

O/587/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3461017
BY GLYCOLOGIC LIMITED
TO REGISTER:**

QI NUTRITION

**AS A TRADE MARK
IN CLASSES 5 AND 30**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 420322
BY RSG GROUP GMBH**

Background and Pleadings

1. On 24 January 2020, Glycologic Limited (“the applicant”) applied to register the trade mark QI NUTRITION in the UK. The application was accepted and published in the Trade Marks Journal on 7 February 2020 in respect of the following goods:

Class 5: *Dietetic foods; Dietetic food supplements; Dietary supplements and dietetic preparations; Dietary supplemental drinks; Dietetic food adapted for infants; Food for babies; Baby foods; Cereals for babies; Medicinal drinks; Vitamin drinks; Dietary supplement drinks.*

Class 30: *Coffee, tea, cocoa, artificial coffee; sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, pastries; ices; ice-cream; ice cream bars; chocolate; biscuits; cookies; confectionery; pies; pizzas; pasta; pasta sauces; cooking sauces; maize, corn and rice snacks; prepared meals and snacks; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; oil; ice; sandwiches; Cereal based energy bars; Cereal-based snack food; Snack foods made from corn; Corn chips; Corn curls; Corn, roasted; Bread; Nut flours; Processed corn; Puddings; Puffed corn snacks; Rice-based snack food; Roasted corn; Crackers; Pretzels; Popcorn; Steamed corn kernels.*

2. RSG Group GmbH (“the opponent”) opposed the application on 16 April 2020 on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the trade marks shown below:¹

EU010624039 (“the first earlier mark”)

Qi²

Filing date: 25 January 2012.

¹ Although the UK has now left the EU, as these proceedings were commenced before 31 December 2020, the UK’s departure from the EU does not impact upon the opponent’s ability to rely upon EUTMs.

Date of entry in register: 1 August 2012.

Relying on the following goods:

Class 5: *Nutritional supplement and Health foods; Food supplements, not for medical purposes; Vitamin preparations; Preparations with minerals and trace elements; Preparations with fatty acids and plant extracts.*

Class 29: *Health foods, Not for medical use, Included in class 29; Milk products; Milk-based beverages; Preserved, frozen, dried and cooked fruits and vegetables.*

Class 30: *Health foods, Not for medical purposes, All the aforesaid goods included in class 30; Cereals and cereal bars for human consumption, muesli and muesli slices, mainly consisting of cereals, fruits and proteins.*

Class 32: *Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Vegetable juices; Syrups and other preparations for making beverages.*

EU017969041 (“the second earlier mark”)

Qi²

Filing date: 16 October 2018.

Date of entry in register: 24 July 2019.

Relying on the following goods:

Class 29: *Dietetic food and dietary supplements, consisting predominantly of charcuterie, meat extracts, dairy products, fruit, vegetables, either singly or in combination; Charcuterie, including sausages and frankfurters; Vegetarian sausages; Vegetable burgers; Snack foods based on vegetables; Snack foods based on legumes; Potato-based snack foods; Snack foods based on nuts; Meat-*

based snack foods; Meat extracts; Vegetable and potato-based crisps; Yucca chips; Protein-based, nutrient-rich snack bars; Milk products; Milk based beverages; Dairy products and dairy substitutes; Preserved, frozen, dried and cooked fruits and vegetables.

Class 30: *Dietetic food and dietary supplements, based on carbohydrates, consisting predominantly of cereals, fruit and protein, either singly or in combination; Sweet biscuits for human consumption; Crackers; Cheese curls [snacks]; Crisps; Savory pastries; High-protein cereal bars; High-protein snacks; Cereal-based snack food; High-carbohydrate and chocolate-based protein bars and snacks; Rice-based snack food; Snack food products made from cereal starch; Snack food products made from maize flour; Energy bars; Grain-based chips; Cereal and muesli bars for human consumption; Muesli and muesli bars, consisting predominantly of cereals, fruits and protein.*

UK00003280428 (“the third earlier mark”)

Qi²

Filing date: 4 January 2018.

Date of entry in register: 25 May 2018.

Relying on the following goods:

Class 5: *Nutritional supplement; Health foods, namely health food supplements consisting of proteins, health food supplements consisting of amino acids, health food supplements consisting of trace elements, health food supplements consisting of creatin, health food supplements consisting of vitamins and health food supplements consisting of minerals; Food supplements, not for medical purposes; Vitamin preparations; Preparations with minerals and trace elements; Preparations with fatty acids and plant extracts.*

Class 29: *Health foods, not for medical use, included in class 29 , namely protein based nutrient-dense snack bars, vegetable and potato based crisps and snacks which contain protein, sausage and meat snacks ; Milk products; Milk-based beverages; Preserved, frozen, dried and cooked fruits and vegetables. .*

Class 30: *Health foods, not for medical purposes, all the aforesaid goods included in class 30 , namely energy bars, grain based crisps and snacks which contain protein, high protein cereal-based and chocolate-based bars and snacks, low carbohydrate cereal-based and chocolate-based bars and snacks ; Cereals and cereal bars for human consumption, muesli and muesli slices, mainly consisting of cereals, fruits and proteins.*

Class 32: *Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Vegetable juices; Syrups and other preparations for making beverages.*

3. The opponent submits that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar, and the goods are either identical or similar.

4. The applicant filed a defence and counterstatement denying claims made and putting the opponent to proof of use of the first earlier mark.

5. The opponent represents itself; the applicant is represented by Vault IP Limited. Both parties filed evidence and written submissions. Although I do not intend to summarise the submissions here, I will bear them in mind and refer to them as necessary throughout the decision. No hearing was requested, and no submissions were filed in lieu of a hearing. The decision is taken following a careful perusal of the papers.

The opponent's evidence

6. The opponent's evidence consists of a witness statement by Harald Schnalke dated 8 April 2020 and two witness statements by Camille Wendling dated 11 November

2020 and includes eighteen exhibits. Mr Schnalke is the Chief Executive Officer of Qi² Sports Nutrition GmbH a company which was granted a licence to use the earlier mark by the opponent. Camille Wendling is an employee of the opponent's company.

7. The opponent's evidence has been provided to demonstrate use of the earlier mark. Given the approach I will take in relation to the issue of proof of use, which I will explain in paragraph 13, I do not need to refer to this evidence in any detail. However, I will refer to the rest of the evidence to the extent that it is considered appropriate or necessary.

The Applicant's evidence

8. The applicant's evidence consists of the witness statement of Professor Richard Frank Tester and five exhibits. Professor Tester is a Director of Glycologic Limited, i.e. the applicant, and has held that position since 2002. In his witness statement he explains the type of products his company produces and provides an analysis of the key nutritional component provided by those goods. For the purpose of this decision, it suffices to say that the applicant provides carbohydrate based nutritional products which are used to control blood glucose to avoid hypo-and hyperglycaemia.

9. Whilst Professor Tester gave evidence about the areas of interest of the applicant's company, the particular segments of the market in which the applicant (and the opponent) has so far chosen to trade do not deprive the opponent's marks of the normal level of protection afforded to every registered trade mark. This is because I must consider the notional and fair use of the competing marks across all segments of the markets for the goods which they are registered and applied for. For these reasons, whilst the evidence is noted, it will not be summarised in any detail. Further, insofar as the applicant's evidence also includes submissions, I will bear them in mind and refer to them as necessary throughout the decision.

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

(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.”

11. An earlier trade mark is defined in Section 6 of the Act, the relevant parts state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

12. The opponent’s marks qualify as earlier marks within the meaning of Section 6(1) of the Act because they have an earlier filing date than the contested application. The first earlier mark had been registered for more than five years on the date on which the opposed application was filed and, as a result, is subject to proof of use. The second and third earlier marks have not been registered more than five years on the date on which the opposed mark was filed and, as a result, are not subject to proof of use.

13. Since the earlier marks are all identical and the second and third earlier marks provide specifications that are the same or broader than that provided by the first earlier mark, which is subject to proof of use, there will be no benefit to either party to

assess the proof of use for the first earlier mark. Hence, I will proceed on the basis of the second and third earlier marks only.

14. 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 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.

Section 5(2) - Case law

15. The following principles 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.

(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 impression created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

16. The goods to be compared are as follows:

Applicant's goods	Opponent's goods
<p><u>Class 5</u></p> <p><i>Dietetic foods; Dietetic food supplements; Dietary supplements and dietetic preparations; Dietary supplemental drinks; Dietetic food adapted for infants; Food for babies; Baby foods; Cereals for babies; Medicinal drinks; Vitamin drinks; Dietary supplement drinks.</i></p> <p><u>Class 30</u></p> <p><i>Coffee, tea, cocoa, artificial coffee; sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, pastries; ices; ice-cream; ice cream bars; chocolate; biscuits; cookies; confectionery; pies; pizzas; pasta; pasta sauces; cooking sauces; maize, corn and rice snacks; prepared meals and snacks; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; oil; ice; sandwiches; Cereal based energy bars; Cereal-based snack food; Snack foods made from corn; Corn chips; Corn curls; Corn, roasted; Bread; Nut flours; Processed corn; Puddings; Puffed corn snacks; Rice-based snack food; Roasted corn; Crackers; Pretzels; Popcorn; Steamed corn kernels.</i></p>	<p>Second earlier mark</p> <p><u>Class 29</u></p> <p><i>Dietetic food and dietary supplements, consisting predominantly of charcuterie, meat extracts, dairy products, fruit, vegetables, either singly or in combination; Charcuterie, including sausages and frankfurters; Vegetarian sausages; Vegetable burgers; Snack foods based on vegetables; Snack foods based on legumes; Potato-based snack foods; Snack foods based on nuts; Meat-based snack foods; Meat extracts; Vegetable and potato-based crisps; Yucca chips; Protein-based, nutrient-rich snack bars; Milk products; Milk based beverages; Dairy products and dairy substitutes; Preserved, frozen, dried and cooked fruits and vegetables.</i></p> <p><u>Class 30</u></p> <p><i>Dietetic food and dietary supplements, based on carbohydrates, consisting predominantly of cereals, fruit and protein, either singly or in combination; Sweet biscuits for human consumption; Crackers; Cheese curls [snacks]; Crisps; Savory pastries; High-protein cereal bars; High-protein snacks; Cereal-based snack food; High-carbohydrate and chocolate-based protein bars and snacks; Rice-based snack food; Snack</i></p>

food products made from cereal starch; Snack food products made from maize flour; Energy bars; Grain-based chips; Cereal and muesli bars for human consumption; Muesli and muesli bars, consisting predominantly of cereals, fruits and protein.

Third earlier mark

Class 5

Nutritional supplement; Health foods, namely health food supplements consisting of proteins, health food supplements consisting of amino acids, health food supplements consisting of trace elements, health food supplements consisting of creatin, health food supplements consisting of vitamins and health food supplements consisting of minerals; Food supplements, not for medical purposes; Vitamin preparations; Preparations with minerals and trace elements; Preparations with fatty acids and plant extracts.

Class 29

Health foods, not for medical use, included in class 29 , namely protein based nutrient-dense snack bars, vegetable and potato based crisps and snacks which contain protein, sausage and meat snacks ; Milk products; Milk-

	<p><i>based beverages; Preserved, frozen, dried and cooked fruits and vegetables.</i></p> <p><u>Class 30</u></p> <p><i>Health foods, not for medical purposes, all the aforesaid goods included in class 30 , namely energy bars, grain based crisps and snacks which contain protein, high protein cereal-based and chocolate-based bars and snacks, low carbohydrate cereal-based and chocolate-based bars and snacks ; Cereals and cereal bars for human consumption, muesli and muesli slices, mainly consisting of cereals, fruits and proteins.</i></p> <p><u>Class 32</u></p> <p><i>Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Vegetable juices; Syrups and other preparations for making beverages.</i></p>
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17. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary”.

18. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

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

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

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

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

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

20. I note that the parties' goods are registered in different classes. However, I bear in mind that whether goods are in the same or different classes is not decisive in determining whether they are similar or dissimilar as per Section 60A of the Act:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

Class 5

21. Dietetic foods; Dietetic food supplements; Dietary supplements and dietetic preparations; Dietary supplemental drinks; Dietetic food adapted for infants; Food for babies; Baby foods; Cereals for babies; Dietary supplement drinks; Vitamin drinks.

Dietetic foods, dietetic preparations and food for babies are foods and preparations prepared for special dietary requirements. Dietary supplements are products that are taken in order to supplement a diet and provide additional nutrients. Consequently, I consider the applicant's goods to be identical on the principle outlined in *Meric* to the opponent's goods in class 5, namely *Nutritional supplement; Health foods, namely health food supplements consisting of proteins, health food supplements consisting of amino acids, health food supplements consisting of trace elements, health food supplements consisting of creatin, health food supplements consisting of vitamins and health food supplements consisting of minerals; Food supplements, not for medical purposes; Vitamin preparations; Preparations with minerals and trace elements*. If I am wrong and the goods are not identical, they must be similar to a high degree, as they would target the same users, have the same purpose, i.e. improve a patient's medical condition, share distribution channels and be competitive to a degree, for example, dietetic food could also be enhanced with nutritional supplements.

22. Medicinal drinks. Medicinal drinks are drinks for treating or preventing diseases. Similarly to what I have said above, bearing in mind that the purpose of these goods

is the same as that of the opponent's food supplements (insofar as they are used to improve a patient's medical condition), and that the goods have the same relevant public and share the same distribution channels, they are at least similar to a medium degree.

Class 30

23. Some of the goods at issue are identical. For example, Cereal-based snack food; Rice-based snack food and Crackers appear in both parties' specification and are self-evidently identical; Maize, corn snacks; Snack foods made from corn; Processed corn; Roasted corn; Steamed corn kernels; Corn, roasted; Puffed corn snacks; Popcorn; Corn curls in the applicant's specification are encompassed by *Cereal-based snack food* in the opponent's specification and are identical on the principle outlined in *Meric*; rice snacks in the applicant's specification encompasses *Rice-based snack food* in the opponent's specification and is also identical on the principle outlined in *Meric*; Biscuits in the applicant's specification encompasses *Sweet biscuits for human consumption* in the opponent's specification and are identical; pastry, pastries in the applicant's specification encompasses *Savory pastries* in the opponent's specification and so are identical (*Meric*); Corn chips falls within the wider category of *Grain-based chips* in the opponent's specification and is identical (*Meric*); Cereal based energy bars in the applicant's specification falls within the broader categories of *Cereal-based snack food* and *Energy bars* in the opponent's specification and is identical on the principle outlined in *Meric*. As the opponent's *Milk products* is a broad category that encompasses Ice-cream; ice cream bars in the applicant's specification, the goods are also identical on the principle outlined in *Meric*. Prepared [meals and] snacks in the applicant's specification is a broad category that encompasses *High-protein cereal bars*; *High-protein snacks*; *High-carbohydrate and chocolate-based protein bars and snacks*; *Snack food products made from cereal starch*; *Cereal and muesli bars for human consumption*; *Muesli and muesli bars, consisting predominantly of cereals, fruits and protein* in the opponent's specification. If not identical, the applicant's prepared meals must be highly similar to the opponent's *Dietetic food and dietary supplements, consisting predominantly of charcuterie, meat extracts, dairy products, fruit, vegetables, either singly or in combination* which would include dietetic food

made of those ingredients and sold in the form of prepared meals. Therefore, I find these goods to be identical on the principle outlined in *Meric*.

24. Pizzas; sandwiches; pasta; bread; puddings in the applicant's specification may be inclusive of cereal-based (gluten free) goods which would be encompassed by the opponent's *Dietetic food and dietary supplements, based on carbohydrates, consisting predominantly of cereals, fruit and protein, either singly or in combination* in the opponent's specification. Therefore, I find these goods to be identical on the principle outlined in *Meric*. However, if I am wrong, I find the goods to be similar to a high degree.

25. Flour and preparations made from cereals; Nut flours in the applicant's specification may be provided as products designed to meet a gluten free diet and be encompassed by *Dietetic food and dietary supplements, based on carbohydrates, consisting predominantly of cereals, fruit and protein, either singly or in combination* in the opponent's specification. Consequently, I find the goods to be identical on the principle outlined in *Meric*. However, if I am wrong, I find the goods to be highly similar.

26. Pretzels in the applicant's specification are a baked snack food typically made from wheat flour. I find that these goods are similar to the opponent's *crackers* as they have a similar nature and purpose, target the same users, are likely to be found in the same part of the supermarket and are competitive. Therefore, I find the goods to be highly similar.

27. Chocolate; cookies; confectionery (twice); pies in the applicant's specification and *sweet biscuits for human consumption* in the opponent's specification are either identical or, if not identical, coincide in users, uses, purpose, trade channels and are competitive and, as such, are similar to a high degree.

28. Pasta sauces; cooking sauces in the applicant's specification and *Dietetic food and dietary supplements, consisting predominantly of charcuterie, meat extracts, dairy products, fruit, vegetables, either singly or in combination* in (class 29 of) the opponent's specification have a similar nature, purpose and would be complementary and competitive to a degree. The goods in the opponent's specification could be used

to make pasta dishes and cooking sauces, for example lactose free bechamel or vegetable puree. Therefore, I find the goods are similar to a medium degree.

29. Coffee, tea, cocoa, artificial coffee in the applicant's specification are similar to *Milk based beverages* in (the class 29) of the opponent's specification, which include milk based beverages that are flavoured with coffee, tea and cocoa. The goods coincide in users and share trade channels, although they might not be found in close proximity. They also have a similar purpose (although the method of use is different) and are neither complementary, although they might be competitive to a certain degree. Therefore, I find the goods to be similar to a low degree.

30. Although Sugar, rice, tapioca, sago; honey; treacle; yeast; baking powder; salt; mustard; vinegar, sauces (condiments); spices; oil; ice; ices in the applicant's specification are all types of foods, that is where the similarity with the opponent's goods ends. The goods differ in nature, users, uses, purpose, and methods of use and are neither competitive nor complementary. Although trade channels coincide, the goods would be placed in different areas of supermarkets. Therefore, I find the goods to be dissimilar.

31. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion,² the opposition must fail in respect of the following goods in the applicant's specification that I have found to be dissimilar to the opponent's goods:

Class 30: *sugar, rice, tapioca, sago; honey; treacle; yeast; baking powder; salt; mustard; vinegar, sauces (condiments); spices; oil; ice; ices.*

The average consumer and the purchasing process

32. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc*,

² eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA

Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

33. The average consumer of the goods at issue will be a member of the general public. The selection of the goods will be primarily visual, as the goods are likely to be purchased by self-selection from the shelves of retail premises such as health food shops and supermarkets, or their online equivalents. That said, as many goods may also be the subject of, for example, word-of-mouth recommendations or oral requests, aural considerations must not be forgotten.

34. Although the goods are relatively inexpensive and everyday purchases, the consumer will select the goods taking into account individual needs and taste, nutritional content, and quality. As a result, I consider that the average consumer will purchase the goods with a medium level of attention.

Comparison of the marks

35. The respective trade marks are shown below:

QI NUTRITION	Qi ²
Contested trade mark	Earlier trade marks

36. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

Overall Impression

38. The opponent's marks consist of the letters “Qi” written in title case and the numeral “²” which is presented in superscript. The “Qi” element of the mark has slightly more of an impact than the superscript “²” due to its size and position. Despite this, the superscript “²” is not negligible and contributes to the overall impression of the mark.

39. The contested mark consists of the words “QI NUTRITION” written in capital letters. Whilst both elements contribute to the overall impression of the mark, the element “QI” is more distinctive than the element “NUTRITION” because it is placed at the beginning of the mark and is inherently more distinctive (as the word NUTRITION is descriptive of the goods).

Visual similarity

40. The opponent submits that the marks are highly similar because the “NUTRITION” element of the contested mark is descriptive, negligible, and therefore should not be considered. It also submits that when “NUTRITION” is removed and the signs “QI” and “Qi²” are compared there is a high level of similarity. Whilst I agree with the opponent that word “NUTRITION” is descriptive in the context of the goods at issue, it has a visual impact.

41. Visually, there is obviously some similarity between the marks because they share the first two letters “QI/Qi” at their beginning. Further the letters “QI/Qi” represent the dominant element in each mark. There are also points of visual difference between the marks, as the marks end in a superscript “²” and the word “NUTRITION” respectively, however, these elements are weaker in the overall impression of the marks. I also bear in mind that as a general rule, the beginnings of marks tend to make more impact than their endings,³ and that although the opponent’s marks are presented in title case, as a matter of law,⁴ the registration of a word mark does not prevent its use in different scripts (fonts or typefaces) so the use of a different typeface does not create a point of visual difference. Therefore, I consider the marks to be visually similar to a medium degree.

Aural similarity

42. The opponent submits that the marks have a high level of aural similarity due to the similar pronunciation of the letters “Qi”. Whilst I agree that the letters “QI” and “Qi” will have the same pronunciation in both marks, the additional elements, namely the superscript “²” and the word “NUTRITION” in the respective marks, create a point of aural difference. Therefore, I consider the marks to be aurally similar to a medium degree.

Conceptual similarity

³ *El Corte Ingles, SA v OHIM*, Cases T-184/02

⁴ Case T-364/04 *Sadas SA v OHIM*

43. Conceptually, both parties submit that “Qi” is a word that originates in the Chinese language. “Qi” is defined, by the opponent’s evidence, as “the life force” in traditional Chinese medicine. The opponent submits that the shared “Qi” element results in a high level of conceptual similarity between the marks. On the other hand, the applicant submits that conceptually the marks differ due to the suffixes. In my view, the average consumer is likely to perceive “Qi” in both marks as a string of two letters. For those consumers that are unaware of the meaning of “Qi”, the conceptual similarity between the marks will be limited to the fact that the marks contain the same sequence of two letters that convey no specific meaning. For those consumers, I find the marks to have a low degree of conceptual similarity. For those who understand the meaning of “Qi” in Chinese, they will find the conceptual similarity is stronger as the marks will convey the same concept. For those consumers, I find the marks to have a high degree of conceptual similarity. Whilst I also note the presence in both marks of differentiating elements, they are insufficient to differentiate the marks conceptually. In particular, word “nutrition” in the contested mark is descriptive of the goods for which it is used and does not introduce any distinctive concept. Likewise, the element “²” will be seen for what it is, namely, a superscript (with a very low degree of distinctiveness). Further, the fact that the element “²” is presented as superscript means that consumers are more likely to perceived the string “Qi” as a separate element and there is no evidence that the string “Qi” corresponds to (or will be understood as) a chemical compound and, as such, it is not sufficient to counteract the conceptual similarity created by the presence in both marks of the same string of letters Qi/Qi.

Distinctive character of the earlier marks

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

45. Registered trade marks possess varying degrees of inherent distinctive character through use, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

46. The opponent has pleaded that its marks have acquired enhanced distinctive character through use in relation to the provision of gyms in Germany and Austria, but not in the UK. However, the assessment I must make in regard to enhanced distinctiveness must be made from the point of view of the relevant public in the UK and is limited to the goods and services for which the opponent’s marks are registered (which do not include the provision of gym services which is proper to class 41). Therefore, the evidence provided does not assist the opponent.

47. The earlier mark consists of the sequence “Qi²”. Both parties submit that “Qi” originates in the Chinese language and it is defined by the opponent as “the life force”. The specification in the earlier marks does not suggest that the goods target solely the Chinese speaking public and, as I have already found, the goods are available to the UK general public who has no knowledge of the Chinese language.

48. Therefore, most average consumers are likely to perceive the earlier marks as an invented sequence. For those consumers who are unaware of the meaning of “Qi”, I consider that the earlier mark has a medium degree of distinctive character. But even for the consumers who understand “Qi” as meaning life force in the Chinese culture, the marks are neither descriptive nor allusive of the goods for which the earlier marks are registered. In respect of these consumers, I also find that the earlier marks have a medium degree of inherent distinctive character.

Likelihood of confusion

49. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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 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 recognized 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)."

51. I have found the marks to be visually and aurally similar to a medium degree and conceptually similar to a low (for consumers who perceive Qi as an invented word) or high degree (for consumers who are aware of the meaning of Qi). I have identified the average consumer to be members of the general public who will select the goods primarily through visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods to vary from identical to dissimilar. I have found the earlier marks to have a medium degree of inherent distinctive character.

52. Taking all the above factors into account, I consider that the differences between the marks (particularly the endings of each mark) are not sufficient to avoid direct

confusion, when imperfect recollection is factored in, in particular taking into account that 1) the word NUTRITION in the applicant's mark is descriptive and 2) the superscript ² is so small that can be overlooked. There is a likelihood of direct confusion at least when identical or highly similar goods are involved.

53. But even if one recalls the difference in the endings of the marks and/or becomes aware of both parties' products (noting the difference between the competing goods that are not identical or close to being so), I consider that the presence in the contested mark of the identical "Q" element will lead the average consumer to think that the marks come from the same or related undertaking. The difference in endings, will then, consequently, be put down to some form of brand variation. Therefore, I find that there is a likelihood of both direct and indirect confusion.

OUTCOME

54. The opposition has succeeded in relation to the following goods which will be refused:

Class 5: *Dietetic foods; Dietetic food supplements; Dietary supplements and dietetic preparations; Dietary supplemental drinks; Dietetic food adapted for infants; Food for babies; Baby foods; Cereals for babies; Medicinal drinks; Vitamin drinks; Dietary supplement drinks.*

Class 30: *Coffee, tea, cocoa, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, pastries; ice-cream; ice cream bars; chocolate; biscuits; cookies; confectionery; pies; pizzas; pasta; pasta sauces; cooking sauces; maize, corn and rice snacks; prepared meals and snacks; sandwiches; Cereal based energy bars; Cereal-based snack food; Snack foods made from corn; Corn chips; Corn curls; Corn, roasted; Bread; Nut flours; Processed corn; Puddings; Puffed corn snacks; Rice-based snack food; Roasted corn; Crackers; Pretzels; Popcorn; Steamed corn kernels.*

55. The opposition has failed in relation to the following goods which will proceed to registration:

Class 30: *sugar, rice, tapioca, sago; honey; treacle; yeast; baking powder; salt; mustard; vinegar, sauces (condiments); spices; oil; ice; ices.*

Costs

56. Both parties have achieved a measure of success. In these circumstances, the opponent has had more success overall and is entitled to a contribution towards its costs. On the 20 July 2021 the opponent submitted a costs proforma setting out the costs incurred in opposing these proceedings. These consisted of:

Notice of opposition:	2.5 hours
Preparing the evidence	22 hours
Written submissions	20 hours
Commenting on the other sides written submissions	8 hours
Official fees	£100

57. The registrar usually awards costs on a scale published in Tribunal Practice Notice 2/2016. As a matter of practice, litigants in person are asked to complete a costs proforma. The purpose of this is to ensure that the costs awarded do not exceed the amount spent on the proceedings. There is no right to be awarded the amount claimed. This is subject to an assessment of the reasonableness of the claim and must also take account of the registrar's practice of awarding costs on a contributory, not compensatory basis.

58. Approaching the matter this way, I consider the following figures to be a fair and reasonable award of costs:

Task	
Notice of opposition	2 hours
Preparing the evidence	10 hours
Written submissions	2 hours
Commenting on the other sides written submissions	2 hours
Official fees	£100

59. I have calculated the latter by adopting the standard rate used to calculate costs for unrepresented parties under The Litigants in Person (Costs and Expenses) Act 1975 (as amended) which sets the minimum level of compensation for litigants in person at £19 per hour. I multiplied this by the time I consider was reasonably spent on this application (16 hours). I have also borne in mind that, whilst the opponent filed written submissions and a statement of grounds, there is a significant overlap in each. Further, I applied a reduction to the hours spent in preparing the opponent's evidence, because the evidence of use was unnecessary given what I said about the mark subject to proof of use not improving the opponent's case. The total award of costs would therefore come to £404, however, applying a reduction of 20% to reflect the applicant's degree of success, this is reduced to £ 323.20.

60. I therefore order Glycologic Limited to pay RSG Group GmbH the sum of £323.20. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of August 2021

A Klass

For the Registrar,
the Comptroller - General