

O-097-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2425249
BY VIRGINIA HEALTH FOOD COMPANY TO REGISTER THE TRADE MARK**

**V-Pro
V Pro
V-PRO
V PRO**

(Series of four marks)

IN CLASSES 29, 30 and 31

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 94842
BY THE PROCTER & GAMBLE COMPANY**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2425249
By Virginia Health Food Co to register the trade mark
V-Pro, V Pro, V-PRO, V PRO in Classes 29, 30 and 31**

and

**IN THE MATTER OF Opposition thereto under No. 94842
by The Procter & Gamble Company**

BACKGROUND

1) On 23rd June 2006 Virginia Health Food Company (“Virginia”) applied to register the following trade marks:

V-Pro
V Pro
V-PRO
V PRO

as a series of four marks.

2) The application was in respect of the following goods:

Class 29

Preserved, dried and cooked fruit and vegetables.

Class 30

Flour and preparations made from cereals.

Class 31

Agricultural, horticultural and forestry products and grains not included in other classes; fresh fruit and vegetables, seeds, natural plants and flowers.

3) The application was subsequently advertised on 8th September 2006 and on 8th December 2006, The Procter and Gamble Company (“Procter”) filed notice of opposition to the application. The opposition is based on grounds under Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (“the Act”).

4) Procter relies upon its earlier Community trade mark (CTM) registration 273292 and UK registration 1447891. The details of these trade marks are set out below:

Trade Mark	Registration Date	Relevant Specification
CTM 273292 PRO-V	09/02/1999	Class 3 Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices, preparations for the cleaning, care and beautification of the skin, scalp and hair.
UK 1447891 PRO-V	20/ 03/1992	Class 3 Non-medicated toilet preparations; cosmetics; preparations for the cleaning, care and beautification of the hair and skin; soaps; shampoos; hair lotions; dentifrices; all included in Class 3.

5) Virginia subsequently filed a counterstatement denying the grounds for opposition. However, on the accompanying Form TM8 they left blank Box 5, which requires an answer to the following question: “If a statement of use of any earlier trade marks has been given in support of the opposition or invalidation action, do you accept this statement?”. They also left blank Box 6 which provides: “If you answered “No” to question 5, do you want the other side to provide proof of use of the earlier marks? And the follow up question, “If you want the other side to provide proof of use you must state in your counterstatement for which earlier marks and for which goods and services you require that proof.” The counterstatement is likewise silent on the question of Virginia requiring proof of use from Procter of their earlier marks. I will return to this issue in due course.

6) Both sides filed evidence in these proceedings. Neither side however wanted an oral hearing, and both were content for the matter to be decided on the basis of the evidence and written submissions (also filed by both parties) on file.

Opponent’s Evidence

7) There are seven witness statements. Six are from attorneys, assistants and paralegals working for the firm (D. Young & Co) representing Procter and one from a beauty therapist who runs her own company in Reading. The evidence can broadly be classified into two groups; the first being in relation to surveys conducted by D. Young & Co in September 2007. The second concerns the concept of brand extension or stretching which, loosely described, concerns the approach of some companies who own established brands and who then use that brand to launch new and modified products into the same market or even

into unrelated markets. To borrow just one illustrative example taken from internet material researched by Wendy Waller, a Paralegal with D. Young & Co, in her witness statement of 22nd June 2007; YAMAHA is a well established brand for motorbikes and this provided the platform for expansion into the unrelated field of musical instruments. However I need firstly to deal with the survey evidence.

8) In her witness statement of 15th October 2007, Angela Claire Thornton-Jackson, an attorney and partner in the firm D. Young & Co, explains that surveys were conducted by members of the firm on her instructions (Exhibit ACTJ4). Those members of her firm: Gemma Maria Williams, Kate Elizabeth Symons, Wendy Lucille Waller and Richard Phillip Burton have also provided their own witness statements regarding the surveys. The surveys were conducted on 11th September 2007 in London and on 10th and 11th September 2007 in Southampton. The London survey was designed to test reaction to Virginia's mark V-PRO, whilst the Southampton survey was designed to test public recognition of Procter's mark PRO-V. Instructions were issued on 7th September, and in Ms Thornton-Jackson's words, the primary aim behind both surveys "was to establish whether PRO-V (the Opponent's trade mark) enjoys a reputation in the UK in relation to their relevant goods". To that end, only the opponent's target market were interviewed, that is women between the ages of 18 and 84.

9) The London survey tested women's reaction to Virginia's trade mark V-PRO. To do this a card was used which I have annexed at A (Exhibit ACTJ2). As can be seen the 'V-PRO' sign appears on a container which is blank, save for the measure 200ml between two lines at the bottom and what appear to be splash marks on the lower part of the container. In relation to the container, Ms Thornton-Jackson says that the "shape does not relate to either the applicant's or the opponent's respective products. The bottle was chosen as a generic shape type being typical of those used both in the hair care and cosmetics industry and in the food sector." I will return to this point as this is the subject of evidence from Wendy Waller.

10) For the London survey, interviewers stood in Covent Garden moving to other areas in the vicinity and stopped women in the age group identified, asking them if they were willing to take part in the survey. Around 60 people agreed and their response was recorded on pre-printed sheets as well as using a dictaphone.

11) On being shown the card at Annex A, the interviewee was initially asked if they had any thoughts or comments. If necessary they were prompted with the question "Do you recognise the product?". They were then asked, "Why?", following which they were asked, "Where would you expect to buy this ?". Then they were asked to identify their age range and asked finally whether they minded being contacted again (blank questionnaire is exhibit ACTJ 1). Blank questionnaires were completed by the interviewers and these are exhibited as

exhibit GMW4 to Gemma Williams's witness statement and a collation of the results as exhibit GMW5. According to this exhibit, 26% (16 people) of interviewees are said to have "recognised the product as PANTENE "either because of the V-PRO element, or because it looks like a bottle of PANTENE PRO-V, or because of the bottle shape". 16% (10 people) recognised the product as "some form of hair product or shampoo because of the shape of the bottle or the matter present on the bottle". Various other results are also recorded, concluding with 28% (17 people) who "did not recognise the product at all". On being asked where they would expect to buy the product 86% (52) people responded by saying "in a chemist (pharmacy) cosmetics shop or supermarket". I should mention that the London survey was conducted also by Kate Symons along with Gemma Williams, and Ms Symons's witness statement and exhibits repeat the evidence of her colleague.

12) On the other hand, the Southampton survey was designed to test women's reaction to Procter's trade mark "PRO-V". To that end, a different card was used which I have annexed at B (exhibit ACTJ3). This card shows the same bottle as in A, but with the words "PRO-V" on the front. Wendy Waller and Richard Burton were responsible for this survey which was conducted using the same methodology as the London survey. In this case the interviewers stood in the main shopping precinct in the High Street and waterfront area of Ocean Village in Southampton. Again they only interviewed women as the target group. The handwritten responses are exhibited as WLW5 and results collated as WLW6. This exhibit shows that 51% (30 people), in the words of the exhibit, "recognised the product as being PANTENE PRO-V because either the word PRO-V, they had seen PRO-V in adverts for PANTENE PRO-V products or simply recalled the slogan [*sic*] 'PANTENE PRO-V'." 33% (20 people) "recognised the product as being a bottle of shampoo because either the PRO-V, they recall seeing it on an advert or because of the colour/shape of the bottle". As in London other responses are recorded and 7% (4 people) did not recognise the product at all. On being asked where would you expect the product to be bought, 58% (34 people) said Boots, 49% (29 people) said a supermarket, and 36% (21 people) said Superdrug. Richard Burton simply repeats the evidence of Wendy Waller.

13) In her second witness statement, dated 15th October 2007, on the question of food product packaging Wendy Waller addresses the question whether the shape and style of packaging used in the cards annexed at A and B is also used for food products. To that end, she visited Asda in Southampton and selected 10 examples of what she considered was similar packaging and these include various sauces, ketchups, a salad cream and honey. These examples are shown as exhibit WLW2 to her witness statement of 15th October 2007.

14) The second category of evidence goes to the question of 'brand extension'. Lisa de-la- Plain is a beauty therapist and has her own company LDLP Studio Ltd of Reading combining therapy and specialist retail. She speaks about the use of vitamins and minerals in relation to beauty care products such as Dermalogica

and many other skin and beauty care products. She also mentions the possibility of buying nutritional supplements specifically designed for the hair, nails and scalp for example. She states that vitamins and minerals can be best applied to the skin rather than ingested. Healthy eating is very much a part of the kind of holistic approach she advocates, and she points out that many food manufacturers offer healthy alternatives such as wheat, dairy or gluten free products. In addition many include extra vitamins or minerals for added health benefits such as cereal producers and others. She notes finally that mineral water producers in particular, including EVIAN and VITTEL, have diversified into fruit juices and skin care products. The EVIAN example (exhibit LDLP4) shows an advertisement for skin care wipes marketed under the EVIAN brand.

15) Wendy Waller provides a third witness statement dated 22nd June 2007 outlining her own researches on brand extension conducted on the internet. She cites many examples, including BOOTS, which now provide fitness equipment and optical services having started from the core Pharmacy Stores. She also talks about the phenomenon known as “cosmeceuticals”, defined as supplements that target skin, health and beauty. There are also a number of articles which speak about joint ventures in the relevant field, eg NESTLE’S joint venture with L’OREAL to produce a product designed for use in restoring firmness to the skin. There is an article covering the marketing of the Avon Wellness line of products which includes the VITADVANCE AQUANEW tablets containing a skin supplement, and of the skin care line OLAY’s joint venture with Pharmavite (a vitamin and supplement manufacturer in the US), to create OLAY Vitamins being the “first vitamin line to support beauty from within”.

Applicant’s evidence

16) This takes the form of three witness statements. Two by Norman William MacLachlan who is a director of Ansons, the firm representing Virginia. The third by Helen O’Dowd, a partner in Virginia. Much of Mr MacLachlan’s evidence is not evidence of fact but either submission or critique of Procter’s evidence. I will only deal with matters of fact here, and leave the submissions and critique (insofar as I consider them relevant) to the later part of my decision. He says that the mark PRO-V is, in use, a subsidiary element to the trade mark PANTENE, and in support of this Exhibit NM1 to his first witness statement of 16th April 2008 comprises a photograph of four bottles of PANTENE shampoo, each showing the word ‘PRO-V’ in much smaller script beneath the dominant PANTENE and logo device. Exhibits NM21 and 22 to his second witness statement of 16th May 2008 comprise, respectively, advertisements for the PANTENE product and copies from the PANTENE website also showing, in both cases, how much reduced in size and dominance the PRO-V element is compared to the PANTENE element. He says that he was unable to find any food container similar to the ones which are shown in exhibit NM1 containing the PANTENE shampoo although he did find deodorants and antiperspirants in similar containers.

17) Helen O'Dowd says in her witness statement that in 2005 Virginia commenced production of a range of totally natural, unadulterated whole foods. The mark V-PRO was adopted because Virginia's products were suitable for vegetarians and contain protein derived from plant material.

Opponent's evidence in reply.

18) Much of Gemma Williams evidence in reply is either submission or critique and I will deal with that below. In terms of fact, she says that the PRO-V mark stands independently from PANTENE in use, on a separate line in a different font and on the cap. Exhibit GMW2 shows use of the PRO-V element only on the cap (when viewed from above). She concedes that combining vitamins and beauty care products may be a new concept but it is nevertheless growing. In response to Helen O'Dowd, she reiterates the examples of EVIAN and OLAY already referred to, and also SNAPPLE. SNAPPLE is a juice product produced by CADBURY, which has now branched out into lip balms.

DECISION

The surveys

19) Before commencing my analysis I need to form a view on the survey evidence. I shall draw on the general conclusions arrived at below in relation to the surveys at appropriate stages of my later analysis. At the outset, it is important to recall that there are two surveys, each of which may be utilised for different purposes in relation to the grounds of opposition pleaded. Procter's stated purpose (see para 8 above) behind both surveys is to establish whether PRO-V enjoys a reputation in the UK in relation to their relevant goods. Relating this to specific grounds of objection, the surveys may then be used to support a case for enhanced capacity to distinguish through use of the PRO-V mark under section 5(2), as well as establishing reputation under section 5(3). Specifically, the V-PRO survey could in theory be used to support the overall case of likelihood of confusion under section 5(2), as well as the existence of a 'link' under section 5(3).

20) Case law on surveys is plentiful, the basic rules for the conduct of probative surveys being set out in *Imperial Group plc & Another v Philip Morris Ltd & Another* [1984] RPC 293 (the "*Raffles*" case). Mr Justice Whitford observed that if a survey is to have validity, (a) the interviewees must be selected so as to represent a relevant cross section of the public ; (b) the size must be statistically significant; (c) it must be conducted fairly; (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved; (e) the totality of the answers must be disclosed and made available to the defendant; (f) the questions must not be leading or if they are leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question never been

put; (g) the exact answers and not some abbreviated form must be recorded; (h) the instructions to the interviewers as to how to carry out the survey must be disclosed and (i) where the answers are coded for computer input, the coding instructions must be disclosed.

21) Of relevance to this case, element (b) above was further developed in *Citibank NA and Citicorp v Citybond Holdings PLC (BL O/197/06,)* (“*Citibank*”) in which the Appointed Person notes, at para 31, that no attempt was made to establish by means of expert (or any other) evidence that the survey work had provided the Registrar with a body of information from which statistically reliable conclusions could be drawn as to responses that might have been received if the same questions had been asked of a much larger survey population interviewed on a similar basis. He goes on to say, at para 34, that if the research provides no or insufficient basis for extrapolation, the individual responses could only be taken into account for what, individually, they may be worth. That may be little or nothing. In the event, the Appointed Person treats the evidence in this case as no more than fifty-nine hearsay statements taken at random.

22) In my view there are three serious flaws in these surveys. The first flaw relates to the very small size of the respective samples involved and the absence of any evidence which may render extrapolation, as per the *Citibank* case, possible. The PRO-V sample involved just 59 women in Southampton, the V-PRO survey 60 women in London. No information is provided by Procter regarding their sales turnover, marketing spend, size of the potential market or size of market share etc in relation to shampoos. Therefore there is no overall context within which to view either survey results. However, I take judicial notice of the fact that the hair product market is huge, being a market that has application to virtually the whole of the population. The numbers of respondents provide a wholly insufficient basis for extrapolation as to the level of recognition in the market as a whole. Even if the market is segmented into men’s and women’s hair products I would still say that the size of the surveys is inadequate. . Element (b) of *Raffles* is accordingly compromised.

23) Related to this, the second flaw, in both surveys, is that Procter’ s attorneys only interviewed women, whereas the average consumer for Victoria’s goods will be both male and female and all ages, not just female. Of itself, the PRO-V survey can only, at best, (which in any event is denied above in connection with the first flaw) show that recognition or reputation in the PRO-V mark is established in relation to women, albeit that they are the target audience for the product. Element (a) of the *Raffles* criteria speaks of the need for a relevant cross section of the public to be surveyed. As far as Virginia’s goods are concerned this must be assumed to be both sexes and all ages and therefore, insofar as the V-PRO survey in particular could be argued to show that the relevant consumer might confuse the two marks, or simply that PRO-V is brought to mind, plainly there is no cross section of the relevant (Virginia) public. Not only then is the small number of respondents fatal as in the first flaw, so too (and

remembering that there is no evidence by which any extrapolation could be made) is the limitation to women.

24) The third flaw, in both surveys, concerns the presentation of the respective marks to the interviewees as shown in the Annexes. Given the presentation of the 'V-PRO' mark on a container which, based on my own experience as a consumer and in Mr MacLachlan's submission, looks like a shampoo bottle, or at least a bottle containing a cosmetic product, this cannot be said to replicate or even resemble packaging encountered, if indeed there is packaging at all, *by someone purchasing Virginia's goods*. Whilst Procter's representatives seek to address this flaw by reference to similar shaped food bottles found in a supermarket, all such bottles do not contain anything resembling Virginia's goods. I do not need Mr MacLachlan's own research to make that finding. Invariably they are sauces, ketchups and goods which are generally of a consistency suitable to be squeezed out of a container similar to one containing shampoo. Whilst such products may contain fruit and vegetables such as tomato ketchup for example, they are not preserved, dried and cooked fruit and vegetables or flour and preparations made from cereals per se. As regards this flaw in relation to the PRO-V survey, one has to ask exactly what factor(s) prompt the interviewees to make the link between what they are shown on the card and the word 'PANTENE' or 'shampoo'. By showing the word PRO-V on the side of what I have already said looks like a shampoo bottle, an undoubted element of uncertainty is introduced, whereby one has to ask whether recognition of PRO-V is due to the word itself, the shape or colour of the bottle, or other material appearing on the bottle (ie the 200ml indicator or splash marks), or a combination of all factors. Thus, element (c) of the *Raffles* criteria, being the requirement for fairness, is compromised.

25) Notwithstanding the compromised nature of the surveys, my intention is to attribute to them such evidential worth as I consider appropriate within the context of my later analysis below.

Section 5(2) (b)

26) The opposition is founded upon Section 5(2)(b) of the Act. This reads:

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

(a) or

(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.”

27) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

28) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

29) With registration dates in 1992 and 1999 respectively, it is clear that within the meaning of Section 6(1) of the Act, both Procter’s marks are earlier trade marks. Further, as they both completed their registration procedures more than five years before the publication of the contested mark, they are both subject to the proof of use requirement set out in section 6A of the Act. However, as mentioned in paragraph 5 above, Virginia has not expressly put Procter to proof of their use, and nor have they denied or that use. In my view the lack of a specific denial or non-admittance of the statements of use, together with the failure of Virginia to answer the questions on the counterstatement form, mean that Procter are not required to substantiate its statements of use.

Consequently, the statements of use stand as the goods to be utilised for the purposes of this opposition. Procter has declared use on its Form TM7 for the following “*preparations for the cleaning, care and beautification of the hair; shampoos; hair lotions*”. It is thus these goods only which will form the basis of the opposition.

30) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods

31) The relevant goods for comparison are:

Virginia's goods	Procter's revised list of goods based on use
<p>Class 29</p> <p>Preserved, dried and cooked fruit and vegetables.</p> <p>Class 30</p> <p>Flour and preparations made from cereals.</p> <p>Class 31</p> <p>Agricultural, horticultural and forestry products and grains not included in other classes; fresh</p>	<p>Class 3</p> <p>Preparations for the cleaning, care and beautification of the hair; shampoos; hair lotions.</p>

fruit and vegetables, seeds, natural plants and flowers.	
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32) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

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

33) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance SA v OHIM – Johnson & Johnson (monBeBé)*).

34) Insofar as Virginia’s goods in classes 29 and 30 are concerned, such products are intended for human consumption, either in their own right or as ingredients in other products. The products in class 31 are less obviously intended for human consumption and may go into animal feed or for some other purpose. It is nevertheless important to record the specificity of the goods, as much of the evidence and submission tends to treat Virginia’s goods as food products at large, or at the least as being all the goods covered by classes 29, 30 and 31. This is plainly not the case. Nevertheless, like the wider category of goods in which they fall, the nature, function and end use of Virginia’s goods is simple – nourishment and enjoyment. They are intended for consumption (whether human or animal), and in either processed or raw form. As regards Procter’s goods, again the evidence runs the risk of regarding them as cosmetic goods at large, or as being all the goods covered by class 3. In fact, as I have already found, the use is in respect of hair products only. Such products are externally applied for the purpose of beautification and/or personal hygiene. Therefore the respective purposes are different. The evidence does not establish that the respective goods are similar in terms of their nature, method of use or that they compete with each other. In the absence of such evidence I am entitled to take a common sense approach in reaching a conclusion on similarity of goods, see eg *Rouselon Freres et Cie v Horwood Housewares Ltd* [2008] RPC 30 at para 58). Only at a very general level can any of the factors identified in *Canon* be described as suggesting similarity between the respective goods. Similarity at such a general level in relation to these factors is not sufficient for me to conclude that there is any similarity between the respective goods. It is

nevertheless my experience as a consumer that in a supermarket or larger chemist, fresh fruit and vegetables are sold along with hair products, sharing the same respective point of sales for the general public. Unsurprisingly, however, the food products are clearly separated from hair products. In tinned or processed form the products are again clearly separate from hair products which have their own discreet area of sale, usually amongst cosmetics and/or bath products.

35) At a general level there may be some fruit, vegetables and cereals containing vitamins and minerals which are claimed to be good for hair growth, lustre and so forth, but the evidence does not establish that this results in any connection between the two trades. From my own knowledge as a consumer of these common products, that producers of such products will often refer to them as having the smell of, or having been produced from the extract of a particular (usually exotic) fruit, but that does not mean that the two trades overlap in the eyes of the consumer. There is evidence of certain joint ventures, collaborations and 'brand extensions', but nothing that would specifically connect the trade in hair products to that for Virginia's food goods. The EVIAN, OLAY and CADBURY examples do not link hair products to the same goods that are of interest to Virginia. Even if there were evidence of specific connection it would have to be a connection which would resonate and be recognised by the average consumer, such that it could be said to lead to confusion. I agree also with Mr MacLachlan, in his submission in connection with Wendy Waller's evidence relating to brand extension, that the known phenomenon of supermarket own brands is not to be confused with 'brand extension'. The average consumer will be aware that many major retailer's own brands are sold side by side with known brands, and are often intended to offer cheaper alternatives, sometimes even originating from the same source. But this is not to be confused with 'brand extension', and in any event has no application in this case. Nor do I accept that the tendentious evidence of 'brand extension' establishes any material connection in the two respective trades, which is a factor in the current case.

36) I am aware that relatively recently the European Courts have developed the concept of 'complementary goods' and in that regard have held that complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, eg, CFI Case T-169/03 *SISSI ROSSI*, [2005] ECR II-685, paras 60-64). The respective goods here plainly cannot be called 'complementary' in the sense meant by the European Courts as the respective products are not indispensable or important for the use of the other. Whilst I am sure the notion of a holistic approach to health and beauty is entirely credible, as recognised by Lisa de la Plain in her witness statement, by which I mean that food in general is an essential ingredient to general well being, this far from makes the case for 'complementarity' here. Ms de la Plain's submissions that the respective goods are 'complementary' reflect a general meaning to the word 'complementarity', and not the specific meaning

attributed by the Courts. As such, the dramatic conclusion she draws from that, namely that the consumer will assume that the same manufacturer is responsible for both, is nothing more than unsubstantiated assertion on her part.

37) I have however referred in paragraph 32 above to the sale of both parties' products in a supermarket or larger, and diverse, chemists such as BOOTS or SUPERDRUG, albeit that the respective products may be sold in different areas. The fact that they are sold in different areas is relevant (see eg *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 297, where it is said:

“Turning to the present case, the two products to some extent have the same use, but broadly in practice have different uses. *They are hardly in direct competition and consumers will find them in different places in supermarkets. [my emphasis].* Their physical nature is somewhat different, the Robertson product being hardly pourable and really needing spooning out of the jar whereas the British Sugar product is meant to be poured out of the small hole in the plastic top. Moreover it seems that for the purposes of market research the two products are regarded as falling within different sectors. Taking all these things together, I think the spread is not to be regarded as *similar* to the dessert sauces and syrups of the registration. I therefore think there is no infringement”.

Taking all these points into account I find that the goods are not similar, and on the basis of that finding, using the authority of the Court of Appeal's *esure v direct line* [2008] EWCA Civ 842, would have abandoned my analysis of likelihood of confusion under section 5(2)(b) in favour of Virginia at this point. In other words, there cannot be likelihood of confusion under section 5(2)(b) where the goods are not similar. However, in case I am wrong on this point, I will continue my analysis of the other factors that constitute the global assessment of likelihood of confusion.

The average consumer

38) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. Both parties' goods can be described as ordinary consumer products and as such will share the same relevant consumer, namely the general public. However, this may not necessarily be the case for Virginia's class 31 goods being agricultural, horticultural and forestry products at large. With the exception then of these class 31 goods, the purchasing act will not be an especially considered one for either parties' goods. We are not talking about high cost items available only through intermediaries; both sets of goods are available through self service outlets at low cost.

39) I conclude that the average consumer for both sets of relevant goods, excluding Virginia's class 31 goods, will be the general public, who will be

reasonably, but not excessively circumspect. The breadth of the class 31 goods may also involve trade purchasers and for that reason I have refrained from saying that the average consumer will solely be the general public for these goods. That said, I have no evidence or specific submission on the matter, that is, either that the average consumer is someone other than the general public for the class 31 goods. Nonetheless, it is a factor which I shall bear in mind in my overall conclusion on likelihood of confusion.

Comparison of marks

40) I will now go on to consider the similarities and differences between the trade marks themselves and the impact of any differences upon the global assessment of similarity. When assessing this factor, I must do so by reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*, para 23). The trade marks to be compared are:

Procter’s trade marks	Virginia’s trade mark
PRO-V	V-PRO

41) Firstly, I will consider the visual similarities between the respective trade marks. Visually both marks are the same (short) length and both contain the same single letter ‘V,’ and the three letter ‘PRO’ element linked by a hyphen. The respective marks differ in that one begins with ‘PRO’ and ends with ‘V’, and the other is the reverse, namely it begins with the letter ‘V’ and ends with ‘PRO’. Taking into account these observations, visually, there is a relatively high level of similarity as the marks are the same length with the same elements, albeit reversed. Secondly, in terms of aural similarity, the elements are likely to be separated in aural use and pronounced thus, “pro-vee” and “vee-pro” respectively. Aurally, I regard the marks as being reasonably similar, particularly as the ‘PRO’ element is likely to dominate in speech.

42) Conceptually, I have already found in paragraph 36 that ‘PRO-V’ as a totality, may convey a number of possible meanings, which are allusive and uncertain. For some there may be no meaning at all. The effect of reversing the elements ‘V’ and ‘PRO’ in relation to Virginia’s goods means that, in trying to make some linguistic sense of the word, the average consumer will render the ‘PRO’ element as qualified by the ‘V’. But that is as far as it goes; the *totality* of the mark ‘V-PRO’ will convey no clear and obvious meaning in relation to Virginia’s food products either. With neither mark conveying any single, clear and obvious meaning in connection with the goods in relation to which it may be used, I find, contrary to Procter’s submissions on the matter, that conceptually the marks are neither similar nor dissimilar.

Use and distinctive character of the earlier trade mark

43) I have to consider whether the opponent's trade mark has a particularly distinctive character either arising from the inherent characteristics of the trade mark or because of the use made of it.

44) The effect of recognition (arising through use) on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

45) There is some debate in the evidence as to the distinctiveness of Procter's 'PRO-V' mark. Mr MacLachlan for Virginia says that based on usage by other manufacturers of terms such as "PRO VITAMIN" and "PRO VITAMIN B5" the mark 'PRO-V' is plainly not highly distinctive as it would be simply seen by the consumer as a contraction of the longer term. This is not necessarily the case for all consumers, and there is no evidence to support that view. Mr MacLachlan exhibits other manufacturers use of the term 'PRO VITAMIN B5' (exhibit NM3 to his witness statement of 16th April 2008), and also internet hits on a search on 'PRO VITAMIN B5 (exhibit NM4 to his witness statement of 16th April 2008) but this evidence cannot be said to prove that consumers will inevitably see 'PRO-V' as a contraction of the descriptive term 'PRO VITAMIN B5'. I therefore believe Procter's mark to be averagely inherently distinctive in relation to all the goods for which use is claimed by Procter. But as the case law quoted above requires, I

need also to factor into the distinctiveness assessment the question whether recognition through use has contributed to distinctiveness, or capacity to distinguish. Significantly, no-one from Procter itself has given evidence in the case and so there are no facts provided which would tell me how long the PRO-V has been used, what kind of market share it has attracted, any advertising spend and geographical spread. Ordinarily, such a void would seriously undermine, if not condemn entirely, a person who may be relying upon a mark's enhanced capacity to distinguish through use. But in this case, and as I have pointed out, flawed though it may be, I will assess what weight I consider appropriate to the survey evidence.

46) In particular, can the PRO-V survey be said to give rise to a claim for enhanced distinctiveness by virtue of the use made of PRO-V ? I have already concluded that the surveys are flawed against the *Raffles* criteria. On that basis I cannot accept that either survey provides any basis for conferring an enhanced capacity to distinguish on the PRO-V mark. I would add that, even if I were to have concluded that an enhanced capacity to distinguish through use had been established it would not have affected my overall conclusion under section 5(2).

47) I do nevertheless accept that PRO-V has inherent distinctiveness. Whilst I have rejected the submission by Mr MacLachlan that 'PRO' will necessarily be seen as part of the descriptive term 'PRO-VITAMIN', it is possible that some consumers may make that link. It is nevertheless also possible that the suffix 'PRO' in the context of hair products, may convey or allude to a number of other possible meanings for the average consumer. I notice for example that exhibit NM3 to Mr MacLachlan's witness statement of 16th April 2008 shows the words "Used by Professionals" on a bottle of TRESEMME conditioner. 'PRO' is a known shortening of the word 'professional', and thus it is not beyond the realms of possibility that the suffix 'PRO' may be seen by the consumer as some reference to the word 'professional'. But when combined with the other element, the single letter 'V', the possible meanings that 'PRO' may have had will become, at best, vaguely allusive and uncertain. No single, possible, meaning will predominate. I would concede that for some even, the word 'PRO-V' may have no meaning at all. But the very existence of possible meanings, albeit that they may be vague and uncertain, lead me to conclude that 'PRO-V' is not at the highest level of inherent distinctiveness, which would apply, for example, to invented words which have no clear derivation or relationship with qualities of the goods or service. Nevertheless, I find that PRO-V is averagely inherently distinctive for the goods. This is but one factor in the overall mix of likelihood of confusion.

Likelihood of confusion

48) In accordance with the case law I must now bring my findings together in an overall evaluation of likelihood of confusion.

49) The assessment of likelihood of confusion must be taken having regard , in particular, to the fact that the average relevant consumer does not generally analyse marks to the extent required of me, and the fact that the consumer may well retain only an imperfect recollection of the respective marks in the market place. Moreover, the nature of the purchasing process is not, in this case, an especially considered one. I must also take into account especially the level of distinctive character of the earlier mark. In balancing all factors, and in particular giving due recognition to the visual, aural and conceptual similarities and considering the level of similarity in relation to the respective goods, **I find, in connection with Virginia's goods in classes 29 and 30, that the relevant public will not confuse the trade marks, or be led into believing that the respective goods originate from the same source. There will be even less prospect of confusion in relation to Virginia's class 31 goods, insofar as the average consumer may be the trade rather than the general public. Adopting the global approach advocated by case law, I find that there is no likelihood of confusion under section 5(2)(b).**

Section 5(3)

50) Section 5(3) of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

51) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd (Davidoff)*

[2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01) .

52) The applicable legal principles arising from these cases are as follows.

a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122).

b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign, *Adidas Salomon v Fitnessworld ('Adidas')*, paragraphs 29-30.

c) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).

d) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

53) To these I would also add the following legal principles that have arisen from the recent ECJ Judgment in *Intel Corporation Inc. v CPM United Kingdom Ltd ('INTEL')* C-252/07:

a) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier trade mark with a reputation and the later trade mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

b) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting trade marks, within the meaning of *Adidas-Salomon and Adidas Benelux*.

c) Whether use of the later trade mark takes or would take unfair advantage of, or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

Reputation

54) The starting point then is whether the PRO-V mark has a ‘reputation’ in the UK, that is to say that, in accordance with the *CHEVY* case, it is known by a *significant* part of the public concerned with the products or services covered by the PRO-V trade mark and for which, in this case, use is claimed. Without such a reputation, the section 5(3) claim falls at the first hurdle. In my analysis under section 5(2), I found that, given the flawed nature of the surveys, I could not factor in an enhanced capacity to distinguish by virtue of use. If I was unable to do that under section 5(2) I am also reluctant to find that PRO-V has a reputation under section 5(3). The *CHEVY* case, at paragraph 27, states that the relevant facts to be taken into account for assessing a reputation are: “in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it”. The ECJ were not necessarily intending to be prescriptive, or to rule out the possibility that a tribunal could take into account other alternative or supplementary evidence, such as surveys, which may also establish reputation. That said, in this case, the total absence of contextual evidence and evidence by which any extrapolation of the samples could fairly be assumed renders the case for reputation under section 5(3) fatally compromised. This, combined with the skewed nature of the presentation of the PRO-V mark renders a finding on reputation impossible. **I find that there is no reputation established under section 5(3).**

55) In case I am wrong on this finding and that the surveys, with all their inherent flaws and without any contextual evidence, it may nevertheless be said that Procter has established reputation in the PRO-V mark, I will continue the analysis under section 5(3). This may appear a pointless exercise in the light of my overall view of the survey evidence but it recognises that Procter can point to at least 50% of women interviewed for the PRO-V survey linking what they are shown to ‘PANTENE’. Whilst I maintain that the survey is flawed in the ways discussed, I am nevertheless prepared to undertake, on a contingent basis, the next step in the analysis.

The ‘link’

56) According to the *Adidas* and *Intel* cases the existence of a ‘link’ between the respective marks is a prerequisite for the required detriment or unfair advantage to be established. Paragraphs 41 and 42 of the *Intel* case read as follows:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas*

Benelux, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

I intend to follow this guidance for the purposes of establishing whether or not there is a required link in this case.

57) It is also plain from the *Adidas* and *Intel* cases that the nature of the ‘link’ under section 5(3) includes, but also goes beyond, ‘likelihood of confusion’ (paragraphs 57 – 60 of *Intel*). Thus, it suffices if the later mark simply “calls the earlier mark to mind” (see paragraph 60 of *Intel*).

58) Turning then to the factors identified in *Intel* as going into the ‘global assessment’, and recognising that the ECJ were not necessarily producing an exhaustive list, I will nevertheless use the list as my template. As regards the degree of similarity between the conflicting marks, plainly the marks are not identical. I have already found a reasonably high level of visual similarity, a reasonable level of aural similarity, and made a finding that the marks are not conceptually similar or dissimilar. These are findings which I shall, in due course, factor into the global assessment.

59) In relation to the nature of the goods and services and their degree of closeness or dissimilarity, I have found that the respective goods are not similar. But for the fact that the respective goods share the same trade channels in relation to ‘end of the chain retailers’, such as supermarkets or larger chemists, I would not have undertaken a full section 5(2) analysis.

60) I appreciate that a significant part of Procter’s evidence has endeavoured to alert me to the concept of brand extension, whereby brand owners extend the usage of normally well - known brands into related, sometimes unrelated, fields. Submissions on behalf of Procter also draw my attention to the *CFI case T-93/06*

Muhlens GmbH & Co KG v OHIM regarding similarity between goods in class 3 and 32, where it is stated at paragraph 42 that:

“thermal waters, cosmetic products, soaps and essential oils can be used together for skin and beauty treatments. In addition, mineral waters and mineral salts can be used in the production of soaps, other cosmetic products and preparations for the hair. Furthermore, mineral water operators sometimes sell cosmetic products comprising mineral water”.

The last sentence echoes the EVIAN example, reference to which is made in Procter’s evidence. Such cases cannot however be said to constitute ‘rules’ of general application, still less, legal principles. I would simply observe that in the case of mineral water, given the nature of that product, use of a well- known and distinctive brand in the realm of, eg moisturisers or as an ingredient of some other cosmetic product may well have some resonance with the consumer as a natural extension. The case before me concerns, specifically, hair products and fruit, vegetables, flour and cereals. I do not believe that there is any natural extension here in relation to the respective products and that view has not been displaced by the evidence of other joint ventures and collaborations. I would just add that, by their very nature, it is highly improbable that manufacturers looking to collaborate, or simply to extend their own ranges, would use marks which are not the same as the established mark. To do so would be to jeopardise the very advantage that they seek.

61) The relevant public for both sets of goods as registered, or applied for, with the exception of Virginia’s class 31 goods, will be drawn from the general public. On the one hand there will be purchasers of shampoos and conditioners and on the other, purchasers of fruit, vegetables, flour and cereals. Being drawn from the same source there will undoubtedly be overlap in relation to the relevant public for both sets of goods.

62) As regards the degree of distinctive character in the earlier mark, I have found PRO-V to be averagely inherently distinctive. I made such a finding on the basis that, unlike a completely invented word having no conceivable connection with the relevant goods or services, PRO-V may allude to characteristics of the products. The fact that such allusions exist albeit that they may be different to different people, ie for some it could be referring to, eg vitamins, and to others that the products are ‘professional’ and for others some other meaning, renders the mark averagely, rather than highly distinctive.

63) In relation to the strength of PRO-V’s reputation, I have already concluded that Procter’s evidence is insufficient to establish any reputation. If, for the purposes of the analysis of the existence of the necessary ‘link’ I accept that a reputation exists, I would conclude that the existence of such would not affect my findings regarding the existence of a link.

64) Finally, in relation to likelihood of confusion I have already found that this does not arise in this case.

65) Taking these factors into account, **I find that there will be no 'link' made by the average consumer in this case.** The factors that weigh most heavily with me in drawing that conclusion are that the respective goods are, but for their coincidence in supermarkets and chemists, dissimilar. The marks are not identical and cannot be said to be conceptually similar or dissimilar, and that Procter has failed to demonstrate any reputation in PRO-V.

66) The finding of absence of a 'link' also ends the matter, and I need not go further (see paragraph 31 of the *INTEL* case).

67) The ground of opposition under section 5(3) has therefore failed.

Conclusion

68) The opposition to the application has failed in its entirety.

Costs

69) Both parties seek an award of costs. As the applicant has been successful I award them a total of £2,000. The total is made up as follows:

Considering the statement of case and preparing counterstatement- £500

Filing evidence- £800

Considering opponent's evidence - £ 400

Preparation of submissions – £ 300

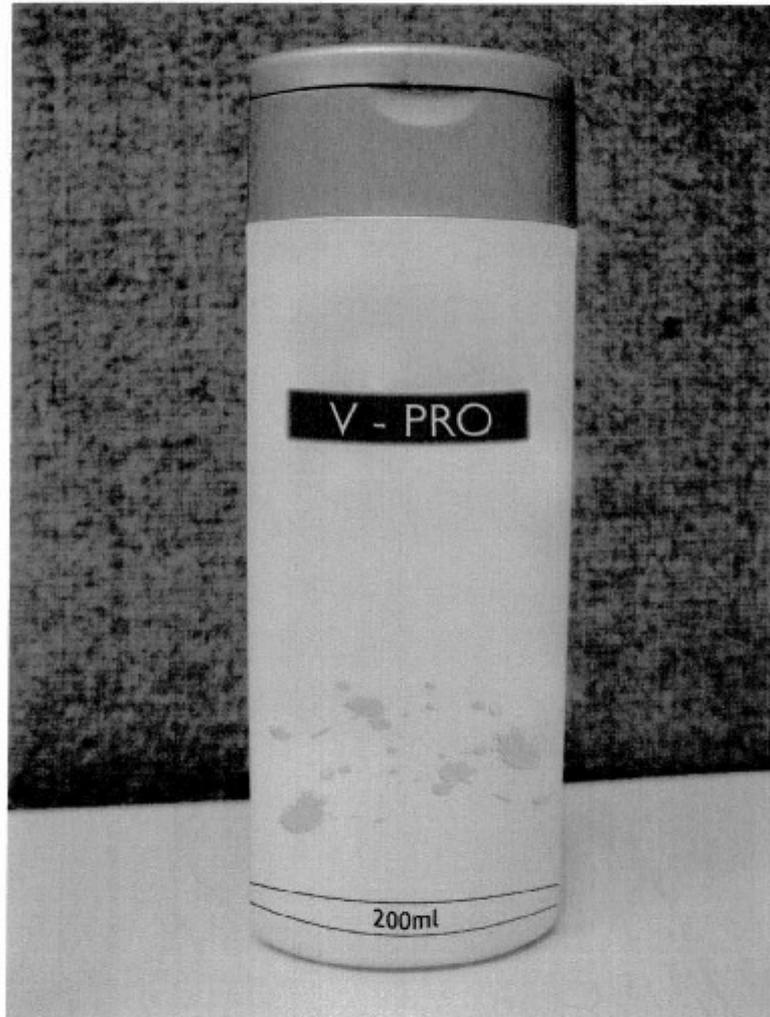
Total £2,000

70) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 16th day of April 2009

**Edward Smith
For the registrar,
the Comptroller General**

Annex A



Annex B

