; Dietary food supplements; Dietary supplement drinks; Dietary supplements consisting of vitamins; Dietary supplements for humans not for medical purposes; Health food supplements for persons with special dietary requirements; Mineral food*

*supplements; Powdered nutritional supplement drink mix; Food supplements consisting of amino acids; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Vitamin and mineral supplements; Powdered nutritional supplement energy drink mix; Probiotic supplements; Nutraceuticals for use as a dietary supplement; Medicated food supplements; Dietary and nutritional supplements.*

5. The essence of objection on section 5(2)(b) grounds is that the Opponent has registered trade mark rights, obtained before the Applicant applied to register the contested trade mark, where there is similarity between the parties' respective marks, and where the goods at issue are identical or similar, such that there is likely to be confusion among the average consumer group as to the source of the goods. The Opponent elaborates its claims in support of the section 5(2)(b) ground in various ways:
- (i) it relies on the similarity of the applied-for mark to each or any of the EUTMs **individually**;
  - (ii) it argues that the average consumer would understand the applied-for trade mark, "nakedbiotics", as a combination of the separate words "naked" and "biotics" and that the lack of spacing between the two words is of no significance;
  - (iii) it asserts that it is the "naked" component which is the **dominant and distinctive element** of the marks at issue, and the position of that common element "naked" at the start of the applied-for mark leads to it having greater prominence and resonance for the average consumer. It submits that the word "naked" does not have a specific and generally understood meaning for any of the goods in issue, and is distinctive because it does not directly describe, but merely alludes to wholesomeness, purity and natural good health and fitness, which it submits are mainly aspirational qualities as opposed to concrete qualities of the goods themselves;
  - (iv) it submits that in the applied-for trade mark the "biotics" component is non-distinctive as it describes the intended goods. It claims that "biotics" has a particular meaning in the health foods and supplements sector in the sense of "probiotics", which it states are, according to the Association of UK Dietitians, "good" bacteria found in food products or supplements that can beneficially affect health by improving the balance and function of the gut bacteria;

- (v) it claims that it has a **'family of marks'** and that the applied-for mark is similar to **the EUTMs collectively**, on the basis of its displaying characteristics capable of associating it with the family, namely, its use of the term 'naked' in relation to identical or similar goods;
- (vi) paragraph 4.1 of the statement of grounds states that average consumers will be aware of the Opponent's "family of 'NAKED' brands as a whole", which extends beyond the three registered trade marks (the EUTMs) and involves the Opponent's earlier use of various **unregistered** marks such as "NAKED PEA", "NAKED PB", and "NAKED ENERGY", which it states are all marketed in the UK under the Opponent's "house brand" 'NAKED NUTRITION'" in relation to dietary supplements, and promoted on social media such as Facebook, Twitter and Instagram;
- (vii) The Opponent claims that its "family of brands" confers an **enhanced distinctiveness** to the Opponent's EUTMs and that the applied-for mark is just the sort of mark that the Opponent might add to its portfolio of "NAKED" marks, and members of the public will believe it to be part of the family, **originating from the same or connected undertaking**;

6. I also note that the three earlier EUTMs relied on had been registered for less than five years when the Applicant filed its application. The earlier marks are consequently not subject to the proof of use provisions under section 6A of the Act and the Opponent may rely on the protection afforded to its registered goods as specified.

### **The Applicant's defence**

7. The Applicant filed a notice of defence, denying the claims. I note the following points from the counterstatement:
- (i) the Applicant admitted that the respective goods are identical or similar;
  - (ii) the Applicant denied that the word "NAKED" is distinctive of the Opponent, arguing that other entities have registered and use trade marks that include that word in respect of identical and similar goods. It stated that, in open correspondence before the opposition was filed, the Applicant had sent the Opponent an example of another

entity that had registered NAKED” in combination as a trade mark and had used its mark in Class 5;

- (iii) it denied that the Opponent’s EUTMs have an enhanced distinctiveness and denied that the contested mark creates a likelihood of association;
- (iv) it denied that the Opponent’s EUTMs form part of a family of ‘NAKED’ trade marks, arguing that the Opponent does not have exclusive rights to trade marks that include the word “NAKED”;
- (v) it denied that the Opponent has a family of trade marks in the UK at all and argued that the Opponent’s *unregistered* rights were not relevant to an opposition that is based solely on section 5(2) of the Act and “should be struck out”;
- (vi) it admitted that no significance attached to there being no space between the words “naked” and “biotics”, but denied that the applied-for mark “nakedbiotics” is similar to the Opponent’s marks;
- (vii) it denied that the word “naked” is a dominant element, arguing that trade marks should be looked at as a whole and not by dissection; accordingly, it also denied that the word “biotics” is non-distinctive “as it should not be considered alone”;
- (viii) it denied that the words “BIOTICS” and “NUTRITION” have similar meanings.

### **Representation, papers filed and hearing**

8. The Applicant’s trade mark attorney is Simon Walters; the Opponent is represented by Temple Bright LLP. During the evidence rounds the Opponent filed evidence; evidence was also filed on behalf of the Applicant, which, as I explain below, was not admitted into these proceedings. I have read all the papers filed and shall refer to matters of evidence only to the extent that I consider warranted in order to decide the sole ground of opposition in these proceedings. Both parties filed skeleton arguments ahead of the oral hearing, which took place before me by video conference on 1 December 2020, where Mr Walters attended for the Applicant and Victoria Jones of Counsel represented the Opponent.

## Evidence and related matters

### *Refusal to admit the Applicant's evidence*

9. On 27 January 2020 the Opponent filed its evidence in chief (and the Applicant acknowledged receipt the same day). The registry refused a request by the Opponent for confidentiality in respect of two of the exhibits in evidence and the Applicant was given a deadline of 27 March 2020 to file its own submissions and/or evidence. In view of the coronavirus pandemic, the Intellectual Property Office declared 24 March 2020 and subsequent days to be 'interrupted days'. Following successive extensions communicated to stakeholders at large, the period of interrupted days ended on 30 July 2020. On that date the Applicant filed a Form TM9 which requested a further month to conclude preparation of its evidence - notably relating to third party use in the marketplace of "Naked" trade marks - although it stated that it expected that it would require only two weeks. The registry permitted a deadline of 20 August 2020 for the Applicant to file its evidence and/or submissions. The Applicant emailed the registry on the evening of 20 August 2020, requesting more time; the Opponent resisted the Applicant's request and I conducted a case management conference (CMC) on the matter on 1 September 2020. Although the Applicant filed its evidence on the day of the CMC, I gave my decision at the CMC not to admit the late filed evidence. (Annexed at the end of this decision is a letter sent to the parties on 4 September 2020, which confirmed the context of that decision.) I note from the end of that letter that the material filed on the part of the Applicant: *"showed (i) entries in the register of trade marks or (ii) goods for sale featuring the word "naked". As Mr Morton [the attorney for the Opponent] commented at the hearing, it offered no information on when those marks were used in the UK or on the extent of use. None of the exhibits appears to be from before the relevant date, indeed as Mr Morton pointed out, the dates apparent at Exhibits SW8 and SW9 indicate that they were generated around 30 August 2020. It is therefore doubtful that the refusal to admit the evidence filed would have had a material impact."*
10. On 2 October 2020, the Applicant filed a form TM55P notice of appeal to the Appointed Person against the decision not to admit the late filed evidence. However, rule 70(2) of the Trade Marks Rules 2008, states that such an interim decision "... *may only be appealed against independently of any appeal against a final decision with the leave of the registrar.*" The registry notified the Applicant on 5 October 2020 that no such leave to

appeal had been requested in the present case and that it was not possible to process the Form TM55P without the necessary permission having been both sought and given. The associated fee was refunded. The skeleton argument filed by Mr Walters ahead of the main hearing on 1 December 2020 revisited the earlier refusal to admit the late filed evidence. I confirmed at the hearing that if the Applicant still wished to appeal against the non-admission of its evidence it would be able to do so, without leave from the registry, following the issuing of my final decision in these opposition proceedings.

### *The Opponent's Evidence*

11. The Opponent's evidence in chief comprised a Witness Statement dated 25 January 2020 in the name of **Stephen Edward Zieminski** founder, owner and president of the Opponent together with exhibits **SEZ1 – SEZ6**; and a Witness Statement in the name of **Jeremy Spencer Morton**, solicitor for the Opponent, together with exhibits **JSM1 – JSM6**.
  
12. From Mr Zieminski's evidence I note the following points:
  - the Opponent was established in the USA in 2014, trading online in the sale of dietary and nutritional supplements
  - its website [www.nkdnutrition.com](http://www.nkdnutrition.com) ('the Website') is available globally, from which visitors can also, by reference to a Union Jack icon in a drop-down menu, choose a .co.uk website link ("the UK site").
  - **Exhibit SEZ1** shows example pages from the Opponents website(s), where the words NAKED NUTRITION consistently appear within the page banner;
  - the pages also show various products for sale, where the tubs are clearly labelled with names such as NAKED MASS, NAKED RICE, NAKED MILK, NAKED MEAL, NAKED CASSEIN, LESS NAKED WHEY, NAKED PEA, LESS NAKED EGG, and others.
  - The exhibit includes the slogan "nutrition with nothing to hide" and refers to Naked Nutrition providing "the purest supplements" without "additives"
  - It is not precisely clear when the .co.uk function became available, but I anyway note that product prices on the UK site are given in US dollars, and **Exhibit SEZ2** shows Google analytics in relation to usage of the UK site between 1 January 2018 – June 2019, where the presented figures are certainly not strikingly high.

- More significantly, Mr Zieminski states that the Opponent commenced sales to the UK only in January 2018 and that whereas the Opponent sells to customers in the United States via the Website, sales to UK customers appear to be solely via Amazon - notwithstanding that paragraph 6 of the witness statement by Mr Zieminski refers to the Opponent having “marketed” its products in the UK via Amazon, the websites, UK-based bloggers and social media. **Exhibit SEZ3** provides copies of extracts from the Opponent’s social media accounts as of October 2019, where the Opponent is shown, for example, to have had over 86,000 Facebook followers; however, it is not clear what proportion of these derive from the UK.
- **Exhibit SEZ4** shows example pages from Amazon from August and October 2019, which the witness believes are as they would have been in January 2018. The pages show products labelled, for example, “Naked Choc PB” and “Less Naked Mass”. The goods tend to be shown in the description as “by Naked Nutrition”. The goods are shown to have garnered very few reviews on the Amazon UK site – often a single review. **Exhibit SEZ5** shows a total of around 1200 single UK sales of the Opponent’s goods via Amazon, between January 2018 and June 2019 mainly the NAKED MASS product.
- **Exhibit SEZ6** shows a few reviews or mentions of the Opponent’s products in online articles. Thus, an article dated 5 November 2018, from the dailywaffle.co.uk, on making a collagen smoothie, shows a tub branded NAKED COLLAGEN; another from freefitnesstips.co.uk shows LESS NAKED WHEY; and a third from neverseenbefore.co.uk refers to NAKED WHEY. However other articles exhibited appear to post-date the filing of the Applicant’s contested mark, or are from .com sites and though they may have been accessible to UK readers, are not obviously targeted to the UK; no indication is given of readership reach.

13. From Mr Morton’s evidence I note the following points:

- **Exhibit JSM1** comprises extracts from a May 2018 research report by the Food Standards Agency, dealing with various aspects of consumer behaviour in relation to food supplements. It defines a food supplement as “any food stuff the purpose of which is to supplement the normal diet and which are concentrated sources of nutrients or other substances with a nutritional or physiological effect, alone or in combination, marketed in dose form, namely forms such as ... forms of liquids and powders designed to be taken in small measured small unit quantities.” It highlights “the growth



in the consumption of food supplements in recent years, especially in the sports nutrition, probiotic and traditional categories” (my emphasis). It refers to the expansion of the sale of supplements beyond health shops, chemists, supermarkets or direct selling, extending to outlets such as gyms, leisure centres, beauty salon, small retail shops and sports shops. The UK food supplements market is forecast to grow to £1 billion in 2021.

- **Exhibit JSM2** is a Food Fact Sheet produced by the British Dietetic Association (BDA) on the subject of probiotics, which explains that probiotics are good bacteria which can help improve the balance of our gut bacteria and can be found in food products such as fermented milk drinks, some yoghurts and supplements.
- **Exhibit JSM3** is the “open correspondence” referenced in the Applicant’s counterstatement, which is a letter dated 23 August 2019 from the Applicant’s attorney to the Opponent’s attorney, which refers to a registered EU trade mark “NAKED WHEY” in Class 5 and in use for nutritional products, which is owned not by the Opponent, but by a third party (see JSM4 below). Mr Walters writes: *“Accordingly, your client does not have a monopoly in “NAKED” trade marks in Class 5 and cannot prevent a later mark being registered for identical or similar goods incorporating this word, unless of course the trade mark as a whole, is confusingly similar with other matter present in your client’s marks. The fact that your client has a number of trade marks prefixed with the word naked is therefore not relevant. In the present case the trade mark ‘nakedbiotics’ cannot be confused with any earlier naked mark.”*
- **Exhibit JSM4** comprises screenshots of products offered on the website proteinworks.com (as at 23 January 2020). The Protein Works is indicated to be a trade mark (by the inclusion of the small superscript “TM”) and is the trading name of the third party referenced in Mr Walters’ letter (Exhibit JSM3). The exhibit shows products labelled “Naked Whey Protein 80” and “Naked Diet Whey Protein 90”. However, Mr Walters argued in his witness statement that it was not apparent that Naked or Naked Whey were identified as trade marks.
- **Exhibit JSM5** shows a table of screenshots made by Mr Morton on 23 January 2020, drawn from the results of a search for “biotics” on amazon.co.uk, selected to illustrate the use of “-biotics” as a suffix in the product name, as well as examples of food and bodybuilding products said to contain probiotic ingredients. Listed there for sale, priced in pounds sterling, are products such as Kiki Health BODY BIOTICS supplements and Inessa Advanced Daily Biotic (probiotic capsules). **Exhibit JSM6** includes extracts

from the website of rawbiotics.co.uk showing non-freeze-dried probiotics for sale in liquid form, under the brand rawbiotics, and priced in pounds sterling. The extracts from that website include references to the role of bacteria in the uptake of nutrition.

## **MY APPROACH IN THIS DECISION**

14. The Skeleton Argument filed by Ms Jones on behalf of the Opponent accepted that the contested mark “nakedbiotics” is most likely closest in similarity to the Opponent’s ‘NAKED NUTRITION’ mark, and her submissions focused on that mark. In my view, Ms Jones is correct in her assessment that NAKED NUTRITION is the most similar of the three earlier marks. In line with my comments within paragraphs 5 and 8 above, I also consider that earlier mark to found the Opponent’s best case for opposition on the ground of section 5(2)(b) of the Act. I therefore proceed to make this decision premised initially on that individual mark alone; I shall deal with other aspects of the claims only to the extent that I may consider it warranted to do so.

## **DECISION**

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

15. At paragraph 2 above, I set out the provisions of section 5(2)(b) of the Act as part of the background and pleadings. Determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions 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. The principles are:
  - (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 great 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 the goods

16. The goods to be compared are:

The applied-for goods
<i>Nutritional supplements in drink form; Preparations and food additives for the strengthening [sic] of the intestinal flora and the stimulation [sic] of beneficial intestinal bacteria; Dietary and nutritional supplements</i>
The Opponent's goods
<i>Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Dietary supplements and dietetic preparations; Dietary food supplements; Dietary supplement drinks; Dietary supplements consisting of vitamins; Dietary supplements for humans not for medical purposes; Health food supplements for persons with special dietary requirements; Mineral food supplements; Powdered nutritional supplement drink mix; Food supplements consisting of amino acids; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Vitamin and mineral supplements; Powdered nutritional supplement energy drink mix; Probiotic supplements; Nutraceuticals for use as a dietary supplement; Medicated food supplements; Dietary and nutritional supplements</i>

17. The Applicant admitted in its counterstatement that the parties' respective goods are identical or similar. At the hearing, Ms Jones argued that the goods should be considered identical.
18. In considering the extent to which there may be similarity between the goods and services, I take account of the guidance from relevant case law. Thus, in *Canon* the Court of Justice of the European Union ("**the CJEU**") stated that:

*"In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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*".<sup>1</sup>

19. In *Boston Scientific*, the General Court described goods as "complementary" in circumstances where "... *there is a close connection between [the goods], 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*".<sup>2</sup> I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.<sup>3</sup>
20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>4</sup> for assessing similarity were:
  - (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.
21. So far as identity between the goods, it is trite law that the goods need not be specified in terms that exactly mirror one another in order to be considered identical; it is sufficient that goods are described in terms that are essentially equivalent. Moreover, in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the CJEU (the General Court) stated that goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa).<sup>5</sup>

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1 Case C-39/97, at paragraph 23.

2 *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06 Case C-50/15 P

3 *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

5 Case T- 133/05 at paragraph 29 of that judgment.

22. With the above principles in mind, the respective goods not only satisfy the criteria for similarity, but I agree with Ms Jones that the Opponent’s earlier trade mark registration includes goods that may be considered identical to those contested. The selection of the Opponent’s goods in the table below suffices to establish the identity with the contested goods:

The applied-for goods	The Opponent’s goods
<i>Nutritional supplements in drink form;</i>	<i>Dietary supplement drinks; Dietary and nutritional supplements</i>
<i>Preparations and food additives for the strengthening [sic] of the intestinal flora and the stimulation [sic] of beneficial intestinal bacteria;</i>	<i>Probiotic supplements Dietary and nutritional supplements</i>
<i>Dietary and nutritional supplements</i>	<i>Dietary and nutritional supplements</i>

**The average consumer and the purchasing process**

23. In *Hearst Holdings Inc*,<sup>6</sup> Birss J explained that “... 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 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 word “average” denotes that the person is typical”.

24. The average consumer for the parties’ goods will be a member of the general public, particularly those with an interest in fitness and/or healthy diet. The goods will typically be consumed daily as part of a person’s normal diet/daily routine, and consequently replenished with a certain regularity. Ms Jones characterised the consumer as having a tendency to try different products and experiment; I do not know if that is a fair and apt characterisation of the typical consumer, but nor do I suppose that every consumer typically has stringent and unwavering brand loyalty – they may well try out other products. Ms Jones also referred to the UK Food Standards Agency research at **Exhibit JSM1** to suggest that customers pay little attention when purchasing such products.

<sup>6</sup> *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), at paragraph 60.

Again, I do not attach undue weight to whatever evidence there may be on that point, since these are goods for the general public, of which I am a member, and the notion of the average consumer is a legal construct. However, although the make-up of what we choose to ingest into our bodies for health purposes might warrant a reasonable degree of attention in the purchasing process, I would not estimate the level of attention to be more than medium. The average consumer will purchase the goods either by self-selection from a retail outlet (of the range identified in **Exhibit JSM1**), or from a website or even catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I recognise that there may well be an important aural component to the purchase, given the potential for oral recommendations, including via social media,<sup>7</sup> and that advice may be sought from retail assistants.

### **Distinctiveness of the earlier mark**

25. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.<sup>8</sup> In *Lloyd Schuhfabrik*, 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-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the

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<sup>7</sup> Again, in line with Exhibit JSM1.

<sup>8</sup> *Sabel BV v Puma AG*, Case C-251/95 at [24].

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)".

26. The earlier mark on which I am focusing, submitted and accepted to be most similar of the earlier marks, is "NAKED NUTRITION". I shall consider first its degree of distinctiveness based on its inherent characteristics.
27. The mark clearly comprises two ordinary words in the English language. The second word in the mark, as Ms Jones recognised in her skeleton argument, is essentially descriptive of or else is highly allusive in relation to the goods for which it is registered, all being in the line of dietary and nutritional supplements; that part of the mark has little or no distinctiveness.
28. As to the first word in the mark, Ms Jones referred in her skeleton argument to a dictionary definition of "naked" as meaning bare or unclothed. I have no doubt that the average consumer will be aware of such a definition of the word, but the Opponent's position is that the word has no specific and generally understood meaning for the goods in issue, and is distinctive because it does not directly describe the goods. However, Ms Jones acknowledged that the word could be said to allude to the purity and stripped-back nature of the food supplements; indeed the Opponent appears to have such a conception in mind in the various references in the promotional descriptions on its Website (**Exhibit SEZ1**) that I mentioned in my evidence summary. In my view, the average consumer will readily perceive that allusive implication, but there can be little doubt that the word "NAKED" is the component that carries greater distinctive weight in mark. There was no evidence filed to indicate that the term "NAKED" was in use on the UK market on such a scale that it had become lacking in distinctiveness when used in relation to the goods at issue.
29. Considered in the round, I find the earlier trade mark "NAKED NUTRITION" distinctive to a degree that is not especially high, certainly no more than medium, and I would allow that it may be estimated as a little lower than medium.
30. Were the Opponent to have any prospect of benefiting from a claim of enhanced distinctiveness, the evidence would need to show use of the earlier mark, whether alone



or as part of a family, in relation to the relevant goods, sufficient to have enhanced the distinctiveness of the mark among the average consumer in the UK, and to have done so by the date that the Applicant applied for its marks i.e. by 6 June 2019 (the relevant date). As implied by the extract from *Lloyd Schuhfabrik* above, evidence going to enhanced distinctiveness may include elements such as turnover and sales, advertising expenditure, market share, duration and reach of use and so on. In regard to all of those factors the evidence has notable weaknesses. I note in particular the following:

- the Opponent has sold to the UK only as of January 2018, and that 18-month period led to sales of only around 1200 individual goods in the UK, with consequent extremely limited Amazon review profiles;
- the UK market for food supplements has an estimated value nearing a billion pounds, so the Opponent's share is evidently tiny;
- no information is provided on advertising expenditure in the UK and the blogs or articles at **Exhibit SEZ6** are not likely to have had a significant impact on public awareness of the Naked Nutrition mark, not least since those articles show different branded goods of the Opponent, such as NAKED COLLAGEN or LESS NAKED WHEY;
- the sales in evidence at **Exhibit SEZ5** relate primarily to goods branded NAKED MASS, but even on the premise that the 'house-brand' featured at some point in the sales process for all those sales – such as the goods being indicated on Amazon as “by Naked Nutrition” – the scale of sales, which may be averaged as around 67 individual items in each month of the relevant period, is anyway too small to assist the Opponent.

31. Taken in the round the evidence falls very far short of what would be needed to conclude that the mark benefits from enhanced distinctiveness through use.

### **Comparison of the marks**

32. It is clear from *Sabel* 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 in *Bimbo* 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.”<sup>9</sup>*

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

<b>The Opponent’s earlier EUTM</b>	NAKED NUTRITION
<b>The contested mark:</b>	nakedbiotics

34. The overall impression of the Opponent’s mark is that it comprises the two ordinary English words, NAKED and NUTRITION. My earlier analysis of the mark, set out above in the context of its distinctive character, is also applicable to the overall impression for the purposes of similarity. Thus, it is the word NAKED that is the dominant and distinctive component. This is partly because it starts the mark and will be read and said first, but principally because it will strike the average consumer as allusive, rather than concretely descriptive in relation to the goods at issue; the second component of the mark, the word “NUTRITION”, is more closely descriptive in relation to goods whose central purpose is to assist with the consumer’s nutritional needs. It contributes to the overall impression of the mark and is not negligible, but it is less dominant and distinctive.
35. As to the overall impression of the contested mark, I have noted that the Applicant’s position, as expressed in its counterstatement, is that no significance is to attach to there being no space between the words “naked” and “biotics”. Although the mark is presented as conjoined, the average consumer will readily perceive it to comprise two elements. The first of those elements is the word “naked”, and I find that the same connotations of that word apply in the context of the contested mark as they do for the Opponent’s mark. The second word of the mark is a less common word in isolation; nonetheless, I accept

<sup>9</sup> *Bimbo SA v OHIM, Case C-591/12P* (at paragraph 34)

the submission on the part of the Opponent that for the average consumer of the goods at issue, “BIOTICS” will be understood in the sense of ‘probiotics’, which are microorganisms intended to have health benefits when consumed.<sup>10</sup> The word is essentially descriptive of or else is very highly allusive in relation to the goods for which the contested mark is specified. It contributes to the overall impression of the mark and is not negligible, but it is less dominant and distinctive than its opening component, “naked”.

#### *Visual similarity*

36. Any comparison of the marks must be on the basis of how they appear in the registers. Nonetheless, since they are both word marks, ordinary use allows for changes of case and typeface, so the fact that the Opponent’s mark is presented in uppercase, whereas the contested mark is in lowercase, has no differentiating impact for the purpose of comparing the marks. And while I do not entirely discount the absence of a space between the two components of the Applicant’s mark, it has only a minimal visual impact. The opening component of both marks is the same: the word ‘naked’, which in each of the marks plays the more dominant and distinctive role. After that identical component, come the words “nutrition” and “biotics”; these components share some letters, but are visually quite different. Overall, I find the marks visually similar to no more than a medium degree.

#### *Aural similarity*

37. From an aural perspective, the marks will be pronounced identically in their opening component; and while the second components have the same number of syllables, creating an overlap in intonation and length when spoken, the words “nutrition” and “biotics” obviously differ. For the purpose of an aural comparison, the absence of a space between the two components of the contested mark has no significance or impact. Taking account of the overall impressions of the marks and the greater role borne by the shared identical component, I find the marks aurally similar to a medium degree.

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<sup>10</sup> The use of ‘biotics’ as an abbreviation of ‘probiotics’ in this way is supported by the evidence at Exhibits JSM5 and JSM6.

### *Conceptual similarity*

38. The marks are conceptually identical to the extent that they share the opening component “naked”, which carries the same connotations in each mark. The words “nutrition” and “biotics” do not mean the same thing as one another, but nor are they entirely separate concepts. Ms Jones referred me to a definition of ‘NUTRITION’ as the process of providing or obtaining the food necessary for health and growth i.e. nourishment, or, the branch of science that deals with nutrients and nutrition, particularly in humans. Those definitions more or less accord with my own understanding of the term and likewise with how the average consumer will perceive the word. Ms Jones also referred me to a definition of ‘BIOTICS’ as generally describing the living or once living components of a community, for example organisms such as animals and plants, but also highlighted its use as an abbreviation of ‘probiotics’ in relation to food supplements. Ms Jones also referred to **Exhibit JSM6**, showing extracts from the website of rawbiotics (an enterprise seemingly connected with the Applicant) which attests to the role of bacteria in the uptake of nutrition. Accordingly, Ms Jones submitted that in relation to the relevant goods both terms refer or relate to things to be consumed by or applied to the human body which will provide health benefits. In my view, whilst the words have different particular meanings, they nonetheless have a conceptual overlap and create no strong conceptual difference between the marks. In the context of their overall impressions I find the marks to be conceptually similar to a high degree.

### **Conclusion as to likelihood of confusion**

39. Confusion can be either direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). Indirect confusion (and the difference between direct confusion), was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>11</sup> where he noted that:

*“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in*

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<sup>11</sup> Case BL-O/375/10

*nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.*

*17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

40. No likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). Sitting as the Appointed Person in *Eden Chocolat*<sup>12</sup>, James Mellor QC stated as follows:

*“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was*

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<sup>12</sup> Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017)

*explaining<sup>13</sup> in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”*

41. In my global assessment of likelihood of confusion, I take account of all of my findings relevant to this ground. The factors operate interdependently and I make my assessment in line with the case law principles I outlined at paragraph 15 of this decision.
- I have proceeded on the basis of the mark that is most similar to that applied for.
  - My findings have included that visual and aural factors are important in the purchasing process and that “NAKED NUTRITION” is visually similar to “nakedbiotics” to no more than a medium degree; aurally similar to a medium degree, and that the marks share a high degree of conceptual similarity. These findings factor in the greater role played in both marks by the shared component “naked” as an indicator of origin, since both “nutrition” and “biotics” are components that are essentially descriptive of the goods and are non-distinctive in that regard.
  - I have also found that on an inherent basis the earlier word mark “NAKED NUTRITION” is distinctive to a degree that is not especially high, and may be estimated as a little lower than medium. I have found the evidence of use too limited to support the claimed enhancement in the distinctiveness of the earlier mark.
  - I have found that the average consumer will pay no more than a medium degree of attention in selecting and buying the goods.
  - The Applicant’s goods are identical to those in respect of which the Opponent has protection, and this factor may offset a lesser degree of similarity between the marks.
42. Notwithstanding that the average consumer is deemed to have the attributes of being reasonably well informed and reasonably circumspect and observant, when I consider all of the above factors in the round, and particularly taking account of the effect of imperfect recollection, I conclude that there is a risk that the marks may be directly confused – mistaken one for the other by a significant proportion of the relevant public. The component “naked”, will be recalled as the more distinctive opening aspect, and the second components of the marks are too directly descriptive to reliably distinguish the

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<sup>13</sup> In L.A. Sugar Limited v By Back Beat Inc Case BL-O/375/10 –above.

marks in the recall of the average consumer. I have noted the Applicant's point expressed in the correspondence at **Exhibit JSM3**, that the Opponent should not be considered to have a monopoly in "NAKED" trade marks in Class 5, and may prevent a later mark being registered for identical goods incorporating that word only if the contested trade mark as a whole is confusingly similar with other matter present in the earlier mark. My conclusion is just that – that the contested trade mark as a whole is confusingly similar. I do not overlook that the second words in the marks have clear visual and aural differences, nor that the word "biotics" is a less common word in isolation than the word "nutrition". Nonetheless, both words have in common a slightly scientific terminological ring to them and possess - at best - very limited distinctiveness for the identical goods at issue. These factors, in my view make the marks apt for direct confusion through imperfect recollection, since the average consumer rarely has an opportunity to compare marks side by side.

43. I also conclude that a significant proportion of the relevant public may recognise that the marks are different from one another, but since the goods are so close, conclude that substitution of the second component is merely a logical and consistent brand extension reflecting a particularisation within the range of goods. I therefore find that a likelihood of indirect confusion cannot be ruled out.
44. Having found that there is a risk that the public will wrongly believe that the respective goods come from the same or economically linked undertakings on the basis solely of the earlier EUTM "NAKED NUTRITION", I do not consider it necessary to deal further with the Opponent's arguments as to a family of marks and the related case law points put to me. Even if the EUTMs were capable of constituting a family, and even if the evidence of use were held to be sufficient, and even if the unregistered marks could feature in considerations, the outcome of the section 5(2)(b) ground would be no different from my findings of indirect (as well as direct) confusion based only on the one EUTM that I have dealt with.

**Outcome:** The opposition based on section 5(2)(b) succeeds in full.

## **COSTS**

45. The Opponent is entitled to a contribution towards its costs in these proceedings. I therefore make the following determination of costs in line with the scale published in the annex to Tribunal practice notice (2/2016).

<b>Official fee</b> for filing the Form TM7	£100
Preparing statement of grounds and reviewing the counterstatement:	£350
Preparing evidence and considering and commenting on the other side's late filed evidence and attending the CMC on 1 September 2020	£1100
Preparing for and attending a hearing	£750
<b>Total</b>	<b>£2300</b>

- (a) I order Naked Nutrition Efficient Microbes Limited to pay Naked Whey Inc. DBA Naked Nutrition the sum of £2300 (two thousand three hundred pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated this 21<sup>st</sup> day of January 2021**

Matthew Williams

**For the Registrar**



## **Annex: My letter to the parties (4 September 2020) re: refusal to admit the Applicant's late filed evidence**

### **Post-hearing letter – refusal of requested extension of time to file evidence**

This letter records the outcome of a hearing held by telephone before me on 1 September 2020, where Simon Walters attended as the attorney for the Applicant and Jeremy Morton of Temple Bright LLP attended for the Opponent. The hearing concerned a request by the Applicant for an extension of time in which to file its evidence. The reasons for the request were set out in the Form TM9 filed on 30 July 2020. Mr Morton filed a skeleton argument to set out his resistance to the requested extension.

**Outcome:** At the hearing I gave my decision that the extension of time given by the preliminary view of the registry – permitting a further deadline of 20 August 2020 – had provided the Applicant with sufficient time in which to file its evidence. Consequently, notwithstanding that Mr Walters filed the evidence on the date of the hearing, it is not admitted into the proceedings because it was filed too late. The evidence rounds are therefore at an end and the caseworker will shortly write to the parties to establish whether they wish to request an oral hearing of the substantive opposition, or whether a decision is to be made from the papers. The matter of costs arising from this CMC/hearing will be taken into account when overall costs are considered as part of the determination of the substantive opposition.

### **Context**

The second Tribunal Practice Notice of 2011 (TPN 2/2011) states:

*The timetable is to be adhered to. It provides more than enough time, in the vast majority of cases, for facts or submissions pertinent to the pleaded grounds to be gathered and presented to the Tribunal. Parties should not regard this timetable as a 'starter for ten', to be varied at a later date. The Tribunal will, in exceptional cases, consider requests to extend the time allowance. Such requests will need to be fully supported with explanations as to not only what has been done to date but, more particularly, what is left to do and how long it will take to produce the evidence. The Tribunal will also need to be satisfied that the extra time is warranted in the context of the pleaded grounds and what is necessary to determine the case efficiently and fairly.*

*Further, the Tribunal will use its discretion to set time periods as it sees necessary, which may be less than the further time which the party has requested. Parties should particularly note that, if they have specified a time when the evidence will be ready and been allowed that further period of time, the Tribunal will look unfavourably upon further extension requests.*

In *Siddiqui's Application O/481/00*, Simon Thornley QC as the Appointed Person stated:

*It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. The Act and the rules lay down a comprehensive code for the conduct of prosecution of applications and for the conduct of opposition. The code presumes a normal case and provides for it. There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.*

## **Reasoning**

- I did not accept the contention that the volume of the evidence in this case was unusually great; nor were the issues it raised in support of the single 5(2)(b) ground of opposition so complex that consideration of that evidence warranted more than the standard period of two months.
- Despite the TM9 citing impeded access to “certain stores” as limiting the evidence gathering, that does not appear to have in fact been a material factor. The evidence filed comprised almost exclusively of materials drawn from an online search. The only part of the evidence that involved an image of a branded product featuring the word “naked” was a single page in Exhibit SW7 that showed Naked bacon for sale at a Waitrose store, said to be in Ruislip in September 2019.
- The interrupted days period commenced just a few days before the original two-month deadline for the filing of evidence, so it is reasonable to expect that the evidence gathering would by that stage have been well progressed, and Mr Walters referred to the TM9 statement that considerable progress had been made (by research on-line). I allow too that changes in behaviour (such as social

distancing) arose earlier in March, which may have curtailed face-to-face meetings. However, the interrupted days period effectively gave an extension of over four months to deadlines falling within it. Mr Walters requested still a further month beyond the end of the extended deadline of 30 July following the interrupted days, though indicating that two weeks would probably be enough. The registry's preliminary view allowed nearly three weeks for the further extension (until 20 August). Mr Walters gave no clear reason as to why that indulgence proved insufficient and why the evidence filed could not have been filed in time to meet the deadline(s) given.

- Mr Walters observed that the process of curating the evidence involved not only what to put into evidence, but what to omit. He referred to the Applicant itself having unearthed materials and that it was not possible to meet face-to-face to lay out the evidence and conclude the process in the round. However, given that it was well over six months since the Opponent filed its evidence, it seems to me that it would have been entirely feasible to convey and discuss the evidence by video conferencing and other remote means. I also take into account the absence of any detail as to what was the physical evidence to be considered in person. Mr Walters also referred at the hearing to the need to meet in person with Counsel, but he gave no detail on when or whether such a meeting took place.
- While clearly it was not the purpose of the hearing on 1 September to assess the evidence, I do not overlook that it largely showed (i) entries in the register of trade marks or (ii) goods for sale featuring the word "naked". As Mr Morton commented at the hearing it offered no information on when those marks were used in the UK or on the extent of use. None of the exhibits appears to be from before the relevant date, indeed as Mr Morton pointed out, the dates apparent at Exhibits SW8 and SW9 indicate that they were generated around 30 August 2020. It is therefore doubtful that the refusal to admit the evidence filed would have had a material impact.