

O-426-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2526352  
BY VITASOY INTERNATIONAL HOLDINGS LIMITED  
TO REGISTER THE TRADE MARK**

The logo for VITA is rendered in a bold, black, sans-serif font. The letter 'V' is stylized with a thick, slanted stroke. The 'I' is a simple vertical bar. The 'T' has a thick horizontal top bar. The 'A' is a simple, blocky shape. The letters are closely spaced and have a slightly irregular, hand-drawn appearance.

**IN CLASSES 29 & 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 100119 BY  
DAIRY CREST LIMITED**

## BACKGROUND

1) On 16 September 2009 Vitasoy International Holdings Limited (hereinafter the applicant), applied to register the following trade mark:



2) In respect of the following goods:

In Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruit and vegetables; jellies, jams; milk and other dairy products; edible oils and fats; preserves, pickles; soy milk, milk, milk drinks, milk substitutes and tofu, soya bean milk in liquid and solid form, soya bean-based food products including sausage, cheese and yoghurt, salad dressing, ice cream, puddings and desserts.

In Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard, pepper, vinegar, sauces, spices; ice; tea and tea drinks; seasonings.

3) The application was examined and accepted, and subsequently published for opposition purposes on 6 November 2009 in Trade Marks Journal No.6810.

4) On 8 February 2010, Dairy Crest Limited, (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Number	Mark	Filing and Registration Date	Class	Specification relied upon
1588865	VITALITE	24.10.1994 / 29.12.2000	29	Dairy products; milk and milk products; edible oils and edible fats; butter; spreads
CTM 1228766	VITALITE	02.07.1999 / 05.01.2005	29	Yellow fat spreads; spreads; edible oils and edible fats; (which edible oils, spreads and fats contain at least one of hydrogenated fats or oils animal fats or oils or synthetic ingredients); but not including foodstuffs or beverages containing at least 5% herbal products, acidophilus or like cultures and bacteria which are present other than as a naturally occurring part of animal products which are used as ingredients in foodstuffs, and nutritional supplements such as tablets, tonics, capsules, lozenges and the like.

b) The opposition is limited to “Milk and other dairy products; edible oils and fats; milk, milk drinks”. The opponent claims to have used its UK mark upon edible oils and edible fats, and spreads. The opponent relies upon the marks above for its opposition under section 5(2)(b). It contends that the mark in suit is similar to its marks as the term “lite” will simply be viewed as meaning “light” or healthier, and that the specifications of its marks and that applied for are similar. The opponent contends that it has used its mark in relation to sunflower oil spread since 1983. It contends that although not a dairy product the spread is sold alongside dairy products and is similar to dairy products. The mark in suit therefore offends against section 5(2)(b) and 5(4)(a) of the Act.

5) On 15 August 2011, the applicant filed a counterstatement which denied the opponent’s claims. The applicant put the opponent to strict proof of use of its UK trade mark 1588865.

6) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard but both provided written submissions which I shall refer to as and when relevant in my decision.

## **OPPONENT’S EVIDENCE**

7) The opponent filed two witness statements. The first, dated 13 January 2012, is by Magdalena Ostrowska the opponent’s Trade Mark Attorney. She states that she carried out an internet search between 28 December 2011 and 13 January 2012 for information about the meaning and use of the words “LIGHT” and “LITE” in relation to foodstuffs, and the familiarity of the public with these terms as a reference to food products which are low in fat. She provides two exhibits from Wikipedia which state that diet food is referred to as, inter alia, “light”, “lite”, “lean” “no/low calorie” and “no/low fat”. It also states that “lite” is a variant spelling of “light” which may refer to diet food or diet beverages. At exhibit MO5 she provides copies of pages from the websites of various manufacturers. These show use of the word “light” extensively e.g. Lurpak lighter spreadable, Flora Light, Philadelphia Light, Pilgrims Choice Lighter Mature Cheese, Dairylea Light, The, Laughing Cow Light, The Laughing Cow Extra Light, Gartsnag Grated Light Cheese, Yoplait Light fat Free, Activia Light, Muller Light, Alpro Soya Light, Elmlea single light, Hellmans Light, Kraft Light, Heinz salad cream light Carte D’O Vanilla light and Walkers Lights.

8) However, there are only a few exhibits which show use of the term “lite”. These are:

- A print out from Sainsbury’s which features Cardini Lite Caesar Dressing product; a reduced fat Cesar dressing with 39% less fat than the original.
- A print out from Sainsbury’s which features Spam Chopped Pork and Ham Lite Tin product. This product contains 25% less salt and fat than regular Spam Chopped Pork and Ham.

- A print out from Tesco which shows search results for “lite” in the groceries section of the website, which provides a range of hits on “light”, “lite”, “low fat” and “reduced fat” products. I note that most of the products with the term “lite” are sports drinks.

9) Ms Ostrowska concludes that the words “light” and “lite” are commonly used to refer to products which are low in fat and so healthier. At exhibit MO7 she provides examples from the websites of Asda, Sainsbury’s, Tesco and Waitrose which shows considerable use of the term “light”, some use of the term “lighter” and very little use of the term “lite” other than on sports drinks and spam. At exhibit MO8 she provides extracts from Slimming World magazine which shows use of the term “light” in relation to low fat/low calorie versions of products. She also provides “state of the register” evidence again to reinforce the contention that there are a large number of products which have a low fat or low calorie version and that the term “light” is used to describe these versions.

10) The second witness statement, dated 12 January 2012, is by Fiona Wylie the Group Brands Manager at the opponent company a position she has held since December 2010. She states that the mark VITALITE was first used in 1983 on a vegetable oil based spread. She also states that whilst the branding has changed over the years the word “VITALITE” has always been prominent. The product is sold via major supermarkets throughout the UK. She provides the following sales figures:

Year	Sales £million
March 2008-February 2009	8.6
March 2009-February 2010	9.0
March 2010-February 2011	8.1

11) Ms Wylie states that an advertising campaign from fifteen years ago is still remembered and that in a report, copied at exhibit FW12, dated 4 March 2011, 69% of those questioned were aware of the brand when prompted. She contends that the current vegetable oil based product is a substitute for butter and is sold alongside it in supermarkets alongside cheese, cheese spreads and milk. She points out that another of her company’s brands COUNTRY LIFE was originally used as a butter brand but is now being used on milk. She states that this could equally occur with VITALITE. She also contends that dairy products are not purchased with a great deal of care.

## **APPLICANT’S EVIDENCE**

12) The applicant filed a witness statement, dated 16 March 2012, by Iain Michael Richardson its Trade Mark Attorney. He states that the applicant has supplied evidence to him in addition to his own searches and knowledge. He provides a potted history of the applicant from its inception in Hong Kong in 1940 through its initial moves into exporting in the 1970s to its position today where its products are sold in 20 countries such as USA, Australia, China and the EU. They are sold under the VITASOY and VITA marks and include soybean drinks, dairy milk products, juice drinks, teas, bottled water and tofu. These marks are registered in many countries around the world. VITA

products were first sold in the UK in 1985. He provides the following sales figures for the UK for sales of drinks (tea, yoghurt, juice and milk) under the VITA mark:

Year	Turnover Amount in Euros	Year	Turnover Amount in Euros
1991-1992	102,750	2001-2002	367,712
1992-1993	121,675	2002-2003	334,501
1993-1994	172,226	2003-2004	380,621
1994-1995	204,443	2004-2005	n/a
1995-1996	172,199	2005-2006	n/a
1996-1997	217,496	2006-2007	411,325
1997-1998	318,740	2007-2008	383,332
1998-1999	277,212	2008-2009	389,614
1999-2000	303,976	2009-2010	340,928
2000-2001	304,059		

13) Mr Richardson does not provide any details as to when particular products began to be sold in the UK. There is no way of knowing quite how long any product has been sold for from the information provided. He contends that EU regulations only allow for a product to use the term “light” when the product has at least 30% less fat content than the regular product. He claims that this is not the case when considering the opponent’s product to a normal sunflower spread, where the opponent’s product has only 11% less fat content. He also points out that the opponent has the mark VITALITE LIGHT registered under UK 2143319 filed in August 1997 for goods in class 29. He provides the following exhibits:

- IMR2: Examples of packaging related to the UK. These all show use of the VITA mark on drinks cartons. They are undated.
- IMR6: A sample of eleven invoices relating to VITA and VITASOY drinks to distributors in the UK during the period October 2006-July 2010. The invoice in 2006 refers only to tea, whereas the first invoice in 2007, dated 24 February, shows juice drinks, yoghurt drinks, milk drinks as well as tea.

## **OPPONENT’S EVIDENCE IN REPLY**

14) The opponent filed a witness statement, dated 17 May 2012, by Lorna Hobbs who has been a registered Trade Mark Attorney since 1992 and who represents the opponent. She states that she would advise clients to register word marks in block capitals as this gives rights to the word in a degree of stylisation. She also describes a visit to a local supermarket, Sainsbury’s, on 16 May 2012. She states that butter and cheese were on the same aisle whilst in the next aisle were yoghurt and milk. She states that the butter section was divided into three groups “butters”, “butter and spreadable” and “healthier spreads”. Her clients product appeared in the last group next to a product called FLORA CUISINE which is a cooking liquid made from a blend of rapeseed, linseed and sunflower oils. Photographs at exhibits LH1-4 corroborate these claims. An internet search at exhibit LH5 shows that there are a number of Flora

products including a skimmed milk product and a mini drink. She states that a similar situation exists with the opponent's COUNTRY LIFE mark and provides a copy of the relevant website at exhibit LH6. Photographs at a Tesco store, Co-op store and independent grocer at exhibits LH9-LH11 show that similar juxta-positioning is commonplace.

15) Ms Hobbs states that it is now common for vegetable oil spreads and oils to be used in cooking as substitutes for butter. At exhibits LH12 & 13 she provides an extract from WikiRecipes which explains this in addition to various recipes which show vegetable oil spreads and vegetable oils being used instead of butter.

16) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

17) I will first consider the ground of opposition under Section 5(2)(b) of the Act which reads:

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

(a)....

(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.”

18) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

19) The opponent is relying upon its UK trade mark 1588865 and CTM 1228766 which are clearly earlier trade marks. Given the interplay between the dates that the opponent's marks were registered, 29 December 2000 and 5 January 2005, and the date that the applicant's mark was published, 6 November 2009, only the opponent's UK mark is subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

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

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

20) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. In the instant case the publication date of the application was 6 November 2009, therefore the relevant period for the proof of use is 7 November 2004 – 6 November 2009. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

“(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in

particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

21) In its statement of grounds the opponent stated that it was relying upon its trade mark 1588865 and specifically upon the following goods in Class 29: Dairy products; milk and milk products; edible oils and edible fats; butter; spreads. However, I note that on 26 April 2002 the opponent part surrendered its mark. This surrender was granted and published on 24 July 2002. The surrender was worded: “but not including foodstuffs or beverages containing at least 5% herbal product, acidophilus or like cultures and bacteria which are present other than as a naturally occurring part of animal products which are used as ingredients in foodstuffs, and nutritional supplements such as tablets, tonics, capsules, lozenges and the like and not including milk, cream cheese (plain, flavoured or with seasoning and other cheese spreads), yoghurt and cream (fresh, plain or with seasoning).” Therefore, milk is specifically excluded from the specification of the opponent.

22) I must now consider the evidence filed and determine a fair specification for use in the comparison test. In determining a fair specification I take into account the approach set out by Mr Richard Arnold QC (as he was then) acting as the Appointed Person in O/262/06 (*NIRVANA*) where he said:

“58. I derive the following propositions from the case law reviewed above:

(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].”

23) The applicant contends that the opponent’s product is a vegetable oil based spread and differentiates between this and “edible oils” as it states that the latter, in the case of vegetable fats and oils, are lipid materials derived from plants. They also state that oils are liquid at room temperature and fats are solid e.g. lard. More fundamentally they state that an edible oil or fat is an unprocessed compound whereas a “spread” has been cooked or processed. I do not accept that the term “edible oils” would not include oils in the form of a spread which is edible. Clearly the only evidence of use of the opponent’s mark concerns the use on a sunflower oil based spread. Taking all of the above into account, to my mind, a fair specification would be as follows: Edible Oils; Oil based spreads.

24) I now turn to my consideration of a likelihood of confusion. I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

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

(i) 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;

(j) 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.

25) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration

of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

26) In the instant case the opponent has provided evidence regarding use of its marks. It is clear from the evidence filed that the opponent has used its mark VITALITE for at least twenty five years. However, use does not necessarily equal reputation. Whilst the opponent has provided sales figures for the year prior to the mark in suit being filed, these sales figures have not been put into context. The opponent has not commented upon market share or recent advertising. Indeed the only reference is to an advertising campaign which occurred over fifteen years ago. The only evidence which goes to reputation is a report that 69% of people questioned were aware of the brand "when prompted". No explanation of what this means is provided. The evidence filed does not establish that the opponent has a reputation in the mark VITALITE and it cannot therefore benefit from an enhanced reputation. However, the mark is, to my mind inherently highly distinctive for the goods for which it is registered in the case of CTM 1228766 and for edible oils and oil based spreads in the case of 15688865.

27) As the case law in paragraph 24 above indicates I must determine the average consumer for the goods of the parties. I must then determine the manner in which these goods are likely to be selected by the said average consumer. The applicant's specification covers most food items as well as certain beverages whereas the opponent's marks cover a specific subset of foods. Such goods are purchased by all members of society and so the average consumer would be the UK public. Food comes in a variety of forms and varies enormously in terms of cost and complexity. Allergies are more commonplace these days and the average consumer is more likely to be conscious of issues such as calorific content and presence of trans-fats and additives. As such the goods of the two parties will not be purchased or selected without a degree of care. The visual aspect is likely to be the most important, as most will be self selected in a supermarket, petrol station or corner shop. Even when ordering across a shop counter in the few remaining old fashioned shops where the produce is behind the counter, most goods will be displayed behind the counter with the labels on display. I accept that aural issues have a part to play and so must be considered but these would be of secondary importance.

28) I shall first consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Opponent's Trade Mark
	1588865: <b>VITALITE</b>

	CTM 1228766: <b>VITALITE</b>
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29) The applicant contends that its mark consists of three letters in upper case and one in lower case. It does not specify which letters it considers to be in which case. To my mind the letters “i” and “a” are both lower case, the letter “T” is upper case and the letter “v” could be either. The applicant points out that in its mark the letters “T” and “a” are joined, they also claim that the use of a vertical line at the start of the letter “v” “creates the impression that the word is contained in a rectangular shape”. They then demonstrate by drawing a box around the mark. I regard this last submission as ridiculous. They also contrast the different lengths of the marks (four and eight letters respectively). To my mind the average consumer will simply view the applicant’s mark as the word “vita” written in a slightly stylised script. They will view the opponent’s mark as the words “VITA” and “LITE”. Clearly, the two marks share the first four letters. To my mind there are clear visual similarities which outweigh the differences.

30) Phonetically, the applicant contends that its mark will be pronounced as either “VITA” or “VEETA” whilst contending that the opponent’s mark will be pronounced “VI-TA-LITE” or “VI-TA-LI-TE”. Quite why the same consumer would pronounce the applicant’s mark as “VEETA” and yet change this to “VITA” when considering the same four letters is not explained and I do not accept this view. The consumer will see both marks as either “VITA” or “VEETA” marks, and so there is a high degree of similarity which to my mind outweighs the additional word element of the opponent’s mark.

31) Conceptually, the opponent contends that the average consumer will view the “VITA” element of its mark as implying energy. I do not accept this contention and the opponent has not provided any submissions to persuade me otherwise. For its part the applicant contends “the element VITA is non distinctive and descriptive when used in relation to the word LITE”. Although it does not provide any submissions as to why the average consumer would take this view. The applicant also contends that as the opponent does not have a “VITA” brand then it cannot have a “light” or “lite” version of the brand. The average consumer may not be aware of a “VITA” brand, but to my mind when seeing “VITALITE” for the first time the average consumer would simply assume that it was a “light” or “lite” version of the product. They would not be aware of the calorific requirements which makes a brand “light” but have been conditioned by advertising of all types of products to accept that there are regular and light versions. The misspelling of “light” as “lite” would, unfortunately, not cause the average consumer to pause because of the relentless Americanisation of the English language and the deliberate misspelling of words in advertising as part of a “dumbing down” culture.

32) I shall now consider the goods of the two parties. The opposition is limited to only certain of the goods applied for by the applicant and so these alone will be considered. For ease of reference, I set out the relevant specifications of both parties below:

Applicant’s specification	Opponent’s specification
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Milk and other dairy products; edible oils and fats; milk, milk drinks.	CTM 1228766: Class 29: Yellow fat spreads; spreads; edible oils and edible fats; (which edible oils, spreads and fats contain at least one of hydrogenated fats or oils animal fats or oils or synthetic ingredients); but not including foodstuffs or beverages containing at least 5% herbal products, acidophilus or like cultures and bacteria which are present other than as a naturally occurring part of animal products which are used as ingredients in foodstuffs, and nutritional supplements such as tablets, tonics, capsules, lozenges and the like.  UK 1588865: Class 29: edible oils and oil based spread.
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33) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective 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.

34) The question of complementary goods has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the CFI stated:

“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, Case 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).”

35) The applicant points out that in the statement of grounds the opponent itself states that “The opponent’s product is technically not a dairy product”. For its part the opponent states that the term “spreads” includes cheese spreads, also that spreads can be dairy based or oil based and that spreads are typically sold alongside butter and margarine and in close proximity to cheese and milk.

36) Clearly both parties' specifications include the terms "edible oils and fats" and so must be regarded as identical. Turning to the applicant's specification of "other dairy products" this must, to my mind include butter and cheese and so these would be identical to "edible fats" in the opponent's specification. The remaining items in the applicant's specification are "milk, milk drinks". To my mind, the respective uses of milk and milk drinks are obviously different from those of spreads and edible fats. It is by no means certain that the respective users would be the same and the physical characteristics are also significantly different. I am willing to accept that the trade channels will, broadly, be the same and that the goods would be found in reasonably close proximity in the average store. However, the goods are clearly not competitive and it is also clear that one is NOT indispensable or important for the use of the other.

37) To conclude, the following goods are identical "edible oils and fats; other dairy products"; whereas the following are not similar "milk, milk drinks".

38) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There 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. I must consider whether the opponent's trade marks have a distinctive nature, the average consumer for the goods, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods will not be chosen without a degree of care. In the instant case the opponent's mark is inherently highly distinctive for the goods relied upon in the opposition. The similarities in the two parties' marks is such that when used on identical goods there is a likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. However, when used on goods which are not similar there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. **The ground of opposition under Section 5(2)(b) succeeds in respect of edible oils and fats; other dairy products"; but fails in respect of "milk, milk drinks".**

39) I now turn to consider the position under section 5(4)(a) which reads:

"5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

40) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

41) I also note the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself

are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

42) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

43) First I must determine the date at which the opponent's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

44) If the applicant had used its VITA trade mark prior to the application date then this use must be taken into account. It could, for example, establish that the applicant was the senior user, or that there had been common law acquiescence, or that the status

quo should not be disturbed; any of which could mean that the applicant's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. The opponent has claimed, and it is not challenged, that it has used its mark VITALITE on a sunflower oil based spread in the UK since 1983. Although the opponent has only provided sales figures since March 2008 they have shown that despite running an advertising campaign over fifteen years ago, 69% of those questioned remembered the mark. I am prepared to accept that the opponent has shown that it has enjoyed goodwill in its mark with regard to oil based spreads since at least 1996. The applicant has claimed use in the UK since 1985. However, it has not specified precisely what was sold at that initial date, nor when other products began to be sold under the mark in suit in the UK. The earliest use on an item which is part of the registration was in 2006 and relates to its use on tea. The first use on juice drinks, yoghurt drinks and milk drinks was in February 2007. The opposition is limited to the following goods "Milk and other dairy products; edible oils and fats; milk, milk drinks", therefore the relevant date for "milk, milk drinks" is February 2007; whilst the relevant date for "Other dairy products; edible oils and fats" is the date of application 16 September 2009.

45) Earlier in this decision (paragraph 38) I found that if the mark in suit were to be used upon "Other dairy products; edible oils and fats" there was a likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. I take into account the comments of Morritt L J in the Court of Appeal in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said, in effect, that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant's products in the belief that they were the registered proprietor's. To my mind, I must therefore find that there would be misrepresentation if the mark in suit were used upon "other dairy products; edible oils and fats".

46) Also earlier in this decision I determined that if the mark in suit were to be used upon "milk, milk drinks" there was no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.'s judgment in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised

that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

47) Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

48) And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations.”

49) The opponent contended that other parties had used marks upon both milk and butter. Indeed the opponent did exactly this with another of its brands COUNTRY LIFE using it initially upon butter and then expanding into milk. However, I regard the connection between butter and milk as being one which the average consumer would understand and regard as entirely normal, given that butter is made from milk. However, expanding from a sunflower oil based spread into milk and milk products is not a natural step as there is no link other than very tenuous ones, such as sunflower spreads can be substituted for butter; butter and spreads are sold in the same cabinets; and that milk is usually close by as it too needs to be kept refrigerated and shops tend to group refrigeration units together to keep costs down. To my mind there would be no misrepresentation if the mark in suit were used upon “milk, milk drinks”.

50) I must now go on to consider if the opponent has suffered, or is likely to suffer, damage as a result of the misrepresentation set out in paragraph 45 above. Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that “he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill”. Taking all this into account and considering the similarity of the marks, I conclude that the opponent’s goodwill will be damaged in that,

the opponent may, for example, lose business to the applicant because of the existence of a mistaken belief that the applicant's goods are in fact those of the opponent. It would therefore be deprived of its benefits.

51) The opposition under Section 5(4)(a) therefore succeeds in relation to "other dairy products; edible oils and fats" but fails in relation to "milk, milk drinks".

## **SUMMARY**

52) The opposition was limited in that it was only filed in relation to the following goods: "Milk and other dairy products; edible oils and fats; milk, milk drinks."

53) The opponent has succeeded under Sections 5(2) and 5(4)(a) in relation to "other dairy products; edible oils and fats" but also failed under both sections in relation to "milk, milk drinks".

54) The mark can therefore be registered in respect of the following:

In Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruit and vegetables; jellies, jams; preserves, pickles; soy milk, milk, milk drinks, milk substitutes and tofu, soya bean milk in liquid and solid form, soya bean-based food products including sausage, cheese and yoghurt, salad dressing, ice cream, puddings and desserts.

In Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard, pepper, vinegar, sauces, spices; ice; tea and tea drinks; seasonings.

## **COSTS**

55) Both sides have enjoyed a degree of success. I therefore decline to make an award of costs in this case.

**Dated this 29th day of October 2012**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**