

O/0744/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001632334

DESIGNATING THE UK

BY HIMS, INC.

FUTURE YOU THANKS YOU

IN CLASSES 3 AND 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 434499

BY CAMBRIDGE NUTRACEUTICALS LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark 1632334 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Hims, Inc. The IR is registered with effect from 5 November 2021. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The mark also claims priority from 21 May 2021.

2. The request to protect the IR was published on 25 March 2022. On 24 June 2022, Cambridge Nutraceuticals Limited (“the opponent”) partially opposed the protection of the IR in the UK based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). However, the opponent withdrew the section 5(3) ground in writing on 28 November 2022.¹

3. The opposition is directed against the following goods of the IR:

Class 5 Medicated hair care preparations; pharmaceutical preparations for the treatment of hair loss; medicated dandruff shampoo; pharmaceutical preparations used to treat eyelashes; medicated anti-aging cream; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of premature ejaculation; medicated skin care preparations; medicated mouth care and treatment preparations; cold sore treatment preparations; vitamins; dietary and nutritional supplements; dietary and nutritional supplements, namely, sleep supplements; dietary and nutritional supplements, namely, urinal tract health supplements; dietary and nutritional supplements, namely, protein supplements; powdered nutritional supplement concentrate; dietary and nutritional supplements, namely, multivitamin gummies; acne treatment preparations; pharmaceutical and medicinal preparations for use in the treatment of herpes, sleep disorders, behavioral health conditions, depression, anxiety; pharmaceutical

¹ The opponent also withdrew their reliance upon the UK0091786727 mark which was subject to proof of use.

preparations in the nature of birth control pills; antifungal preparations; personal lubricants; sexual arousal and sexual stimulant preparations; sexual care products, namely, oral vitamin supplements.

4. Under section 5(2)(b), the opponent relies upon the following trade mark:

The logo consists of the word 'Future' in a bold, orange, sans-serif font, followed by three orange chevrons pointing to the right, and the word 'You' in a bold, red, sans-serif font.

Comparable UK trade mark (EU) registration no. UK00917186727

Filing date 7 September 2017.

Registration date 21 December 2017.

Relying upon some of the goods for which the mark is registered, namely:

Class 5 Dietary food supplements and substances for medical use; dietary and nutritional supplements for medical use; chemical products for therapeutic use; therapeutic drugs and agents; pharmaceuticals; dietary fiber to aid digestion; dietary supplemental drinks; dietary supplements; dietary supplements for animals; dietary supplements for humans and animals; dietary supplements for infants; dietary supplements for medical use; dietetic beverages adapted for medical purposes; dietetic confectionery adapted for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietetic foods adapted for infants; dietetic foods adapted for invalids; dietetic foods adapted for medical purposes; dietetic foods for medicinal purposes; dietetic foodstuffs for medical purposes; dietetic infusions for medical use; dietetic preparations adapted for medical use; dietetic products for medical purposes; dietetic substances adapted for medical use; digestants; digestive enzymes; digestives for pharmaceutical purposes.

5. The opposition is based upon the opponent's earlier Comparable UK trade mark (EU),² claiming that there is a likelihood of confusion because the goods are identical or highly similar, the marks are highly similar and the opponent's marks are highly distinctive.

6. The holder filed a counterstatement denying the claims.

7. The opponent is represented by Mewburn Ellis LLP and the holder is represented by Jones Day. Neither party requested a hearing, however, the opponent filed evidence in chief and submissions in lieu of a hearing. I have taken all of the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE AND PRELIMINARY ISSUE

9. The holder's evidence consists of the witness statement of Soleil Boughton dated 30 January 2023. Ms Boughton is the Chief Legal Officer at Hims & Hers Health Inc., to which the opponent is incorporated with, and therefore she is authorised to make this statement on behalf of the opponent. Ms Boughton's statement was accompanied by 4 exhibits (SB01-SB04).

10. I note that **exhibit SB01** contains a list of 63 examples of class 5 UK trade marks using the word "FUTURE" and 112 examples of class 5 marks using the word "YOU".

² Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 the General Court (“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). “

11. The mere fact that there are multiple marks on the Register which contain the words “FUTURE” or “YOU” for class 5 goods in the UK is not relevant to my assessment. I have no evidence of how (if at all) these marks have been used in practice. This submission, therefore, does not assist the holder.

12. I have taken the remaining evidence and submissions into account in reaching this decision.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) reads 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.”

14. The earlier mark had not completed its registration process more than five years before the relevant date (the priority date of the IR in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall 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

16. The competing goods are as follows:

Opponent's goods	Holder's goods
<p><u>Class 5</u> Dietary food supplements and substances for medical use; dietary and nutritional supplements for medical use; chemical products for therapeutic use; therapeutic drugs and agents; pharmaceuticals; dietary fiber to aid digestion; dietary supplemental drinks; dietary supplements; dietary supplements for animals; dietary supplements for humans and animals; dietary supplements for infants; dietary supplements for medical use; dietetic beverages adapted for medical purposes; dietetic confectionery adapted for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietetic foods adapted for infants; dietetic foods adapted for invalids; dietetic foods adapted for medical purposes; dietetic foods for medicinal purposes; dietetic foodstuffs for medical purposes; dietetic infusions for medical use; dietetic preparations adapted for medical use; dietetic products for medical purposes; dietetic substances adapted for medical</p>	<p><u>Class 5</u> Medicated hair care preparations; pharmaceutical preparations for the treatment of hair loss; medicated dandruff shampoo; pharmaceutical preparations used to treat eyelashes; medicated anti-aging cream; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of premature ejaculation; medicated skin care preparations; medicated mouth care and treatment preparations; cold sore treatment preparations; vitamins; dietary and nutritional supplements; dietary and nutritional supplements, namely, sleep supplements; dietary and nutritional supplements, namely, urinal tract health supplements; dietary and nutritional supplements, namely, protein supplements; powdered nutritional supplement concentrate; dietary and nutritional supplements, namely, multivitamin gummies; acne treatment preparations; pharmaceutical and medicinal preparations for use in the treatment of herpes, sleep disorders,</p>

<p>use; digestants; digestive enzymes; digestives for pharmaceutical purposes.</p>	<p>behavioral health conditions, depression, anxiety; pharmaceutical preparations in the nature of birth control pills; antifungal preparations; personal lubricants; sexual arousal and sexual stimulant preparations; sexual care products, namely, oral vitamin supplements.</p>
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17. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

18. Guidance on this issue has 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

19. In *G rard Meric v 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 trade mark application (Case T-388/00 Institut f r Lemsysteme 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.”

20. 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.”

21. 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 the responsibility for those goods lies with the same undertaking.”

22. Firstly, within its counterstatement, the holder states that its products are “only available through a subscription service and there are some restrictions on who can use the products” and “by contrast, none of the opponent’s goods require a medical prescription and there is no access to an online prescribing physician”. However, this submission does not assist the holder. I have to carry out a notional assessment based upon all the ways in which the goods covered by the respective specifications could be used and sold. The way in which they are used and sold in practice is not relevant to my assessment.

Pharmaceutical preparations for the treatment of hair loss; pharmaceutical preparations used to treat eyelashes; pharmaceutical preparations for the treatment of erectile dysfunction; sexual arousal and sexual stimulant preparations; pharmaceutical preparations for the treatment of premature ejaculation; cold sore treatment preparations; pharmaceutical and medicinal preparations for use in the treatment of herpes, sleep disorders, behavioral health conditions, depression, anxiety; pharmaceutical preparations in the nature of birth control pills.

23. The holder’s above goods fall within the broader categories of “pharmaceuticals”, in the opponent’s specification. The goods are identical on the principle outlined in *Meric*.

Medicated hair care preparations; medicated dandruff shampoo; medicated anti-aging cream; medicated skin care preparations; medicated mouth care and treatment preparations; acne treatment preparations; antifungal preparations.

24. Therapeutic drugs, agents or chemicals are all products which are designed to treat an illness or condition.³ I therefore consider that the holder's above goods fall within the broader categories of "therapeutic drugs and agents" and "chemical products for therapeutic use" in the opponent's specification. The goods are identical on the principle outlined in *Meric*.

Vitamins; dietary and nutritional supplements; dietary and nutritional supplements, namely, sleep supplements; dietary and nutritional supplements, namely, urinal tract health supplements; dietary and nutritional supplements, namely, protein supplements; powdered nutritional supplement concentrate; dietary and nutritional supplements, namely, multivitamin gummies; sexual care products, namely, oral vitamin supplements.

25. The holder's above goods fall within the broader categories of "dietary and nutritional supplements for medical use", "dietary supplements" and "dietary supplements for medical use" in the opponent's specification. The goods are identical on the principle outlined in *Meric*.

Personal lubricants.

26. With the above goods, I note that the opponent's best case comparison would be with the term "pharmaceuticals", which is a very broad category which encompasses a range of medicines and substances which are used in treating conditions, diseases or illnesses. On this basis, the goods may overlap in nature as some medicines can appear in a gel based form. I also consider that there may be some overlap in distribution channels, as all of the goods would be sold in pharmacies, supermarkets or in health and beauty retail stores. However, they would not be sold in the same aisle. I also do not consider that the goods overlap in purpose and method of use, as the holder's goods are used for sexual pleasure. Lastly, the goods are neither complementary nor in competition. Therefore, taking all of the above into account, I consider that that goods are similar to a low degree.

³ <https://www.collinsdictionary.com/dictionary/english/therapeutic> accessed 17 July 2023

The average consumer and the nature of the purchasing act

27. 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 (as he then was) 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.”

28. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the General Court considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed

and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, **medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect** (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 [...]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness.”.

29. The average consumer for the pharmaceutical goods will be both medical professionals and members of the general public. I consider that the goods may either be obtained via a prescription, or could be sold over the counter. The cost of the goods is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. Furthermore, as the goods are in relation to the user’s health, as highlighted above, both sets of consumer would pay a high degree of attention during the purchasing process.

30. For the remaining vitamins, dietary and nutritional supplement goods, I consider that the cost of the goods on balance is likely to be relatively low. The majority of the goods will be purchased relatively frequently. These goods are easily accessible to the general public, with aisles dedicated to these goods in supermarkets, health and

beauty retail outlets and pharmacies. The average consumer will take various factors into consideration such as the cost, quality, and the suitability for their specific needs. Furthermore, because the goods are also in relation to improving the user's health, I consider that the level of attention paid during the purchasing process will be above a medium degree.

31. Lastly, for personal lubricants, I consider that these goods are easily obtained and selected from aisles in supermarkets, health and beauty retail outlets and pharmacies. The cost of the goods will be relatively low, and the purchase of the goods will be relatively frequent. The average consumer will take various factors into consideration such as the cost and suitability for their specific needs. Therefore I consider that the level of attention paid during the purchasing process will be medium.

32. As highlighted above, the goods are likely to be obtained by prescription or self-selection from the shelves of a retail outlet, supermarket or their online equivalents. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a medical professional or sales assistant.

Comparison of the trade marks


33. 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.”

34. 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.

35. The respective trade marks are shown below:

Opponent's trade mark	Holder's IR
	FUTURE YOU THANKS YOU

36. The opponent's mark consists of the word "FutureYou", which is comprised of 2 ordinary dictionary words, clearly highlighted by the distinct use of colour. The word "Future" is presented in an orange typeface, followed by the word "You" presented in a red typeface. I note that the letter "Y" is stylised, with the top-left diagonal line, being replaced with 3 arrows, presented in an orange to red colour gradient. I consider that the words "FutureYou" plays a greater role in the overall impression of the mark, with the arrow device, colour and stylisation playing a lesser role.

37. The holder's mark consists of the words "FUTURE YOU THANKS YOU". I consider that the overall impression of the mark lies in the combination of these elements.

38. Visually, the words contained within the opponent's mark, "FutureYou", are wholly contained at the beginning of the holder's mark. This acts as a visual point of similarity. However, the opponent's mark is presented in an orange and red typeface, with the letter "Y" being composed of an arrow device. The holder's mark also puts a space between the words FUTURE and YOU, and also ends in the words "THANKS YOU". These act as visual points of difference. I note that registration of a word only mark covers use in any standard typeface, and registration of a mark in black and white

covers use in any colour. I also bear in mind that the average consumer tends to pay more attention to the beginning of the marks.⁴ Consequently, I consider that the marks are visually similar to a medium degree.

39. Aurally, and as highlighted by the opponent, as the opponent's mark is wholly contained at the beginning of the holder's mark, this element is aurally identical. However, as the holder's mark ends with the words THANKS YOU, the marks are aurally similar to a medium degree. I also note that the arrow device in the opponent's mark will not be articulated.

40. For the sake of completeness, I note that the opponent in its submissions in lieu states that the phrase "thank you" is "used by all parties in almost all commercial transactions, as in the following example dialogue:

Customer: "Excuse me, I'm looking for a particular supplement I've heard good things about."

Shop assistant: "Do you know the brand name? I can take a look at our inventory."

Customer: "FUTURE YOU. Thank you (for your help)."

41. My comparison must be of the marks as registered. Therefore the above submission that the way the mark may be aurally pronounced within a dialogue is flawed and does not assist the opponent.

42. Conceptually, the opponent's mark evokes the meaning of a future version of yourself, or you in the future. The holder's mark evokes the concept of the future version of yourself thanking the older or current version of yourself. Consequently, as the marks overlap in the concept of "future you", I consider that they are conceptually similar to a medium degree.

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

Distinctive character of the earlier trade mark

43. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

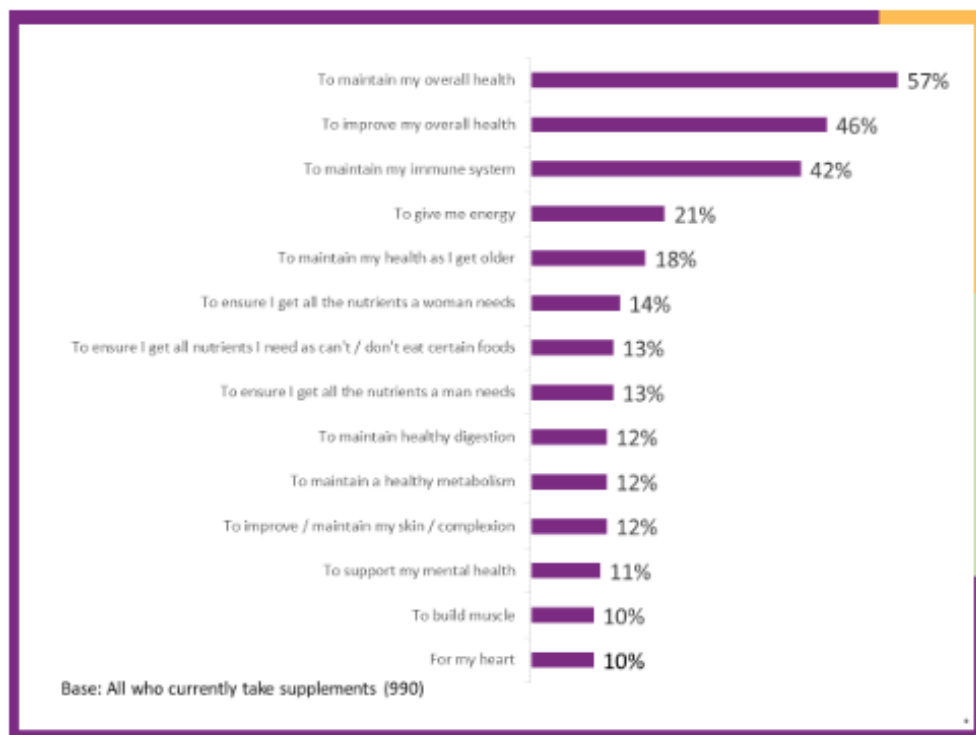
23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically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

44. 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.

45. The opponent submits that the combination of “FutureYou” is “fanciful” and is not descriptive of the goods at issue. In its submissions in lieu, they also note that the

holder's evidence appears to relate to the distinctiveness of the opponent's mark. I note the following from this evidence:

- **Exhibit SB02** contains screenshots demonstrating the sale of supplements and pharmaceuticals under the marks “BETTER YOU”, “SUPER YOU”, “FUTURE CBD” and “FUTURE KIND”. However, these printouts are either undated or dated “1/29/23” which I understand to be the 29 January 2023. These printouts therefore fall after the relevant date.
- **Exhibit SB03** contains a study/report conducted by the Food Standards Agency, dated May 2018, called “Food Supplements Consumer Research”. I note that page 17 of this report presents the following graph of reasons why the consumers apart of the study take supplements (including multivitamins, vitamin C, fish oils, vitamin D, iron, vitamin B, calcium, folic acid, magnesium, and protein etc.):



- The holder notes that 46% of the study take supplements to improve their overall health, “and thus achieve a better future”.

- **Exhibit SB04** contains an article by Tim Restrerer dated 19 December 2018 called “Can one little word change marketing and sales success?”. It states that in its most recent study it shows the power of using the word “you” in marketing, which “does a better job of unconsciously grabbing attention and transferring ownership to your buyer to personally “try on” the concepts you are sharing- both the problem and the solution”. According to a recent industry survey, 40% of marketers and sellers said they used “you-phrasing” to “focus on customers and encourage them to take ownership of their challenges and possible solutions”.

46. Ms Boughton states that the terms “FUTURE” and “YOU” “are commonly used to refer to the improved health and well-being of the future you if you take supplements, therapeutic products or pharmaceuticals”, and that the average consumer would be aware of the common use of these words in the sale of these class 5 goods. Furthermore, “the word “FUTURE” is synonymous with health, being linked to the idea of improving well-being over time. People take dietary supplements to improve an aspect of their health and improvement is a process which implies a past and a future”.

47. Taking the above into account, and my own personal knowledge and experience, I consider that the words “Future” and “You” used together for class 5 supplement goods is mildly allusive on the basis that it evokes the consumers “future self”, which by taking supplements, should be or has become a healthier or improved version of them. However, I note that the mark is presented all in one word (FutureYou), in an orange and red typeface, with the “Y” composed of an arrow device. I consider that this, to some extent, contributes to the distinctiveness of the mark. Therefore, taking the mark as a whole into account, I consider that it is inherently distinctive to no more than a medium degree.

Likelihood of confusion

48. 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier 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.

49. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually, aurally and conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to no more than a medium degree.
- I have identified the average consumer for the goods to be medical professionals and members of general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a high degree of attention will be paid during the purchasing process for the pharmaceutical and medical goods, above a medium degree for vitamins, supplements and dietary goods and a medium degree for personal lubricants.
- I have found the parties' goods to be identical or similar to a low degree.

50. Therefore, taking all of the factors listed in paragraph 49 into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is on the basis that I do not consider that the average consumer would overlook the words "THANK YOU" at the end of the holder's mark. Consequently, I do not consider there to be a likelihood of direct confusion.

51. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

53. I also bear in mind the decision of the CJEU in *L’Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

54. In the present case, the opponent’s and holder’s marks both share the concept of “FUTURE YOU” which to some extent is mildly allusive of the parties’ goods. The addition of the laudatory words “THANKS YOU” in the holder’s mark does not significantly change the concept of the mark. It evokes the idea that the future you is thanking the past or current you. Consequently, I consider that the average consumer

will see the addition of the words “THANKS YOU” at the end of the holder’s mark as a logical brand extension of the opponent’s FutureYou mark, with the holder’s mark either being a sub-brand or an updated version of the same mark and therefore indicative of re-branding. I consider that it is not uncommon for undertakings to re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, I consider there to be a likelihood of indirect confusion for the goods which are identical.

55. For those goods that are similar to only a low degree, I consider that this will offset the similarity between the marks in accordance with the interdependency principle and will prevent there from being a likelihood of confusion (directly or indirectly).

CONCLUSION

56. The opposition is partially successful in respect of the following goods, for which the application is refused:

Class 5 Medicated hair care preparations; pharmaceutical preparations for the treatment of hair loss; medicated dandruff shampoo; pharmaceutical preparations used to treat eyelashes; medicated anti-aging cream; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of premature ejaculation; medicated skin care preparations; medicated mouth care and treatment preparations; cold sore treatment preparations; vitamins; dietary and nutritional supplements; dietary and nutritional supplements, namely, sleep supplements; dietary and nutritional supplements, namely, urinal tract health supplements; dietary and nutritional supplements, namely, protein supplements; powdered nutritional supplement concentrate; dietary and nutritional supplements, namely, multivitamin gummies; acne treatment preparations; pharmaceutical and medicinal preparations for use in the treatment of herpes, sleep disorders, behavioral health conditions, depression, anxiety; pharmaceutical preparations in the nature of birth control pills; antifungal preparations;

sexual arousal and sexual stimulant preparations; sexual care products, namely, oral vitamin supplements.

57. The IR will be designated for protection in the UK in respect of the following goods for which the opposition has been unsuccessful, and those for which the opposition was not directed against:

Class 3 Non-medicated hair care preparations; non-medicated skin care preparations; hair shampoo and conditioner; hair masks; scalp scrubs; cologne; anti-wrinkle cream; skin cleansers; facial moisturizers; non-medicated skin serums containing vitamins.

Class 5 Personal lubricants.

COSTS

58. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the opponent's only partial success. In the circumstances, I award the opponent the sum of **£450** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£150
Preparing and filling written submissions in lieu	£250
Official Fee	£100
Total	£450

59. I therefore order Hims, Inc. to pay Cambridge Nutraceuticals Limited the sum of £450. This sum is to 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 3rd day of August 2023

L FAYTER

For the Registrar