

O/1015/22

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3709986  
BY SED SWISS ENGINEERING DEVELOPMENTS AG  
TO REGISTER AS A TRADE MARK:**

**SWISSVITAE**

**IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600002185  
BY VITAE HEALTH INNOVATION, S.L.**

## **Background and pleadings**

1. On 14 October 2021, SED Swiss Engineering Developments AG (“the applicant”) applied to register the trade mark **SWISSVITAE** in the UK, under number 3709986 (“the contested mark”). Details of the application were published for opposition purposes on 29 October 2021. Registration is sought for the following goods:

Class 5: Vitamin preparations; food supplements, dietetic or non-dietetic, whether or not based on plants, not for medical purposes; proteins [food supplements] for human consumption, proteins [food supplements] for human consumption in the form of protein powder, with or without minerals, vitamins and herbal ingredients (not for medical purposes); vitamins for the preparation of nutritional supplements; dietary supplements consisting of vitamins; energy bars with nutritional supplements as a meal replacement; mixed vitamin preparations; meal replacement powders.

2. On 31 January 2022, VITAE HEALTH INNOVATION, S.L. (“the opponent”) opposed the application by way of the fast track procedure. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application.

3. The opponent relies upon the following comparable UK trade marks:<sup>1</sup>

### **VITAE HEALTH INNOVATION**

Registration no. 917883532

Filing date: 4 April 2018

Registration date: 14 September 2018

(“the first earlier mark”)

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<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement between the UK and EU, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM numbers 17883532 and 17883534 being registered as at the end of the implementation period, comparable UK trade marks were automatically created. The comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original EUTM filing dates.

## **VITAE NUTRACEUTIC INNOVATION**

Registration no. 917883534

Filing date: 4 April 2018

Registration date: 14 September 2018

("the second earlier mark")

4. The earlier marks are registered for an identical list of goods and services in classes 3, 5 and 39. However, for the purposes of the opposition, the opponent only relies upon some of the goods, namely:

Class 5: Pharmaceuticals (other than goods for dental purposes); dietetic substances adapted for medical use; nutritional supplements.

5. Given the respective filing dates, the opponent's marks are earlier marks in accordance with section 6 of the Act. However, as neither had been registered for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods identified, without having to establish genuine use.

6. The opponent essentially contends that the competing marks are similar and that the parties' goods are identical, giving rise to a likelihood of confusion, including the likelihood of association.

7. The applicant filed a counterstatement, denying the ground of opposition.

8. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit". The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. The opponent is professionally represented by Lara Grant and the applicant by Hansel Henson Limited. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers, keeping all submissions in mind.

10. 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 and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **My approach**

11. As noted above, the opponent relies upon an identical list of goods in respect of both earlier marks. Moreover, neither are subject to proof of use. To my mind, the second earlier mark does not put the opponent in a more favourable position than the first earlier mark. As such, I will proceed to determine the opponent's claim initially on the basis of the first earlier mark, returning to consider the second earlier mark later in this decision if it becomes necessary.

### **Decision**

#### **The law**

12. Sections 5(2)(b) and 5A of the Act read 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.”

13. 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 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 goods

14. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) 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”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-133/05, the General Court (“GC”) stated that:

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

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is 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”.

18. The goods to be compared are displayed above at paragraphs 1 and 4.

19. The opponent’s term ‘*nutritional supplements*’ refers to substances which are consumed or added to other foodstuffs to compliment one’s diet. They are commonly available as dry powders, pills or liquids, and may contain, for example, vitamins, minerals, proteins or carbohydrates. It is my view that this term would encompass the applicant’s terms ‘*vitamin preparations; food supplements, dietetic or non-dietetic, whether or not based on plants, not for medical purposes; proteins [food supplements] for human consumption, proteins [food supplements] for human consumption in the form of protein powder, with or without minerals, vitamins and herbal ingredients (not for medical purposes); [...] dietary supplements consisting of vitamins; [...] mixed vitamin preparations*’. Consequently, these goods are to be regarded as identical in accordance with *Merica*.



20. As dietetic substances could consist of vitamins and nutritional supplements which could be used for medical purposes, I am of the view that the applicant's term '*vitamins for the preparation of nutritional supplements*' falls within the scope of the opponent's term '*dietetic substances adapted for medical use*'. As such, they are identical under the principle outlined in *Meric*. Even if I am wrong in this finding, it remains the case that the respective goods are highly similar. This is because there is an overlap in nature, method of use and intended purpose. Moreover, the respective goods are likely to reach the market through shared channels of trade and may be offered by the same undertakings. Given that dietetic substances could be purchased instead of vitamins and used for the preparation of nutritional supplements (for ultimate use in a medical context), the goods are also in competition.

21. I do not agree with the opponent that the applicant's terms '*energy bars with nutritional supplements as a meal replacement; [...] meal replacement powders*' would be covered by its goods, resulting in them being identical. When confining the parties' goods to their core and natural meanings,<sup>2</sup> I do not consider the applicant's energy bars or meal replacement powders to be pharmaceuticals, which typically refer to compounds that are manufactured for use as medicinal drugs. Neither can these goods be fairly described as dietetic substances. In addition, although the applicant's goods contain nutritional supplements as an ingredient, I do not consider them to be nutritional supplements *per se*. Nonetheless, the applicant's goods and the opponent's '*nutritional supplements*', both being consumed to benefit the human body, overlap in intended purpose and method of use. Moreover, the respective goods reach the market through shared trade channels; they are commonly found in retail establishments and health food stores, wherein they are likely to be located near one another. Nutritional supplements are indispensable to energy bars and meal replacement powders which contain them, delivery of the former being the *raison d'être* of the latter; consumers are also likely to assume that they are produced by the same undertakings (which, in my experience, is not uncommon). Consequently, the parties' goods are complementary. To my mind, a consumer could select an energy bar or meal replacement powder containing supplements over the supplements

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<sup>2</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraph 12

themselves, and vice versa, to gain the same nutritional benefit. As such, they are also in competition. In light of all this, I find that the respective goods are highly similar.

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

22. 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.”

23. 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.<sup>3</sup>

24. It is common ground between the parties that the goods at issue in these proceedings are directed at the general public as well as more specialist consumers, such as professionals in the nutrition and health sectors. Considering the nature of the goods in question, I consider this to be a sensible position. The goods at issue are likely to be relatively frequent purchases for both groups of consumers; the general public are likely to purchase the goods for ongoing dietary support or for treating a medical condition, whereas professionals are likely to purchase the goods for, for example, stocking a health food store or pharmacy, or prescribing them to patients. The parties are also in agreement that these consumers will demonstrate an average to high level of attention during the purchasing process. Taking into account that the general public will wish to ensure that the products are safe to use and are appropriate

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<sup>3</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

for their needs, whilst professional users will be alive to the increased liability and responsibility inherent in recommending or prescribing such products to others, I am content to proceed on this basis.

25. The goods are likely to be purchased by the general public from retail outlets, such as health stores, or pharmacies, wherein they will be self-selected from shelves. It is possible that, in some circumstances, the goods will be obtained after a verbal consultation with a healthcare professional. As for professional users, the goods will be purchased from suppliers and manufacturers. Information about the products will likely be sought primarily from brochures and webpages, though the selection process may also include verbal discussions with sales representatives. Therefore, in my view the purchasing process will be a combination of visual and aural for both groups of relevant consumers.

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

26. 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).”

27. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

28. Further, the distinctive character of a mark may be enhanced as a result of it having been used in the market. In its statement of grounds, the opponent claimed that the first earlier mark enjoys an enhanced distinctive character. In this connection, it provided submissions on its history, activities, use of the mark, patent and trade mark portfolios, and an alleged ‘VITAE’ family of marks. However, no evidence has been filed by the opponent that could support a finding that the distinctiveness of the first earlier mark has been enhanced above its inherent characteristics. It has not provided, for example, details as to its turnover or market share, evidence of use of the first earlier mark, or any information or evidence regarding promotional expenditure and activities connected with goods sold under the mark. On this basis, I am unable to assess how strongly the first earlier mark indicates to consumers in the UK that the goods originate from the opponent. Therefore, I have only the inherent position to consider.

29. The first earlier mark is in word-only format and consists of the words ‘VITAE HEALTH INNOVATION’. The opponent has submitted that the word ‘VITAE’ will be generally understood by consumers in accordance with its Latin meaning, i.e. ‘life’. I disagree. Given that Latin has ceased to be a commonly used or understood language in the UK, I consider it highly unlikely that the meaning of the word would be apparent to consumers. The opponent has not adduced any evidence to demonstrate that consumers of the goods at issue in these proceedings would be aware of the same. I

do not consider the fact that it forms part of the term 'curriculum vitae' as argued by the opponent alters this finding. Firstly, as the opponent has itself indicated, this is in the context of employment. Secondly, there is nothing before me which establishes that consumers understand the meaning of the word 'VITAE', merely because it (and its abbreviation, C.V.) are used interchangeably with 'resume'. The applicant has submitted that the word 'VITA' is widely used in the relevant industry, especially in relation to vitamins. However, it has not adduced any evidence on the point, and I do not consider it to be a well-known fact of the kind which would enable me to take judicial notice of it. A mere assertion cannot be considered evidence *per se* as to the distinctiveness of the word. In any event, the mark contains the word 'VITAE', rather than 'VITA', and there is nothing before me which indicates that the meaning of one would be attributed to the other. In my view, the word 'VITAE' would be perceived by consumers as an invented word with no discernible meaning. It is, therefore, highly distinctive. The mark also contains the words 'HEALTH INNOVATION'. The opponent has suggested that consumers would not attribute any trade mark significance to the words, since they are a descriptive reference to innovation being integral to the inception, development and bringing to market the health-related goods at issue. The applicant has denied this and submitted that the words are allusive, rather than descriptive and, therefore, have a "level of distinction". It is my view that the words, in combination, are likely to be perceived by consumers of the goods in question as a company ethos statement, namely, an indication that the undertaking responsible for the mark is committed to developing new ideas, methods and products for the maintenance or improvement of health. As it will be seen as an unambiguous marketing tag line requiring no form of mental processing or analysis, these words are low in distinctiveness at best. I agree with the opponent that the distinctiveness of the mark predominantly lies in the word 'VITAE'. Considering the first earlier mark as a whole, I find that it possesses a high level of inherent distinctive character.

### **Comparison of the marks**

30. 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 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.”

31. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

32. The competing trade marks are as follows:

<b>The first earlier mark</b>	<b>The contested mark</b>
VITAE HEALTH INNOVATION	SWISSVITAE

### Overall impressions

33. The first earlier mark is in word-only format and comprises the words ‘VITAE HEALTH INNOVATION’ with no additional elements. Given that the word ‘VITAE’ appears at the beginning of the mark, a position which is generally considered to have more impact,<sup>4</sup> it dominates the overall impression of the mark. The words ‘HEALTH INNOVATION’ are not negligible; however, as they will be perceived as a marketing tag line, they play a much lesser role in the overall impression.

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<sup>4</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

34. The contested mark comprises the plain word 'SWISSVITAE'. There are no other elements in the mark. I acknowledge that the mark is presented as a single word. Nonetheless, as 'SWISS' will be immediately recognised, it is my view that the mark will be separated in the minds of consumers and perceived as the words 'SWISS VITAE'. These two words co-dominate the mark in roughly equal measure.

#### Visual comparison

35. Visually, the competing marks coincide in the identical word 'VITAE', which dominates the first earlier mark and co-dominates the contested mark. Clearly, the competing marks are visually different insofar as this word occupies different positions, i.e. it appears at the beginning of the first earlier mark and at the end of the contested mark. The competing marks also differ visually as they each contain additional words which are not replicated by the other, i.e. 'HEALTH INNOVATION' in the first earlier mark and 'SWISS' in the contested mark. In this connection, the first earlier mark is noticeably longer than the contested mark. Bearing in mind my assessment of the overall impressions, I find that there is between a low and medium degree of visual similarity between the competing marks.

#### Aural comparison

36. The first earlier mark consists of seven syllables, i.e. "VI-TIY-HEALTH-IN-OH-VAY-SHON", whereas the contested mark comprises three syllables, i.e. "SWISS-VI-TIY". The competing marks are aurally similar as they share two syllables, i.e. "VI-TIY". However, I acknowledge that these syllables appear in different positions in each of the marks. In addition, the competing marks are aurally different in that the remaining syllables in each mark have no counterparts in the other. The contested mark is also shorter than the first earlier mark. Overall, I find that the competing marks are aurally similar to between a low and medium degree.

#### Conceptual comparison

37. As outlined above, the word 'VITAE' in the first earlier mark will be perceived as an invented word with no meaning. This applies equally to the contested mark. This

part of the competing marks is, therefore, conceptually neutral. However, the first earlier mark includes the words 'HEALTH INNOVATION', which, as explained above, will be understood by consumers as a marketing tag line. Further, the contested mark contains the word 'SWISS', which will evoke the concept of belonging to or relating to Switzerland or its people. As the competing marks each convey a meaning which is not replicated by the other, overall, they are conceptually dissimilar.

### **Likelihood of confusion**

38. 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. One such factor 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 vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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 they have retained in their mind.

39. 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.

40. Earlier in this decision, I concluded that:

- The parties' goods are either identical or highly similar;
- Relevant consumers of the goods at issue will consist of both the general public and professionals, who will both demonstrate an average to high level of attention when selecting the goods;



- The purchasing process for the goods will be by a combination of visual and aural means;
- The first earlier mark has a high level of inherent distinctive character;
- The overall impression of the first earlier mark is dominated by the word 'VITAE', whereas the words 'HEALTH INNOVATION' play a much lesser role;
- The words 'SWISS' and 'VITAE' co-dominate the overall impression of the contested mark;
- The competing marks are visually and aurally similar to between a low and medium degree, and conceptually dissimilar.

41. I acknowledge that the invented word 'VITAE' appears in both of the competing marks. Indeed, I have found that it dominates the overall impression of the first earlier mark and co-dominates the contested mark. Nevertheless, there are differences between the marks which are not negligible, whether that be in a visual or an aural context. The common element appears in different positions within the competing marks, which are also different in length. Further, the first earlier mark contains the words 'HEALTH INNOVATION'. Whilst I have found that these words play a much lesser role in the overall impression of the mark, they still provide a contribution and will not be entirely overlooked. Moreover, the contested mark includes the word 'SWISS'; given that this word appears at the beginning of the contested mark and is co-dominant in its overall impression, it is highly unlikely that it will be overlooked. Additionally, insofar as they provide meanings, the competing marks are conceptually dissimilar. In my view, taking all the above factors into account, notwithstanding the distinctiveness of the first earlier mark, the differences between the competing marks are likely to be sufficient for consumers – paying an average to high level of attention during the purchasing process – to distinguish between them and avoid mistaking one for the other, even in relation to goods that are identical. Accordingly, notwithstanding

the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

42. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), 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).”

43. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>5</sup> However, indirect confusion has its limits. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>6</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>7</sup>

44. Although I have found that consumers will immediately notice and recall the differences between the competing marks, they will also recognise the identical element ‘VITAE’. Whether consciously or unconsciously, this will lead consumers through the mental process described in *L.A. Sugar*. This element dominates the overall impression of the first earlier mark and co-dominates that of the contested mark. It will be perceived as an invented word and is, therefore, highly distinctive. As such, consumers may assume that no-one else other than the opponent would be using it in a trade mark. Alternatively, it is my view that the differences between the competing marks readily lend themselves to a variant brand or sub-brand. I have found that the additional words in the first earlier mark, i.e. ‘HEALTH INNOVATION’, will be perceived as a marketing tag line, namely, a company ethos statement informing consumers that the company (in this instance, ‘VITAE’) is committed to developing new ideas, methods and products for the maintenance or improvement of health. The removal of such a marketing tag line and the addition of the word ‘SWISS’ appears to be consistent with a variant brand or sub-brand, indicating the Swiss limb of the company, or that the particular goods offered under the mark originate from, or are in some way connected with, Switzerland. In my view, this is particularly the case

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<sup>5</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

<sup>6</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>7</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

considering the level of distinctive character possessed by the first earlier mark and that the parties' goods are identical or highly similar. Taking all of the above into account, I am satisfied that consumers – even paying an average to high level of attention – would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the presence of the identical and highly distinctive word 'VITAE'. Accordingly, I find that there is a likelihood of indirect confusion.

### **Conclusion**

45. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to a successful appeal against my decision, the application will be refused.

46. I should add that, as this conclusion has been reached on the basis of the first earlier mark, it is not necessary to go on to consider the opponent's reliance on the second earlier mark as this will not place it in a stronger position.

### **Costs**

47. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the guidance published in Tribunal Practice Notice 2/2015,<sup>8</sup> I award the opponent the sum of **£250** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£150
Official fees	£100
<b>Total</b>	<b>£250</b>

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<sup>8</sup> Which capped costs in fast track proceedings at £500, excluding official fees.

48. I therefore order SED Swiss Engineering Developments AG to pay VITAE HEALTH INNOVATION, S.L. the sum of **£250**. This 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 (subject to any order made by the appellate tribunal).

**Dated this 18<sup>th</sup> day of November 2022**

**James Hopkins**  
**For the Registrar**