

O/0546/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003912640
BY SHENZHEN KAIYAN MEDICAL EQUIPMENT CO. LTD.
TO REGISTER:**

LIGHT VITAMIN

AS A TRADE MARK IN CLASSES 9, 10 & 42

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 442785 BY
OUTSIDE IN (CAMBRIDGE) LIMITED**

BACKGROUND AND PLEADINGS

1. On 17 May 2023, Shenzhen Kaiyan Medical Equipment Co. Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The application was published for opposition purposes on 2 June 2023 and registration is sought for the following goods and services:

Class 9: Ampere-hour meters; Battery testers; Electronic-based instruments for measuring environmental parameters including humidity, mold, bacteria, air quality and water quality; Electronic devices for measuring electric current; Radiation-measuring instruments; Scientific instrumentation for measuring intensity and wavelength of light ; Scientific instrumentation for measuring resistance, voltage, current, frequency and conductivity; Scientific instrumentation for measuring temperature, pressure, humidity, ph load, and force; Scientific measuring instruments, namely, conductivity meters; Voltmeters.

Class 10: Heating pads, electric, for medical purposes; massage apparatus; Electro-stimulation apparatus for use in therapeutic treatment; Apparatus for the electrical stimulation of groups of muscles; Transcutaneous electrical nerve stimulation instruments; Visible light treatment instruments; Apparatus for phototherapy; Medical radiation apparatus; Hot therapy apparatus; Vibration generating apparatus for massage; LED masks for therapeutic purposes.

Class 42: Product safety testing services; Radiation measurement services; Research and development in the field of lighting products, namely, light bulbs, lamps, luminaires, lighting fixtures, LED modules, and LCD backlighting modules; Research and development in the field of light therapy; Testing, analysis and

evaluation of the services of others to determine conformity with certification standards; Testing, analysis, and evaluation of the goods of others to assure compliance with industry standards.

2. The applicant's mark claims partial priority from two trade marks. The first being an EUTM which has a filing date of 5 January 2023 and relates to the class 10 goods. The second is a US trade mark which has a filing date of 21 April 2023 and relates to the class 9 goods and class 42 services. For the purposes of this decision, the relevant date is the earlier priority date, being 5 January 2023.
3. On 30 August 2023, the applicant's mark was opposed by Inside Out (Cambridge) Limited ("the opponent"). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following mark:

Vitamin L

UK registration no. 2425964

Filing date 23 June 2006; registration date 20 April 2007

Relying on all goods, namely:

Class 10: Medical instruments and apparatus; lights and light apparatus for use in the field of light therapy. ("the opponent's first mark");

Class 11: Apparatus for lighting including lighting connected to alarm clocks.

("the opponent's mark").

4. The opponent's position under its section 5(2)(b) ground is that the marks are highly similar, the mark relied upon is highly distinctive and the goods and services at issue are either identical or similar to the opponent's goods. As a result, the opponent claims that confusion between the marks at issue is more than likely.

5. Under the section 5(3) ground, the opponent claims that its mark enjoys a reputation for all of the goods for which it is registered. Together with the similarity of the marks and the identity/similarity of the goods and services at issue,¹ the opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the opponent's mark. In addition, the opponent claims that use of the applicant's mark would also have an irreversible dilutionary effect on the ability of the opponent's mark to perform the essential function of a trade mark. The opponent also argues that in the event that the applicant's goods and services are of a lower quality, the mis-association between the marks would almost certainly cause lasting and irreversible damage to the opponent's reputation.
6. The applicant filed a counterstatement wherein it denied the claims against it and made a request that the opponent provide proof of use for its mark.
7. The applicant is represented by Dynham Limited and the opponent is represented by Harrison IP Limited. Only the opponent filed evidence in chief. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

¹ Though I note that the opponent maintains that even if the goods/services are not identical or similar, the provisions of section 5(3) would still apply.

EVIDENCE

9. The opponent's evidence in chief came in the form of the witness statement of Jonathan Cridland dated 4 January 2024. Mr Cridland is the company secretary and Chief Executive Officer of the opponent; positions he has held since 2006. Mr Cridland's evidence is accompanied by nine exhibits, being those labelled JC1 to JC9, and was adduced in order to prove genuine use of the opponent's mark and to demonstrate the existence of a reputation in the same.
10. I do not intend to summarise the evidence in full here (or the submissions of the parties, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

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

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

(a) a registered trade mark or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected

international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

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

12. Section 6A is also relevant. It reads:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

13. Section 100 of the Act is also relevant. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. Given its earlier filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process over five years prior to the priority dates of the applicant’s mark. As set out above, the applicant requested that the opponent provide proof of use in respect of its mark. As a result, the opponent’s mark is subject to the proof of use assessment.

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer*

BV [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) 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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not

suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period ending with the priority date of the applicant’s mark. As there are two priority dates, there are two relevant periods, being 6 January 2018 to 5 January 2023 and 22 April 2018 to 21 April 2023. Given the significant overlap between them, I will simply treat the relevant period as covering both, so will deem it as 6 January 2018 to 21 April 2023. For the avoidance of doubt, the overlap is such that any finding in respect of one relevant period will apply to both.

17. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”² because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Evidence of use

18. The evidence begins by setting out that ‘Vitamin L’ is not only a leading lighting product for the treatment of SAD (presumably seasonal affective disorder) and mood disorders but it is also among the top-selling lighting products in the UK. It is claimed that this is a very competitive market segment but offers no supporting evidence for this claim.

² *Jumpman* BL O/222/16

19. The opponent confirms that its mark relates to, and is applied to, a slim portable lamp that has the appearance of an electronic tablet such as an iPad or Kindle. It is claimed that the lamp may be used for general decorative purposes or as a device for treating seasonal affective disorder or improving mood.
20. A range of sample invoices are provided showing sales of the Vitamin L light to different Amazon locations within the UK.³ The invoices are dated between 5 October 2018 and 25 November 2022 and cover approximately 30 pages of evidence. While no breakdown of the invoices is provided in Mr Cridland's narrative evidence, it is noted that each invoice involves what can only be described as bulk orders of the opponent's product. For example, the majority of the invoices all show sales of at least 100 goods with some invoices reaching 800 or over 1,000 products. In respect of these invoices, I will say here that I do not consider it appropriate for me to undertake a calculation of the invoices to determine the level of use covered. To do so would involve me formulating the opponent's case on its behalf and I consider it reasonable to expect that if the opponent wished to rely on an overall figure, it should have provided the same.
21. Further to the Amazon invoices above, it is noted that the opponent has provided a printout taken from Amazon.co.uk that shows its product listed for sale.⁴ The printout is undated but shows the date the product was first available on Amazon as being 3 July 2017. The opponent has drawn my attention to the fact that the product has over 2,000 ratings via the platform and that it ranks number two in the category of 'SAD Lights'. Dealing with these in turn, it is my understanding that the ratings are global ratings and could stem from purchases outside of the UK or from other Amazon platforms. In respect of the category, I have nothing to suggest the size of the category at issue and, further, whether this is a category that relates to global use. That being said, the repeat and voluminous invoices discussed above are clearly indicative of an ongoing level of sales via the Amazon platform. On this

³ JC2

⁴ JC3

point, I will say that while no sales figures are provided, it is clear that sales have consistently been made during the relevant period and this can be reasonably inferred by the repeat orders from Amazon UK itself.

22. The evidence goes on to discuss the fact that the opponent's Vitamin L goods were sold via John Lewis and Boots throughout the relevant period. Evidence showing the goods listed for sale via John Lewis are provided in evidence and I note that these have been obtained from the internet archive facility, the Wayback Machine, and cover the years 2019 to 2022.⁵ As for Boots, it is explained that the opponent was unable to obtain archived pages showing the goods for sale. While the printouts would have been helpful, I have no reason to disbelieve Mr Cridland's unchallenged statement confirming that the applicant sold its goods via Boots during the entirety of the relevant period.

23. As was the case with the Amazon evidence, there is no confirmation as to how many sales were made via John Lewis or Boots. Saying that, it is not controversial to suggest that these two retailers are large, nationwide retailers that are well-known. As such, I consider it reasonable to infer that by being sold via these retailers throughout the entirety of the relevant period is sufficient to demonstrate an ongoing and reasonable level of sales.

24. In respect of press coverage, I note that the opponent has provided approximately 100-pages of evidence covering its products appearances in various publications.⁶ I have no intention to discuss these in full but note that all but one printout shows an article within the relevant period (the lone exception being 'Health and Wellbeing' on 3 January 2018, being just days before the relevant period). It is noted that the press coverage includes a range of UK-based publications wherein the Vitamin L product is discussed or recommended to the publication's readers. The publications include national newspapers such as Metro, Evening Standard,

⁵ JC4

⁶ JC7

The Sunday Post, The Times and The Guardian, as well as many others. There are also appearances in tech and woman focused publications such as 'T3 Magazine' and 'Woman', respectively. Lastly, I note that there are some localised publications included such as 'Cornwall Life', 'Local Answers' (being confirmed in evidence as a Cheltenham based publication) and 'insideKENT'.

25. In addition to the above, the press coverage evidence also covers online publications such as 'Tech Advisor', the 'British Vogue' website and 'TimeOut', amongst many others.⁷ Again, I have no intention to discuss these in full but note that they feature the opponent's Vitamin L product and are dated during the relevant period.

26. In respect of the press coverage, it is noted that the articles provided all discuss the 'Vitamin L' light as being something used to improve mood and to combat seasonal affective disorder. It also features in various 'Health and wellbeing' sections of the publications.

27. Lastly, there is a range of additional printouts from the opponent's brochures that show various goods offered by the opponent.⁸ Some of these are the Vitamin L product but some others are shown as being under the brand 'Halo', 'Brazil' or 'Zest'. The brochures cover the years 2018 to 2022. As was the case with the evidence of press coverage, I see no reason to discuss this evidence in detail save to say that the goods are all categorised as either being 'Light Therapy' goods or 'SAD and energy lights'. Further, it is noted that one brochure confirms that the opponent is a specialist in light therapy and only light therapy.⁹

⁷ JC8

⁸ JC9

⁹ See pages 242 and 247 at JC9

Assessment of the evidence

28. Having considered the evidence as a whole, I do not consider it controversial to suggest that it is missing a range of key information usually adduced in order to prove genuine use. I say this because the evidence lacks any information as to unit sales or turnover in the UK. Further, there is no evidence as to the opponent's advertising spend and neither is there anything outside of a number of brochures to suggest the level of advertising or marketing activities undertaken. Saying all that, the absence of this sort of evidence is not fatal to the opponent's case. In the present case, the opponent has provided evidence of repeat custom with Amazon UK, being a major retailer. Additionally, the opponent also confirmed that its Vitamin L goods were sold via two major UK-based retailers. Even though I cannot determine how much sales stemmed from these business avenues, I consider it reasonable to infer that the opponent engaged in a reasonable and consistent level of sales. In addition, the press coverage provided is extensive and consistent to the point that it supports the fact that the opponent was selling its goods in the UK.
29. Taking all of the above into account, I am of the view that while the evidence could have benefitted from more clarity as to sales/advertising, it is sufficient as a whole to demonstrate that the opponent has sought to create or preserve a market share for its goods in the UK. Saying that, however, I am not willing to find that the opponent may rely on all of the registered goods covered by the earlier mark. My reasons follow.
30. It is noted that the opponent's evidence sets out that its Vitamin L goods may be used for decorative purposes. However, I do not consider that this is supported by the evidence. I say this because the entirety of the evidence points to the fact that the goods have a specific purpose for enhancing the user's mood and treating depression and/or seasonal affective disorder. This is not only confirmed by the nature of the press coverage provided but it is also confirmed by the opponent's own brochures which, as I have explained above, set out that the opponent's focus

is solely on light therapy. Additionally, I note that the brochures refer to the goods as a 'Class 11a' medical device¹⁰. Due to its advertised medical nature, I find that this product falls within class 10 of the Nice Classification of goods. As the only product covered by the evidence, I do not consider that the opponent has sufficiently demonstrated any use of goods in class 11.

31. In terms of the actual class 10 goods relied upon, I note that the opponent's specification includes the broad term of "medical instruments and apparatus". Such a term can cover any type of medical instrument and given the nature of the opponent's evidence (in that it focuses on one product under the Vitamin L brand), I do not consider it appropriate to permit the opponent to rely on this term going forward.

32. I turn lastly to the remaining term in class 10, being "lights and light apparatus for use in the field of light therapy". As discussed above, the opponent's goods are clearly intended to be used for various types of light therapy and, as a result, I consider that this term reflects a fair description of the goods actually used. Further, it is my view that this is how the average consumer for the opponent's goods would describe the use demonstrated in evidence. As such, and bearing in mind the case law in respect of a fair specification,¹¹ I consider that the opponent may only proceed in respect of this opposition in reliance upon the following goods:

Class 10: Lights and light apparatus for use in the field of light therapy.

Section 5(2)(b): legislation and case law

33. Section 5(2)(b) of the Act reads as follows:

¹⁰ On this point, I will say that the reference to Class 11a appears to be the opponent's own distinction and not a reference to the Nice Classification of goods that would possibly be relevant here.

¹¹ See the cases of *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

“(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 or association with the earlier trade mark.”

34. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

35. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 be dominated by one or more of its components;
- (f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

36. The competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
<p><u>Class 10</u> Lights and light apparatus for use in the field of light therapy.</p>	<p><u>Class 9</u> Ampere-hour meters; Battery testers; Electronic-based instruments for measuring environmental parameters including humidity, mold, bacteria, air quality and water quality; Electronic devices for measuring electric current; Radiation-measuring instruments; Scientific instrumentation for measuring intensity and wavelength of light ; Scientific instrumentation for measuring resistance, voltage, current, frequency and conductivity; Scientific instrumentation for measuring temperature, pressure, humidity, ph</p>

	<p>load, and force; Scientific measuring instruments, namely, conductivity meters; Voltmeters.</p> <p><u>Class 10</u></p> <p>Heating pads, electric, for medical purposes; massage apparatus; Electro-stimulation apparatus for use in therapeutic treatment; Apparatus for the electrical stimulation of groups of muscles; Transcutaneous electrical nerve stimulation instruments; Visible light treatment instruments; Apparatus for phototherapy; Medical radiation apparatus; Hot therapy apparatus; Vibration generating apparatus for massage; LED masks for therapeutic purposes.</p> <p><u>Class 42</u></p> <p>Product safety testing services; Radiation measurement services; Research and development in the field of lighting products, namely, light bulbs, lamps, luminaires, lighting fixtures, LED modules, and LCD backlighting modules; Research and development in the field of light therapy; Testing, analysis and evaluation of the services of others to determine conformity with</p>
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	certification standards; Testing, analysis, and evaluation of the goods of others to assure compliance with industry standards.
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37. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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 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 or services 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 or services in the same or different sectors.

39. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

40. I note that in putting forward its position in respect of the goods and services comparison, the opponent has provided a table wherein it has highlighted where it considers the goods/services to be identical/similar. As for the applicant, I note that its submissions maintained its position that the goods/services were dissimilar and noted the fact that the opponent has failed to prove otherwise in its evidence. While I do not intend to discuss the submissions of the parties any further, I can confirm that I have taken them into account in making the following comparison.

Class 9

Ampere-hour meters; Battery testers; Electronic-based instruments for measuring environmental parameters including humidity, mold, bacteria, air quality and water quality; Electronic devices for measuring electric current; Radiation-measuring instruments; Scientific instrumentation for measuring intensity and wavelength of light; Scientific instrumentation for measuring resistance, voltage, current, frequency and conductivity; Scientific instrumentation for measuring temperature, pressure, humidity,

ph load, and force; Scientific measuring instruments, namely, conductivity meters; Voltmeters.

41. The opponent argues that the above goods are either highly similar or similar to between a low and moderate degree with its own goods. The argument as to high similarity is based on the claim that the above goods can be said to be used for health or wellbeing purposes and will be sought by the same consumer and sold via the same trade channels as its own goods. In terms of the claim as to a low to moderate degree of similarity, there is no reasons given.

42. While the arguments put forward by the opponent are noted, I disagree with the reasoning provided. I appreciate that goods used for health can be used to monitor the user's temperature and that radiation goods may be used to obtain x-ray images, for example. However, I do not consider that the above terms can be construed to cover such goods. Firstly, the above goods are designated in class 9, which are not health or wellbeing goods in the way claimed by the opponent. Secondly, the plain reading of the above terms is that they are for technological or scientific purposes.¹² As a result, I do not consider that the above goods can be said to be used for the purpose of healthcare or well-being. In addition, I disagree that the above goods will be provided by the same undertaking as those who provide the holder's goods. On this point, I note that the opponent has provided no evidence in support of such a claim. Lastly, in terms of user, I do not consider that there is any sufficient degree of overlap here. Even if there were, this alone is not sufficient to warrant a finding of similarity between the goods. As a result, I find that these goods are dissimilar.

¹² On this point, see *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) which set out that it is not justifiable to strain the language of terms unnaturally so as to produce a meaning that does not cover the goods in question.

Class 10

Heating pads, electric, for medical purposes; massage apparatus; Electro-stimulation apparatus for use in therapeutic treatment; Apparatus for the electrical stimulation of groups of muscles; Transcutaneous electrical nerve stimulation instruments; Medical radiation apparatus; Hot therapy apparatus; Vibration generating apparatus for massage.

43. The applicant submits that these goods are similar to a high degree with its own.

The reasons for this are the same as those that I have discussed at paragraph 41 above. While there is some overlap on the basis that, broadly speaking, all of the goods have medical benefits, they are all somewhat specialist in nature. As such, and without anything further from the opponent, I am not willing to simply find that there exists any meaningful overlap in purpose simply because they are medical goods. I say this because even if goods may be broadly for medical purposes, this does not mean that any and all medical goods overlap in purpose. This would, in my view, offer far too broad a level of protection for medical goods. As for trade channels, I repeat what I have said above in that the goods of the applicant are somewhat specialist and without anything further from the opponent, I am not willing to find that it is common in the trade for these goods to overlap in trade channels. As for user, I appreciate that although the selection will be in different contexts (one being for light therapy, the other being for pain relief) someone looking for a light therapy light of the opponent may also select a heating pad of the applicant, for example. However, this is a relatively fleeting overlap due to the broad nature of the userbases for both parties' goods. Taking all of this into account, I am of the view that the above goods are dissimilar to those of the opponent.

Visible light treatment instruments; Apparatus for phototherapy.

44. The opponent submits that the above goods are identical to its own. Given that a light treatment instrument can cover a light for light therapy purposes and on the basis that, as far as I understand it, phototherapy and light therapy are terms used for the treatment of the same ailments, I am inclined to agree. As a result, I find that because the opponent's term falls within the applicant's, these goods are identical under the principle outlined in *Meric*.

LED masks for therapeutic purposes.

45. The opponent submits that the above goods are identical to its own goods. It is my understanding that the above term is a lighting apparatus for use in light therapy, I agree with the opponent and hereby find that the above goods and identical under the principle outlined in *Meric* with the applicant's goods. However, if I am wrong to find identity, I consider that there is still a medium degree of similarity between the goods on the basis that they overlap in purpose, user and trade channels.

Class 42

Research and development in the field of lighting products, namely, light bulbs, lamps, luminaires, lighting fixtures, LED modules, and LCD backlighting modules; Research and development in the field of light therapy.

46. The above services relate to light therapy and even where this is not expressly stated, they are broad enough to cover services relating to the same. While that may be the case, the above services differ in nature and method of use when compared to the opponent's goods. In addition, the purpose of the above goods is to research and develop products. This is not the same as the purpose of the opponent's goods, which are intended to improve the user's mood or combat seasonal affective disorders. In terms of trade channels, I appreciate that the

provider of the opponent's goods is also likely to undertake research and development of such products, I have nothing before me to suggest that those undertakings would actually offer those services to third parties. As such, I do not consider that there is any meaningful overlap in trade channels. Turning to user, I do not consider that the user of the opponent's goods would look to select research and development services for those same products, or vice versa for that matter. Lastly, in considering complementarity, I accept that the research and development of products (in this case, light therapy goods) is important to those products themselves. However, I do not consider this relationship is one that would give rise to a finding of complementarity between them. I say this because the consumer who selects the opponent's goods would not encounter the applicant's services so would ultimately not consider them to originate from the same undertaking in the way describe by the case law.¹³ Taking all of this into account, I find that these services are dissimilar to the opponent's goods.

Product safety testing services; Radiation measurement services; Testing, analysis and evaluation of the services of others to determine conformity with certification standards; Testing, analysis, and evaluation of the goods of others to assure compliance with industry standards.

47. I see no obvious reason why any of the above services share any degrees of overlap with the opponent's goods. Plainly, they differ in nature, method of use and purpose. Further, without anything before me to demonstrate any overlap in trade channels or user, I am not willing to find that there is any. Lastly, the goods and services are neither complementary nor in competition. As a result, I find that these services are dissimilar to the goods of the opponent.

¹³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Conclusion of the goods and services comparison

48. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) grounds.¹⁴ In light of my findings above, it follows that the present ground of opposition fails against the dissimilar goods and services. It will, however, proceed against the following goods, being those I have found to be identical:¹⁵

Class 10: Visible light treatment instruments; Apparatus for phototherapy; LED masks for therapeutic purposes.

The average consumer and the nature of the purchasing act

49. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

¹⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

¹⁵ I appreciate that I have made a backup finding in respect of similarity for some goods. Regardless, the opposition will proceed in respect of the same.

50. The applicant has filed submissions in respect of the average consumer for the goods in the parties' marks' specifications. While noted, they are of no real assistance at this point of my decision on the basis that the argument relates to a range of goods/services that I have found to be dissimilar. However, where the submissions relate to the goods that remain at issue, the applicant submits that the average consumer base consists of members of the general public who are seeking to manage their health and well-being. I agree and hereby find that the average consumer of the goods at issue will be members of the general public who are looking for light therapy treatments. I have nothing to suggest that the goods are available via specialist medical retailers and, as such, I find that the goods are likely to be sold through a range of ordinary retailers, either in physical stores or online.¹⁶ In physical environments, the goods will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will take place for online purchases where the consumer will select the goods having viewed an image on a webpage. The selection of these goods is, therefore, primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants.

51. The goods at issue are not expensive items and, as far I understand it, they will be selected on a relatively infrequent basis. In respect of the level of attention paid, the opponent submits that the goods will bring no special degree of sophistication. As such, the opponent's position is that the degree of attention paid will be average. I agree on the basis that the goods are not overly specialist and would, instead, be selected after having given due consideration to a range of ordinary factors. While the reference to an average degree of attention is noted, I would ordinarily categorise this as medium and will proceed on this basis.

¹⁶ I note that this was even demonstrated in the evidence.

Comparison of the marks

52. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

53. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

54. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

55. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
Vitamin L	LIGHT VITAMIN

56. I have submissions from both parties in respect of the comparison of the marks. While I do not intend to reproduce those in full here, I can confirm that I have given them due consideration.

Overall impression

57. The applicant's mark is a word only mark that consists of the words 'LIGHT VITAMIN'. As for the opponent's mark, this is also a word only mark that consists of the word 'Vitamin' followed by the single letter 'L'. There are no other elements that contribute to the overall impression of the marks, which lie equally across the words/letters within them.

Visual comparison

58. As the marks are word only, they are capable of being presented in upper case, lower case or in any customary combination of the two. As such, the different use in case across the marks is not a point of visual distinction between them. Visually, the marks at issue share the word 'Vitamin'. This is the first word of the opponent's mark and the second word of the applicant's. The marks differ in the letter 'L', which is the second element of the opponent's mark, and the word 'LIGHT', which is the first word in the applicant's mark. I appreciate that the word 'LIGHT' includes the letter 'L', however, I do not consider that the shared use of a single letter in the body of another word is a sufficient point of similarity. Taking all of this into account and bearing in mind that consumers tend to focus on the beginnings of marks,¹⁷ I find that the marks at issue are visually similar to a medium degree.

Aural comparison

59. Aurally, both parties' marks will be pronounced in full and in the ordinary way. Therefore, both marks are four syllables in length with the first three syllables of

¹⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

the opponent's mark being reproduced identically in the last three syllables of the applicant's mark. As for the remaining syllables (being the last syllable of the opponent's mark and the first syllable of the applicant's mark), I find that despite the letter 'L' appearing in the word 'LIGHT', the syllables are different. Taking all of this into account and again remind myself of the fact that consumers focus on the beginnings of marks, I find that the marks are aurally similar to a medium degree.

Conceptual comparison

60. The opponent submits that the 'L' in its mark is meant to stand for 'Light'. In respect of this argument, I note that the opponent's mark will be viewed on lighting goods. I have given consideration as to whether this is something that supports the opponent's case. However, in doing so, I remind myself of the comments of Professor Phillip Johnson who, sitting as the Appointed Person in the case of *EMILIANA* (BL O/054/22) set out that an assessment of the conceptual similarity of marks is usually done without reference to the goods or services at issue. As a result, I do not consider the fact that the opponent's goods are lighting goods assists this argument. Overall, I appreciate that this may very well have been the intention of the opponent, however, I am not convinced that it is something that would be immediately grasped by consumers.

61. In considering the opponent's mark as a whole, I consider that it will be viewed as a type of vitamin, being one under the letter 'L'. In respect of vitamins, I appreciate that consumers will be aware of vitamins such as A, B, C and D, but not necessarily a vitamin labelled as 'L'.¹⁸ While that may be the case, this does not take away from the understanding that the opponent's mark is a reference to a type of vitamin. I say this because I do not consider that average consumers are likely to be aware of what vitamin designations are real and what are not. As for the applicant's mark,

¹⁸ On this point, I note that the opponent's submissions confirm that there is no Vitamin L in reality.

I am of the view that consumers will simply view it as either a reference to a vitamin that is light in weight or a non-sensical reference to a vitamin that gives off light.

62. In comparing the marks, the shared concept of the word 'Vitamin' is one that will be readily identified by the consumer. That being said, I consider that this will be offset somewhat by the differing references to the word 'LIGHT' and the letter 'L'. Overall, I consider that the marks are conceptually similar to a medium degree.

Distinctive character of the opponent's mark

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

64. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence to that effect. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent’s mark has been enhanced through use. Before doing so, I will consider the inherent position.

65. The opponent’s mark is a word only mark, being ‘Vitamin L’. I have set out above that the opponent submits that the letter ‘L’ will be understood as meaning ‘Light’. In making this argument, the opponent claims that this will be viewed as alluding to the properties of the opponent’s goods. As was the case above, I do not agree with this submission but even if I were, it seems an unusual one for the opponent to pursue. I say this because if it was found that ‘L’ meant ‘Light’ and alluded to the goods relied upon, the mark would ultimately be found to possess a lesser degree of distinctive character.

66. In light of the above, I find that the opponent’s mark has no connection to the goods relied upon by the opponent. Therefore, it cannot be said to be descriptive or allusive to the goods at issue. Having said that, the connection to a type of vitamin, albeit an unknown one is not particularly remarkable on the basis that this is something that attracts a relatively ordinary meaning. Taking all of this into account, I find that the opponent’s mark enjoys a medium degree of inherent distinctive character.

67. I turn now to consider the position in respect of an enhanced degree of distinctive character. In considering this issue, I refer to the evidential summary I have prepared at paragraphs 18 to 27 above and rely on the same here. While I have accepted that the evidence was sufficient to give rise to a finding of genuine use, I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking. In the present case, I am of the view that the lack of precision and clarity in the opponent's evidence as to any actual level of sales achieved in the UK is such that it prevents me from finding that its mark enjoys an enhanced degree of distinctive character. As above, I was satisfied that the level of use was genuine but anything beyond that would, in my view, be the result of an unreasonable inference in the opponent's favour. Such an inference would be inappropriate in the circumstances on the basis that there is no actual level of use before me that would allow me to categorically be able to say that consumers would be aware of the mark as a result of the use made of it. For the avoidance of doubt, I do not consider that the press coverage evidence alone is sufficient to overcome the issues I have discussed above.

68. As a result of everything I have said above, I find that the opponent's mark does not benefit from an enhanced degree of distinctive character. Therefore, I find that the inherent position applies.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

70. In respect of the goods at issue, I have found them to be identical, though I appreciate that if some goods are not identical, they are similar. The average consumer base is formed of members of the general public who will select the goods by primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. I have found the marks to be visually, aurally and conceptually similar to a medium degree. Lastly, I have found the opponent's mark to possess a medium degree of inherent distinctive character.

71. Taking all of the above factors into account and even bearing in mind the principle of imperfect recollection, I do not consider that the marks at issue will be misremembered or inaccurately recalled for one another. While the shared use of the word 'Vitamin' will be noticed, neither the beginning word of the applicant's mark, being 'LIGHT', or the letter 'L' at the end of the opponent's mark will be ignored. As such, I am of the view that when seeking to remember the marks, consumers will pin their recollection of the applicant's mark on the entirety of its verbal element, being 'LIGHT VITAMIN'. Further, I do not consider that the shared conceptual hook of a reference to a 'Vitamin' will be something that consumers will

see as remarkable to the point that they would be directly confused by its shared use. Lastly, the fact that the beginnings of the marks are different is something that further assists the conclusion that the marks will not be directly confused. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even when considered on identical goods.

72. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

73. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

74. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

75. While the common use of the word 'Vitamin' will be noticed, I do not consider that it is so strikingly distinctive, even on goods with no real connection to vitamins, that average consumers would believe that only one undertaking would use it. In considering the two marks, I do not consider that the applicant's mark can be said to be one that simply adds a non-distinctive element to the earlier mark. I say this because it not only has a different element (the word 'LIGHT', not the letter 'L') but

the order of the elements within the marks differs. Therefore, I do not consider that the scenario set out in category (b) of *L.A. Sugar* (cited above), is applicable here. Moving to the last category of confusion set out by Mr Purvis Q.C., I see no reason why consumers would consider it logical for an undertaking that uses the mark 'Vitamin L' to change the letter 'L' to the word 'LIGHT' and then rearrange its mark so as to move that element from the end of the mark to the beginning. Conversely, I am of the view that the same applies when consumers consider the applicant's mark first. While I have set out above that the categories in *L.A. Sugar* are not exhaustive, the opponent has not provided any additional arguments in respect of the instances where indirect confusion would occur and, without such, I am not willing to formulate the opponent's argument on its behalf. Instead, I will simply say that if any additional scenarios existed then it was for the opponent to argue as such. Taking all of this into account, I find that there exists no likelihood of indirect confusion, even when the marks are considered on identical goods.

76. The present ground fails and I will now proceed to consider the remaining ground of opposition.

Section 5(3)

77. Section 5(3) of the Act states:

"5(3) A trade mark which –

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

78. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

79. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the application. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

80. I have assessed the opponent's evidence of use at paragraphs 18 to 27 above. While I do not intend to reproduce it in full here, I remind myself that the opponent sold its goods via Amazon, John Lewis and Boots during the relevant period. While that may be the case, the opponent has not provided any actual level of sales and neither has it provided any evidence as to marketing spend or advertising campaigns, for example. This is a significant issue for the opponent as I am wholly unable to determine the actual level of use undertaken by the opponent prior to the relevant date. I say this whilst also bearing in mind the presence of the opponent's press coverage. As was the case above, I remind myself that while I was satisfied that the evidence crossed the threshold for genuine use, the current assessment is, like the enhanced degree of distinctive character assessment, considerably more onerous on the opponent. As a result, and following similar reasons to those I have discussed at paragraph 67 above, I am not satisfied that the evidence is sufficient to warrant a finding that the opponent enjoyed a reputation in its mark as at the relevant date. Therefore, my primary position is that the section 5(3) ground fails at the first hurdle.

81. The above being said, even if my primary finding was incorrect and there were to exist a reputation in the opponent's mark, it would only be of a relatively weak strength. Even taking into account this level of reputation, I do not consider that the opposition under the present ground would succeed in any event. I say this because even if a reputation was to exist in the opponent's mark, there would be no link. In order to demonstrate this, I will proceed to discuss the ordinary factors for considering whether a link exists, being those set out in the case of *Intel*.

The degree of similarity between the conflicting marks.

82. The marks at issue are visually, aurally and conceptually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

83. While some goods are identical (namely "visible light treatment instruments", "apparatus for phototherapy" and "LED masks for therapeutic purposes", though I appreciate that if the latter term is not identical, it is similar to a medium degree), the remaining goods and services of the applicant are dissimilar. I appreciate that for some dissimilar goods, the relevant section of the public that selects them will be the same or relatively close (such as the dissimilar class 10 goods, for example). However, this is not the case for the applicant's services which will be selected solely by business users.

The strength of the earlier mark's reputation.

84. While my primary finding was that there exists no reputation in the opponent's mark, I have proceeded to this point on the basis that there exists a reputation that is only relatively weak in strength.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

85. I have found that the opponent's mark is inherently distinctive to a medium degree. This has not been enhanced to any degree.

Whether there is a likelihood of confusion

86. There is no likelihood of either direct or indirect confusion between the marks.

Conclusion on link

87. While the lack of confusion does not mean that the present ground automatically fails, I am of the view that upon taking all of the above factors into account, the marks at issue would not be linked. I say this because neither the reputation or distinctive character of the opponent's mark are significant enough to warrant a finding that the shared use of the ordinary dictionary word 'VITAMIN' is such that consumers would believe that the marks originate from the same or economically linked undertakings. In addition, I do not consider that these factors would result in the consumer being caused to wonder if there existed any link between the marks at issue. Bearing this in mind and repeating what I have said regarding the differences between the marks when considering confusion at paragraphs 71 to 75 above, I see no reason why consumers, even those aware of the opponent's mark, would believe that there exists any link between the marks.

88. Without a link between the marks, there can be no damage. Therefore, even if I was wrong to find that there exists no reputation in the opponent's mark, the opposition under the section 5(3) ground fails in any event.

CONCLUSION

89. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant's mark may proceed to registration for all of the goods and services applied for.

COSTS

90. The applicant has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,200 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing the counterstatement:	£250
Considering the opponent's evidence:	£600
Filing written submissions in lieu:	£350
Total:	£1,200

91. I hereby order Inside Out (Cambridge) Limited to pay Shenzhen Kaiyan Medical Equipment Co. Ltd. the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of June 2025

A COOPER
For the Registrar