

O/104/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003351965

BY ALLDAY PHARMA PVT LTD.

TO REGISTER THE TRADE MARK:

**SWISSLIFE FOREVER**

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 415597 BY

SWISS LIFE INTELLECTUAL PROPERTY MANAGEMENT AG

## BACKGROUND AND PLEADINGS

1. On 8 November 2018, Allday Pharma PVT LTD (“the applicant”) applied to register the trade mark **SWISSLIFE FOREVER** in the UK. The application was published for opposition purposes on 23 November 2018 and registration is sought for the following goods:

Class 5 Vitamins; Dietary food supplements; Food supplements; Mineral food supplements.

2. On 25 February 2019, Swiss Life Intellectual Property Management AG (“the opponent”) opposed the application based upon sections 5(2)(b) and 3(3)(b) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its opposition based upon section 5(2)(b), the opponent relies upon EUTM no. 16650491 for the trade mark **SWISS LIFE NDK**. The opponent’s trade mark was filed on 6 May 2015 and registered on 28 April 2017. The opponent relies upon some of the goods for which the earlier mark is registered, namely:

Class 3 Cleaning preparations; cosmetics; toiletries; shampoo; hair conditioner; hair mousse; facial scrubs; facial masks; cosmetic preparations and substances; lip-stick; lip gloss; moisturiser; non-medicated toiletries; non-medicated preparations for the application to, conditioning and care of hair, scalp, skin and nails; soaps; bath salts (not for medical purposes); beauty masks; essential and herbal oils; make-up preparations; non-medicated toilet preparations; preparations for use in the bath or shower; bath and shower oils, gels, creams and foams; face and body scrubs; facial washes; skin cleansers and hydrators; skin toners; skin care preparations; moisturisers; preparations for use before shaving and after shaving; shaving soaps; shaving creams; shaving gels; after-shave preparations; pre-shave preparations; dentifrices; toothpastes; sunscreen preparations; sun care preparations; sun creams; sun-tanning preparations; sun blocking preparations; after sun preparations; cosmetics for protecting the skin from sunburn.

4. The opponent claims that there is a likelihood of confusion because the marks are similar and the goods are identical or similar.

5. For the purposes of its opposition based upon section 3(3)(b) the opponent states:

“The applied for mark SWISSLIFE FOREVER contains the geographical name “SWISS” (shorthand for SWITZERLAND). The opponent submits that the indication of the geographical name SWISS in the applied for mark is deceptive as it implies that the applicant’s good originate from or have a connection with Switzerland, when in fact the applied for goods and the applicant are in no way connected to Switzerland or any Swiss entities.

When consumers see the trade mark SWISSLIFE FOREVER, they will automatically think of Switzerland or the Swiss (citizens of Switzerland) and the idea of having a ‘Swiss life’ or like the Swiss people.

Switzerland is well known for being one of the highest ranking countries in the world for nominal wealth, quality of life, civil liberties and human development. The Swiss people are perceived to be happy and wealthy people. ‘Swiss made’ products are synonymous for being high quality and of a superior standard including for example; chocolate, watches, and pharmaceutical products. Many pharmaceutical companies are headquartered in Switzerland, including some of the world’s most well-known pharmaceutical companies such as Hoffmann-La Roche, Novartis, Alcon and Bayer (Consumer Health Division).

When faced with the applied for mark, a consumer is likely to reasonably believe that the vitamins and supplements produced by the Applicant originate from or are made in Switzerland. However, the applicant is an Indian pharmaceutical company based in Mumbai. The applicant does not have a place of business in Switzerland, its goods are not subject to the control of a Swiss entity, and the applicant is not associated with or connected to any Swiss entities.

It is likely that this reference to Switzerland would influence a consumer's purchasing decision, on the basis that the pharmaceuticals produced by Swiss companies are known for being of a high quality. The geographical reference to Switzerland in the applied for mark and the resulting positive connotations is therefore inaccurate and misleading, as it is clear that the goods in respect of which the applicant has been made do not actually originate from that geographical place."

6. The applicant filed a counterstatement denying the claims made.

7. The opponent is represented by Carpmaels & Ransford LLP and the applicant is unrepresented. Only the opponent filed evidence. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

8. The opponent's evidence consists of the witness statement of Jonathan Day dated 6 September 2019. Mr Day is the opponent's solicitor and representative in these proceedings. I have read Mr Day's evidence in its entirety, but have summarised only the most pertinent points below.

9. Mr Day has filed an NHS report which states that vitamins keep skin, teeth and cells healthy and that one of the reasons people take vitamin supplements is to limit the signs of ageing.<sup>1</sup> The report states that 8% of supplement sales in 2009 related to beauty.

10. Mr Day has also provided a print out (which is undated) from a website called Perfectil, which sells vitamins and supplements intended to benefit hair, skin and nails.<sup>2</sup> Mr Day has provided articles dating back to 2011 which describe

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<sup>1</sup> Annex 1

<sup>2</sup> Annex 2

“cosmeceuticals” as cosmetics that include pharmaceutical products (including vitamins).<sup>3</sup>

11. An extract from an online blog dated November 2016 states: “vitamins are very effective ingredients in cosmetic formulations” and they “have a variety of effects on the skin such as fading hyperpigmentation, cleaning age spots, reducing wrinkles, decreasing inflammation, and providing protection from UV damage”.<sup>4</sup> This is reflected in two articles from Glamour magazine dated July 2017 and April 2018, that address the benefits of different vitamins for skin.<sup>5</sup> Similar examples are provided to demonstrate that vitamins can be included in hair care products.<sup>6</sup>

12. Mr Day has provided an extract from the website businesswire.com dated 23 September 2003 which announced the launch of “OLAY vitamins – the first vitamin line to support beauty from within”.<sup>7</sup> It is not clear whether, or indeed when, these products became available in the UK. This article appears to be directed at the US market as it states that this is “the only affordably priced cosmeceutical line available at U.S. mass market retailers” and the price is given in dollars. Mr Day has provided a number of other website print outs intended to show sales of vitamin supplements alongside or as part of cosmetic products, but these are all dated after the relevant date.

13. Mr Day has provided an article dated April 2018 entitled “UK women are buying more supplements than skincare serums”. The substance of that article states:

“You’re still skincare obsessed (we’ll get to that), but supplement powders have taken off in a big way, with UK women buying more health powders than serums. Net A Porter Beauty Director Newby Hands explains how supplement powders have segued into our beauty regimes, and which ones are the most popular among Net A Porter’s Beauty connoisseurs:

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<sup>3</sup> Annex 7

<sup>4</sup> Annex 4

<sup>5</sup> Annexes 5 and 6

<sup>6</sup> Annex 8

<sup>7</sup> Annex 14

‘Nowadays, women have an entire wardrobe of skincare products, especially serums, and while we have a lot of skincare, we now know that what works on the inside has an effect on the outside.’

‘Supplements not only make us feel better and more energetic but they also affect our skin, hair and nails, so they’re the next step in our skincare regime. They can work at much deeper levels where new cells are formed, something normal skincare products cannot do. We’ve seen a huge shift in sales, with our customers in the UK now buying more supplements than serums and we don’t see this slowing down.’”

14. A HSBC report dated March/April 2018 confirms that Switzerland has the highest average income in the world.<sup>8</sup> An article in the Telegraph dated October 2014 states that “Switzerland is ranked as the number one country by expats looking for a well-balanced, high quality lifestyle, followed by Singapore, China, Germany and Bahrain in a new survey of thousands of people around the world”.<sup>9</sup>

15. A report from the Made-In Country Index 2017 shows how positively products ‘Made in...’ are perceived globally.<sup>10</sup> Switzerland was ranked second in this index. A report from the University of St Gallen in Switzerland dated July 2016 involved more than 7,900 respondents from 15 countries and found that “between 52% and 89% of the world’s respondent’s prefer Swiss products to offers of unknown origin at the same price” and noted that China, Brazil, India and Russia were the “biggest fans” of Swiss products.<sup>11</sup>

16. An article from “Discover Switzerland” states that the EU is Switzerland’s main trading partner, with around 43% of Swiss exports being destined for EU countries.<sup>12</sup> The report confirms that over 44% of goods exported from Switzerland are chemical

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<sup>8</sup> Annex 19

<sup>9</sup> Annex 20

<sup>10</sup> Annex 23

<sup>11</sup> Annex 24

<sup>12</sup> Annex 26

or pharmaceutical goods. A report dated 2018 and an article dated 2003 state that Switzerland has a thriving pharmaceutical industry.<sup>13</sup>

17. Mr Day has provided examples of businesses that use the word SWISS in their name to identify the origin of the businesses and/or the products.<sup>14</sup>

18. The opponent's evidence was accompanied by written submissions. Whilst I have not summarised those submissions here, I have read them in their entirety, and will refer to them below where necessary.

### **PRELIMINARY ISSUE**

19. In its counterstatement, the applicant refers to other trade mark applications (for the marks SWISSLINE and SWISSDREAM). The applicant notes that the opponent did not object to these registrations. The opponent is, of course, entitled to make decisions as to which trade marks it objects to. I note that the application in issue differs from these marks as it shares the common element SWISSLIFE with the opponent's mark, whereas the applications referred to only share the common element SWISS. In any event, the fact that the opponent chose not to object to these registrations does not prevent it from objecting to the present application and is irrelevant to the matters before me.

20. The applicant also referred me to two cases: 1) "application no. M740186 in the name of WOLF(ASIA) LTD v/s WATCHES OF SWITZERLAND LIMITED under number 70536" and 2) "application number 523144, Goldkenn SA v/s Cadbury UK Limited". It is not clear to me which case the first of these is a reference to. No correct citation or copy has been provided by the applicant. I cannot, therefore, comment upon its relevance to these proceedings. The second of these related to an application before this Registry for the mark SWISSDREAM and an opposition brought by Cadbury based upon various 'dream' marks. As the marks in the present case are entirely different, I do not consider that case to be relevant to the matter before me.

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<sup>13</sup> Annexes 28 and 29

<sup>14</sup> Annex 31

## **DECISION**

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

21. Section 5(2)(b) of the Act states as follows:

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

(a)...

(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.”

22. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. In its counterstatement, the applicant requested that the opponent prove use of its earlier mark. However, as the opponent’s mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

### **Case law**

23. 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 to mind the earlier mark, is not sufficient;

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

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

### Comparison of goods

24. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 3</u> Cleaning preparations; cosmetics; toiletries; shampoo; hair conditioner; hair mousse; facial scrubs; facial masks; cosmetic preparations and substances; lip-stick; lip gloss; moisturiser; non-medicated toiletries; non-medicated preparations for the application to, conditioning and care of hair, scalp, skin and nails; soaps; bath salts (not for medical purposes); beauty masks; essential and herbal oils; make-up preparations; non-medicated toilet preparations; preparations for use in the	<u>Class 5</u> Vitamins; Dietary food supplements; Food supplements; Mineral food supplements.

bath or shower; bath and shower oils, gels, creams and foams; face and body scrubs; facial washes; skin cleansers and hydrators; skin toners; skin care preparations; moisturisers; preparations for use before shaving and after shaving; shaving soaps; shaving creams; shaving gels; after-shave preparations; pre-shave preparations; dentifrices; toothpastes; sunscreen preparations; sun care preparations; sun creams; sun-tanning preparations; sun blocking preparations; after sun preparations; cosmetics for protecting the skin from sunburn.	
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25. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

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

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

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

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

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

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

27. 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.”

28. 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.”

29. In its submissions, the opponent referred me to the decision of this Tribunal in *Clinique La Prairie Franchising SA v Clinique Laboratories LLC* [2013] O-488-13, in which the Hearing Officer stated, at paragraph 47 of that decision:

“There is a significant degree of similarity of purpose between cosmetics/skin care/anti-ageing products and some nutritional products for medical purposes, such as PERFECTIL, WELEDA birch juice drink and COLLAGEN SHOTS. This overlap is recognised by the emergence of the term ‘nutricosmetics’. These products may be competitive to a degree, but they are probably more often complementary.”

30. I accept that there is overlap in purpose between a number of goods in the opponent’s specification, such as “cosmetic preparations and substances” and “skin care preparations”, and the applicant’s goods. This is because users may purchase both the opponent’s goods and the applicant’s goods in order to improve the appearance of skin. There will be overlap in users, as both may be used by members of the general public who wish to improve the appearance and wellbeing of their skin. I recognise that the example of shared trade channels provided in the opponent’s evidence (that is, of OLAY selling both cosmetics and vitamins) appears to be directed to the US market. However, I do consider that the overlap in purpose and user may lead the average consumer to conclude that there may be common trade channels for such goods. This is supported by the fact that ‘cosmeceuticals’ are a growing trend, which will lead the average consumer to identify a closer connection between the goods. I also consider that there will be a degree of complementarity between these goods.<sup>15</sup> Clearly, there is no overlap in nature and method of use. I recognise that

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<sup>15</sup> *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

there may be a degree of competition to the extent that someone seeking to achieve a particular outcome or change to their skin may choose to purchase a supplement that promises to achieve that benefit, or a cosmetic with the same purpose. However, to my mind, it is more likely that they would be used together rather than as an alternative. Overall, I consider the goods to be similar to a medium degree.

### **The average consumer and the nature of the purchasing act**

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

32. The average consumer for the goods will be a member of the general public. The goods are likely to be reasonable in price and purchased reasonably frequently. I recognise that in some circumstances the average consumer will pay a higher degree of attention when purchasing vitamins and supplements, such as if the goods are being taken to combat a particular medical issue or deficiency. However, this case is concerned with vitamins and supplements taken for aesthetic reasons. As this is not a medical purpose, I do not consider that a high degree of attention will be paid during the purchasing process. However, various factors will be taken into account when purchasing both the applicant's and the opponent's goods, such as the benefits that the particular product will provide, fragrance or flavour and ingredients. Consequently,

I consider that a medium degree of attention will be paid during the purchasing process for the goods.

33. The goods are most likely to be selected from the shelves of a retail outlet or their online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I recognise that advice may be sought from retail assistants and consultations may take place in which a consultant may make recommendations for the particular user's needs. I do not, therefore, discount that there may also be an aural component to the purchase of the goods.

### **Comparison of trade marks**

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

36. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
SWISS LIFE NDK	SWISSLIFE FOREVER

37. The opponent's mark consists of the words SWISS LIFE NDK. The words SWISS LIFE will play the greater role in the overall impression because the letters NDK will not have an identifiable meaning, and so will play a lesser role in the overall impression. The applicant's mark consists of the words SWISSLIFE FOREVER. The overall impression lies in the combination of these words.

38. In its counterstatement, the applicant states that the "font and size of the applicant's UK trade mark is different than that of the opponent's EUTM". There does not appear to be any difference in font or font size from the registrations. In any event, registration of a word only mark covers use in any standard typeface and so even if one of the marks was registered in a slightly different font and size, this line of argument would not assist the applicant.

39. Visually, the marks coincide in the presence of the words SWISS and LIFE. Although they are conjoined in the applicant's mark, they will still easily be identified by the average consumer. The marks differ in the presence of the letters NDK in the opponent's mark and the word FOREVER in the applicant's mark. As the opponent notes in its submissions, consumers tend to pay greater attention to the beginning of marks than the end. I consider the marks to be visually similar to a medium degree.

40. Aurally, the opponent's trade mark will be pronounced SWIS-LYF-ENN-DEE-KAY. The applicant's mark will be pronounced SWIS-LYF-FORE-EVER. The marks, therefore, coincide in the pronunciation of the first two syllables, but differ in their endings. I consider the marks to be aurally similar to a medium degree.

41. Conceptually, the words SWISS and LIFE in both marks will be given the same meaning i.e. a reference to life in Switzerland. I accept that some people may view this as a reference to a positive way of living (healthy and prosperous etc.) but this will be



the same for both marks. The letters NDK in the opponent's mark will be attributed no particular meaning. The word FOREVER in the applicant's mark will be given its ordinary dictionary meaning i.e. to continue indefinitely. In the context of the applicant's mark as a whole, this will be seen as a reference to life in Switzerland continuing indefinitely. Overall, I consider the marks to be conceptually similar to a higher than medium degree.

### **Distinctive character of the earlier trade mark**

42. 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-2779, paragraph 49).

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

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods, 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 that has been made of it.

44. The opponent has not pleaded that its mark has acquired enhanced distinctive character and, in any event, has filed no evidence to support such a claim. Consequently, I have only the inherent position to consider. The words SWISS LIFE in the opponent's mark will be recognised as ordinary dictionary words. I consider it unlikely that the average consumer will view the word SWISS when followed by the word LIFE as an indicator of geographical origin. However, when taken together they may be seen to allude to the goods conferring some benefit associated with the Swiss way of life. The letters NDK will be attributed no particular meaning by the average consumer but may be assumed to be an acronym for something. I consider the earlier mark to be inherently distinctive to no more than a medium degree.

### **Likelihood of confusion**

45. 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 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

46. I have found the marks to be visually and aurally similar to a medium degree and conceptually similar to a higher than medium degree. I have found the opponent's

mark to have no more than a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public, who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the parties' goods to be similar to a medium degree.

47. I consider that the visual, aural and conceptual differences between the marks are sufficient to avoid them being mistakenly recalled as each other. I do not consider that the different endings of each mark will be overlooked by the average consumer, notwithstanding the principle of imperfect recollection. I do not consider there to be a likelihood of direct confusion.

48. A finding of indirect confusion should not be made merely because two marks share a common element.<sup>16</sup> However, I consider that the common phrase SWISS LIFE/SWISSLIFE in both marks will be viewed by the average consumer as indicating marks that originate from the same or economically linked undertakings. I consider that the addition of the words/letters FOREVER and NDK will be viewed as alternative marks being used by the same business. I consider this to be the case notwithstanding the fact that the average consumer will be paying a medium degree of attention during the purchasing process. I consider there to be a likelihood of indirect confusion.

49. The opposition based upon section 5(2)(b) is successful in its entirety.

### **Section 3(3)(b)**

50. For the sake of completeness, I now turn to the opposition based upon section 3(3)(b) of the Act.

51. Section 3(3)(b) states as follows:

“(3) A trade mark shall not be registered if it is –

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<sup>16</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

52. In *TWG Tea Company Pte Ltd v Mariage Frères SA*, BL O/358/17, Mr Phillip Johnson, sitting as the Appointed Person, conveniently summarised the case law as follows:

“(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: *C-87/97 Consorzio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; *C-259/04 Emanuel*, ECLI:EU:C:2006:2015, paragraph 47; *C-689/15 W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;

(b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer); *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 56;

(c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder’s Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the decision must have some material effect on consumer behaviour: *CFA Institute’s Application* [2007] ETMR, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05, *HUP Usługi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficient specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraph 67 and 68; T-327/16; *Aldi v EUIPO* ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T-29/16 *Caffé Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 *SIMS – École de ski internationale v OHIM*, EU:T:991:200, paragraph 50, *Caffé Nero*, paragraph 47.”<sup>17</sup>

53. There is no evidence of actual deceit. I must, therefore, go on to consider whether there is a sufficiently serious risk of the consumer being deceived in the future as to the nature and/or quality and/or geographical origin of the goods.

54. The opponent submits that the applicant’s mark will deceive the public as to the geographical origin of the goods because of the inclusion of the word SWISS in the mark. The opponent submits:

“The mark comprises three English words; SWISS, LIFE and FOREVER in plain text. The first word element; ‘SWISS’ is defined as ‘relating to Switzerland

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<sup>17</sup> Paragraph 84

or its people' (Oxford English Online Dictionary). The applied for mark therefore suggests or alludes to a connection with a geographical location (Switzerland) and the Swiss people.”

55. Further, the opponent referred me to *Madgecourt's Application; Opposition by Federation des Industries de a Parfumerie* [2000] ETR 825 in which the Registry refused an application to register the trade mark MCL PARFUMS DE PARIS for toiletries because there would be an expectation that the perfume would be manufactured in Paris. That case differs to the matter before me because in the mark in issue the word SWISS, is followed by the word LIFE. In this context, I do not consider that the consumer will view the presence of the word SWISS as indicating geographical origin, but rather will be seen as a reference to the Swiss lifestyle.

56. The opponent goes on to submit:

“The second and third word elements; ‘LIFE’ and ‘FOREVER’, are merely laudatory terms, which directly allude to the nature and quality of the vitamins and food supplements covered, by implying that the vitamins and supplements are long lasting and that taking them will enable the recipient to live forever, improve their wellbeing or extend their life for a long time.”

57. The opponent referred me to the decision of the Board of Appeal in *Movenpick v OHIM (PASSIONATELY SWISS)*, T-377/09, in which it was found that “the goods and services of Swiss origin are generally perceived as being of good quality and that the element ‘Swiss’ of the trade mark applied for is not only an indication of geographical origin of the goods and services concerned but also conveys information relating to quality’. That case differs from the matter before me because the word SWISS, in that case, was not followed by the word LIFE. I have also not had the benefit of reviewing the evidence that led the Board of Appeal to come to the finding that they did. In any event, decisions of the Board of Appeal are not binding upon this Tribunal.

58. The evidence does indicate that some average consumers may perceive Switzerland as a source of higher quality products. However, as I have found that the mark as a whole will not be viewed as indicating Switzerland as the geographical origin

of the goods, I see no reason why this association with quality would transfer. I recognise that the applicant's mark may be seen as a reference to the Swiss lifestyle and this may allude to some benefit conferred by the product that relates to that high quality, well-balanced lifestyle. However, it is clear from the case law cited above that a 'hint' cannot give rise to deception.

59. As a consequence, I find that the opponent has failed to demonstrate that there is a sufficiently serious risk that the UK average consumer will be deceived if the mark is used in respect of goods not originating from Switzerland or not having some recognisable enhanced quality associated with Switzerland.

60. The opposition based upon section 3(3)(b) is unsuccessful.

## **CONCLUSION**

61. The opposition is successful, and the application is refused.

## **COSTS**

62. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,350** as a contribution towards the costs of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£300
Preparing evidence and written submissions	£850
Official fee	£200
<b>Total</b>	<b>£1,350</b>

63. I therefore order Allday Pharma PVT LTD to pay Swiss Life Intellectual Property Management AG the sum of £1,350. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 19<sup>th</sup> day of February 2020**

**S WILSON**

**For the Registrar**