

O-1012-22

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS
IN THE MATTER OF
TRADE MARK APPLICATION NOS 3506265, 3570884 & 3570893 FOR THE
FOLLOWING MARKS RESPECTIVELY:**

**ION*BIOME
ION* INTELLIGENCE OF NATURE
POWERED BY ION***

IN THE NAME OF BIOMIC SCIENCES LLC

AND

**OPPOSITION THERETO BY
THE INSTITUTE FOR OPTIMUM NUTRITION
UNDER NUMBERS 421832, 425609 & 425610 RESPECTIVELY**

Background and pleadings

1. This dispute concerns three consolidated trade mark oppositions. The parties to the dispute are Biomic Sciences LLC (“the applicant”) and The Institute for Optimum Nutrition (“the opponent”).

2. The applicant applied to register the following trade marks:

Mark: ION*BIOME

UK TM No: 3506265

Filing date: 30 June 2020

Goods/services:

Class 3: Cosmetics; face powder; skin care products, namely, non-medicated skin serum; skin moisturizer.

Class 5: Dietary supplements; dietary food supplements; dietary and nutritional supplements; health food supplements.

Class 35: On-line wholesale and retail store services featuring dietary and nutritional supplements, cosmetics, skin care products, and nasal spray preparations.

Class 41: Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition.

Class 42: Bacteriological research; biochemical research and development; biological research; biotechnology research.

Mark: ION* INTELLIGENCE OF NATURE

UK TM No: 3570884

Filing date: 22 December 2020

Goods/services:

Class 3: Cosmetics; face powder; skin care products, namely, non-medicated skin serum; skin moisturizer.

Class 5: Dietary supplements; dietary food supplements; dietary and nutritional supplements; health food supplements; nasal spray preparations.

Class 35: On-line wholesale and retail store services in relation to dietary and nutritional supplements, cosmetics, skin care products, and nasal spray preparations.

Mark: POWERED BY ION*

UK TM No: 3570893

Filing date: 22 December 2020

Goods/services:

Class 3

Cosmetics; face powder; skin care products, namely, non-medicated skin serum; skin moisturizer.

Class 5

Dietary supplements; dietary food supplements; dietary and nutritional supplements; health food supplements.

Class 35

On-line wholesale and retail store services in relation to dietary and nutritional supplements, cosmetics, skin care products, and nasal spray preparations. nasal spray preparations.

3. The applications were subsequently opposed on the basis of section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. In support of its ground under s.5(2)(b), the opponent relies upon the following trade mark registration (“the earlier mark”):

Mark: ION

EUTM No: 12046405

Filing date: 6 August 2013

Date of entry in register: 16 March 2017

Goods/services:

Class 9: Downloadable electronic publications; computer application software; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages.

Class 16: Printed matter; printed publications; magazines; newsletters; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages.

Class 41: Education and training services; publication services; sporting and cultural activities; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages.

It is claimed that the respective marks are highly similar and the goods/services similar such that there exists a likelihood of confusion under s.5(2)(b).

5. The same earlier mark is also relied upon under s.5(3) of the Act. It is claimed that the earlier mark enjoys a reputation in the UK in respect of all the goods/services shown above. The opponent argues that the applicant will benefit from the “power of attraction, the reputation and the prestige of the mark ION”, leading to an advantage, riding on its coat tails. The opponent also claims that the use of the later mark will be out of its control, and it will “tarnish the reputation and power of attraction of the Earlier Mark”. It claims that use of the later mark will dilute the distinctive character and reputation of its mark.

6. Under s.5(4)(a) of the Act, the opponent relies upon the sign ION which it claims to have used throughout the UK since 1984. It claims to have accrued goodwill under this sign “in relation to a broad range of publications and educational, therapy and information services, in the fields of diet, nutrition and health.”¹

7. The applicant filed counterstatements denying all of the claims made and the oppositions were subsequently consolidated.

8. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

EVIDENCE

10. The opponent’s evidence consists of two witness statements, one being from Mr Matthew Peter Smith who is a partner for Abel and Imray, the opponent’s representative. The second is from Jacqueline Lynch who is the Chair of Trustees of the Institute for Optimum Nutrition (ION), a position held since January 2012.

11. Ms Lynch describes herself as an ION graduate and has been a practising nutritional therapist since 2010 and is registered with the British Association of Nutrition & Lifestyle Medicine (“BANT”) and the Complementary & Natural Healthcare Council (“CNHC”) since graduating from ION. She is an established figure in the field of nutrition.

¹ Para. 20 of the counterstatement

ION background

12. Ms Lynch states that “The principal activity is as a key education provider and ION has been training nutritional therapists for over 35 years, with students travelling from all over the globe to study here”.

13. Ms Lynch states that ION was founded in London in 1984 and that “Today, ION is the leading educational establishment in the United Kingdom for training and supporting nutritional therapists, and one of the most respected bodies of its kind in Europe. ION has over 2,000 alumni, and currently over 600 students registered and in training”. ION provides various graduate diploma courses along with shorter courses, all relating to health and nutrition.

14. Exhibit JL5 to the witness statement consists of ION’s prospectuses for the years 2015-16, 2016-17, 2017-18, 2018-19, 2019-20 and 2020-21. It states that the “ION Diploma courses are uniquely dual-accredited by the Nutritional Therapy Education Commission (NTEC) and the British Accreditation Council (BAC); and endorsed by Qualifi”. It goes on to state that “On successful completion of the course, ION graduates can apply to join the Nutritional Therapists’ professional register, CNHC, allowing them to apply for BANT professional body membership and to practise as a fully Registered Nutritional Therapist”.

Attendance figures

15. The attendance figures for the courses are set out below:

	2017-2018	2018-2019	2019-2020
Attendance (in-person)	222	202	186
Online attendance	212	246	230
TOTAL	435	448	416

16. Ms Lynch states that “ION students come from across the globe, UK (85%), Europe (10%), rest of the world (5%), and when asked why they chose to study ION, the most common key reason cited is “reputation” (57% of responses)”.

17. In terms of the various courses offered, Ms Lynch states:

Below are the qualifications and short courses offered by ION from July 2018 to July 2020, with details of the number of students/attendees:

Qualifications:

Science Access course (October, January, May intakes)

Certificate in Nutrition Studies (September, February intakes)

DipION Nutritional Therapy (September, February intakes)

Science Access	2017-2018	2018-2019	2019-2020
October intake	39 students	38 students	47 students
January intake	36 students	34 students	22 students
May intake	13 students	17 students	21 students
TOTAL	88 students	89 students	90 students

Certificate in Nutrition Studies	2017-2018	2018-2019	2019-2020
September intake	2 students	0 students	1 students
February intake	4 students	3 students	2 students
TOTAL	6 students	3 students	3 students

DipION Nutritional Therapy	2017-2018	2018-2019	2019-2020
September intake	365 students	364 students	335 students
February intake	64 students	80 students	78 students
TOTAL	429 students	444 students	413 students

18. There is also reference to 32 “CPD short courses” running between Sept 2018 and July 2020. The number of attendees range from 12 to 60.

19. In terms of marketing there is a print and digital magazine which is sent out quarterly. It has a global distribution of over 14,000 per quarter with 13,833 being sent to an address in the UK and the digital version has over 4,500 global subscribers. Ms Lynch states that for the summer issue of July 2020 (which is before the relevant date), 12,500 hard copies of the magazine and 4621 issues of the digital magazine were issued. She goes on to state that direct subscriptions are mostly taken out by those members of the public that are interested in nutritional therapy and healthcare practitioners receive the ION magazine by way of free trade show exhibition placement. Further, free copies of the publication are placed in supermarkets, surgeries, etc but the exact figure and how widespread the distribution goes is not stated.

20. The marketing spend is broken down as follows:

Year ending 30 June	2016	2017	2018	2019	2020
Magazine costs	£37,379	£30,234	£29,879	£33,981	£33,672
Marketing and Promotion	£45,401	£45,697	£33,424	£105,076	£66,785
Annual Totally Expenditure	£82,780	£75,931	£63,303	£139,057	£100,457

21. Ms Lynch states that in 2002 the opponent launched its monthly newsletter. In 2014, an annual subscription to the online version was £14 and in 2016 it was £16.50. Since 2018 the electronic version of the magazine has been free and in July 2020 it was circulated to 24,607 subscribers. The cost to receive a hard copy of the magazine is set out below:

Year	Single print issues	Annual subscription
2013	UK £3.99: Europe €4.60	UK £18: EU £18 @ RoW £38
2014	UK £3.99: EU €4.60	UK £19: EU £28 @ RoW £38
2016-2021	UK £6.99: EU £9.99 @ RoW £10.99	UK £22: EU £134 @ RoW £46

22. Exhibit JL14 to the witness statement consists of an example monthly newsletter and it is noted that the mark appears as follows:



23. In terms of social media, Ms Lynch lists the various social media platforms that the opponent has used, these include:

- Twitter since February 2009 with 5,754 followers
- Facebook since February 2011 with 9,066 followers
- Instagram since May 2016 with 8,696 followers
- YouTube since July 2012 with 26 videos posted which have cumulatively had 17,315 views and 420 subscribers.

24. It is noted that there are no turnover figures provided in relation to any of the goods or services provided.

25. The second witness statement is from Mr Matthew Peter Smith who a Partner for the opponent's representative. The evidence relates to the alleged descriptive use of the term "microbiome" which is relevant to the assessment of the marks and therefore I shall summarise the evidence there.

Decision

Section 5(2)(b)

The law

26. Sections 5(2)(b) and 5A of the Act are as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

The case-law

27. 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.

28. The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

30. It would be wrong, therefore, to dissect the trade marks artificially, 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.

31. The respective trade marks are shown below:

Applied-for marks	Earlier mark
<p style="text-align: center;">ION*BIOME ION* INTELLIGENCE OF NATURE POWERED BY ION*</p>	<p style="text-align: center;">ION</p>

32. The earlier mark is word only, consisting of just one word, being “ION”. There are no other elements that contribute to the overall impression of the mark, which lies solely in the word itself.

33. The applicant argues that “The distinctiveness of the later mark ION* INTELLIGENCE OF NATURE lies in its totality. In particular, the phrase ‘intelligence of nature’ is a highly distinctive phrase for cosmetics, health products and retail of the same”.

34. Specifically in relation to, the opponent argues that “INTELLIGENCE OF NATURE” is of limited distinctiveness as it only clarifies the meaning of the preceding acronym, with the first letter of each word corresponding to the initials in the acronym”. I do not believe that the average consumer would make the link between the first letters of “INTELLIGENCE OF NATURE” forming the acronym “ION”, especially for those who recognise and understand the meaning of “ION”.

35. All of the applied for marks include the word ION followed by a “*”. I do not believe that the “*” has any material impact on the distinctive character of the application as it would largely go unnoticed. The applications also include the words “BIOME”, “INTELLIGENCE OF NATURE” and “POWERED BY”. I consider these words to be of less distinctive character and therefore contribute less to the overall impression. Having said that, I do not consider there to be any single element which dominates the overall impression and therefore it resides in the marks as a whole.

ION*BIOME vs ION

Visual comparison

36. The applicant argues that by virtue of the earlier mark consisting of only 3 letters, whereas the applied-for mark has 9, 6 of which are “*BIOME” and not present in the

applied-for mark, then they are either dissimilar, or at the very best, similar to an extremely low degree.

37. The opponent argues that the respective marks are visually similar by virtue of “ION” appearing at the beginning of the applicant’s mark and being the only element to the earlier mark.

38. The applied-for mark comprises of the word ION which is separated from the word “BIOME” by the “*”. Further, “ION” is present at the beginning of the applied-for mark. Taking these factors into account, I find the marks to be visually similar to a medium degree at most.

Aural comparison

39. The applicant claims that by virtue of the applied-for mark containing “two long syllables, followed by two short syllables”, and the earlier mark having two, then the marks are aurally dissimilar, or at the very best, similar to an extremely low degree. The opponent simply maintains that as “ION” appears at the beginning of the respective marks, they are aurally similar.

40. The earlier mark would be pronounced in its ordinary manner, i.e. I-ON. It would be pronounced in the same way in the applied-for mark. Whilst the “*” element will not be verbalised the respective marks do aurally differ insofar that the applicant’s marks include BIOME which is not present in the earlier mark. Therefore, I consider the respective marks to be aurally similar to a medium degree, at most.

Conceptual comparison

41. The applicant argues that: “Conceptually, the ION*BIOME, in totality, has a conceptual meaning distinct from the opponent’s mark ION. In particular, the word “biome” vaguely hints at something to do with ecology, the concept of which is entirely absent from the opponent’s mark.” In view of this, the applicant argues that the respective marks are conceptually dissimilar, or at the very best, similar to an extremely low degree.

42. The Collins English dictionary definition for “BIOME”, as evidenced by the opponent,² is “a major ecological community, extending over a large area and usually characterised by a dominant vegetation”. The evidence submitted is also aimed at demonstrating that the word “biome” is used in the context of health and nutrition, e.g. ‘gut biome’, ‘microbiome’.

² Exhibit MPS1 to the witness statement of Matthew Peter Smith

43. The opponent argues that “the common term ‘ION’ has no meaning in relation to health and nutrition”.³ It also states that the dictionary definition for “ion” is “an atom or molecule with a net electric charge due to the loss or gain of one or more electrons”.

44. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer⁴. In line with the submissions of the Opponent, I find that “ION” has no immediately graspable concept in relation to the health and nutrition goods and services at issue. I do not believe that the precise definition of “ION” will be known to all, but I would expect some consumers to recognise “ION” as an English defined word which probably relates to physics, chemistry or electricity. Others will not know what the word ION means and would therefore consider it to be an invented word.

45. For the consumers who know that the word ION has some concept - (whether it be the precise dictionary definition, or more loosely of something that relates to chemistry or physics), there will be some conceptual similarity regardless of whether they understand BIOME or not. For those that understand the meaning of BIOME a conceptual difference arises, though the combination of BIOME and ION does not create its own separate conceptual meaning. For those that do not understand BIOME but know the meaning of ION then they are conceptually very similar (though in my view this is a less likely sub-set of the average consumers). For those that do not understand ION, then there is no conceptual similarity regardless of whether they understand BIOME or not.

ION* INTELLIGENCE OF NATURE v ION

Visual comparison

46. The applicant argues that as the earlier mark is “very short, comprising only three letters”,⁵ whereas the application has four elements, the marks are visually dissimilar. The opponent points out that “the signs coincide in the distinctive string of letters “ION” which comprise the entirety of the Earlier Mark and the beginning of the Mark of the Application.”⁶

47. The marks do coincide with the word “ION” present in both marks but differ by virtue of the application also consisting of the “*” symbol and the words “INTELLIGENCE OF NATURE”. Given the number of words difference, letters and a symbol I consider the marks to be visually similar to a low degree.

Aural comparison

³ Para. 27 of the written submissions

⁴ Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29)

⁵ Para. 24 of the applicant’s submissions

⁶ Para. 43 of the opponent’s written submissions

48. The applicant argues that the marks are not aurally similar, or, in the alternative, degree by virtue of the marks sharing 2 syllables they are similar but only to an extremely low degree.

49. The opponent states that “irrespective of the different pronunciation rules...the signs coincide in the sound of the shared letters ‘ION’.”⁷ It also argues that the public would not verbalise the words “INTELLIGENCE OF NATURE”.

50. I agree with the opponent. The word “ION” would be pronounced in the same manner. I also agree that the words “INTELLIGENCE OF NATURE” are unlikely to be spoken by many and therefore they are aurally identical. For those that would verbalise “INTELLIGENCE OF NATURE” they are aurally similar to a low degree.

Conceptual comparison

51. The opponent argues that the relevant public would simply assume that the earlier mark ION is, in the absence of any other description or expansion, an abbreviation of “INTELLIGENCE OF NATURE”. I am not convinced by this argument. I do not believe consumers would examine and conceptualise the marks to the extent the opponent argues. Nonetheless, the phrase INTELLIGENCE OF NATURE in the applied-for mark is composed of ordinary words that will be understood by the average consumer, and those words, absent from the earlier mark, therefore introduce a conceptual difference.

52. In my view, for those that give ION a meaning there is conceptual similarity to a medium degree because the word would be given the same meaning in both marks. For those that don’t give the word ION any meaning, there is no conceptual similarity.

POWERED BY ION* v ION

Visual comparison

53. The applicant’s argument is effectively that since the earlier mark is “very short, comprising only three letters”⁸ they are dissimilar, or at the very best, similar to an extremely low degree.

54. The opponent states that:

“Visually, the signs coincide in the distinctive string of letters ‘ION’ which comprise the entirety of the Earlier Mark and the end of the Mark of the

⁷ Para. 44 as above

⁸ Para. 33 as above

Application. The words 'POWERED BY' have no counterpart in the Earlier Mark but, as discussed above, would be understood to be secondary and subordinate to the distinctive element ION. We submit that the asterisk at the end is not significant and would go unnoticed by the average consumer; it is certainly not sufficient to distinguish the marks."

55. There is a clear visual similarity between the marks as they both contain the word ION. This is not altered by the existence of the asterisk. Clearly the words POWERED BY ION, and the * to a lesser degree reduces the level of similarity to a level which I consider to be less than medium but not low.

Aural comparison

56. The earlier mark would be pronounced in its ordinary manner, i.e. I-ON. It would be pronounced in the same way in the applied-for mark. The respective marks do aurally differ insofar that the applicant's marks include the words "POWERED BY" which is not present in the earlier mark. The "*" element will not be verbalised and therefore the respective marks are similar to a degree less than medium but not low.

Conceptual comparison

57. The applicant argues that:

"The later mark POWERED BY ION*, as a whole, has a concept distinct from that conveyed by the earlier mark since 'powered by' is absent. The phrase 'powered by ion' is distinctive in relation to the goods/services, and 'powered by' will not be disregarded by consumers. The consequence is that the marks are not conceptually similar in totality. If the Office perceives a degree of conceptual similarity between the marks, which we refute, we submit in the alternative that any perceived similarity is only to an extremely low degree."

58. The opponent argues that 'ION' has no meaning in relation to health and nutrition and so if "consumers were to first encounter the Opponent's ION in the context of health and nutrition and subsequently encounter POWERED BY ION* in relation to nutritional supplements, they would presume that the Applicant's mark is merely an expanded form of the Opponent's mark in order to educate consumers that these goods are produced by ION."

59. For consumers that consider the word "ION" to be an invented word there is no conceptual similarity. For those that attach a concept then the meaning would be the same for each of the marks. This would not be altered by the inclusion of POWERED BY as this element provides the consumer with an indication of the provider, i.e. ION. Further, the "*" device would also not alter the concept. Therefore, for these consumers there is a high degree of conceptual similarity.

Comparison of goods and services

60. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

61. The competing goods and services are given below:

Applied-for goods	Earlier goods/services
<p>3570884 Class 3: Cosmetics; face powder; skin care products, namely, non-medicated skin serum; skin moisturizer.</p> <p>Class 5: Dietary supplements; dietary food supplements; dietary and nutritional supplements; health food supplements; nasal spray preparations (not present in '884 and '893).</p> <p>Class 35: On-line wholesale and retail store services in relation to dietary and nutritional supplements, cosmetics, skin care products, and nasal spray preparations.</p>	<p>Class 9: Downloadable electronic publications; computer application software; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages.</p> <p>Class 16: Printed matter; printed publications; magazines; newsletters; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages.</p>
<p>3570893 Class 3: As above Class 5: As above except that it does not cover "nasal spray preparations" Class 35: As above</p>	<p>Class 41: Education and training services; publication services; sporting and cultural activities; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages.</p>
<p>3506265 Class 3: As above Class 5: As above except that it does not cover "nasal spray preparations" Class 35: On-line wholesale and retail store services featuring dietary and nutritional</p>	

<p>supplements, cosmetics, skin care products, and nasal spray preparations.</p> <p>Class 41: Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition.</p> <p>Class 42: Bacteriological research; biochemical research and development; biological research; biotechnology research.</p>	
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62. The applied for classes 3, 5 and 35 are largely the same and therefore I shall deal with these collectively. I shall then move on to the other services applied for under trade mark application no. 3506265.

Class 3

Cosmetics; face powder; skin care products, namely, non-medicated skin serum; skin moisturizer

63. The applicant argues that 1) the opponent has not obtained protection for the earlier mark in class 3, 2) since the class 5 and 41 goods and services are not similar then it must follow that there cannot be similarity with class 3, and 3) a broad statement that applying each of the principles set out in *Treat*, I cannot conclude there to be similarity. Point 1 is simply irrelevant, not least by virtue of s.60 of the Act, which states that just because goods and services are in different classes does not mean they are to be regarded as dissimilar. Point 2 may be indicative, but the assessment is between the opponent’s earlier goods and services and those applied for under class 3.

64. The opponent’s submissions relating to the comparison of goods are brief and therefore I duplicate them in full below:

“The providers of dietary supplements will commonly also provide cosmetics and skin care products (the Class 3 products), as these products are often made using the same natural ingredients, and they have the same purpose of improving the appearance of skin, hair and nails. The Class 3 and 5 products therefore all contribute to a person’s health and wellbeing and are complementary and therefore similar to the Opponent’s education and training services and related goods relating to health.”

65. Both parties seem to want the assessment to begin with class 41 against class 5 and then by virtue of that conclusion I should then adopt a similar approach to class

66. This is not the correct way to approach a comparison of goods and services. I must assess the applied-for class 3 goods against what I consider to be the closest earlier relied upon goods and services.

67. The term *cosmetics* in the applied-for specification is a very broad term that can be said to cover any product that is applied to the body for cleansing the skin or for altering the user's appearance. It covers the remaining goods covered by the applied-for class 3 specification, along with products such as soaps, gels and make ups. In view of this, I agree with the applicant that when applying the principles of *Treat*, there is no similarity. I see no point of overlap with the earlier relied-upon goods or services in classes 9, 16 or 41 as they differ in nature, purpose and uses. I accept that the users may be the same, but the overlap is too general to conclude that there is any degree of similarity between the respective goods and services. They are dissimilar.

Class 5

Dietary supplements; dietary food supplements; dietary and nutritional supplements; health food supplements

68. In the opponent's submissions it refers me to four separate EUIPO Opposition Division decisions which have all found similarity between "education and training services relating to health and nutrition" (as covered by the earlier mark), and the above-mentioned applied-for goods in class 5. It is argued that decisions of the EUIPO Opposition Division should continue to apply in the UK, but the fact is that even when the UK was part of the European Union findings of the Opposition Division were not binding and, therefore, they are not binding now either. Notwithstanding this, I have read the rationale for the findings and bear it in mind for this comparison of goods and services.

69. The above-mentioned applied-for class 5 goods are all aimed at improving one's health. They are goods which are likely to come in a variety of forms such as pills, capsules, powder, liquid vitamins. They are consumed to supplement one's diet to ensure users have sufficient nutrition and minerals. They would be consumed by the general public, and available in supermarkets, online and in specialist nutritional and dietary shops.

70. The earlier relied-upon goods in classes 9 and 16 differ in nature, purpose and uses. With respect to the earlier class 41 services, the nature of services and goods differ as goods are tangible products whereas services are intangible. Further, the purpose of the respective goods and services are also different for similar reasons. The opponent argues that "the knowledge of nutritional and dietary supplements is integral to the work of nutritional therapists" and therefore this is an overlap in users. I do agree with this to a certain degree but not all dietary supplement users are, or consult, a nutritional therapist. Often the users will differ and so any user similarity is in a very broad sense.

71. I do not consider there to be any competition between the various dietary supplements and the class 41 services as an average consumer looking to purchase the goods would not face a choice between these goods and class 41 services. Further, they are not complementary as one is not indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.⁹

72. Taking all of the above into account, whilst there is a broad overlap in the user of the goods and services, this is too broad to find similarity. They are dissimilar.

Nasal spray preparations

73. The opponent has not made any submissions relating to the similarity (or not) between the above applied-for goods and the earlier goods and services. I do not see any point of similarity with these goods and the goods and services relied upon by the opponent. There is no overlap in users, they are in competition nor complementary, sold via different trade channels and differ in nature. They are dissimilar.

Class 35

On-line wholesale and retail store services in relation to dietary and nutritional supplements, cosmetics, skin care products, and nasal spray preparations

74. It is noted that the class 35 services covered by trade mark application no. 3506265 includes the word “featuring”, whereas application no. 3570884 has “in relation to”. I see no material difference between the terms and shall proceed on this basis.

75. The applied-for services are for the wholesale and retail of dietary and supplements, cosmetics, skin care products, and nasal spray preparations. None of the earlier relied-upon goods are those which the applicant is seeking the protection to sell (for others). Whilst this does not preclude there being similarity, the nature of the goods and services clearly differ, they are not in competition nor complementary with one another. I accept that a person that purchases the goods sold by the applicant may also purchase, for example, magazines about nutritional items but this does not result in similarity.

76. With regard to the earlier relied class 41 services, once again I do not see any level of similarity. They differ in nature, users, are not in competition nor are they complementary. They are dissimilar.

77. Trade mark application no. 3506265 includes services covered by classes 41 and 42. I shall now consider these.

⁹ See paragraph 82 of the ruling of the General Court in *Boston Scientific Ltd v OHIM*, Case T-325/06

Class 41(3506265 only): *Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition.*

78. I consider the services listed above for trade mark application no. '884 are aligned to the earlier relied upon class 41 "publication services". Although the physical nature of the services and the channels of trade may differ, there is an overlap in end users and purpose. Further, I consider the services to be in competition with one another. Overall, I find the services to be similar to at least a medium degree.

Class 42 (3506265 only): *Bacteriological research; biochemical research and development; biological research; biotechnology research.*

79. The opponent argues that "The goods and services of the Earlier Mark all relate to health and nutrition and are ancillary". It argues, therefore, that they are similar. I disagree. The applied for services are highly technical and specialist and to then consider them to be similar to the goods and services of the earlier mark would be far too broad an assessment. They are not similar in nature, purpose, and are not in competition or complementary. They are dissimilar.

80. In summary, all of the respective goods and services are dissimilar except for the class 41 services covered by trade mark application no. 3506265, which are similar to at least a medium degree to the opponent's "publication services".

81. In order for there to be a likelihood of confusion, there must be some similarity between the goods and services¹⁰. Since I have found that the vast majority of the respective goods and services are not similar then the oppositions under section 5(2)(b) fail to this extent. With regard to the services I have found to be similar to some of the earlier relied upon services I shall proceed to assess whether there is a likelihood of confusion. These are:

"Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition"

82. In view of the above, the rest of the s.5(2)(b) decision will focus on these services.

Distinctive character of the earlier trade mark

83. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of

¹⁰ See *Waterford Wedgwoodplc v OHIM- C-398/07 P* (CJEU).

confusion (*Sabel BV v Puma AG*). 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).”

84. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

85. The opponent claims that the earlier mark is both inherently distinctive but also enhanced as a result of the use made of it for over 35 years in relation to health and nutrition. It is true that the evidence shows that the mark has been used for over 35 years and there is a study which states that 57% of respondents chose ION to study because of its “reputation”. However, the number of attendees to the various courses is typically between 400 and 450 per annum and there are no turnover figures to determine the extent and scope of reputation. Therefore, if the distinctive character of the mark is enhanced by virtue of the use made of it, the increase is marginal.

86. From an inherent perspective, the word ION is not descriptive or allusive/suggestive of the goods and services in question. Some consumers would give it its dictionary definition and others who are not familiar with it may see it as being an invented word. For the former, even taking into account the distinctive character of the mark being increased by virtue of the use made of it, it is above medium. For the latter consumers who view it as being invented, then it’s distinctive character is high.

Average consumer and the purchasing act

87. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

89. The services in question are “*Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition*”. These are services which would predominantly be sought by the general public and, as evidenced, professionals. The level of attention paid by the general public would be at least medium, whereas the professionals are likely to pay a high degree of attention. They are services which would be purchased following a visual inspection of websites, though I do not discount aural recommendations.

Likelihood of confusion

90. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*), from the perspective of the average consumer. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

91. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods and services down to the responsible undertakings being the same or related. 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. 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 services and the nature of the purchasing process.

92. As can be seen from the above, the majority of the s.5(2)(b) claims are unsuccessful by virtue of the lack of similarity between the goods and services. However, I have found some similarity between the applied for class 41 services of trade mark application no. 3506265 (ION*BIOME) and those of the opponent. In this regard I have made the following findings:

- The marks are visually similar to medium degree; aurally similar to a medium degree, at most. Conceptually they are similar to a high degree to those who understand ION. To those that do not recognise the word ION then there is no conceptual similarity.
- The applied for Class 41 services are similar to at least a medium degree to the opponent's earlier publication services; all relating to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages..
- The average consumer of the services in question is a combination of the general public and professionals. The level of attention they pay will vary from at least medium for the former to high for the latter.
- The services will predominately be purchased following a visual inspection, though I do not discount aural recommendations.
- For those familiar with the word "ION" then the earlier mark is inherently distinctive to a degree marginally above medium, and to those who view it as an invented word then it is highly distinctive.

93. Taking all of the above into account, and even considering the principle of imperfect recollection, I do not consider that the average consumer will mistake one mark for the other. I recognise that the marks share the same common element, "ION", but it is followed by "*BIOME" would be sufficient for the average consumer to differentiate between them. Whilst the "*" would not be pronounced, the overall visual and aural differences are noticeable to the extent that they would not be misremembered as each other. On this basis, I find that there is no likelihood of direct confusion between the marks.

94. I now turn to whether there is a likelihood of indirect confusion. In *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

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

95. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

96. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

97. The respective marks share the common element “ION”. The inclusion of the other elements in the applied for marks do not create a unitary meaning and therefore ION retains an independently distinctive role. Accordingly, I find that it is likely that the average consumer will attribute “ION” to the same or economically linked undertakings, for example a brand extension or collaboration.

Conclusion

98. The s.5(2)(b) claim fails against trade mark application numbers 3570884 (ION* INTELLIGENCE OF NATURE) and 3570893 (POWERED BY ION*), but succeeds against trade mark application no. 3506265 (ION*BIOME) succeeds against the following Class 41 services:

“Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition”

Section 5(3)

99. I now turn to the claim under s.5(3) of the Act and shall focus my consideration of this claim in relation to the goods/services of the applications which have survived the opposition under s.5(2)(b). The relevant law is as follows:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

100. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”

The case-law

101. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort mark in order to create and maintain the

mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

102. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

103. Question 1 on the form TM7 statement of case asks the opponent for which goods or services the earlier trade mark has a reputation. In response the opponent ticked the “All” box. However, in the supporting statement of claim it states that: “The Earlier Mark enjoys a considerable reputation within the EU, in particular the UK, in relation to the provision of education, information and advice about nutrition, diet, health and well-being”. It is for these services which I shall consider the opponent claims to have a reputation. The opponent goes on to state that “The Earlier Mark ION has been in use for 35 years and the Opponent is one of the leading and most respected training bodies of its kind in Europe.”

104. The relevant date to assess whether the opponent had a reputation is the filing date of the contested applications. Trade mark application number 3506265 (ION*BIOME) was applied for on 30 June 2020 and therefore this is the relevant date. For trade mark application numbers 3570884 (ION* INTELLIGENCE OF NATURE) and 3570893 (POWERED BY ION*) the relevant date is 22 December 2020.

105. The evidence shows that the opponent has consistently used its earlier ION mark in relation to the provision of education, information and advice in relation to nutrition, diet, health and well-being. Originally founded in 1984 the opponent now delivers a number of educational qualifications and courses all relating to nutrition. The main course appears to be the ION diploma which upon successful completion allows graduates to join the professional nutritional therapist register (CNHC).

106. I have no evidence about the size of the market, but I nevertheless do not consider 400 to 450 per annum course attendees to be very significant. In fact, I would say it is relatively modest. In terms of marketing the annual expenditure ranged from around £60k to £140k for the years of the relevant period. Again, this is not an especially significant spend. It is notable that the turnover figures have not been provided and therefore it is difficult to determine market share.

107. It is clear from the evidence that ION graduates stand in good stead within the nutritional therapy field. Further, they have been using the mark for 35 years and many (57%) graduates choose its course based on its reputation.

108. In view of the above, I am satisfied that the opponent has a modest reputation for the provision of education and information about nutrition, diet and health. I note that the claim is that it has a reputation for “the provision of education, information and advice in relation to nutrition, diet, health and well-being”, however no turnover figures have been provided. The evidence does show that between 2019 and 2020 there is reference to 1231 attendees at advice clinics in Richmond but this figure is not significant, nor is the geographical extent. Further, the educational courses provided are all aimed at becoming a nutritional therapist and allowing the claim to proceed for well-being is too broad a term and does not reflect what they have reputation for.

109. I have found that the earlier relied upon mark has a reputation for “education services in relation to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages”. This reputation is not among the general public but is for graduates and professionals within this sector.

The link

110. As I noted above, my assessment of whether the relevant public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

111. At paragraphs 36 to 59 I have reached conclusions in respect of the level of similarity between the respective marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

112. For the reasons set out in paragraphs 63 to 80, I found the respective goods and services to be dissimilar.

The strength of the earlier marks' reputation

113. I have concluded that at the relevant date the opponent's evidence establishes that the strength of the earlier mark's reputation is modest and focused on "education services in relation to health and nutrition except relating to pharmaceutical products and preparations, dietetic beverages (non-medical) and isotonic beverages".

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

114. I have previously concluded that the distinctive character of the earlier mark is enhanced by virtue of the use made of it, but the increase is marginal and will be limited largely to those who have participated in its courses. Such professionals may be more discerning in their attention levels. In view of this, I concluded that for those consumers who are aware of the meaning of the word ION, the distinctive character is marginally above medium. For those that would view it as an invented word ION it is of high distinctive character.

Whether there is a likelihood of confusion

115. There is no likelihood of confusion.

116. This does not preclude me from finding in the opponent's favour under s.5(3). However, the reputation is modest, the goods and services are dissimilar and the distinctive character acquired through use is marginal. I accept that the marks are similar but, in my view, this does not overcome the remaining considerations which are against the opponent. Therefore, I do not consider there to be a link and the s.5(3) claim must be dismissed.

Section 5(4)(a)

The law

117. Once again I shall proceed on the basis that the opposition under s.5(4)(a) is only against those goods and services which did not survive the s.5(2)(b) claim. The relevant law is:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

118. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

The case-law

119. The three elements which the opponent must show are well-known: goodwill; misrepresentation leading to deception or a likelihood of deception; and, damage resulting from the misrepresentation.¹¹

120. In a case where the contested mark is unused, the relevant date is the date when the application was made for the contested mark. Here the mark is unused before the filing date, or more accurately, I take it to be unused because there is no claim or evidence of prior use; whilst the applicant’s evidence contains examples of packaging to be used, there is no evidence about any use in the marketplace.

121. As previously stated, the relevant dates are 30 June 2020 for trade mark application number 3506265 (ION*BIOME), and 22 December 2020 for on ION* INTELLIGENCE OF NATURE (3570884) and POWERED BY ION* (3570893).

Goodwill

¹¹ *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a deputy judge of the High Court.

122. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

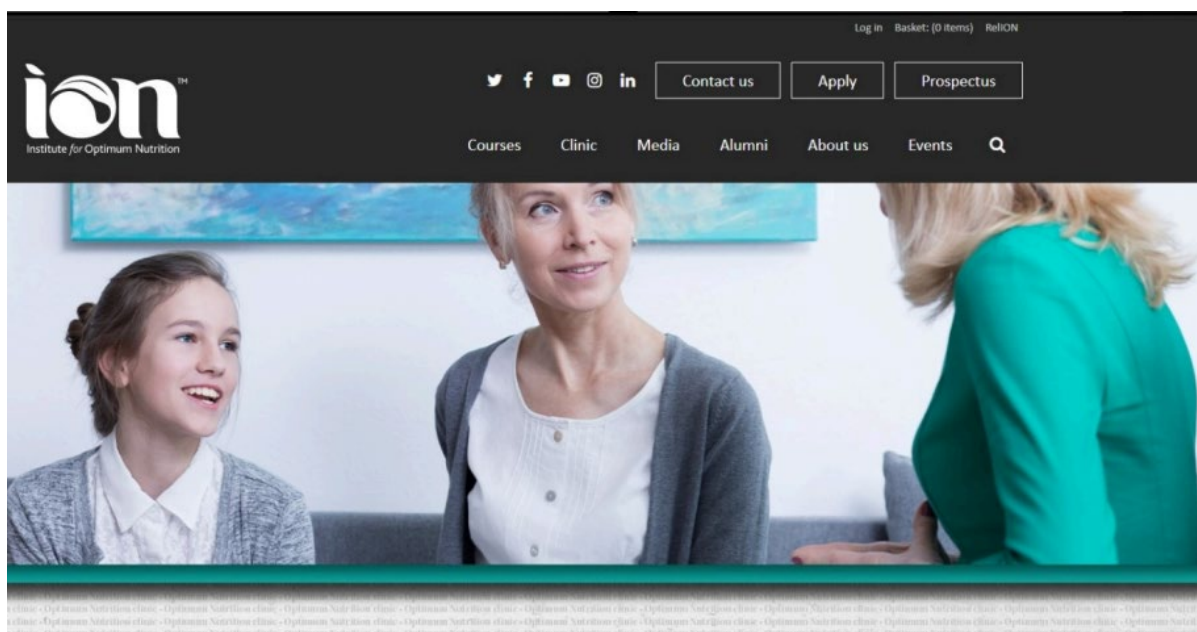
123. The opponent claims to have goodwill in a business under the sign ION “in relation to a broad range of publications and educational, therapy and information services, in the fields of diet, nutrition and health.”

124. The opponent states that in addition to the goodwill established in relation to the provision of education and training in the field of nutrition, diet, health and well-being it also has also “been providing clinics to the general public since 1993 in which it provides general information about nutrition and diet”.

125. In the witness statement of Ms Lynch it is stated that:

“ION also provides information to the public about nutrition and its impact on health through its not-for-profit clinic that it has run since 1993; in 2019-2020 there were 1231 clinic consultations, and in 2020-2021 there were 885 clinic consultations.”

126. Exhibit JL7 to the witness statement is a Wayback Machine extract dated 15 May 2020 from the opponent’s website. I duplicate a copy below:



Optimum Nutrition Clinic

Eat well. Live well. Be well.

Most people recognise that good nutrition is important for good health, but many don't understand the real impact that the food we eat can have on our daily lives and wellbeing.

Whether you are feeling unwell, have a long standing condition, or just want to improve your sense of overall wellbeing, visit our friendly, trusted Richmond upon Thames clinic in south-west London.

Our fully qualified and supportive Nutritional Therapists work with people every day to improve health and wellbeing, whatever your issue, they will help you find out how to improve your health naturally and safely.

Clinic packages

127. The exhibit also includes undated information on costs where packages range from a “2 appointment low-cost package £40” with a final year nutritional therapy student to a “3 appointment package £295” with either a senior nutritional therapist or sports nutritional therapist. The exhibit includes a further Wayback Machine extract dated 17 September 2007 from the opponent’s website headed “ION Richmond Nutrition Clinic”. The article refers to a clinic which offers tailor-made nutritional programmes that cost £90 for the initial consultation and £45 for the follow-ups.

128. Further, the uncontested statements that the opponent has carried out 1231 consultations between 2019-2020 and 885 between 2020-2021, there being a price list and reference to the clinics prior to the relevant date.

129. The evidence also shows that the opponent circulates magazines both online and in hard copies. The costs of producing the magazines were consistently over £30k per

annum and there are single print and annual subscription charges which would have covered the costs incurred.

130. Whilst it is notable the clinics are not for profit and the opponent has not provided turnover, neither of these factors preclude a finding of goodwill. Therefore, based on the information above I am satisfied that the opponent has goodwill in a business under the sign ION for the services claimed.

Misrepresentation

131. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than de minimis” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

132. The opponent argues that:

“The use of the Applicant's ION* marks (ION*BIOME, POWERED BY ION* and ION* INTELLIGENCE OF NATURE) would constitute a misrepresentation that, due to the common field of activity, is likely to leave the relevant consumer to mistakenly believe that the Applicant's goods are manufactured by, endorsed by, or otherwise connected to the ION mark of the Opponent.”

133. The opponent also argues that “the knowledge of nutritional and dietary supplements is integral to the work of nutritional therapists” and therefore this is an overlap in users, which is likely to mean that there is an overlap in areas of activity.

134. The applicant takes the stance that as the marks “are very different” and the goods/services are sufficiently different, deception leading to passing off cannot occur.

135. I have carefully considered the opponent’s arguments, in particular that nutritional therapists would have integral knowledge of supplements, but I do not consider there to be a risk that a substantial number of consumers would be deceived and therefore for misrepresentation to occur. The tests for likelihood of confusion and passing off are different, but it has been recognised in *Marks and Spencer PLC v Interflora* that it is doubtful whether the difference between the legal tests will produce different outcomes.¹² In this instance I find that the outcome is the same as for the considerations under section 5(2)(b), and the s.5(4)(a) claim is dismissed.

Overall conclusion

136. The oppositions against trade mark application numbers 3570884 (ION* INTELLIGENCE OF NATURE) and 3570893 (POWERED BY ION*) have failed and therefore, subject to appeal, they will proceed to registration.

137. The opposition against trade mark application no. 3506265 (ION*BIOME) is partially successful meaning that, subject to appeal, it will proceed to registration for all of the applied for goods and services except for the following Class 41 services:

“Providing a website featuring blogs and non-downloadable publications in the nature of articles in the field(s) of health, diet, and nutrition”

COSTS

138. Apart from the opponent succeeding against some of the Class 41 services of trade mark application no. 3506265, the applicant has largely been successful in defending its applications. Therefore, it is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £950 as a contribution towards the cost of the proceedings. This takes into account the opponent’s limited measure of success. The sum is calculated as follows:

Considering the three notices of opposition

¹² [2012] EWCA (Civ) 1501

and preparing three counterstatements ¹³	£450
Considering the other side's evidence and providing written submissions	£500
TOTAL	£950

139. I therefore order the Institute for Optimum Nutrition to pay Biomic Sciences LLC the sum of £950. 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 17th day of November 2022

MARK KING
For the Registrar

¹³ This takes into account that the cases weren't consolidated but there was repetition and therefore less to consider for the later counterstatements.