

O-389-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3119105
BY BIOFLORATECH LTD**

TO REGISTER THE TRADE MARK:

LB2

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 405454
BY NOVA BRANDS S.A.**

BACKGROUND

1. On 23 July 2015 Biofloratech Ltd (the applicant) applied to register the mark LB2 for *Probiotic supplements* in class 5.
2. The application was published for opposition purposes on 14 August 2015.
3. The application is opposed by Nova Brands S.A. (the opponent). The opposition is based upon Section 5(2)(b) of Trade Marks Act 1994 (the Act). The opponent relies upon international trade mark registration no. 1252925 for the mark **LB-55**, which designated the EU on 3 April 2015, claims a priority date of 10 October 2014 and was granted protection in the EU on 27 April 2016. The opponent relies upon all of the goods in its registration, namely:

Class 5: Pharmaceutical preparations, nutrients, dietetic substances for medical use; food for babies; culture of micro-organisms for use in foodstuffs for babies.

4. The opponent claims that there is a likelihood of confusion, including the likelihood of association, because the marks are highly similar and because the goods are identical or highly similar.
5. The applicant filed a counterstatement denying the claims and made a number of comments as to why the opposition should fail. Rather than detailing with them here, I will take them into account, referring to them when necessary.
6. Both sides filed written submissions during the evidential rounds. Whilst neither of the parties asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing, in response to which the applicant made a number of comments by way of an email dated 28 June 2016. I do not intend to summarise these submissions and comments here, but I will bear them in mind and refer to them where appropriate.

DECISION

7. Section 5(2)(b) of the Act reads:

“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.”

8. An earlier trade mark is defined in Section 6(1) of the Act, which states:

“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.”

9. In these proceedings, the opponent is relying upon the mark shown in paragraph 3, which qualifies as an earlier mark in accordance with Section 6 of the Act. The earlier mark had not been protected for more than five years at the date on which the applicant’s mark was published, meaning that it is not subject to proof of use. The opponent can, as a consequence, rely upon the full specification for which protection was conferred.

Section 5(2)(b) - case-law

10. 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 impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. Both parties refer in their submissions to what they consider to be the differences and similarities in the goods upon which the respective marks are actually used and in the respective trade channels. The applicant provides a photocopy of an advertisement, which describes LB2 as a probiotic designed for neonatal use. It states, in its counterstatement:

“...LB2 is a neonatal probiotic supplement for use in highly specialised applications within specialist hospital units and by professional practitioners, directed for specified and specialist use. This means that the market and trade channels for LB2 are not public but rather are very narrow and are directed at highly qualified medical establishments and professional practitioners [...]”.

12. The opponent states in its written submissions:

“12. The Opponent will use the LB-55 trade mark in respect of probiotics for infants, which will be sold in pharmacies and hospitals on prescription or through the recommendation of healthcare professionals.”

.....

“15. [...] the explanation provided by the Applicant shows that the trade channels of interest of both parties are identical as are the end users (babies) the administrators of the goods (those who care for the end user) and the professionals who prescribe or recommend the goods (pharmacists, doctors, nurses, healthcare professionals, etc. who deal with the neo natal market).”

13. The applicant also states that, despite its request, the opponent did not adduce any evidence of use of the mark in the marketplace and did not clarify the details of the products on which the mark is used. The purpose of this request was to establish whether there was any similarity between the parties' respective products. The applicant's submissions are based upon a misunderstanding of how use of the mark must be assessed. As indicated above, the earlier mark is not subject to proof of use and the opponent is entitled to rely on it for all the goods for which it is protected, whether or not it has, in fact, used the mark on these goods. The correct approach is to compare the goods on a notional basis, looking at the respective specifications, as protected and as applied for. Consequently, despite the parties' submissions, the manner in which either party may actually be operating in the marketplace is not pertinent.

14. In comparing the respective specifications, all the relevant factors 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:

“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”.

15. The parties' goods are as follows:

Applicant's goods	Opponent's goods
<i>Probiotic supplements</i>	<i>Pharmaceutical preparations, nutrients, dietetic substances for medical use; food for babies; culture of micro-organisms for use in foodstuffs for babies.</i>

16. As per the judgement of the General Court (GC) in *Gérard Meric v OHIM*, case T-133/05, goods can be considered identical when the goods of the earlier mark are included in a more general category, included in the specification of the application and vice versa.

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

19. The opponent states that *probiotic supplements* are identical to *pharmaceutical preparations, nutrients, dietetic substances for medical use; culture of micro-organisms for use in foodstuffs for babies*. It also submits that the term *food for babies* would include *probiotic supplements*. Oxford English Dictionary contains the following definitions:

“Probiotic: (noun) a probiotic substance or preparation.

A microorganism introduced in the body for its beneficial qualities”.

“Supplement: (noun) a substance taken to remedy the deficiencies in a person’s diet”

“Nutrient: (noun): a substance that provides nourishment essential for the maintenance of life and for growth”

20. The applicant’s *probiotic supplements* fall within the opponent’s *nutrients (for medical use)* and would also likely fall within the opponent’s *pharmaceutical preparations* and *dietetic substances for medical use*. It follows that the respective goods are identical in accordance with *Meric*.

The average consumer and the nature of the purchasing act

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade. 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.”

22. The applicant submits that the goods will be distributed by specialist hospital units and by professional practitioners only. However, the respective specifications are not so limited and, from my experience, the goods can be purchased without a medical prescription. Accordingly, notional and fair use of the marks would include both ‘over the counter’ goods and prescription only and the average consumer could therefore be either an ordinary member of the public or a medical professional¹. However, even for prescription goods the perspective of the end user is also relevant.

23. The general public is likely to obtain the goods through self-selection from, for example, the shelf of a chemist or the page of a website, over the counter purchases, word of mouth recommendations or by prescription after discussion with a medical professional. Turning to the position where a medical practitioner is involved, prescribers are likely to encounter the mark in medical journals/catalogues or to select the goods after discussion with the manufacturer’s sale representatives. Bearing all this in mind, the selection process is likely to consist of a mixture of visual and aural considerations in relation to each category of users.

24. As to the degree of care and attention, the opponent submits that the average consumer is likely to pay a high level of attention as the goods relate to the end user’s health but that a number of factors (which I will consider below) might increase the likelihood of confusion.

¹ See *Mundipharma AG v OHIM*, Case T-256/04,

25. The applicant takes issue with the opponent's use of the term "medicaments" in relation to probiotics and it states that "no health claims are permitted for probiotics under EU law as they are classed as foodstuffs". I reject this approach. The respective goods are registered and applied for in class 5, which covers pharmaceutical and other preparations for medical purposes (rather than in other classes which cover foodstuffs, i.e. 29 and 30); further, the copy of the advertisement provided by the applicant describes LB2 as a probiotic "manufactured to pharmaceutical-grade standards" and "under the supervision of a consultant microbiologist". Whilst probiotics (and nutrients) may not undergo the same rigorous testing that medicines do, the goods are intended for ingestion by individuals in order to satisfy a need or deficiency of their body. Accordingly, whilst the level of attention may vary depending, for example, on the cost and potential side-effects, the level of attention is always likely to be higher than average, both for the general public and the prescriber, even though it may not be of the highest level.

Distinctive character of earlier mark

26. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

27. In its written submissions, the opponent states that its mark is highly distinctive and provides the results of a search of the Intellectual Property Office’s (IPO) website. The aim of this search is to demonstrate that the opponent’s mark is the only UK mark on the register, which consists of the prefix LB and a number. To illustrate the point further, the opponent states that it has carried out an Internet review of 15 registered marks including the prefix LB, the results of which show that these marks are irrelevant mostly because either no use could be located on the Internet or because the marks were used on different goods.

28. The applicant, for its part, takes a contradictory position about the distinctive character of the opponent’s mark. On the one hand, it states that the mark is highly distinctive and incorrectly assumes that this would reduce the likelihood of confusion². On the other hand, it states that the mark is not distinctive and provides, in support, the results of a search from the European Union Intellectual Property Office’s (EUIPO) website showing examples of additional marks registered in respect of class 5 including the letters LB in combination with other elements and/or numbers. The opponent sought to counter this by submitting the results of a further search aimed at demonstrating that the examples submitted by the applicant are irrelevant as most of them refer to marks not valid in the UK. Despite the parties’ time and efforts spent on arguing these points, this evidence is not pertinent. In relation to what is often called ‘state of the register evidence’, I note that in *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the CJEU found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into

² The correct approach established by the case-law is that there is a greater likelihood of confusion where the earlier mark has a highly distinctive character. See CJEU case C-251/95 *Sabel BV v. Puma*, paragraph 24.

consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

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

29. Also, in *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

30. This approach is also reflected in Tribunal Practice Notice 1/2015, which states that “it is not appropriate to file the results of searches of trade mark registers showing that other marks, including an element common to the marks at issue, are registered in the names of third parties, without evidence that those marks were in use in the UK at the relevant date.” While the parties made a number of submissions

as to the use of the marks to which they refer, these submissions are not supported by any evidence. Thus, I will say no more about this evidence.

31. The applicant also submits that LB is descriptive for probiotics. It states:

“19. [...] LB is a well-recognised and nonspecific term, familiar in the probiotic world. This is because **LB is a recognised shorthand term for bacteria Lactobacillus**, widely recognised as a key group of probiotic bacteria.

.....

Being a group of bacteria, the LB prefix is then followed by a suffix which delineates a specific bacterial class. For example Lactobacillus acidophilus (LB acidophilus) strains include LB2, LB3 and LB45. LB brevis (LB6), LB rhamnosus (LB11, LB24), LB fermentum (LB32) LB plantarum (LB42) LB reuteri (LB38). [...]

.....

25. We disagree [with the opponent’s submission that the marks are conceptually meaningless]. Again the Opponent demonstrates a lack of knowledge of the probiotic world. LB may often have a meaning (that is, Lactobacillus) and to an expert market this would be well known. This is confirmed by our Consultant Neonatologist advisor. It is incorrect of the Opponent to suggest that expert users, or even consumers of normal intelligence, are unable to remember such marks. Conceptually the Opponent argues that the marks have no meaning. But this is not the case. For the knowledgeable consumers in our marketplace, the prefix LB would be understood to mean Lactobacillus.”

32. The opponent has neither denied nor accepted that LB is a known abbreviation for Lactobacillus, however, the opponent cannot be taken as having admitted the matter and the onus remains on the applicant to provide evidence of its claim³. There

³ The Registrar may look at the CPR for guidance on a specific issue particularly if the statutory provisions giving it powers are, as in the case here, silent on the issue. On that basis, I look at the approach adopted in Rule 16,7 CPR which states “16.7(1) A claimant who does not file a reply to a defence shall not be taken to admit the matter raised in the defence. (2) A claimant who:

is no evidence confirming the perception of LB as an abbreviation for, or recognised reference to, Lactobacillus, and there is no dictionary reference confirming the meaning of LB as such. Even if it had been established that medical professionals were aware of the abbreviation (which it has not), it would not have followed that that perception can be attributed to the general public (who are also relevant consumers), who cannot be assumed to be knowledgeable of scientific terms/names. Taken in the round, neither the suffix LB nor the number 55 appears to be suggestive or allusive of the goods and, in my view, the mark is endowed with an average degree of distinctive character.

Comparison of marks

33. 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 them, 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.”

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

(a) files a reply to a defence; but (b) fails to deal with the matter raised in the defence, shall be taken to require that matter to be proved.

35. The marks to be compared are: **LB-55** v LB2

Overall impression

36. The opponent submits that the dominant element of each mark is the prefix LB. The applicant disagrees, as it states that the prefix LB is descriptive (a claim which I have already dismissed) and that taken as wholes, the marks are different.

37. The applied for mark consists of the letters LB presented in a plain upper-case font, in conjunction with the number 2. Although the mark contains two identifiable elements, in my view, no one element dominates the other. The overall impression of the mark will be of a string of two letters and a number and its distinctiveness rests in its totality.

38. The opponent's mark consists of the letters **LB** presented in upper-case and in a bold typeface, followed by a hyphen and the number **55**. Although the presence of the hyphen will not be overlooked and serves to separate the letters **LB** from the number **55**, so that **LB** may have slightly more significance, the overall impression of the mark is still of a string of two letters and a number, albeit hyphenated.

Visual similarity

39. The marks share an obvious similarity in that they both begin with the letters **LB/LB**. In the applicant's mark, the number 2 follows the letters LB, as opposed to a hyphen and the number **55** in the opponent's mark. This contributes to some degree of visual distinction and I am conscious that in short marks small differences can have a greater impact than in longer marks. Balancing the similarities and differences, I consider that there is, at best, a medium degree of visual similarity between the competing marks.

Aural similarity

40. In relation to the aural use, whilst the hyphen present in the opponent's mark may have some visual impact, it will not be articulated. The beginning of the marks

sounds the same and, in my view, LB will be pronounced as individual letters, i.e. L and B. The only difference between the marks is in the numbers. The pronunciation of the number 2 in the applied for mark is entirely predictable. Insofar as the opponent's mark is concerned, whilst it is possible that some consumers may pronounce it as 'five-five' or 'double five', I think it is more likely than not that it will be pronounced as 'fifty-five'. As separate elements, the numbers 2 and **55** will sound quite different. In my view, the marks are similar to, at best, a medium degree.

Conceptual similarity

41. My consideration of the issue of distinctive character has already touched on the question of conceptual meaning of the marks. There is no evidence supporting the meaning of either mark or of any part of the marks. If there is any conceptual similarity then it will be based upon the common presence of the letters LB and their concept as being letters, but this does not give rise to a strong degree of conceptual similarity as a whole.

Likelihood of confusion

42. The opponent submits that as the goods in question are of a medical nature, the consequences of confusion and misadministration may be fatal; thus, I should find that there is a likelihood of confusion. The opponent also states that while the level of attention when selecting the goods is high, other factors, i.e. medical professionals facing time pressures to complete tasks and users relying on their memory when repeat purchasing or repeating the administering of medicaments, may increase the likelihood of confusion. In this connection, in *OROPRAM*, BL-O-208/02, Prof. Ruth Annand, sitting as the Appointed Person, having found that the marks OROPRAM and SEROPRAM were confusingly similar, stated:

"I have arrived at this view without engaging in the debate whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between pharmaceutical trade marks. For my own part, I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged

according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, supra., namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to selfprescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals may be on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions).”

43. Accordingly, the potential consequences to public health when two products are confused are not a reason for the adoption of a different threshold, before confusion can be found.

44. The applicant states that by registering its mark, the opponent has not acquired a monopoly over the prefix LB and that this should not prevent the registration of its mark because it has a different numerical suffix. The applicant draws my attention to the coexistence of similar marks in the car industry. However, here I am concerned with the perception of the average consumer for different marks in relation to different goods and these examples are not pertinent.

45. In determining whether there is a likelihood of confusion, 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

46. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods come from the same or a related trade source). This distinction was summed up by Mr 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).”

47. Earlier in my decision, I found that the average consumer is not likely to perceive LB as an abbreviation for Lactobacillus or a strain thereof. Therefore, I must proceed on the basis that LB is a distinctive component of the competing marks.

48. Both marks begin with the same distinctive letters LB which is what is first perceived about each mark whether by sight or sound. Whilst the higher than average level of attention militates, to some degree, against the marks being misremembered, it does not mean that the effect of imperfect recollection is diminished to the point of playing no role at all. Further, both marks are likely to be construed as strings of letters and numbers (albeit hyphenated in the opponent's mark); as neither mark evokes any concept, the consumer will have no conceptual hook which may assist in aiding his memory. Bearing all this in mind, together with the identity of the goods and the similarities between the marks, I find that there is a likelihood of one mark being mistaken for the other i.e. there is a likelihood of direct confusion.

49. In the event that I am found to be wrong on this point, I go on and consider whether there may be indirect confusion.

50. Whilst there is a difference in the numeric component of the marks, (irrespective of the hyphen) numerals are used in trade often to denote a particular product in a given range. Having carefully considered all of these factors, I come to the conclusion that, even if the differences between the marks were sufficient to avoid direct confusion, in circumstances where identical goods are involved, the average consumer is likely to consider that the goods originated from the same source. There is also a likelihood of indirect confusion.

Conclusion

51. The opposition has succeeded.

COSTS

52. As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice (TPN) 4 of 2007, I award costs on the following basis:

Official fee:	£ 100
Preparing the notice of opposition and considering the counterstatement:	£ 200
Written submissions (including considering and commenting on the applicant's submissions)	£ 400

53. I order Biofloratech Ltd to pay Nova Brands S.A. the sum of £ 700 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 12th day of August 2016

**Teresa Perks
For the Registrar
The Comptroller – General**