

**O/075/20**

In the matter of UK Trade Mark Application No.3289325 to register the word mark 'Lifes Nutrients' in classes 5 and 35 in the name of Nicholas Crowe and Matthew Crowe (the Applicants)

and

Opposition thereto No. 412846 by DSM IP Assets B.V. (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Applicants against the Decision of the Hearing Officer O-371-19 for the Registrar, The Comptroller General dated 3 July 2019

**DECISION**

**Introduction**

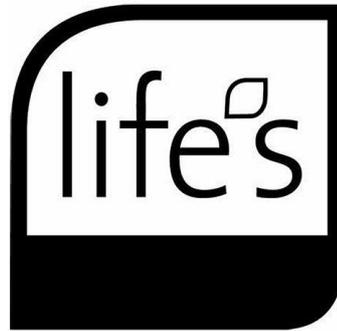
1. On 11 February 2018, the Applicants applied to register the word mark 'Lifes Nutrients' for a range of goods in class 05 and services in class 35, as follows:

**Class 05:** Health food supplements for persons with special dietary requirements; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Herbal supplements; Probiotic supplements; Protein dietary supplements; Protein powder dietary supplements; Protein supplements; Vitamin and mineral food supplements; Vitamin and mineral supplements; Diet capsules; Dietary and nutritional supplements; Dietary fiber to aid digestion; Dietary fibre; Dietary food supplements; Dietary supplement drink mixes; Dietary supplement drinks; Dietary supplemental drinks; Dietary supplements; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Dietary supplements with a cosmetic effect; Mineral dietary supplements for humans; Nutritional supplement meal replacement bars for boosting energy; Nutritional supplements; Herbal dietary supplements for persons special dietary requirements.

**Class 35:** Online retail services in relation to dietary and nutritional supplements; Mail order retail services in relation to dietary and nutritional supplements; Retail services in relation to dietary and nutritional supplements; Online retail store services relating to cosmetic and beauty products; Wholesale services in relation to dietary supplements.

2. The Application was opposed by the Opponent under section 5(2)(b) of the Trade Marks Act 1994 (as amended) on the basis of its earlier International Registration

designating the EU, WE00001203013, with a date of designation in the EU of 20 January 2014. That Registration comprises this device mark:



3. The Registration is registered for goods in classes 01, 05, 29, 30 and 32, but the Opponent only relied on the goods it has protected in classes 01 and 05 (which include food and dietary supplements).
4. As the Hearing Officer pointed out in paragraph 4 of his Decision, the registration process of the Registration was completed less than 5 years before the publication date of the application and accordingly the Registration is not subject to the proof of use provisions in section 6A of the Act. Accordingly, the Opponent is not required to prove they have made any use of the Registration and, to the extent necessary, I must consider the goods in classes 01 and 05 on which the Opponent relies.

#### The Opposition

5. In the Opposition, both sides filed evidence and submissions, but neither requested a hearing. So the Hearing Officer issued his Decision 'following a careful perusal of the papers'.
6. Having reminded himself of the applicable principles, the Hearing Officer started by considering the respective goods and services in three stages.
7. First, and for the reasons he explained, the goods applied for in class 05 fell wholly within the classification of goods in class 05 for which the Opponent's Registration was registered. Therefore, all the class 05 goods applied for were identical to goods for which the Opponent's Registration was registered.

8. Second, he considered the retail services applied for which related to dietary and/or nutritional supplements. Again, for the reasons he set out, he found these services were similar to a medium degree to the Opponent's earlier goods in class 05.
9. Third, he considered the retail services applied for relating to cosmetic and beauty products. He concluded these services were dissimilar to the earlier goods relied upon by the Opponent.
10. The Hearing Officer made findings as to the identity of the average consumer and the nature of the purchasing act and then proceeded to make his comparison of the marks in issue. I will come back to the detail of his conclusions on visual, aural and conceptual similarity because they are the focus of the Appeal.
11. To complete my summary of the Hearing Officer's Decision, he concluded there was no likelihood of direct confusion (i.e. the mark applied for would not be mistaken for the earlier mark), but he decided there was a likelihood of indirect confusion in relation to the goods and services he had found to be either identical or similar to a medium degree. He found there to be no likelihood of either type of confusion in respect of 'Online retail store services relating to cosmetic and beauty products' (because the goods and services were dissimilar), so the Opposition failed in respect of those services but otherwise it succeeded.

#### The Appeal in outline

12. The Applicants appeal (to the extent the Opposition succeeded) on a number of grounds which I consider below. However, it is fair to say that the Grounds of Appeal focus on the assessment of the marks and the degree of attention of the average consumer. The Appellants have also developed a series of arguments (as they did for the Hearing Officer) based on the marks they have actually used on the market since 2016 and the contention that there has been no confusion in practice. As the Hearing Officer pointed out in paragraph 40 of his Decision, the comparison must be made between the Opponent's earlier mark and the Applicants' later mark and in respect of the goods and/or services for which each mark is protected or applied for.

13. Neither side requested a hearing so I requested and received written submissions from the Applicants in support of their Appeal, written submissions from the Opponent in response and written submissions in reply from the Applicants. Although the Applicants represent themselves (as I understand it) and the Respondent is professionally represented, the Applicants'/Appellants' submissions demonstrate an excellent grasp of the relevant concepts. Subject to one point, I am grateful to both sides for their excellent and succinct submissions.
14. The exception concerns the attempt by the Respondent/Opponent to introduce a 'family of marks' argument and evidence for the first time in appeal submissions. This should not have even been attempted. I wish to emphasise I have ignored that part of its submissions in what follows.
15. I start by reminding myself of the standard of review on this Appeal. I shall then consider the Appellants arguments under a series of headings below.

#### Standard of appeal

16. This appeal is by way of review of the Hearing Officer's decision. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that:

“... In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).”

17. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

“78. ... Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant, In re Reef Trade Mark* [2002] EWCA Civ 763; [2003] RPC 5, paras 25-28 per Robert Walker LJ.

...

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge’s conclusions of primary fact but with the correctness of the judge’s evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge’s conclusion is outside the bounds within which reasonable disagreement is possible. ...

81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge’s assessment of obviousness if the appellate court were to reach the view that the judge’s conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong ...”

18. In relation to appeal from a Hearing Officer who has assessed the likelihood of confusion for an opposition based upon section 5(2)(b) of the Act, Mr Iain Purvis QC sitting as the Appointed Person in Rochester BL O/049/17 said at [33]:

“... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the

tribunal on the particular facts of each case

(ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

19. I have kept these principles in mind on this appeal.

#### The Level of Attention of the Average Consumer

20. Having directed himself appropriately by reference to *Lloyd Schuhfabrik* and *Hearst v AVELA*, the Hearing Officer said this:

“35. The goods and services found to be identical or similar are day to day products and services, being dietary, nutritional and health food supplements on the one hand, and the retail and wholesale of those goods on the other. I find that the average consumer of both the goods and the services will be a member of the general public. The average consumer of the wholesale services of the applicant may also be a professional in the relevant sphere of business.

36. The average consumer of the goods at issue would generally pay at least a medium level of attention when selecting them. Dietary and nutritional supplements can be quite basic, e.g. a multi-vitamin tablet, however some are more complex in their nature and, for a consumer with particular dietary requirements or medical issues, a greater degree of care may be required during the selection process. The choice of retailer of such goods is unlikely to be subject to the same level of scrutiny as the goods themselves, but the level of attention being paid by a professional consumer of wholesale services will be at least medium.”

21. I also note that, later in his Decision when summarising these findings in paragraph 60, the Hearing Officer said:

‘the consumer can be expected to be paying a medium level of attention when selecting the services at issue and a medium to higher than average level of

attention during selection of the goods at issue.”

22. The Appellants submit that the Hearing Officer’s finding that the level of attention paid by the average consumer to the goods in issue was ‘*at least medium*’ was wrong. They suggest he should have found the level of attention to be high for two main reasons:

- a. First, because the goods in question are ingested for health purposes, so ordinary consumers would pay a high level of attention to the product as well as the brand because what they are purchasing will impact their health and well-being. Similar considerations they say apply to health professionals who would take care when recommending such products to their patients.
- b. Second, they contrast the decision of another Hearing Officer in *Joshua Ellis v Nenco Holding B.V.* O/362/16, where the Hearing Officer found that the average consumer would pay a high level of attention in what the Appellants contend was a very similar situation.

23. As to the first point, one must be careful not to overstate the significance of products purchased for health purposes and thereby the level of attention. The goods in question are not prescription medicines. They range from quite basic consumer products such as vitamin tablets up to ‘*Health food supplements for persons with special dietary requirements*’.

24. As to the second point, on closer analysis, the situation in *Joshua Ellis* was somewhat different. The Opponent’s goods in class 5 were: “Dietetic food and dietetic substances adapted for medical use; gluten-free food for medical use; gluten-free dietetic food and gluten-free dietetic substances adapted for medical use; gluten-free food supplements.” (my emphasis).

25. Since it was these goods which formed the basis of the comparison, I can well understand why the Hearing Officer in that case:

- a. First, decided that “*The average consumer for the parties’ goods is either a member of the general public with special dietary needs or a professional user such as a dietician who advises those with such needs.*”

- b. Second, concluded that “*the goods at issue will be selected to cater for specific dietary needs and keeping in mind the potentially adverse consequences of selecting an unsuitable product, I am led to conclude that both sets of average consumers are likely to pay a high degree of attention to their selection.*” (my emphasis).

26. Against this background, I see no inherent inconsistency between the findings in this case and those in *Joshua Ellis*. As can be seen from the quoted passages above (from paragraphs 36 and 60), the Hearing Officer reached a careful and nuanced conclusion. He was considering a range of scenarios – from a consumer selecting quite basic multi-vitamin tablets to a consumer with medical issues, where greater care would be exercised in the selection process. In my view, it was entirely appropriate to conclude (as he did) that in the former scenario, the level of attention would be medium, whereas in the latter scenario, the level of attention would be higher.

27. In this case, the phrases used in the class 5 specification are broader than the more specific phrases used in *Joshua Ellis*. I recognise that the broader phrases include the specific, but that does not mean that it is necessary or appropriate to designate the average consumer as having a high degree of attention across all these goods – that is not realistic. This is why I consider the range adopted by the Hearing Officer to be correct. For these reasons, I am unable to detect any material and distinct error of principle in the Hearing Officer’s reasoning on level of attention.

#### The Hearing Officer’s Assessment of the Marks

28. The Applicants level a number of criticisms at the Hearing Officer’s assessment of their mark, which impact on his findings on the degrees of similarity and likelihood of confusion. It is fair to say that they centre on: (a) an allegation of artificial dissection of the mark; (b) an alleged far too great a focus on just the common element ‘LIFES’; and (c) the finding that NUTRIENTS was wholly descriptive and non-distinctive. By contrast, the Respondent argues in various ways that the Hearing Officer’s assessment was correct.

29. The Hearing Officer started the process by reminding himself of the standard principles from *Sabel v Puma* and *Bimbo*. His summary in paragraph 39 is also standard and cannot be faulted:

38. 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.”

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

30. Having set out the marks to be compared, the Hearing Officer continued as follows.

I have underlined certain passages which I discuss further below.

“42. The earlier mark is a figurative mark comprised of the word ‘life’s’, where the apostrophe in the word is replaced with an oval design, and the word is placed within a black and white geometric figurative design. As the figurative elements in the mark are quite basic, the word ‘life’s’ can be said to be the dominant, eye-catching element, and therefore the overall impression of the earlier mark lies in that word.

43. The contested mark is comprised of the plain words ‘Lifes Nutrients’. The word ‘Nutrients’ is defined as ‘substances that help plants and animals to grow’. [FN: <https://www.collinsdictionary.com/dictionary/english/nutrient>] This is a definition that I am familiar, with and one that I believe the relevant public in this regard would also be familiar with. This element will therefore be perceived to be descriptive and non-distinctive within the context of the goods and services at issue. Whilst the mark will be read as a single expression, the word ‘Lifes’ can be said to play a greater role in the later mark and as such, the overall

impression of the later mark lies in that word.

#### Visual similarity

44. The marks are visually similar insomuch as they both contain the word 'lifes'. They differ in the figurative elements of the earlier mark, and in the word 'Nutrients' of the later mark which has no counterpart in the earlier mark.

45. Weighing up the similarities and differences and taking account of my conclusions regarding the overall impression of the marks, I find them to be visually similar to an average degree.

#### Aural similarity

46. The opponent's earlier mark will be enunciated as *LYFS*. The applicant's contested mark will be articulated as *LYFS/NEW/TREE/UNTS*. Whilst the majority of the later mark is different to the earlier mark, both marks share the same first word identically. The marks are therefore found to be phonetically similar to an average degree.

#### Conceptual similarity

47. The figurative elements in the earlier mark are likely to be considered as simply decorative in nature. In the alternative, the figurative elements in the earlier mark may possibly be perceived to allude to the leaf of a plant. The word element 'Life's' in the earlier mark derives from the word 'Life' and will be understood to refer to the quality a plant or animal has when it is alive.

48. The later mark is comprised of the plain words 'Lifes Nutrients'. As with the earlier mark, the word 'Lifes' derives from the word 'Life' and will be readily understood. The word 'Nutrients' will be understood to refer to substances that are needed to help plants and animals to grow.

49. Both marks convey a message that relates to the concept of 'Life'. The word 'Nutrients' in the later mark will be perceived to be descriptive and non-distinctive within the context of the relevant goods and services and will be given little or no weight. Where the figurative elements of the earlier mark are perceived to represent a leaf shape, the average consumer will understand this as a reference to the notion of plant life, which will likely reinforce the impact that the word 'life's' will have on that consumer. I therefore find the marks to be conceptually identical.

50. In conclusion, the marks have been found to be visually and phonetically similar to an average degree and conceptually identical."

31. I have three main interrelated concerns about this analysis.
- a. First, the finding that the two marks are conceptually identical. For the reasons developed below, I consider this finding is wrong.
  - b. Second, the underlined passage at the end of paragraph 43. This suggests that the Hearing Officer has reduced the later mark to just LIFES – which might well lead to a finding of conceptual identity. I note, however, that his analysis of the visual and aural similarities demonstrates he has not done this (at least in those assessments). Furthermore, his last sentence in paragraph 61 confirms this as well.
  - c. Third, the absence of any consideration of the significance of the apostrophe in the earlier mark and whether and how the two words in the later mark hang together.
32. Before explaining my concerns, I should deal with a point the Appellants raise about the dictionary meaning of the word ‘Nutrient’: ‘substances to help plants and animals to grow’. As the Hearing Officer found, the average consumer would have essentially this understanding of the word. The Applicants emphasise that their products and their specification of goods are directed at humans and not animals. However, there is nothing in this point. In this regard, ‘nutrients’ are as essential to humans as animals or plants for that matter.
33. The Hearing Officer’s assessment of the earlier mark in paragraph 42 is correct so far as it goes, but it seems to me to be incomplete. If, as he found, the overall impression of the earlier mark resides in the word ‘Life’s’, it was necessary to comment on the incompleteness of the mark (cf *Cycling Is...* O/561/01). To my mind, this mark creates a question in the mind of the average consumer: Life’s what? This mark has to be considered in notional and fair use on the goods for which it is registered. Thus, the answer to the question is supplied by the goods themselves (e.g. Life’s vitamin C), since the mark is essentially in the possessive form.
34. When it comes to the mark applied for, the Applicants submit that the two words hang together. I very largely agree. There is a small point that the mark applied for

is grammatically incorrect, but the average consumer is used to correcting automatically that type of error and making sense of expressions of this type. I am fully aware of the danger of overanalyzing marks and I remind myself that the purpose of the assessment of the visual aural and conceptual similarities is to provide a structured analysis of the process which happens instinctively in the mind of the average consumer when encountering each mark. With those considerations in mind, I consider that the average consumer would read the mark applied for as 'Life's Nutrients' and in the sense of 'Nutrients for Life'.

35. It is true that this analysis shows the essentially descriptive meaning of 'Nutrients' in this mark. It also shows the word Life being used in its ordinary meaning as well. However, the mark applied for was accepted for registration by the UK IPO and no ground of opposition was raised on the basis of either sections 3(1)(b) or (c). Accordingly, I must assess this mark on the basis that it has at least a minimum degree of distinctive character. I consider it does so, but the distinctiveness lies in the combination: 'Life's Nutrients'.
36. This analysis means that it is difficult (and I believe wrong) to leave 'Nutrients' out of account, which is really the only way that one might get to a conclusion that the marks were conceptually identical. I consider these marks are clearly not conceptually identical. The earlier mark conveys an incomplete meaning: Life's something, where the 'something' is the actual good on which the earlier mark is considered to be used. The later mark conveys a more definite meaning at a much higher level of generality: Life's Nutrients or Nutrients for Life. I assess the degree of conceptual similarity as average.
37. Notwithstanding a degree of confusion in the Hearing Officer's analysis leading up to his assessments of visual and aural similarity, I agree with his assessments of the degree of visual and aural similarity being average.
38. At this point, I pause to state my conclusion that the Hearing Officer did commit distinct and material errors in his assessment, particularly of conceptual similarity. This is why I have already made my own assessment above, and why I must conduct my own assessment of the likelihood of confusion, since the Hearing Officer's conclusions are vitiated by the errors I have identified.

## The Consequential Analysis

39. In the next section of his Decision, the Hearing Officer assessed the inherent distinctive character of the earlier mark and found ‘*the earlier mark to be inherently distinctive to no more than an average degree.*’ Although I have assessed the earlier mark differently, I am inclined to reach the same conclusion on inherent distinctiveness, albeit for different reasons. I should state what those different reasons are. I agree with the Hearing Officer that the figurative elements of the earlier mark are quite basic, with the result that the word element ‘Life’s’ is the dominant element. The presentation of that word in its possessive form serves to emphasise the trade mark significance of ‘Life’. However, in the field of nutritional and dietary supplements, a reference to ‘Life’ is not exactly striking or unusual.

## Likelihood of Confusion

40. I have reminded myself of the applicable principles which the Hearing Officer set out in paragraphs 11 and 12 of his Decision. I here set out a corrected summary of the earlier findings (based on his paragraph 60):

- a. the goods and services are identical, similar to a medium degree or dissimilar;
- b. the marks are visually, phonetically and conceptually similar to an average degree;
- c. the average consumer will be a member of the general public or a professional;
- d. the consumer can be expected to be paying a medium level of attention when selecting the services at issue, and a medium to higher than average level of attention during selection of the goods at issue;
- e. during the selection process, the visual and aural considerations will both be important, however the visual impression will play the greater role;
- f. the earlier mark has no more than an average level of inherent distinctiveness;

41. Weighing up all the factors, I conclude there is no likelihood of direct confusion between the marks. The average consumer would not mistake one mark for the other. As the Hearing Officer said: “*The figurative elements in the opponent’s mark, and the additional verbal element ‘Nutrients’ in the applicant’s mark will not go unnoticed.*”

#### Likelihood of Indirect Confusion

42. Even though his analysis is vitiated by his earlier errors, it is right that I should consider carefully the reasons the Hearing Officer gave for finding that there was a likelihood of indirect confusion where the goods and services were either identical or similar.

“63. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., 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.

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).”

64. Taking into account the earlier finding that the figurative elements in the earlier mark are quite basic in nature and the word ‘Nutrients’ in the later mark will be considered to be descriptive and non-distinctive, I find that the second category set out above, bites here. The average consumer of the opponent’s earlier goods in class 05 will, when faced with the applicant’s goods, and the applicant’s retail and wholesale services of those goods, believe that that use represents a brand extension or sub-brand of the opponent, and expect that the goods and services are economically linked and share the same origin.

65. The applicant has stated in submissions that an internet search of the terms ‘Lifes’ and ‘Lifes Nutrients’ separately, fails to bring back a hit for the other term. It argues that this result should show that, where a consumer searches e.g. ‘Lifes’ and is not exposed to the term ‘Lifes Nutrients’ or vice-versa, confusion between the two terms could not arise. I am not persuaded by this line of argument. The fact that the word ‘Nutrients’ is descriptive and non-distinctive has been established previously. My assessment is made therefore on the basis of the perception or impact that the later mark, as a whole, would have on the average consumer of goods and services where the intention is to purchase and consume products that are marketed specifically for their nutritional values. In that context, that consumer will pay little or no regard to the element ‘Nutrients’ in the applicants mark and will consequently be drawn to the ‘Lifes’ element. Where this is the case, an internet search of the applicant’s mark may be reduced to a search for ‘Lifes’ products, which would bring into play the opponent’s activity in the same field of interest.

66. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

67. In this respect, as the applicant has stated that the word ‘Lifes’ “has no direct link to the goods at issue and can be said to be an arbitrary choice when considering the nature of the goods”, and as ‘Nutrients’ is a descriptive term, I conclude that the average consumer will indirectly confuse the marks and believe that the goods and services found to be identical or similar, originate from the opponent.”

43. In this section of his Decision, the Hearing Officer reminded himself entirely correctly of the applicable principles from *L.A. Sugar* and *Duebros*. His application of those principles is a little back to front, in the sense that he stated his conclusion in paragraph 64, dealt with the Applicants' internet search argument in paragraph 65, and then seems to cite and apply *Duebros* in paragraphs 66 and 67, but I make no particular criticism in that regard. I think it is clear from what I have said above (regarding the way the two words in the later mark hang together) that I do not agree with his finding in paragraph 64 (which he carries through into paragraph 67) that the consumer will pay little or no regard to the element 'Nutrients' in the mark applied for.
44. In paragraph 67, the Hearing Officer quotes from the Applicants' submission that the word 'Lifes' "*has no direct link to the goods at issue and can be said to be an arbitrary choice when considering the nature of the goods*". It seems to me he combined that with his earlier finding that Nutrients is a descriptive term and therefore largely to be ignored. This reasoning then supported his already stated conclusion of indirect confusion. On Appeal the Applicants complain that he took their submission out of context. I need not resolve that issue because I have already held the two words in the later mark 'hang together' and therefore disagree with the way the Hearing Officer reasoned in the passages in paragraphs 64 and 67 to which I have drawn attention.
45. Nonetheless, it is clear that his 'brand extension' reasoning deserves serious re-consideration, but based on my assessment of the degrees of similarity and my reasoning in that assessment.
46. In the way that I have assessed the earlier mark, it lends itself naturally to a brand extension type argument. Whereas the earlier mark (because of its possessive form) applies itself to the particular goods in respect of which it is used, the later mark provides, in essence, the category of goods – nutrients – albeit at a high level of generality. I remind myself that, on the Opponent's best case, the goods in class 5 are identical.
47. I have given anxious consideration to the general point I made in *Duebros* – that just because two marks contain a common element does of itself lead to a finding

of indirect confusion. In that case, the common element was EDEN, but the mark applied for contained other significant word and figurative elements which tended to militate against indirect confusion. However other factors were in favour – notably the fact that EDEN was a distinctive element in each mark. In that case, I made a finding of indirect confusion for the goods which were identical and highly similar but not for a range of other goods. All these points emphasise that each case depends on its own particular circumstances.

48. The Applicants argue that the Opponent’s registration should not give it a monopoly over marks comprising ‘Life’s’ along with another (descriptive) word. I have some sympathy with that argument, which is in line with the point I was making in *Duebros*. Nonetheless I have to deal with the specific facts of this case.

49. I remind myself of another point I made in *Duebros*, that there are four options:

The average consumer mistakes one mark for the other (direct confusion);

The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services.

50. I have already ruled out the first option. On the facts here, I also rule out the fourth option – the ‘Lifes’ element is sufficient to give rise to a link. The issue is whether the various factors in the global assessment lead to the conclusion that the later mark merely calls to mind the earlier mark in the mind of the average consumer or whether the average consumer believes the goods or services in question come from economically linked undertakings.

51. Although I consider this case is close to the line, I have come to the conclusion that where the goods are identical (as they are in class 5), the average consumer would take the ‘Lifes Nutrients’ mark to belong to the same stable as the earlier mark i.e. there is

a likelihood of indirect confusion. I reach the same conclusion for the class 35 services in respect of which the Hearing Officer upheld the Opposition.

52. I have reached the same end result as the Hearing Officer, albeit for different reasons. Accordingly, I dismiss the Appeal. The Application may proceed to registration only in respect of the following class 35 services: “*Online retail store services relating to cosmetic and beauty products.*”

#### Costs

53. The Hearing Officer made an award of £800 as a contribution towards the costs of the Opponent. The parties conducted this Appeal in an economical fashion. I would have awarded the Respondent/Opponent an additional sum of £200 towards its costs of the Appeal if it had not been for the illegitimate attempt to influence me with the new ‘family of marks’ argument. For that reason, I award the Respondent/Opponent only £100 towards the costs of the Appeal.
54. Therefore, the Applicants must pay to the Opponent or its representatives the total sum of £900 (being the combination of the award made by the Hearing Officer and my award in respect of the Appeal) on or before Friday 14<sup>th</sup> February 2020.

JAMES MELLOR QC  
The Appointed Person  
6<sup>th</sup> February 2020