

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 1996**

**IN THE MATTER OF APPLICATION NO M684514 BY
SCHILS BV TO PROTECT THE MARK VITALAT IN
CLASSES 5, 29 AND 30**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 70267 BY LAITERIE COOPERATIVE**

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DECISION

1. On 22 December 1998 Schils BV, on the basis of a registration held in the Benelux, requested protection in the United Kingdom of the trade mark VITALAT under the provision of the Madrid Protocol.

2. The International Registration is numbered 684514 and protection is sought for the following:-

Class 5

Baby Food

Class 29

Milk and milk products; but not including yellow fats and yellow fats spreads, edible oils and fats.

Class 30

Coffee, tea, cocoa, sugar, rice, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ice cream; honey, treacle; yeast, baking powder; sauces (condiments); all the foregoing goods to be used with or to dilute with milk and/or dairy products.

3. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and the particulars of the International Registration were published in accordance with Article 10.

4. On 2 March 2000 Laiterie Cooperative filed notice of opposition to the conferring of protection on this International Registration. They are the proprietors of a CTM registration for the mark VITALAIT under No 401695 and in respect of “Milk, cream, cheese (plain, flavoured, or with seasoning), yoghurts and creams (fresh, plain or with seasoning) but not including edible oils or edible fats, butter, yellow fat spreads, cheese spreads”.

5. On the basis of this CTM registration which has a filing date of 27 November 1996 they say that conferring protection on the International Registration in suit would offend the provision of Section 5(1), 5(2)(a) and 5(2)(b). The remainder of their statement of grounds is a detailed commentary on issues to do with the respective marks and goods. It amounts in effect to submissions and I bear them in mind in coming to my own view of the matter.

6. The International Registration holders filed a counterstatement denying the above grounds. They too make what amount to submissions on the issues before me.

7. Both sides ask for an award of costs in their favour. Both sides filed evidence. Neither side has asked to be heard on the matter. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

8. The relevant statutory provisions read as follows:-

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

9. The opponents have put their case on a number of alternative bases. Two of them, that is the claims under Sections 5(1) and 5(2)(a) depend on there being identical marks. The marks at issue here are VITALAT and VITALAIT. The question of whether marks are identical or simply very similar has been considered in IDG Communications Ltd’s Trade Mark Application [2002] RPC 283 where the marks in issue were DIGIT and digits. The Hearing Officer concluded that the marks were not identical. His reasoning by reference also to Simon Thorley QC’s decision in BAYWATCH (unreported SRIS O/051/01) can be found on pages 286 to 288 of the decision.

10. I also bear in mind the opinion of Advocate General Jacobs in *SA Societe LTJ Diffusion v SA SADAS* Case C-291/100 where he concluded that:

“The concept of identity between mark and sign in Article 5(1)(a) of Council Directive 89/104/EEC covers identical reproduction without any addition, omission or modification other than those which are either minute or wholly insignificant.”

11. It is clear that applying the above principles the opponents must necessarily fail in so far as they base their opposition on grounds which rely on the existence of identical marks. The marks at issue here are not identical.

12. In approaching the ground based on Section 5(2)(b) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

13. 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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) 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;
- (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*, paragraph 24;
- (g) 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;

- (h) 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*, paragraph 41;
- (i) 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.

14. I also bear in mind Mr Geoffrey Hobbs QC's comments in *Raleigh International Trade Mark* [2001] RPC 202 that "similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences."

Submissions of the Parties

15. The evidence filed in this case is as follows:

Opponents' evidence in chief:

Statutory Declaration by Howard Nicholas Matthews with Exhibits A1-A2

International Registration Holders' evidence in support:

Statutory Declaration by Duncan Andrew Welch with Enclosure 1

Statutory Declaration by Harry Drissen with Exhibit S1

16. These declarations consist in the main of submissions. Both sides have referred me to 'state of the register' material. In the absence of evidence to show which marks (if any) are in use such material is not helpful - see *British Sugar Plc v James Robertson & Sons Ltd* (Treat) 1996 RPC 281.

17. The opponents point to the visual similarities between the marks and suggest that an English speaker will pronounce the third syllable of the respective marks such that they will become substantially indistinguishable. Their view is that the Class 29 goods are identical and the Class 5 and 30 goods are similar and will result in confusion.

18. Mr Drissen, for the International Registration Holders submits that VITA is Latin for life and is a popular element for trade marks; that LAIT is French for milk and would be understood as such; that LAIT is pronounced as in 'late'; and that the opponents' mark would be pronounced accordingly and understood as meaning the milk of life. He suggests therefore that VITALAIT is not a highly original mark and may be descriptive. He distinguishes his own company's mark (the International Registration holders) on the basis that, whilst it has the

same prefix element, the suffix LAT (unlike LAIT) has no meaning and will be pronounced differently.

19. In relation to the goods he concedes that the parties' Class 29 goods are similar. He does not accept that 'baby food' is similar to milk and suggests they are sold in different parts of supermarkets. He disputes the opponents' assertion that they are distributed or marketed by the same companies. In relation to his company's Class 30 goods the opponents' assertion that "coffee and cocoa made using milk or milk products and milk having a coffee or cocoa aroma or milk drinks containing coffee or cocoa are all milk based" is disputed. He suggests that the fact that one can make coffee or cocoa with milk does not make these goods similar.

Similarity of marks

20. Neither side has filed any evidence to suggest that the marks VITALAIT and VITALAT are in use. I approach the matter on the basis that both marks would be seen as invented words and distinctive in relation to the goods. I reject the International Registration holders' submission that the average consumer in this country would extract any meaning from the opponents' mark as a result of it being a combination of the Latin word for life and the French word for milk. Consumers do not generally hunt for meanings in this way. It is possible that French speakers might note the presence of the French word for milk but it would require evidence to establish that there was a widespread understanding to this effect.

21. Visually I find the marks to be closely similar in length and appearance. The only difference is the letter I as penultimate letter. That difference is unlikely to have a significant effect on the visual character or perception of the respective marks particularly where, as here, they are invented words.

22. The opponents' mark could, I think, be pronounced in two ways. People with some knowledge of French and who picked out the French word for milk would not pronounce the final T of VITALAIT. Thus it would be rendered more as VITALAY. Most people would probably simply render it phonetically as VITALATE. The International Registration holders' mark might also be pronounced that way but more likely would have a short 'a' sound for the final syllable as the International Registration holders suggest to rhyme with 'hat'. On that basis the marks would have slightly different pronunciations if carefully articulated. But making due allowance for imperfections in pronunciation, the relative importance of the beginning of words and the risk of slurred endings (TRIPCASTROID 42 RPC 264), and the overall character of the words I find that they are still quite similar.

23. I have taken the view that for most people both marks are likely to be seen as invented words. On that basis there is no obvious point of conceptual differentiation. On the whole, however conceptual considerations are unlikely to play a particularly important role with marks of this kind. The goods are primarily of a kind that will be chosen by a visual inspection process in a variety of retail environments.

24. Bearing in mind that imperfection recollection may play a part I have come to the clear view that the marks in issue are closely similar.

Similarity of Goods

25. The opponents say that the Class 29 goods are identical. The International Registration holders concede that they are similar. Milk is common to both specifications. The opponents' specification also includes cream, for instance, which can be said to be a milk product. I regard the Class 29 goods as being identical.

26. The International Registration holders' specification also covers Classes 5 and 30. Clearly the goods in these classes cannot be identical. Are they similar? The Class 5 specification covers 'baby food'. The International Registration holders have filed Exhibit S1 showing four different Heinz baby food products containing various combinations of vegetables, fish, chicken etc. It does not in my view assist that there are baby foods which are not milk or milk based products. Milk powder and milk preparations for babies are, to the best of my knowledge, in Class 5 and must come within the broad term 'baby food'. The question, therefore, arises as to whether such goods would be similar to milk in Class 29.

27. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 296 (the TREAT case). Adapted to the present case, it can be stated as:-

- (a) the uses of the respective goods;
- (b) the users of the respective goods;
- (c) the nature of the goods;
- (d) the trade channels through which the goods reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

28. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

“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 end users and their method of use and whether they are in competition with each other or are complementary.”

29. Considering the above criteria I find that the uses of both goods are as food/beverage items but it should be borne in mind that baby milk fulfils a rather more specialist purpose than milk in Class 29. The users might be said to be different to the extent that adults will not drink baby milk and vice versa. But that ignores the fact that users in the sense of the purchasers may be the same to the extent that a mother will buy both milk for a baby and milk for family consumption. The nature of the goods seems to me to be substantially the same albeit that baby

milk is likely to have undergone a rather stricter purification/sterilisation process. Both products are likely to be sold in retail outlets such as supermarkets. Strictly there is no evidence before me to help resolve the conflicting views of the parties as to whether they are sold in close proximity to one another or in different parts of stores. My impression is that they are more likely to be displayed in different areas and that baby food products will constitute a specialist area within stores. Milk and baby milk do not strike me as being in competition with one another but I am not prepared to say that they could not be complementary in the sense that a mother who was satisfied with the quality of a baby milk might not look to progress the baby's feed to an ordinary milk product from the same source. That begs the question as to whether traders generally cover both segments of the market.

30. There are a number of unanswered questions from both sides point of view as to circumstances in the trade. I have not, therefore, found the question of similarity an easy one to determine. On balance I am inclined to the view that the similarities outweigh the dissimilarities.

31. Turning to the International Registration holders' specification in Class 30, it is noted that it covers a wide range of goods in that Class. The opponents quite reasonably point out that the Class 30 specification is qualified by the following "all the foregoing goods to be used with or to dilute with milk and/or dairy products." That seems a curious qualification given the nature of some of the goods listed but I can do no more than take it at face value. It seems to me that the correct approach is to look at the nature of the goods and not simply the fact that they may have a milk content or be used in conjunction with milk. Thus to take the first item in the list it is perfectly true that milk is usually taken with coffee but the nature of the product, the reason why it has been chosen, is because it is coffee. It is a fundamentally different product to milk and that is not changed simply because it may be taken with milk. The answers to the TREAT/CANON criteria flow from that. In my view they differ on just about every account unless one were to take the view that milk is or can be complementary to coffee to the extent that the two things are commonly used together. However, I have little hesitation in concluding that on the basis of the established test coffee and milk are not similar. The same goes in my view for each of the other items in the International Registration holders' specification. The only item that gives rise to any doubt is 'ice cream' where it is, I suppose, possible that milk might be used as a principal flavouring/ingredient. But even here the end product is quite different in nature, has a different set of customers and different trading circumstances such that it cannot in my view be said to be similar.

Likelihood of Confusion

32. On the basis of the above considerations I find that there is a likelihood of confusion in relation to Class 29. Because I have found the Class 30 goods to be dissimilar the opposition must fail in relation to that Class.

33. In relation to Class 5 I must, per Raleigh, "determine the net effect of the given similarities and differences". The position is, I think, finely balanced. The opponents' mark is a strong one. The International Registration holders' mark is not identical but it is closely similar. It is proposed to use it in relation to goods which could be a milk product. The remainder of the International Registration holders' specification suggests that they have an interest in a range of

milk, milk products or products to be used with milk. It is not fanciful, therefore, to infer that their intentions in Class 5 embrace baby foods in the form of milk or milk products. No amendment to the specification has been proposed which would overcome that problem.

34. In the circumstances I consider that there is a likelihood of confusion if a consumer, familiar with milk or milk products offered for sale under the mark VITALAIT, were to encounter the International Registration holders' Class 5 goods under the mark VITALAT.

35. In summary the opposition succeeds in relation to Classes 5 and 29 but fails in relation to Class 30. The request for protection will be allowed if, within 28 days of the expiry of the appeal period, the International Registration holders delete Classes 5 and 29 and thereby ask for protection to be conferred in Class 30 alone. If they do not do so the application will be refused in its entirety.

36. On the above basis both sides have achieved a measure of success. I therefore make no order as to costs.

Dated this 17TH day of April 2002

**M REYNOLDS
For the Registrar
The Comptroller-General**