

O/566/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3465314

BY SVC LABS LTD

TO REGISTER THE TRADE MARK

Balance™

IN CLASSES 5, 29, 32, 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 420761

BY LONGSHAW LIMITED

Background and pleadings

1. SVC Labs Ltd (“**the Applicant**”) applied to register the plain text word “Balance™” as a UK trade mark in respect of the following goods and services:

Class 5: *Dietary foods supplements; Dietary supplement beverages; Nutritional supplements for athletes; Strengthening preparations for the joints of plants and animals; Vitamin and mineral preparations, including preparations in capsules; Preparations for slimming purposes; Metabolism strengthening preparations; Preparations for supplementing the body with essential vitamins and microelements; Preparations containing plant extracts; Dietary supplements for athletes; Food supplements enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; Diet supplements; Mineral and vitamin food supplements; Amino acid; Mineral waters for medical purposes; Dietary foods; vitamin drinks. High-protein supplements, enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; Protein-based supplements, including those made from additives of plant and animal origin; Carbohydrate-based supplements including made with additives; Dietetic foodstuffs based on protein.*

Class 29: *Foodstuffs, included in this class, enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; High-protein concentrates, enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; Protein-based concentrates, including those made from additives of plant and animal origin; Milk products and milk beverages, carbohydrate-based concentrates, including made with additives.*

Class 32: *Mineral water (beverages); Beverages for athletes; Energy drinks; Beverages, including beverages based on amino acids, carbohydrates and protein; Energy drinks containing caffeine; Isotonic beverages; Preparations for making drinks; Beverages enriched with added minerals; Protein beverages; Protein and carbohydrate beverages; powders for making beverages; Preparations in powder form for making beverages, including beverages based on carbohydrates, amino acids and protein.*

Class 35: *Online Retail store services in the field of dietary and nutritional supplements, food products and beverages, tinctures and clothing; wholesale services connected with the sale of dietary and nutritional supplements, and food products and beverages, tinctures and clothing via a distributorship; Wholesale services connected with the sale of dietetic foods, vitamin and mineral preparations, food supplements, foodstuffs enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin, high-protein concentrates and supplements enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin, supplements for athletes, beverages, including for sale via the internet; Retail services connected with the sale of dietetic foods, vitamin and mineral preparations, food supplements, foodstuffs enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin, high-protein concentrates and supplements enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin, supplements for athletes, beverages, including for sale via the internet.*

2. The application was filed on 10 February 2020, and that is “**the relevant date**” for the purposes of these opposition proceedings. The application was published for opposition purposes on 28 February 2020, and on 24 July 2020,¹ Longshaw Limited (“**the Opponent**”) filed a Form TM7 to oppose the registration.² The opposition is based on grounds under sections 3(1)(b) and 3(1)(c) of the Trade Marks Act (“**the Act**”). The Opponent seeks rejection of the whole application, claiming as follows:

(i) Under section 3(1)(b), the “TM” sign is devoid of distinctive character, as it merely indicates to consumers that a “*term, slogan, logo or other sign is being used as a trade mark, regardless of whether or not that sign is registered.*” The word “Balance” is descriptive and non-distinctive and so is incapable performing the essential function of a trade mark, adding “TM” does not remedy this.

(ii) Under section 3(1)(c), the word “Balance” has an obvious meaning in English, especially in relation to the opposed goods and services where it directly and immediately describes the kind, quality, intended purpose or other characteristics

¹ This date is outside the two/three months for filing an opposition, but as the deadline for opposing the application fell within the period of interrupted days certified by the IPO due to the Coronavirus pandemic (24 March 2020 to 29 July 2020), the TM7 was accepted by the tribunal.

² A notice of threatened opposition, Form TM7A was filed on 12 June 2020.

of the goods and services. No trader of these types of goods and services should be given the exclusive right to promote their goods or services with such an ordinary word. And the word “Balance” should remain available to all traders of the same or similar goods and services.

3. The Applicant filed a Form TM8, Notice of defence and counterstatement in which it denied that its mark contravenes sections 3(1)(b) and 3(1)(c) of the Act for the reasons set out by the Opponent, or at all. The Applicant put the Opponent to strict proof of each of its allegations. The Applicant also contended that in the prosecution of its mark, the UK Intellectual Property Office (UK IPO) had found the mark to possess the distinctive character required for registration and also that the mark is not descriptive in respect of the goods and services.

Representation and papers filed

4. Both parties submitted evidence during the evidence rounds. Neither party requested a hearing, so this decision is made following a careful consideration of the papers filed, which include the submissions in lieu of a hearing submitted by both parties.

5. The Applicant is represented by Forresters IP LLP, and the Opponent is represented by Reddie and Grose LLP.

EVIDENCE

The Opponent’s evidence

6. The Opponent’s evidence is comprised of a witness statement dated 8 December 2020 by Filippa Anne Evans, together with Exhibits FE1 to FE6. Ms Evans is an Associate at Reddie and Grose LLP.

7. Exhibit FE1 provides information on the use of the “™” sign and includes two articles from the International Trademark Association and one from Lexology, an online publisher of articles on aspects of law. Briefly, the articles indicate that the “™” sign is

generally used in association with a trade mark to designate that although the mark is not registered, its owner claims rights under the mark.

8. Exhibit FE2 features definitions of the word “balance” and “balanced”, taken from the Oxford Dictionary on Lexico.com. I note all of the definitions but in particular those highlighted by the Opponent in its submissions in lieu of a hearing of “*balance*” as “*NOUN: 2 [mass noun] A situation in which different elements are equal or in the correct proportions; and VERB: 2.2 [with object] Establish equal or appropriate proportions of elements in.*” And of “*balanced*” as “*ADJECTIVE: 1.2 (especially of food) having different elements in the correct proportions.*”

9. Exhibit FE3 features screenshots from webpages that refer to the word “balance” in relation to diet, supplements, health and wellbeing. The screenshots are taken from the NHS website, the British Nutrition Foundation, Holland & Barrett and a website selling nutritional supplements – nutri ADVANCED. In respect of the pages 23 to 25 of Exhibit FE3 – webpages from the NIH National Heart, Lung and Blood Institute – it is noted that this is an organisation based in the United States, so the value of this in evidencing the use of “*balance*” in the UK market is limited.

10. Exhibit FE4 features search results from the Darts-IP database of cases in Europe (including the UK), where the distinctiveness of a trade mark containing the word “*balance*” was raised as a point in law. The results indicate that in 92% of the cases, the marks were found to be non-distinctive. The results of a second search, limited to goods and services in Classes 5, 29, 32 and 35 indicate that the marks were found to be non-distinctive in 96% of cases. Exhibit FE5 contains copies of a selection of these decisions, which include:

(i) A decision of a Hearing Officer at the UK IPO rejecting on section 3(1)(b) and 3(1)(c) grounds the marks “BALANCE HEALTH” and “BALANCE”³ in respect of various dairy products and spreads.

(ii) Four decisions of examiners at the EU Intellectual Property Office (EUIPO) concerning the marks: “Weight balance” in respect of goods and services


³ Decision no. O/173/12 included in the Opponent’s evidence at Exhibit FE5.

including “*dietetic substances adapted for medical use*,” “Fluid Balance” in respect of goods including “*health food supplements made principally of minerals*,” “BEYOND BALANCE” in respect of goods including “*dietary and nutritional supplements*,” “Balance” in respect of which the goods and services are not listed, although I note that the basis of the refusal is that mark is a promotional slogan conveying that the goods have a “*balanced ratio of ingredients*”.

(iii) A decision of the EUIPO Boards of Appeal concerning the mark “Balance for life” in respect of goods including “*pharmaceutical and veterinary preparations*” and food products in Class 30.

11. Exhibit FE6 features a range of cases concerning marks including the word “balance” that have been refused registration, these having been identified through the EUIPO’s eSearch Plus database. The decisions include:

(i) Six decisions of examiners at EUIPO concerning the marks: “INNER-BALANCE” in respect of “*foodstuffs*”; “NATURAL BALANCE” in respect of goods including “*food supplements*”; “Protein Balance” in respect of which the goods are not listed; “BALANCE IT” in respect of goods including “*dietary food supplements for animals*”; “BIOBALANCE” in respect of goods including “*medicated additives for animal food*.”

(ii) A decision of the General Court in respect of the figurative mark  in respect of services related to diet and nutrition.

The Applicant’s Evidence

12. The Applicant’s evidence is comprised of a witness statement dated 4 February 2021 by Mark Bhandal, together with Annexes 1 to 7. Mr Bhandal is a Senior Associate at Forresters IP LLP.

13. Annex 1 of the Applicant’s evidence features the first four pages of the examination report issued in respect of the application, showing that no objection under absolute

grounds was made to the mark. The Applicant claims that this is evidence that the mark was considered inherently registrable by the IPO.

14. Annex 2 features the first eight pages of a search of the EU trade mark register for registered marks containing the word “balance”, of which there are stated to be 735 such marks. In Annex 3, the results of the same search, but limited to Classes 29 and/or 30 are shown, of which there are 62 marks.

15. Annex 4 features the results of a search of the EU trade mark register for registered marks where the word element consists of the word “balance”. There are stated to be 24 such marks.

16. Annex 5 features the first five pages of a search of the TMView trade mark database for registered marks containing the word “balance” and that are registered for goods in Class 29 and/or 30. There are stated to be 1,484 such marks.

17. Annex 6 features the first four pages of a search of the TMView trade mark database for registered marks where the word element consists of the word “balance” and the marks are registered for goods in Class 29 and/or 30. There are stated to be 1,100 such marks. Annex 7 is described as showing the results of the same search, but limited to trade marks registered in the UK, of which there are 26 marks. However, on examination of this list, it is apparent that it shows UK registered trade marks containing the word “balance”, with just two of the results having a word element consisting only of the word “balance.”

Preliminary matters

Previous examination

18. Before I proceed with this decision, I will address the Applicant’s argument that the distinctive character and descriptiveness of the trade mark have already been considered by the IPO. I agree that the Applicant’s mark was accepted for publication on 28 February 2020, with no objection under section 3(1)(b) or 3(1)(c) of the Act. In this respect, I highlight that the fact that an objection was not raised by the examiner does not preclude a finding for the Opponent under these grounds within the

opposition proceedings, and I am not bound by the results of the examination that took place prior to publication. I will therefore consider the opposition objectively based on the information and evidence I have before me.

State of the register

19. In *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the Court of Justice of the European Union found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

20. It is clear that the existence of analogous registered marks does not mean that a later mark applied for should also be registered. I have anyway reviewed the evidence in Annexes 2 to 7 and have not identified any registered trade marks that I would consider to be on all fours (doubly identical) with the current Application. Of the EU trade marks, there are few that consist *only* of the word “balance”, with most having additional wording and/or figurative elements, and when the search is limited to Classes 29 and 30, I can see no marks consisting only of the word “balance.” I note that there is one mark in Annex 4 that consists of the word “balance” alone, in a class that corresponds to one of the Applicant’s classes⁴ (Class 5), however it is not possible to see the list of goods to establish whether they would be in the same field as the

⁴ EUTM No. 17662966

Applicant's goods. Annexes 5 to 7 feature search results from TMView, of these, Annexes 5 and 6 are not limited by country and therefore include trade marks from non-EU countries, that will operate under different legal frameworks, and also include countries where English is not an official, or commonly spoken language. In addition to these points, the same issues in terms of additional verbal and figurative elements apply which mean that the marks are not comparable to the Application before me. Lastly, each mark in Annex 7 – which features results from the UK only – includes additional verbal and/or figurative elements, meaning they are not directly comparable to the Applicant's mark.

The Legislation

21. Section 3 of the Act deals with the so-called “absolute grounds” for refusal of registration based on the inherent characteristics of the trade mark concerned, and provides as follows:

“3.- (1) The following shall not be registered-

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which 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,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The Case Law

22. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law

as it stood at the end of the transition period. The provisions of the Trade Marks Act 1994 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts and the related EU legislation.

Section 3(1)(b)

23. The principles to be applied under article 7(1)(b) of the Community Trade Mark (“CTM”) Regulation (which is now article 7(1)(b) of the European Union Trade Mark (“EUTM”) Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (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)."

Section 3(1)(c)

24. The case law under section 3(1)(c) of the Act (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

"91. The principles to be applied under article 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 Melkunie, 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].”

25. In relation to questions concerning the perception of descriptiveness, I also find it useful to note the decision in Case BL O-238-189, where Professor Ruth Annand, sitting as the Appointed Person, referred to the ruling in *LG Electronics, Inc. v EUIPO*.⁵ The latter ruling included another statement by the CJEU, equivalent to the *Agencja Wydawnicza* quoted above, but expressed as to include the following:

*“19. The case-law has also stated that, for the purposes of applying Article 7(1)(c) of Regulation No 207/2009, it is necessary to consider whether, from the viewpoint of the relevant public, there is a sufficiently direct and specific relationship between the sign for which registration as a mark is sought and the goods or services concerned that enables that public immediately to perceive, without further thought, a description of those goods or services, or one of their characteristics (judgment of 19 April 2016, *Spirig Pharma v EUIPO (Daylong)*, T- 261/15, not published, EU:T:2016:220, paragraph 19; see also, to that effect, judgment of 28 June 2012, *XXXLutz Marken v OHIM*, C-306/11 P, not published, EU:C:2012:401, paragraph 79).*

⁵ Case T-804/16, *LG Electronics, Inc. v EUIPO* EU:T:2018:8

[...]

Lastly, it should also be noted that the descriptiveness of a sign may be assessed only, first, by reference to the way in which it is understood by the relevant public and, secondly, by reference to the goods or services concerned (judgment of 30 September 2015, Ecolab USA v OHIM (GREASECUTTER), T- 610/13, EU:T:2015:737, paragraph 19)."

26. Professor Annand noted, in reference to the above, that:

"29. As this passage from the GCEU makes clear, to fall foul of Section 3(1)(c) the meaning(s) conveyed by the contested sign must be sufficiently concrete in order immediately and without further reflection to create a specific and direct link with a description of the goods and services in question or one of their characteristics in the minds of the relevant public.

30. ... the test is a question of degree. It seems to me that this was recognised by AG Jacobs in his Opinion in Case C-191/01, OHIM v. Wm. Wrigley Jr. Company [2003 I-12447:

"57. There is clearly a line to be drawn between terms which may be used to designate products or their characteristics and those which are merely suggestive of such characteristics. The latter may be registered and are obviously of great value to the trade mark owner.

58. Exactly where that line is to be drawn is however less clear. In each case, there will come a point where an individual decision must be made.

[...]

61. It seems obvious that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it. There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between

two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is closer...

DECISION

27. Having set out the relevant law and legal principles, I now take stock in light of the claims and evidence in this case. My task here is to decide, whether, on 10 February 2020, when the Applicant applied for its trade mark, the word “BalanceTM” was descriptive of any characteristic of the goods or services applied for, or devoid of any distinctive character in respect of those goods and services. The position must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.⁶

The “TM” sign


28. I find it convenient to first deal with the “TM” sign in the Applicant’s trade mark. The Opponent’s evidence at Exhibit FE1 confirms that the letters “TM”, typically written in superscript, after a trade mark, indicate that the proprietor of the mark may not have registered it, but nevertheless claims rights under it. I note that the Applicant does not dispute the definitions in Exhibit FE1, although it does contend that the mark cannot be said to consist “exclusively of the word BALANCE,” a point that I will return to.

29. That the letters “TM” appear in superscript and follow the mark – as is typical practice – reinforces that they will be understood as indicating that the word “Balance” is being claimed as a trade mark. Although consumers may not be fully versed on the technical detail behind the use of the “TM” sign, I consider that they would at least understand that it is something to do with the legal status of the mark, rather than being part of the trade mark itself.

30. In respect of signs such as the “TM”, which are used alongside trade marks, I note that the CJEU in *BioID.®*, described the “®” sign in the mark as a “*graphic element... [that does] nothing to enable the relevant public to distinguish, without any possibility*

⁶ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

*of confusion, the products or services covered by the trade mark application from others which have another origin.*⁷ Applying the same principle here, and also noting the evidence and submissions before me, I find that the “TM” aspect of the Applicant’s trade mark does not alter the distinctive character of the mark overall, being an accepted reference to convey that rights are claimed in the trade mark preceding it.

31. In respect of the Applicant’s argument that its mark cannot be said to consist *exclusively* of the word “Balance” and therefore cannot fall foul of section 3(1)(c), I refer to the General Court’s finding in Metabolic Balance Holding GmbH,⁸ included in the Applicant’s evidence at Exhibit FE6. In that case, the figurative mark  was found to be descriptive under Article 7(1)(c) of the EU Trade Mark Regulation⁹ (the equivalent of section 3(1)(c) of the Trade Marks Act), with the court stating:

“...where the word element of a mark is descriptive, the mark is descriptive as a whole, provided that the graphic elements of the mark are not capable of diverting the relevant public from the descriptive message conveyed by the word element (judgment of 11 July 2012, Laboratoire Garnier v OHIM (natural beauty), T 559/10,- not published, EU: T: 2012: 362, paragraph 27, and order of 20 November 2015, Zitro IP v OHIM (WORLD OF BINGO), 202/15, not- published, EU: T: 2015: 914, paragraph 22).”

32. Although the mark before me is not a figurative mark, I find the principle of *being capable of diverting the relevant public from the descriptive element* would apply in the present case. Therefore, if my finding is that the word “Balance” is descriptive of any of the goods and services, following this principle, the “TM” symbol would not be capable of diverting from the descriptive nature of the word “Balance” and therefore, a section 3(1)(c) ground could apply, irrespective of the letters “TM”.

⁷ BioID AG v OHIM C-37/03P, at paragraph 72.

⁸ Case 597/15 Metabolic Balance Holding GmbH v European Union Intellectual Property Office (EUIPO), paragraph 33

⁹ No. 207/2009

The average consumer

33. The Applicant has made no submissions on the identity of the average consumer. The Opponent, in its submissions in lieu of a hearing, refers to the Hearing Officer's decision in BALANCE and BALANCE HEALTH where the average consumer of dairy products and spreads was found to be the general public. The Opponent submits that the same average consumer applies in respect of the Applicant's goods in Classes 5, 29 and 32. The Opponent makes no submissions on the identity of the average consumer of the Applicant's services.

34. The Applicant's goods cover a range of supplements, preparations, foods, and beverages, most of which are described as serving particular dietary purposes such as the provision of vitamins, minerals, or protein. While I agree with the Opponent that the average consumer of these goods will be the general public, I would add that for the most part, the goods will be particularly targeted to those with an interest in fitness and/or healthy eating. Some goods – including “*nutritional supplements for athletes; dietary supplements for athletes;*” and “*beverages for athletes*” may predominantly target a specialist public in terms of the athletes themselves, or even a professional public in respect of an athlete's trainer or medical team. Also, there are “*strengthening preparations for the joints of plants and animals*” that will be targeted mainly at a professional public, being a vet, farmer, or horticulturalist, however, I do not discount that the general public of pet owners and people interested in gardening would also be relevant.

35. The Applicant's goods are more or less all of a type that are generally consumed every day and replenished with a certain frequency. The average consumer will pay attention to the claimed health benefits of the goods, their nutritional content and, in the case of vitamins and minerals, their strength. In respect of food and drinks, the consumer will also consider, inter alia, the ingredients and calorie, fat, and sugar content. The consumer may also pay a premium for food and drink that is enriched with vitamins and minerals, or that have a particular protein or carbohydrate content. As a result, I consider the average consumer will pay a medium degree of attention in the purchasing process. In terms of the goods specifically aimed at athletes, a higher degree of attention is likely to be paid – between medium and high – to ensure that

the goods fit with their specific dietary regime, and that there is no possibility of the goods containing banned substances. A higher degree of attention will also be paid by the professional public in the purchase of “*strengthening preparations for the joints of plants and animals*,” again a degree of attention between medium and high.

36. In respect of the services in the Applicant’s mark, these concern retail and wholesale services in relation to the sale of supplements, food and beverages, including those for dietetic purposes, or enriched with vitamins and minerals. Also included are retail and wholesale services for the sale of clothing. For the retail services, I consider the average consumer to be the general public, with the average consumer for the wholesale services being a professional public, principally businesses buying supplements, food, drinks, and clothing. In both instances, the average consumer will pay a medium level of attention when engaging the services.

Decision on section 3(1)(c)

37. In reaching my decision, I note that section 3(1)(b) and 3(1)(c) are independent and have different general interests behind them but that, if a mark is found to be descriptive, it follows that it is also devoid of any distinctive character. I also keep in mind that it is possible for a mark not to fall foul of section 3(1)(c), but to still be objectionable under section 3(1)(b).¹⁰ With these principles in mind, I deal with the ground of opposition under section 3(1)(c) first.

38. The Opponent submits that the mark will immediately be perceived as designating that the Applicant’s goods are designed to assist with maintaining a “*balanced*” diet, sports or health regime, and/or general lifestyle,” or are consumed as part of a “*balanced*” diet, sports or health regime, and/or general lifestyle.” And the Applicant’s services, are retail and wholesale services connected with goods designed to assist with maintaining a “*balanced*” diet, sports or health regime, and/or general lifestyle, or are consumed as part of a “*balanced*” diet, sports or health regime, and/or general lifestyle.” I note that each of the Opponent’s definitions refer to “*Balance*” rather than “*Balanced*.” In support of its claims, the Opponent refers to the definitions of “*balance*”

¹⁰ SAT.1 SatellitenFernsehen GmbH v OHIM, Case C-329/02 P at paragraph 25.

and “*balanced*” and their use on the internet in relation to diet and health, as set out in Exhibits FE2 and FE3. The Opponent also highlights various cases from its evidence where the descriptiveness and distinctiveness of marks consisting of, or containing the word “*balance*” has been assessed, including the UK IPO joined decision in “BALANCE HEALTH” and “BALANCE.”

39. The Applicant submits that the word “balance” would not be immediately perceived by the average consumer as providing information about the goods and services at issue. The Applicant highlights that only the definition of the word “balanced” in Exhibit FE2 relates to food and submits that while the word “balanced” could be descriptive for the goods and services, the same cannot be said for “Balance,” or “BalanceTM”.

40. The question before me under section 3(1)(c) is whether the word “*Balance*,” *solus*, describes a characteristic of the goods and services. In making this assessment, I keep in mind the case law set out at paragraphs 23 to 26 and in particular the general interest of ensuring that descriptive signs may be freely used by all traders offering the specified goods or services. I also keep in mind the submissions of the parties set out above; the definition of the word “balance” as a verb meaning “*Establish equal or appropriate proportions of elements in;*” and the previous finding of the tribunal in respect of the marks “BALANCE HEALTH” and “BALANCE” in respect of dairy products and spreads. I also take note of the findings of Mummery LJ in the *Now TV* case, *Starbucks HK Limited v. BSB Group plc*¹¹ where the figurative mark “NOW” was invalidated in respect of primarily TV and telecommunication services. In his judgment Mummery LJ drew conclusions including that:

(i) [...] *the claimants chose as their trade mark a commonplace, easily understood, ordinary English word, which was also used by other undertakings in relation to other products or services;*

(ii) [...] *it must have been obvious to the claimants that, in making that choice, they were running the risk of invalidity on the ground that the message that was conveyed or could be conveyed by the everyday word to the average consumer designated a characteristic of that service.*

¹¹ [2013] EWCA Civ 1465 at paragraphs 96 to 99.

(iii) [...] *The trade mark would attract the custom of all those viewers who "want it now." The attraction is of having immediate and instant access to programmes of choice on demand rather than having to settle for waiting.*

(iv) [...] *when viewed from the position of the hypothetical average consumer of the claimants' service, the mark NOW would be understood as designating that attractive instant and immediate characteristic of the service for which it was registered. The mark NOW refers to more than just the service itself. It refers to something about the service, an appealing characteristic that will pull in the punters.*

41. Lastly, I have considered whether the trade mark is merely allusive in respect of the goods and services, or whether there is *"a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics."*¹²

42. Taking all of this into account, I find the Applicant's mark to consist exclusively of a sign which may serve in trade to describe the intended purpose of the goods, i.e. that the goods are supplements, vitamins and minerals, foodstuffs, concentrates, beverages, and preparations for making beverages that provide balance to one's diet. Furthermore, many of the goods have a clear purpose in the correction of a deficiency in the body, for example isotonic drinks help to restore and balance sugar and salt levels in the body after exercise; foodstuffs and supplements enriched with minerals help to balance mineral levels in the body.

43. Through its evidence in Exhibit FE3, the Opponent has shown that the concept of balance is important in relation to diet and health. The average consumer who is a health-conscious member of the general public, an athlete or trainer, will be attracted to the supplements, foods and drinks bearing the word "Balance" as it conveys a desirable message about the intended purpose of the goods and as such should be freely available for use by other traders. The trade mark is therefore contrary to section 3(1)(c) in respect of the following goods:

¹² Case T-19/04 Metso Paper Automation v OHIM (PAPERLAB) [2005] ECR II-2383, paragraph 25 and the case-law cited.

Class 5: Dietary foods supplements; Dietary supplement beverages; Nutritional supplements for athletes; Vitamin and mineral preparations, including preparations in capsules; Preparations for slimming purposes; Metabolism strengthening preparations; Preparations for supplementing the body with essential vitamins and microelements; Preparations containing plant extracts; Dietary supplements for athletes; Food supplements enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; Diet supplements; Mineral and vitamin food supplements; Amino acid; Mineral waters for medical purposes; Dietary foods; vitamin drinks. High-protein supplements, enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; Protein-based supplements, including those made from additives of plant and animal origin; Carbohydrate-based supplements including made with additives; Dietetic foodstuffs based on protein.

Class 29: Foodstuffs, included in this class, enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; High-protein concentrates, enriched with vitamins, mineral salts, amino acids, carbohydrates and additives of plant origin; Protein-based concentrates, including those made from additives of plant and animal origin; Milk products and milk beverages, carbohydrate-based concentrates, including made with additives.

Class 32: Mineral water (beverages); Beverages for athletes; Energy drinks; Beverages, including beverages based on amino acids, carbohydrates and protein; Energy drinks containing caffeine; Isotonic beverages; Preparations for making drinks; Beverages enriched with added minerals; Protein beverages; Protein and carbohydrate beverages; powders for making beverages; Preparations in powder form for making beverages, including beverages based on carbohydrates, amino acids and protein.

44. In respect of *strengthening preparations for the joints of plants and animals*, I consider these goods would contain various nutrients to provide balance in the diet of animals and in the nutrient levels of plants, to maintain or improve joint health. As a result, I find the Applicant's mark to describe the intended purpose of these goods, this being to provide balance in the diet of animals and the nutrient levels of plants. As a

result, the average consumer will perceive the trade mark as a descriptive term in respect of the goods.

45. In relation to the goods identified in the above two paragraphs, I find the opposition to the trade mark to succeed under section 3(1)(c) of the Act. Having found that the mark is objectionable under 3(1)(c), it follows that it also lacks distinctive character under 3(1)(b). However, as the Opponent has also objected to the mark in respect of 3(1)(b), *solus*, I will go on to assess the mark in relation to that section as a separate issue.

46. Turning to the Applicant's services in Class 35, I note that none of the earlier decisions provided by the Opponent in its evidence¹³ concern retail or wholesale services and that the examples of use in trade at Exhibit FE3 do not show use of "Balance" in respect of retail or wholesale. I therefore agree with the Applicant that the descriptive nature of the trade mark has not been made out by the Opponent on the retail and wholesale services specifically listed in the Applicant's submissions in lieu of a hearing, or indeed in respect of any of the Applicant's services in Class 35.

47. I find that the average consumer, on encountering the word "Balance" in respect of retail and wholesale services would not perceive the mark as designating the *kind, quality, intended purpose, value, geographical origin, time of rendering of services, or any other characteristic*. There is no *specific or direct relationship*¹⁴ between the word "Balance" and the services concerned, as an undertaking that provides retail services relating to goods that provide "balance," does not provide "balance" or even "balanced" services. As I have found there to be no basis under section 3(1)(c) to refuse the registration of the mark for the services in Class 35, no section 3(1)(b) refusal follows.

48. In its submissions in lieu of a hearing, the Opponent argues that there is a public interest issue in not allowing a mark containing the "TM" symbol to be registered, as this could prevent other traders from freely being able to use said symbol. I have already indicated in this decision that I find the "TM" symbol does nothing to alter the distinctive character of the Applicant's mark and I have gone on to focus my

¹³ At Exhibits FE5 and FE6.

¹⁴ See PAPERLAB case.

assessment of section 3(1)(c) on the basis of the word “Balance.” It is not unknown for a trade mark to be filed which includes such a symbol, and I reflect again on the *BioID.®* case as an example. Putting the nature of the “™” and “®” signs to one side, a trade mark may contain descriptive or non-distinctive elements, but it is the mark as a whole that is protected. A proprietor will not be able to prevent others from using or registering the non-distinctive or descriptive elements of their trade marks so, by allowing this mark for services in Class 35, I cannot accept the Opponent’s argument that the Applicant would be able to block others’ use of the “™” sign.

Decision on section 3(1)(b)

49. I have found the Applicant’s mark to be objectionable under section 3(1)(c) for all of the goods applied for. If my decision is correct, it follows that the mark is also devoid of any distinctive character and therefore excluded from registration by section 3(1)(b) of the Act too. However, it is possible that the mark may be objectionable under section 3(1)(b) regardless of whether the mark is also considered descriptive. I must also consider whether the services in the Applicant’s mark, which I have found to be acceptable under section 3(1)(c), are objectionable under section 3(1)(b) of the Act.

50. In its submissions in lieu of a hearing, the Opponent states that “*BALANCE, as a well-known word, cannot itself be distinctive*” and the addition of the “™” sign “*does not remedy this.*” The Applicant, in its submissions in lieu of a hearing, argues that “*the requirement for distinctiveness is an extremely low threshold and ordinarily if the mark is considered not descriptive it has a very high chance of being considered distinctive.*”

51. I have set out the relevant case law relating to section 3(1)(b) at paragraph 23, which includes the statement 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.*”¹⁵ I agree with the Opponent’s statement that the word “Balance” is a well-known word, and is a word that I find would be generally understood by UK consumers of the goods and services. However, this fact is not sufficient for the Applicant’s mark to be

¹⁵ OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG Case C-265/09 P

objectionable under section 3(1)(b), indeed there are many English words that serve as distinctive trade marks in the UK. Without any indication from the Opponent of the lack of distinctive character of the mark in respect of the specific goods and services at issue, I do not find any reason for the Applicant's mark to be objectionable under section 3(1)(b) of the Act, other than because of the descriptive nature of the mark that I have found to exist in respect of the goods in the application.

52. As a result, I find the Applicant's mark to be objectionable under section 3(1)(b) for all of the goods applied for, on the basis that it has been found to be descriptive under section 3(1)(c), but the Applicant's mark to be acceptable under section 3(1)(b) for all of the applied for services in Class 35.

Conclusion

53. The opposition has partially succeeded. Subject to appeal, the application will be refused in respect of the goods applied for in Classes 5, 29 and 32 and will proceed to registration in respect of the services in Class 35.

COSTS

54. The Opponent and the Applicant have both achieved success and so I order each party to bear its own costs in these proceedings.

Dated this 28th day of July 2021

Charlotte Champion
For the Registrar