

O-151-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2461071  
BY TETLEY GB LIMITED TO REGISTER A  
TRADE MARK IN CLASS 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 95808 BY SOCIÉTÉ DES PRODUITS NESTLÉ S.A.**

## BACKGROUND

1. On 11 July 2007, Tetley GB Limited (Tetley) applied to register the trade mark **VITAX** for a specification of goods in class 30 which reads:

“Tea; tea bags; loose tea; herbal teas; fruit teas; fruit flavoured teas; infusions; tea extracts and essences; tea products; ready to drink tea products; preparations made from or containing tea; tea substitutes; tea-based beverages; iced tea.”

Following examination, the application was accepted and published for opposition purposes on 28 September 2007 in Trade Marks Journal No.6703.

2. On 21 December 2007, Société des Produits Nestlé S.A. (Nestlé) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act), directed against all of the goods contained in the application. Nestlé indicate that their opposition is based upon the following trade mark:

| Trade Mark | No.     | Application Date  | Protection conferred | Goods in Class 30   |
|------------|---------|---|----------------------|---|
| VITAO      | M909270 | 7.12.06<br>(Priority from 7.7.06 claimed from Switzerland). | 29.1.2010            | Although also registered in class 32, the registration includes the following goods in class 30: Coffee, tea, cocoa, sugar; rice, tapioca, sago, artificial coffee, flours and cereal preparations; bread, pastry and bakery products; edible ices; honey; molasses, yeast; baking powder; salt; mustard, vinegar; sauces (condiments); spices; ices for refreshment. |

3. On 3 April 2008, Tetley filed a counterstatement. At the point in time at which Tetley’s counterstatement was filed, Nestlé’s trade mark was still at the application stage. However, I note that in their counterstatement Tetley said of the goods at issue in these proceedings:

“3. However, if the Opponent’s mark survives....and is registered for all goods covered by the application, then the Applicant admits that the goods covered by the application in suit are identical and or similar to “tea” as covered by the Opponent’s mark.”

4. Insofar as the respective trade marks are concerned, Tetley deny they are similar. They say:

“4.1 The Opponent’s mark is VITAO written in a stylised font. By filing its application for a stylised mark, the Opponent does not claim protection for the plain word VITAO.

4.2 The context to the comparison of the marks is that the VITA- prefix is extremely common in Class 30 for beverages such as tea. Indeed, a database search of the UK/CTM/Madrid (UK) registers for VITA- prefixed marks achieved 95 hits for registrations covering tea. A similar search across all products in Class 30 achieved a “hit count” of just over 360.

4.3 This result is not surprising. VITA- is an obvious allusion to “vitality” (with its positive health implications, etc). It is in common use in relation to products and is self-evidently a very weak prefix, as is evidenced by the trade mark searches...

4.4. In [relation to other opposition proceedings] the current opponent stated in its counterstatement that its mark would be regarded as VITA-O. In saying this the Opponent has effectively admitted that what we have here is a comparison of VITA-prefixed marks.

4.5 In view of the weakness of the prefix it is clear that greater attention has to be paid to the suffix.

4.6 Bearing in mind the weakness of the VITA- prefix and considering the marks as a whole, on a visual, phonetic and conceptual comparison using *Sabel v Puma* criteria, there are clear differences between the marks. The Opponent’s mark may be pronounced either as VI-TOW or VITA-O. The Applicant’s mark can only be pronounced VI-TAX. In the Opponent’s mark, the vowel sound is either “ow” or a long “a” as in “cake”. There is a clear distinction between these sounds and the pronunciation of the suffix in the Applicant’s mark, where the “a” is pronounced as a short vowel (as in “cat”).

4.7 The only possible conceptual similarity lies in the VITA- prefix alluding to vitality, but as explained above, this element is commonplace, so there will be an emphasis on the totality. In their totality, beyond the allusion to vitality, there is no conceptual similarity. Neither VITAO nor VITAX has any meaning.

4.8 Because of the obvious phonetic difference between the marks, the visual impressions created by the marks are also different. The relevant consumer is an English speaking consumer. Because consumers are conditioned by language to regard words in the way that they would be pronounced, the differences in pronunciation between the suffixes, as mentioned above, would influence how the marks are perceived visually. Thus consumers would recognise both marks as having an allusive quality due to the obvious links with the word “vitality” because of the prefix, but would concentrate on the very different impression of the marks as a whole.”

5. While only Tetley filed evidence in the proceedings, both parties filed written submissions at both the evidential stages and in lieu of a hearing. I will refer to these written submissions as necessary below. After a careful consideration of all the material before me, I give this decision.

## **EVIDENCE**

### **Tetley's evidence**

6. This consists of a witness statement, dated 22 January 2009, from Roberto Calamita who is a patent and trade mark attorney at Frank B Dehn & Co, Tetley's professional representatives in these proceedings. Attached to Mr Calamita's statement are four exhibits:

RC1 – consists of the results of database searches of the UK/CTM and Madrid (UK) registers conducted on 31 March 2008 for VITA- prefixed trade marks whose specifications include tea;

RC2 – consists of full case details for all the trade marks revealed by the database searches mentioned in exhibit RC1;

RC3 – consists of an extract taken from the counterstatement filed by Nestlé in opposition proceedings No. 71480 (which concerned an opposition to Nestlé's VITAO trade mark by DS Crawford Belgium BV on the basis of their earlier trade mark TAO in class 32);

RC4 – consist of an extract taken from Chambers Dictionary which includes references to, inter alia, vita (as a noun meaning life), and to words such as vital and vitality.

7. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

8. The opposition is based solely upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. 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) or 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings Nestlé is relying on the registered trade mark shown in paragraph 2 above which has an application date prior to that of the application for registration; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 28 September 2007 and protection was conferred on Nestlé earlier trade mark on 29 January 2010. As Nestlé’s earlier trade mark had not been registered for five years at the point at which Tetley’s application was published, it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Section 5(2)(b) – case law**

11. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* paragraph 27;

- (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*, paragraph 23;
- (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*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) 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*, paragraph 17;
- (h) 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*, paragraph 24;
- (i) 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*, paragraph 26;
- (j) 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 + Adidas Benelux BV*, paragraph 41;
- (k) 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*, paragraph 29.

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

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In reaching a conclusion on this point, I must proceed on the basis that the respective parties' trade marks will be used on all the goods for which they have either been applied or are registered.

13. The goods at issue in these proceedings are either tea or products in which tea is the key ingredient. **These are everyday consumer items and the sort of products which will be bought by the general public; they then are the average consumer for such goods.** In their written submissions dated 16 September 2008 Nestlé say:

“10. Looking at the goods in hand, they are likely to be placed on a shelf and/or in a chiller cabinet and they will be available for self selection by the consumer. Therefore, the visual similarities between the marks should be of primary importance.....The goods in question are everyday consumer items. Considering the likely price of that type of goods, consumers are unlikely to spend a long time deciding on their purchase.”

14. I note that in their written submissions dated 14 April 2010 Tetley say:

“8. Tea is not a “moron in a hurry” product. The United Kingdom is one of the prime, if not the prime, tea drinking nations in the world...”

15. Generally speaking, tea and tea products are inexpensive items which are likely to be purchased by the average consumer on a fairly regular basis. **I agree with Nestlé that the purchasing process is likely to consist primarily of self selection in a retail environment such as a supermarket and that in those circumstances the purchasing process is likely, for the most part, to be predominantly a visual one.** While I accept that the cost of the goods in issue is relatively low and this will impact on the average consumer’s level of attention, my own experience suggests that insofar as tea and tea products are concerned, some average consumers are likely to know what type and brand of tea etc. they prefer and are, as a result, likely to display a degree of brand loyalty when making their selection. In those particular circumstances the average consumer’s level of attention is likely to be increased somewhat. However, when considered overall, **Nestlé’s categorisation of the average consumer’s level of attention as “unlikely to spend a long time” is, I agree, appropriate (or to put it another way is likely to be at a relatively low level)**; this is of course also likely to increase the effects of imperfect recollection.

### Comparison of goods

16. The goods to be compared are as follows:

| Tetley’s goods  | Nestlé’s goods in Class 30   |
|---|--|
| Tea; tea bags; loose tea; herbal teas; fruit teas; fruit flavoured teas; infusions; tea extracts and essences; tea products; ready to drink tea products; preparations made from or containing tea; tea substitutes; tea-based beverages; iced tea. | Coffee, tea, cocoa, sugar; rice, tapioca, sago, artificial coffee, flours and cereal preparations; bread, pastry and bakery products; edible ices; honey; molasses, yeast; baking powder; salt; mustard, vinegar; sauces (condiments); spices; ices for refreshment. |

17. Tetley commented on the respective goods at issue in their counterstatement (see paragraph 3 above). I also note that in their written submissions dated 14 April 2010 Tetley say:

“The Applicant’s mark covers tea, tea-products and infusions. The Opponent’s registration covers tea, so in that regard the goods are identical.”

This is a sensible concession. As all of Tetley’s goods are encompassed by the goods contained in Nestlé’s earlier trade mark in class 30 (specifically tea), **the respective goods are therefore identical.**

### **Comparison of trade marks**

18. For the sake of convenience, the trade marks to be compared are as follows:

| <b>Tetley’s trade mark</b> | <b>Nestlé’s trade mark</b> |
|----------------------------|----------------------------|
| <b>VITAX</b>               | <b>VITAO</b>               |

19. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant, but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and with that conclusion in mind, I must, as the case law dictates, then go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

20. Given the manner in which the competing trade marks are presented, neither can be said, in my view, to contain a distinctive or dominant element. **Rather, the distinctiveness of each trade mark resides in its totality.**

### **Visual similarity**

21. Tetley’s trade mark consists of the five letter word VITAX presented in upper case; Nestlé’s VITAO trade mark also consists of a five letter word presented in upper case; the trade marks differ only in respect of their final letter. In their counterstatement Tetley said:

“4.1 The Opponent’s mark is VITAO written in a stylised font. By filing its application for a stylised mark, the Opponent does not claim protection for the plain word VITAO.”

22. In their written submissions dated 16 September 2008 Nestlé say:

“5). Contrary to what the Applicant says in paragraph 4.1 of the Counter Statement, the Earlier Mark is for the word VITAO in standard font. It is not a stylised mark.”

23. A review of the appropriate databases within the Trade Marks Registry indicates that Nestlé’s VITAO trade mark is classified as “Word Only” i.e. it is not considered to have any degree of stylisation. Even if that is wrong (which I have no reason to believe is the case), any stylisation that may be present in Nestlé’s trade mark is so insignificant as to be irrelevant. Consequently, Nestlé’s trade mark must be treated as a five letter non-stylised word presented in upper case. In each trade mark the first four letters i.e. V-I-T-A are identical. In their written submissions dated 16 September 2008 Nestlé say:

“9. Both marks consist of 5 letters the first four of which are identical. Visually, the marks are therefore closely similar.”

24. In their written submissions dated 22 January 2009 Tetley say:

“2. ....the Opponent has taken an overly simplistic approach to the comparison of marks by counting the number of letters and concluding that, because each mark shares the same first four letters and differs in the last letter, the marks are confusingly similar.”

25. Both trade marks consist of five letters the first four of which are identical. I note that in *Inter-Ikea Systems BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-112/06*, the Court of First Instance (now the General Court) said at paragraph 54:

“As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO) [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.”

26. I note that in that case the GC characterised the degree of visual similarity between the word only trade mark “IKEA” and the word element of the contested trade mark “idea” as low. Notwithstanding that conclusion and the visual differences between the letters X and O, there remains, in my view, **a reasonable degree of visual similarity between the respective trade marks.**

## **Aural similarity**

27. This aspect of the comparison has been the issue of much debate in the written submissions. In their counterstatement and written submissions Tetley suggest that their trade mark will be pronounced as a two syllable word i.e. VI-TAX (where the “a” will be pronounced as a short vowel as in “cat”), whereas Nestlé’s trade mark may be pronounced as either a two syllable word i.e. VI-TOW or as a three syllable word i.e. VI – TAY-O. They say that in the first example there is no “a” sound at all and in the second example the “a” would be pronounced as a long sound as in “cake.” In their written submissions dated 14 April 2010 Tetley add:

“5. Furthermore, TAX is a strong sound with the X being prominent and not susceptible to being swallowed by the speaker. Consumers would perceive a marked difference between the marks; the words are very different and unlikely to be confused even allowing for the tendency of slurring words and swallowing word endings.”

28. In their written submissions dated 14 April 2010 Nestlé say:

“12. The Applicant’s mark is comprised of two syllables. Phonetically, the mark could be pronounced as either VI-TAX or VIT-AX.

13. The Opponent’s mark is also comprised of two syllables. Phonetically, the mark would be pronounced as VI-TAOW. We submit that consumers would not ordinarily pronounce the letter O in the Opponent’s mark. As such, in pronunciation the second syllable of the Opponent’s mark becomes noticeably shorter VI-TAW which, in our submission, renders the second syllable closer in sound to -TAX.

14. It is, in our submission, quite unnatural for the average consumer of the goods in question to pronounce the Opponent’s mark as VITA-O and more likely that the mark would be pronounced as VI-TAW.

15. We also reiterate that, in pronunciation, both marks place an emphasis of the final “a” vowel. Although the final vowel sound in the Opponent’s mark may arguably be longer than in the Applicant’s mark, this does not detract from the fact that both marks emphasise the same final vowel sound.

16. Even if the syllables TAX and TAO were phonetically different (which we do not admit) it is established law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

29. No evidence has been provided as to how the average consumer is likely to pronounce either trade mark. That said, I note that the parties agree that Tetley’s trade mark consists of a two syllable word which may be pronounced either as VI-TAX (or as Nestlé suggest VIT-AX). Insofar as Nestlé’s trade mark is concerned, Tetley suggest it

will be pronounced as either the two syllable word VI-TOW or the three syllable word VIT-TAY-O, whereas Nestlé suggest their trade mark will be pronounced as the two syllable word VI-TAW.

30. I agree that Tetley's trade mark consists of two syllables which is most likely to be pronounced as VI-TAX. Whilst the pronunciation of Nestlé's trade mark is to my mind far less certain, the most likely pronunciations are, in my view, as a two syllable word i.e. VI-TOW or VI-TAO or as a three syllable word i.e. VI-TAY-O. In short, while VI-TAX shares more phonetic similarity to VI-TOW and VI-TAO than it does to VI-TAY-O, there is still, in my view, a reasonable degree of phonetic similarity between all the possibilities, particularly when (as Nestlé point out) one considers the effects of "imperfections in pronunciation" and to which I would add the vagaries of regional accents. That said, it appears to me that Nestlé acknowledge that this aspect of the comparison is perhaps not their strongest point, when they say in their written submission of 16 September 2008 that:

"9. ...there is a degree of phonetic similarity."

**31. In summary, although to varying degrees, overall I consider there to be a reasonable degree of phonetic similarity between all the phonetic variations I have identified.**

### **Conceptual similarity**

32. In their written submissions of 16 September 2008 Nestlé say:

"9. Conceptually, both marks are invented words and, on that basis, there is no obvious point of conceptual comparison."

33. However in their written submissions of 22 June 2009 they say:

"7. Conceptually, both marks are invented words which include the letter sequence VITA. There is therefore some conceptual similarity between the marks."

34. In their counterstatement Tetley say:

"4.7 The only possible conceptual similarity lies in the VITA- prefix alluding to vitality, but as explained above, this element is commonplace, so there will be an emphasis on the totality. In their totality, beyond the allusion to vitality, there is no conceptual similarity. Neither VITAO nor VITAX has any meaning."

And in their written submissions of 22 January 2009 Tetley say the respective trade marks have:

"10...no conceptual meaning so cannot be regarded as conceptually similar."

35. Here I find myself in agreement with Nestlé's original position and Tetley's comments in their written submissions of 22 January. **In my view, as both trade marks consist of invented words the conceptual position is neutral i.e. there is neither conceptual similarity nor conceptual dissonance.**

#### **Distinctive character of Nestlé's earlier trade mark**

36. I must now assess the distinctive character of Nestlé's earlier trade mark. I note that in their written submissions of 14 April 2010 Tetley say:

"It is also noted that in entering the evidential stage the Opponent has filed no evidence at all....The Opponent has not established any enhanced distinctiveness of its mark through use.

37. That is of course correct. As Nestlé have not provided any evidence of the use they may have made of their trade mark, I have only the inherent characteristics to consider. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. In their written submissions of 14 April 2010 Tetley say:

"2. The word VITA, commonly used as a prefix, means "life" in Latin and is an obvious allusion to "vitality". Exhibits RC1 and RC2 clearly show the overwhelming popularity of the VITA- prefix in relation to class 29 and 30 products in the UK. This is not a case where there are a couple of VITA- prefixed marks; there are a large number. Very many of these explicitly cover tea. It is submitted that that fact gives good support to the contention that that the VITA- prefix is weak in the context of class 30 products, especially tea. Given the preponderance of VITA- prefixed marks registered in class 30 in relation to beverages such as tea, the Opponent cannot reasonably claim monopolistic rights over the prefix VITA. In that context, the protection afforded to the Opponent's mark should be construed narrowly."

39. In their written submissions of 14 April 2010 Nestlé say:

"20. Applicant's statement that VITA is non-distinctive and would be known to the average consumer of the goods in question is not supported by evidence. Therefore, it cannot be presumed that the average consumer of the goods in

question would be familiar with the Latin word VITA as holding a specific/concrete meaning or being considered commonplace by consumers.

24. The state of the register evidence filed by the Applicant in the form of trade mark database extracts identifying marks incorporating the element VITA is irrelevant for the purposes of considering the issue of confusing similarity and we ask for them to be disregarded. “

40. I note that in paragraph 24 Nestlé refer to the decision of Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the “Treat” case) [1996] RPC 281. This is, I assume, a reference to the following quotation:

“It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. [MADAME Trade Mark](#) and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

41. Nestlé go on to say:

“25. In particular, such material might not reflect the commercial realities of the market concerned, does not identify the specific circumstances which led to the marks being put on the register or confirm that any of the marks cited are used in trade. Presumably, if VITA was commonly used in relation to the relevant goods in issue (as claimed by the Applicant), evidence of this would be available. No such evidence has been submitted by the Applicant.

26. In any event, many of the marks reproduced in the database extract submitted as evidence by the Applicant are not on all fours with the marks at issue. In particular many of the marks relied upon by the Applicant contain additional matter that distinguishes these marks from the marks in issue.”

42. Although not referred to by either party to these proceedings, the decision of Mr Daniel Alexander QC sitting as a Deputy High Court Judge in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24 is of assistance. In that case Mr Alexander had to consider, inter alia, state-of-the-register evidence relating to the strength (or otherwise) of the prefix DIGI in the context of goods which have a digital or computer related element. Having reproduced the extract from *British Sugar* mentioned above, Mr Alexander went on to say:

“63 That was said in the context of a case where absolute grounds were relied on as the basis for refusing registration. However, in the present case, this material is not relied on in support of an argument that a mark which shares characteristics with those already registered should, for that reason, also be registered: the register is not relied on for its precedent value, in my judgment, rightly so. The register is not in this case deployed to show actual use of the marks recorded there either: for that purpose too, it would be of limited, if any,

evidential value. Instead, the register is relied upon to show that, as a matter of fact, a significant number of traders have expressed the intention of using (and *may* be using) the prefix DIGI- as part of a mark in relation to class 9 goods which (one is invited to infer, in the absence of detailed specifications) involve a digital or computer-related element. It does not seem to me to be illegitimate, as a matter of principle, to deploy material of this kind for that limited purpose and, for that purpose, it is of some value as part of a larger body of material.

64 The material relied on is at exhibit PJC2 to Mr Charlton's statement. It shows a large number of marks registered or applied for in class 9 by a large number of different undertakings, which have DIGI- as a prefix. Some, it is true, are for DIGITAL or variants. But a large number are not. They are for marks employing a DIGI- prefix. They include marks such as DIGIANSWER, DIGIBAR, DIGIBET, DIGIBLADE, DIGIBOOK, DIGIBOX, DIGIUS, DIGICALL, DIGICAM, DIGICARD, DIGICARE, DIGICASH, DIGICAST, DIGICAT and so on. The number of such marks is striking.

65 It is, in my judgment, to be inferred that the reason that the prefix DIGI- is intended to be used (as these registrations or applications demonstrate) in at least a significant proportion of those marks is so as to indicate that the product or service is or involves digital apparatus, computers or software and that, to a large number of traders, that is what it means. That seems the most logical explanation for (a) the number and (b) the diversity of such marks. This provides further support for the proposition that DIGI-used as a prefix has a limited capacity as such to distinguish goods or services of one undertaking from those of another when used in relation to goods or services involving digital apparatus, computers or software and is common to this general trade.”

43. The extract from Chambers Dictionary provided as exhibit RC4 in which VITA is defined as a noun meaning “life”, combined with the large number of trade marks (provided as exhibit RC2) which contain this element for, inter alia, goods in class 30 (and in particular those for tea) suggests to me that VITA is a word in which many traders appear to have a commercial interest. If that is right, it is likely to have a somewhat limited distinctive character in its own right.

44. However, I am not considering VITA alone, I am considering the trade mark VITAO. While this trade mark undeniably contains the letters V-I-T-A, the presentation of the trade mark does not isolate or accentuate these letters in any way. As the case law indicates, the average consumer views trade marks as a whole and does not pause to analyse their details. As such, I can see no reason why Nestlé’s trade mark would be “unpacked” by the average consumer to reveal the meaning for which Tetley argue. Rather the average consumer would, as I mentioned above, consider the trade mark as an invented word conveying no conceptual meaning. **In those circumstances, Nestlé’s VITAO trade mark is, in my view, possessed of a high level of inherent distinctive character.**

## **Likelihood of confusion**

45. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of Nestlé's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have retained in their mind.

46. In summary, I have concluded that:

- (i) the respective goods at issue are identical;
- (ii) the average consumer is a member of the general public;
- (iii) given the nature of the goods at issue the visual aspect of the comparison is likely to be the most important;
- (iv) the average consumer is likely to pay a relatively low level of attention to the selection of the goods;
- (v) that neither parties' trade marks have a distinctive or dominant element, the distinctiveness residing in the totality of the respective trade marks;
- (vi) there is a reasonable degree of both visual and aural similarity between the respective trade marks;
- (vii) the respective trade marks are neither conceptually similar nor dissonant;
- (viii) Nestlé's earlier trade mark is possessed of a high level of inherent distinctive character.

47. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the goods would be assumed to come from economically linked undertakings) is likely to occur.

48. I have found that the respective goods at issue are identical and that there is, *inter alia*, a reasonable level of visual similarity between the respective trade marks. Keeping in mind the nature of the purchasing process (which in my view is likely to consist predominantly of a visual act), that the average consumer is likely to pay a relatively low

level of attention when purchasing the goods at issue (which in turn is likely to make them more susceptible to the effects of imperfect recollection), together with the high level of inherent distinctive character Nestlé's trade mark possess results, in my view, in a likelihood of confusion. This confusion is, I think, more likely to take the form of direct confusion i.e. where the average consumer simply mistakes Tetley's VITAX trade mark for the VITAO trade mark of Nestlé.

**49. In summary, the opposition has been successful and the application is refused in its entirety.**

### **Costs**

50. As Nestlé have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Nestlé on the following basis:

|   |              |
|---|--------------|
| Preparing a statement and considering the other side's statement: | £400         |
| Official fee:   | £200         |
| Considering and commenting on the other side's evidence:          | £500         |
| Written submissions:  | £400         |
| <b>Total:</b>   | <b>£1500</b> |

51. I order Tetley GB Limited to pay to Société des Produits Nestlé S.A. the sum of £1500. This sum is to 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 17 day of May 2010**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**