

O/164/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2570308  
BY  
A1 SPORTS LTD  
TO REGISTER THE TRADE MARK**

**Optihealth**

**IN CLASSES 5, 29 AND 30**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 101932  
BY  
OPTIMA HEALTH LIMITED**

Trade Marks Act 1994  
In the matter of application number 2570308  
by A1 Sports Ltd  
to register the trade mark:

The logo for 'Optihealth' features the word 'Opti' in a bold, sans-serif font and 'health' in a cursive script font. A thin, curved line underlines the entire word.

in classes 5, 29 and 30  
and the opposition thereto  
under no. 101932  
by Optima Health Limited

## BACKGROUND

1. On 26 January 2011, A1 Sports Ltd (A1) applied to register the above trade mark in classes 5, 29 and 30 of the Nice Classification system<sup>1</sup> as follows:

### **Class 5**

Vitamins, minerals, health supplements, sports supplements.

### **Class 29**

Vitamin and mineral enriched food, dietary supplements for health and athletes.

### **Class 30**

Vitamin and mineral enriched food, dietary supplements for health and athletes.

2. Following publication of the application in the *Trade Marks Journal* on 18 February 2011, Optima Health Limited (Optima) filed notice of opposition against the application.

3. The grounds of opposition were initially brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act). However, in their written submissions, under the heading 'Section 5(3)', Optima states, '*The opponent requests that this ground be removed from the opposition*'. Consequently, I need not consider this any further. Section 5(2) states:

*"5(2) A trade mark shall not be registered if because –*

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

....

*(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.”*

4. The opposition is directed against all of A1's goods. Optima relies on the following earlier marks:

<b>MARK DETAILS AND RELEVANT DATES</b>	<b>GOODS RELIED UPON</b>
<p><b>CTM:</b> 2081693</p> <p><b>Mark:</b> OPTIMA HEALTH</p> <p><b>Date of application:</b> 12 February 2001</p> <p><b>Date of registration:</b> 26 June 2003</p>	<p><b>Class 03:</b> Soaps, perfumery, essential oils; cosmetics, hair lotions; toothpaste, dentifrices, mouthwashes and other preparations for oral and dental hygiene for teeth, gum, tongue, mouth and dentures.</p> <p><b>Class 05:</b> Pharmaceutical preparations; dietetic substances, food for babies, plasters, materials for dressings; vegetable plant extract.</p> <p><b>Class 32:</b> Mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; syrups and other preparations for making beverages.</p>
<p><b>CTM:</b> 4657714</p> <p><b>Mark:</b></p>  <p><b>Date of application:</b> 17 October 2005</p> <p><b>Date of registration:</b> 1 July 2009</p>	<p><b>Class 03:</b> Soaps, perfumery, essential oils; cosmetics; hair lotions; toothpaste; non-medicated toilet preparations; non-medicated skin care preparations; non-medicated balms, ointments, creams, powders, gels, lotions and emollients; massage preparations; dentifrices, mouthwashes and other preparations for oral and dental hygiene, for teeth, gum, tongue, mouth and dentures.</p> <p><b>Class 05:</b> Pharmaceutical</p>

	preparations and substances; dermatological products; medicated skin care preparations; dietetic substances adapted for medical use; food for babies; food supplements; vitamins; herbal preparations; fungicides and herbicides.  <b>Class 32:</b> Mineral and aerated waters and others non-alcoholic drinks, fruits drinks and fruit juices; syrups and other preparations for making beverages.
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5. In its notice of opposition at paragraph 5, Optima states that its marks have been used in relation to *“a range of dietetic substances, food supplements, vitamins, herbal preparations, cosmetics and healthcare products...in the UK and the EU, since at least 1994.”* It relies on all of the goods for the purposes of these proceedings. Optima submits, inter alia:

*11.4 “Confusion is inevitable given the closeness of the similarity between the Opposed mark and the Trade Marks and the identical nature of or very close similarity between the goods in respect of which the Opposed mark is applied for and those in respect of which the Trade Mark is registered.”*

6. On 26 July 2011, A1 filed a counterstatement in which it states:

*“We do not agree with the opposition under sections 5(2)(b)... that the mark we have applied to register is markedly similar to that of the opponent or will create any consumer confusion as to the goods offered...”*

*Whilst the opposition has based its case on the Optima Health and Nutrition mark and its usage, we can find no evidence of this mark being used on goods for sale.”*

7. Attached to the counterstatement is a single page on which are two pictures said to be of Optima’s products. The attachment has not been filed in evidential form, nor was it submitted as evidence when A1 was given the opportunity to file evidence during the proceedings. However, had it been filed in the correct form it would not have advanced A1’s case because it is not clear where the images have been taken from nor when they were taken, as the page is not dated. I need discuss it no further.

8. At boxes 5 and 6 of the TM8 (notice of defence and counterstatement), A1 requests that Optima provide proof of use in respect of *‘products sold in classes 5, 29 and 30.’* As Optima’s marks are not registered in 29 and 30 this can only be an indication that proof of use is requested in respect of goods in class 5.

9. Proof of use is required where 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 of the opposed application. Optima's earlier mark 4657714 completed its registration procedure less than five years before 18 February 2011, which is the publication date of A1's application. There is therefore no requirement for Optima to prove use of this mark. CTM 2081693, which Optima also relies on in these proceedings, was registered more than five years prior to the publication date of the application, consequently it is subject to proof of use for the period 19 February 2006 until 18 February 2011.<sup>2</sup>

10. Both parties filed evidence in the proceedings; only Optima filed written submissions in lieu of a hearing. I will refer to these written submissions as necessary below.

## **EVIDENCE**

### **Optima's evidence**

11. Optima's evidence consists of a witness statement from Frederick Francis Whitcomb, dated 27 September 2011, accompanied by 5 exhibits. Mr Whitcomb is the Chief Executive of Optima Consumer Health Limited, the parent company of Optima Health Limited (the opponent), a position he has held since June 2010. The main facts emerging from Mr Whitcomb's statement are, in my view, as follows:

- 'OPTIMA HEALTH' has been used in relation to health food supplements since at least 2001. I have taken the reference to OPTIMA HEALTH to mean the variety of marks relied upon by Optima.
- Between 2001 and 2010 'OPTIMA HEALTH' grew into a substantial business in the UK (and overseas) in the health supplement, health food and natural cosmetics sectors. Mr Whitcomb states that products were sold through retail outlets such as Holland & Barrett and Boots, as well as privately owned health food shops and via its own website, at [www.optimah.com](http://www.optimah.com). Turnover from 2001 to 2011 amounted to not less than £156,455,000, though this is described as turnover of the 'OPTIMA HEALTH business' so it is not possible to conclude what percentage of these sales refers to the marks at issue, nor are the sales broken down by classes of goods.
- In respect of turnover figures, in the UK, under the name OPTIMA HEALTH these are broken down as follows:

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Period	Turnover
1 July 2001 – January 2002	Not less than £3,713,000
2002	Not less than £11,439,000
2003	Not less than £11,993,000
2004	Not less than £13,937,000
2005	Not less than £7,189,000
2006	Not less than £11,273,000
2007	Not less than £18,139,000
2008	Not less than £26,458,000
2009	Not less than £21,794,000
2010	Not less than £17,700,000
January 2011 – August 2011	Not less than £16,533,000

- Exhibit FFW-2 consists of a proof for packaging design for 'Maxicol', a product in Optima's range. It is dated 20 October 2004. In his witness statement Mr Whitcomb comments, "I confirm that the label was used for our MAXICOL products during the period 18 February 2006 to 17 February 2011."

12. The stylised word 'Optima' can be seen on the top right of the label above the word Maxicol. On what is to be the rear of the label, the stylised words Optima Health can be seen above the company address which begins 'Optima Health Ltd.'

**NEW**

Optima<sup>®</sup>

PROBIOTIC FORMULA™

# Maxicol

## CAPSULES

### For Bowel Health

With Psyllium Husk Powder, Fructo-Oligosaccharides  
Lactobacillus Acidophilus & Bifidum Bacteria

**60 Million Bacteria per Capsule**

**120 VegCaps**

**DIRECTIONS FOR USE:** Take two to three capsules twice daily before meals with a full glass of water. The capsules can be opened and the contents mixed with water for children (over 5 years of age) and consumed immediately. Alternatively use Optima Maxicol Psyllium Husk Formula.

**CAUTION:** Take with plenty of additional fluid. Do not exceed the stated quantity. Pregnant or lactating women should consult a health-care professional before using. **FOR MAXIMUM BENEFIT PRODUCT CAN BE STORED IN A REFRIGERATOR ONCE OPENED.**

**EACH CAPSULE PROVIDES:**

Psyllium Husk Powder	210mg
Fructo-Oligosaccharides (FOS)	30mg
Lactobacillus Acidophilus & Bifidum Bacteria Complex	60 Million Organisms

▲ Water and/or extra fluid is essential for maximum benefit.

**NUTRITIONAL INFORMATION:**

	Per 100g
Energy	15.25kJ
Protein	<5g
Carbohydrates	<5g
Fat	<2g
Fibre	15.75g

Maxicol™ is a trademark of Optima Health Ltd.

**Ingredients:** Psyllium Husk Powder, Fructo-Oligosaccharides, Lactobacillus Acidophilus & Bifidum Bacteria Complex, Silica, Magnesium Stearate (vegetable origin).

**Maxicol Capsules combine natural soluble dietary fibre and friendly bacteria in an easy to take capsule presentation. Suitable for use by those who find Optima Maxicol Psyllium Husk Formula inconvenient.**

**Lactobacillus Acidophilus and Bifidum Bacteria Complex**  
The balance of the intestinal flora is essential to good health and in the maintenance of a healthy colon. Friendly bacteria in the intestines can easily become compromised due to illness, certain medications or poor dietary habits, which can lead to bowel disorders. Maxicol provides two important bacteria strains to help maintain the balance of bacteria within the colon.

**Fructo-Oligosaccharides**  
This soluble fibre, found in vegetables and fruit, can help to support the growth of beneficial bacteria in the gut. Fructo-Oligosaccharides cannot be absorbed or digested by the body, they act only as a food for the friendly bacteria, and are ideal for maintaining the health of the intestines.

**Psyllium Husk**  
A natural mucilage derived from the seeds and husks of the Plantago plant, Psyllium is a mixed polysaccharide soluble fibre which has the capacity to absorb water and swell in the colon to help facilitate the passage of intestinal contents. Psyllium is not absorbed by the body, it acts only as a gentle bulking agent which unlike wheat fibre does not affect the absorption of nutrients.

Free from preservatives, colours and flavours. Contains no added sugar, salt, yeast, wheat, corn, soy or dairy products.

**Optima Health**  
Optima Health Ltd  
Binbrook Mill, Young Street,  
Bradford, West Yorks, BD8 5XE  
[www.optimah.com](http://www.optimah.com)

- Exhibit FFW-3 consists of an A4 page containing five versions of the mark, namely:

Optima Health

Optima Health

OptimaHealth

OptimaHealth

OptimaHealth

The exhibit also includes a screen print of the properties page which shows that the last amendment to the file was made on 4 July 2005. Mr Whitcomb states that the exhibit shows '*various alternative versions of OPTIMA HEALTH branding dating from 2005*'.

- Exhibit FFW-4 is a copy of a leaflet advertising the aforementioned Maxicol product. The leaflet is undated but is referred to in Mr Whitcomb's witness statement as dating from 28 August 2011. The leaflet shows the following mark on the first and second pages.

**Optima**  
Health & Nutrition

- Exhibit FFW-5 consists of printouts from several third party websites including [www.amazon.co.uk](http://www.amazon.co.uk) and [www.suespantry.co.uk](http://www.suespantry.co.uk), dated 20 September 2011. Also provided are screen shots from the following websites: *Boots*, *Nutriglow*, *40fide* and *worldwide shopping mall*, all of which are undated. The last of these shows a representation of the following mark in the bottom right hand corner:

**Optima**  
Health & Nutrition

Optima's marks cannot be seen on any of the products though the name 'Optima Health' is used in all of the product descriptions and on review pages from *amazon* customers. Mr Whitcomb submits that these products were on sale in the UK during the period 18 February 2006 – 17 February 2011.

- Mr Whitcomb provides advertising figures broken down as follows:

Year	Advertising spend
2001	£360,000
2002	£340,000
2003	£340,000
2004	£370,000
2005	£400,000
2006	£380,000
2007	£380,000
2008	£370,000

13. It is not clear if these figures relate specifically to the UK. However, in the following paragraph Mr Whitcomb comments:

*14. "From the date of first use to date, and specifically during the period of 18 February 2006 to 17 February 2011, OPTIMA HEALTH products have been sold in all areas of the United Kingdom."*

In support of this he provides a list of areas in the UK where Optima Health have customers. This includes areas throughout the whole of the UK including England, Wales, Scotland and Northern Ireland.

### **A1's evidence**

14. A1's evidence consists of a witness statement from Mark Williamson, dated 29 November 2011, accompanied by 2 exhibits. Mr Williamson's role in the company is not specified. The main facts emerging from the statement are, in my view, as follows:

- The 'OptiHealth' trade mark, which is the subject of the application, is not yet in use. The application is part of a re-branding of the 'Optimum Health' range.
- The 'Optimum Health' range has been on sale in the UK since June 2008 and is promoted on the website 'Discount Supplements' (no address provided) to 200,000 unique users in addition to '*...other online and high street retailers.*'
- Sales of the 'Optimum Health' brand are estimated at £150,000 per month.

- Exhibit A1S-1 is a printout from the aforementioned website which shows a picture of a product described as 'Ultimate Whey Protein'. The page is not dated.



- Exhibit A1S-2 consists of a printout showing, what I presume to be, the number of visitors to the website 'Discount Supplements'. The printout shows the period 1 October 2011 – 31 October 2011 in the form of a graph. This graph refers to a period after the material date and does not indicate whether or not the goods being viewed by the site visitors were those of A1.

## DECISION

### Section 5(2)(b) – case law

15. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### The CJEU cases

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; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C.

### **The principles**

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

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **Average consumer and nature of the purchasing act**

16. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and consider the nature of the purchasing process. The average consumer for food supplements and enriched foods will be the same, namely, health conscious members of the general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. There is a fairly wide range of goods within the classes which include snack bars, possibly a fairly frequent, inexpensive purchase and also long term dietary supplements, a less frequent and more expensive purchase. The level of attention paid by the average consumer during the purchasing act will vary accordingly. Both parties have shown that the goods are sold online and through retail outlets. In my experience these are the likely outlets for both parties' goods. The purchasing act is primarily visual as the goods will be selected from shelves, display counters or from a webpage. However, I do not ignore the part that aural considerations may play in relation to these goods, particularly as I am aware that in some cases these goods are displayed behind a counter or in locked cabinets, resulting in the purchasing process including an aural element.

17. Whilst some of the goods are inexpensive, the average consumer is likely to pay a reasonable degree of attention to the purchase, given that the goods are health related and the products are to be ingested. Consequently the average consumer will pay a reasonable degree of attention to the purchase of these goods.

### **Comparison of goods**

18. Optima relies on two earlier marks in these proceedings both of which are registered in classes 3, 5 and 32. In my view, the goods in classes 3 and 32 do not place Optima in any better position than the goods in class 5. Since the later filed of these marks has a broader class 5 specification, it is this mark that provides Optima with its best case. For these reasons I will confine my analysis to CTM 4657714 which, as I indicated above, is not subject to the requirement to show proof of use.

19. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which the CJEU stated at paragraph 23 of its judgment:

“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.”

20. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281(hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses of* the respective goods or services;
- (b) the respective *users of* the respective goods or services;
- (c) the *physical nature* of the goods or acts of service;
- (d) the respective *trade channels* through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

21. For ease of reference the goods are shown below:

<b>Optima’s registration (best case)</b>	<b>A1’s application</b>
<p><b>Class 05:</b> Pharmaceutical preparations and substances; dermatological products; medicated skin care preparations; dietetic substances adapted for medical use; food for babies; food supplements; vitamins; herbal preparations; fungicides and herbicides.</p>	<p><b>Class 5:</b> Vitamins, minerals, health supplements, sports supplements.</p> <p><b>Class 29:</b> Vitamin and mineral enriched food, dietary supplements for health and athletes.</p> <p><b>Class 30:</b> Vitamin and mineral enriched food, dietary supplements for health and athletes.</p>

22. In comparing the goods I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. Optima states that the goods of the parties are identical and if not identical, are ‘closely similar’.

#### A1’s class 5 goods

24. ‘Vitamins’ are included in A1’s application and in class 5 of Optima’s earlier mark. These are self evidently identical terms. ‘Minerals’ are defined as “*an inorganic substance needed by the human body for good health.*”<sup>3</sup> They can be considered, in this context, to be included within the wider category ‘food supplements’ in Optima’s registration. ‘Health supplements’ and ‘sports supplements’ would also be included within ‘food supplements’ which are included in Optima’s earlier registration. Applying the test laid down by the General Court in *Meric*, A1’s goods in class 5 can be considered identical to the goods in class 5 of Optima’s earlier registration.

#### A1’s class 29 and 30 goods

25. In its written submissions, Optima states:

8. “*The goods share the same uses, users, trade channels, pricing and position within a retail outlet or online store and are in competition with one another.*”

26. A1’s goods are classified separately in classes 29 and 30, though the wording of each is identical. The term ‘vitamin and mineral enriched food’ indicates foodstuffs which have been enriched in some way so as to enhance the content (by the addition of vitamins or minerals) but the nature of them is still that of foodstuffs. Optima’s goods take the form of some of the products used to enhance or enrich those foodstuffs i.e. food supplements. Having made such a finding I am mindful of the comments in *Les Éditions Albert René V Office for Harmonisation in the Internal Market* (Trade Marks & Designs) (OHIM) T-336/03, where it was held that:

“*The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.*”

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<sup>3</sup> *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press.

27. The nature of Optima's goods varies in that they may be made available in a variety of forms, including capsules and powders and may include prepared foods. It is clear that there is a wide variety of disparate goods within the class but all of the goods have the overriding intended purpose of regulating and/or enhancing health. The way in which the products will be used is essentially the same in that they will be ingested for their health benefits by an average consumer who is health conscious.

28. In paragraph 5 of his witness statement, Mr Whitcomb states that Optima Health is a well-known business in the UK health supplement and health food sectors and sells its goods through retail outlets such as *Boots* and *Holland & Barrett* as well as through its own website. It is clear from the submissions of both parties that health foods and health supplements are offered through the same retail outlets and will be located, if not on the same shelves, then in close proximity to each other.

29. As a consequence of my findings above, in the case of 'vitamin and mineral enriched foodstuffs' and 'dietary supplements for health and athletes', I find the nature of the goods, the users and uses and trade channels are all either identical or highly similar.

30. Dietary supplements, per se, are proper to class 5, other than when not for medical use. It is not entirely clear what goods are intended to be covered by the term 'dietary supplements for health and athletes' within classes 29 and 30 of the application. A dietary supplement could take the form of a meal replacement, or a non-medical enhancement, such as an additive to provide additional energy (which would be proper to classes 29 and 30) and on this basis I go on to compare the goods with those included within Optima's registration.

31. 'Dietary supplements for health and athletes' may take the form of a finished food product for use in combination with other foods. When compared with Optima's goods in class 5 which are also likely to be available in a variety of forms, I conclude that the users of both products will be health conscious individuals who are purchasing the goods for the purpose of enhancing or regulating their health. In all cases the goods are to be ingested and, as discussed at paragraph 23, are available in the same retail outlets and on the same websites, where they will be positioned in either the same areas or in close proximity to each other.

32. As part of the overall goods comparison I must also consider if the respective goods are complementary. In this respect I am guided by the General Court (GC) judgment in *Boston Scientific Ltd v OHIM (Trade marks and Designs Case)*, Case T-325/06:

*"82. It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685,*

*paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”*

33. In the case of enriched foodstuffs and food supplements, they are clearly related, but in my view, given that there is no evidence before me on this point, not sufficiently so as to enable me to conclude that they are complementary goods in the *Boston Scientific* sense. Neither is indispensable for the use of the other.

34. The goods are, in a broad sense, all related to health and are all products which are to be ingested. It is possible that, despite their differing nature, there may be an element of competition, for example where the average consumer would prefer to take supplements in a prepared food product such as a snack bar, rather than in capsule form.

35. Taking all of these factors into account, I conclude that A1’s goods in classes 29 and 30 are similar to a high degree to Optima’s goods in class 5.

### Comparison of marks

The marks to be compared are:

Optima's mark	A1's mark
	

36. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>4</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

### Distinctive and dominant components

37. A1’s mark consists of the elements 'Opti' and 'health' with a curved line underneath the words which joins the descender of the letter 'p'. The words will be

<sup>4</sup> *Sabel v Puma AG*, para.23

read from left to right with a natural break between the 'Opti' and 'health' elements which is emphasised by a change in typeface. The word 'health' is presented in a handwritten script. 'Opti' does not have a dictionary definition. In his witness statement Mr Whitcomb states:

3. *'Opti is a well known abbreviation of the words OPTIMUM and OPTIMAL'*

38. I have no evidence to support this submission. However, in the context of the goods at issue, it is likely that the average consumer would consider the 'Opti' element, when combined with the word 'health', to be an indirect reference to the known words optimum, optimal or optimise.

39. In my experience, the average consumer is well used to seeing words such as 'health' used in relation to these types of products. As a consequence the word 'health' is unlikely to be afforded any origin significance. The unremarkable line underneath the mark is likely to go unnoticed by the average consumer as will the conjoined letters 'ti'. The 'Opti' element of the mark has a dominant position and is presented in a thicker typeface than the remainder of the mark. I therefore conclude that it is the 'Opti' element that is the most distinctive element of A1's mark.

40. Optima's mark consists of the word 'Optima' presented above the words 'Health & Nutrition'. In terms of position and size 'Optima' is the dominant element in the mark. The words below are considerably smaller and are noticeably subservient to the 'Optima' element. The 'P' of 'Optima' has a gap in its bowl, which is unlikely to be noticed by the average consumer. In the context of the goods the words 'Health & Nutrition' are words with which the average consumer will be familiar and are therefore unlikely to be afforded any trade mark significance. The word 'Optima' is defined as the plural of optimum which means:

*'best or most favourable'*.<sup>5</sup>

41. I have no evidence before me to enable me to conclude that the average consumer will be aware of this definition. The dominant presentation of the 'Optima' element and the non-distinctive nature of the words 'Health & Nutrition' mean that 'Optima' is the distinctive and dominant element of Optima's mark.

### **Visual similarities**

42. Any visual similarity between the marks rests in the distinctive elements 'Optima' and 'Opti'. Both marks are in title case, presented in an unremarkable font and start

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<sup>5</sup> Chambers 21st Century Dictionary, © Chambers Harrap Publishers Limited 2001

with the four letters 'OPTI', presented with the lower case letters 't' and 'i' which are conjoined. The word 'Health' is the next word in both marks. Optima's mark includes the additional elements '& Nutrition' which are not present in the application. A1's mark includes a curved underline, while Optima's has a slight gap in the letter 'P', both of which are likely to go largely unnoticed by the average consumer.

43. Taking these factors into account I find the marks share a high degree of visual similarity.

### **Aural similarities**

44. It is clear to me that the point of aural similarity between the marks rests in the 'Opti' element, which in both marks will be read first, and in the fact that both include the word 'Health'. The 'Opti' element in both marks will be pronounced 'OP-TEE'. Optima's mark is followed by 'ma-health and nutrition' while A1's mark is followed by the word 'Health'.

45. Despite these differences, the 'Opti' and 'health' elements present at the beginning of both marks lead me to conclude there is a moderate degree of aural similarity between the marks.

### **Conceptual similarities**

46. As noted at paragraph 40 above, the word 'Optima' has a clear dictionary definition. Even though I cannot presume that this exact meaning will be known to the average consumer, I am content that similar words, such as optimal and optimum, will be known and that, when coupled with the words 'Health & Nutrition', the totality of the mark gives a clear message that the products will provide the average consumer with the best or most favourable health benefits. The term 'Opti' in A1's mark has several possible meanings. In the context of optical goods it is likely that the average consumer would simply see the mark as a reference to optical products. As I have discussed at paragraph 38, in the context of the goods at issue in this case, even though 'Opti' does not have a dictionary definition, it is likely, in my view, that the average consumer will consider the totality to allude to favourable health benefits.

47. In both cases, the marks contain the word 'health' and while this is not distinctive, in the marks as a whole it does reinforce the message of both marks that the goods sold under them are beneficial to health.

48. Taking all these factors into account I find that the marks share a high degree of conceptual similarity.

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

49. I must now assess the distinctive character of Optima's earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered 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.

50. I have to consider whether Optima's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. In its written submission, Optima states:

*"The opponent claims an enhanced distinctive character in its mark owing to the extent of use made of the mark. We refer to the witness statement of Frederick Francis Whitcomb which provides details of the turnover and marketing expenditure of Opponent [sic], which is significant in the industry."*

51. 'Optima', 'health' and 'nutrition' all have clear dictionary meanings. In relation to the class 5 goods, the trade mark is not descriptive but alludes to goods which will provide improved health and nutrition. In the absence of use, the mark is a normal trade mark, possessed of an average degree of inherent distinctiveness.

52. Optima has provided turnover figures which are sufficient to show an established business and has provided the names of several stores through which its products are sold, which include Boots and Holland & Barrett, referred to above. The use shown in evidence is sufficient for me to conclude that the 'Optima' element of its trade mark has been used throughout its existence, though there is little to show use of the word used with 'Health & Nutrition'. However, as discussed above these elements are not distinctive in respect of the goods at issue. The evidence does show UK turnover and advertising spend (the latter does not clearly indicate that it relates solely to the UK) but does not break these down in relation to the classes for which the mark is registered, for example, the majority of the sales could be related to goods in classes 3 and 32.

53. I can conclude that the average consumer has been exposed to 'Optima' trade marks for a number of years and that Optima's evidence shows that at least some of this has been in respect of goods in class 5. It is likely that this will have enhanced the distinctive character of the mark to some degree, although to what extent, I cannot be sure.

## **Likelihood of confusion**

54. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>6</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

55. I have found that the marks share a moderate degree of aural similarity and a high degree of visual and conceptual similarity, resulting in a reasonably high level of similarity overall. I have also identified a normal level of distinctive character in Optima's earlier mark, which is likely to have been enhanced through use, though I cannot conclude to what extent. In respect of the goods I have concluded that A1's class 5 goods are identical to Optima's goods in class 5, while its goods in classes 29 and 30 are similar to a high degree. I have identified the average consumer, namely the health food and health supplement buying members of the general public. I have concluded that the purchasing act will, generally, be visual (though aural considerations must also be borne in mind) and will involve a reasonable degree of care and attention, given that the average consumer will be health conscious and is purchasing a product to be ingested.

56. Taking all the above factors into account, and considering the marks as a whole, I conclude that the differences between the marks are not sufficient to outweigh the obvious similarities. It is clear from decisions such as joined cases T-183/02 and T-184/02<sup>7</sup> that the first parts of words catch the attention of consumers. In the context of identical and highly similar goods and taking into account imperfect recollection, I find the average consumer is likely to mistake one mark for the other. Even if I am wrong in this regard, I find the average consumer would consider goods to come from linked undertakings, i.e. which would lead to indirect confusion.

## **Conclusion**

**57. I have no hesitation in finding that the opposition succeeds in respect of all the goods opposed.**

## **Costs**

58. The opposition having succeeded in full, Optima Health Limited, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken

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<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>7</sup> *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

place, but that it filed evidence and written submissions in lieu. I make the award on the following basis.

Preparing a statement and considering the other side's statement: (including opposition fee)	£500
Preparing evidence:	£400
Written submissions:	£300
<b>Total:</b>	<b>£1200</b>

59. I order A1 Sports Limited to pay Optima Health Limited the sum of £1200. 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 16<sup>th</sup> day of April 2012**

**Ms Al Skilton  
For the Registrar,**