

O-524-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3271747
BY EVOLUTION SLIMMING LIMITED
TO REGISTER THE TRADE MARK**



**IN CLASSES 3 AND 5
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000823
BY CORE EVOLUTION LIMITED**

BACKGROUND

1. On 20 November 2017, Evolution Slimming Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods:

Class 3: Cosmetics

Class 5: Food supplements

2. The application was published for opposition purposes on 15 December 2017.

3. The application is opposed by Core Evolution Limited (“the opponent”) under the fast track procedure; the opposition is directed at the applied for goods in class 5. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon, inter alia, the goods in Class 5 shown in paragraph 14 below in the following European Union Trade Mark (EUTM) registration:

No. 13004131 for the mark EVOLUTION, which was filed on 17 June 2014 and was registered on 19 August 2015.

4. The applicant filed a counterstatement in which denies the ground of opposition. As these are the only comments I have from the applicant, they are reproduced below in full:

“Evolution Slimming Ltd has been incorporated since 5 November 2007 in the food supplements market; as a retailer of own branded weight management supplements.

Core Evolution Ltd changed their name to 'Evolution Organics Ltd' in May 2017 according to Companies House, and the services changed to food supplements, after starting out as a physical wellness service.

Evolution Slimming Ltd has been trading in the food supplements market with the brand logo in trade mark application UK00003271747 since 2007, aimed at

the weight management supplement market. Evolution Organics, on the other hand, do not sell their own branded products and promote products in general wellbeing, household & pet market.

We disagree that the logos are similar (in fact their logo does not appear to be trade marked). The representation of their trade mark is written as the word EVOLUTION in their opposition, however, the word Evolution is a common word with many brand name uses. Our application is for the phrase and logo 'EVOLUTION SLIMMING'.

It is clear from our logo, product range and branding that we are in no way aiming to be affiliated with Core Evolution Limited and do not agree with their opposition to our application”.

5. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

8. In these proceedings the opponent is represented by Laytons LLP; the applicant represents itself. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) of the Act states:

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

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

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

10. An earlier trade mark is defined in Section 6 of the Act, 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 or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11. The opponent’s mark is an earlier trade mark within the meaning of Section 6(1) of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon it without having to demonstrate genuine use.

Section 5(2)(b) case law

12. 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 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

13. 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:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

14. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (GC) 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 fur 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”.

15. The competing goods are as follows:

Applied for goods	Earlier goods
<p>Class 5: Food supplements</p>	<p>Class 5: Sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Plasters, materials for dressings; Disinfectants; Pharmaceutical preparations; dietetic substances for medical use; diabetic foodstuffs; herbal preparations for medical purposes; herbal supplements and herbal extracts; herbal beverages for medicinal use; vitamins, vitamin preparations; minerals, mineral preparations; vitamin and mineral food supplements; food supplements; food and beverage products for medically restricted diets; all of the aforesaid goods being organic produce or made from organic produce for human consumption; none of the aforesaid goods relating to dentifrices and bleaching preparations for the teeth</p>

16. As can be seen from the *Meric* case cited above, where the goods of the earlier mark are included in a more general broader category of goods, they are identical. In the present case this principle applies since the applied for *food supplements* are broad, and are therefore included and identical to the opponent's *dietary supplements for humans and animals* (subject to the limitation "*all of the aforesaid goods being organic produce*").

17. Notwithstanding the above, there is a further point I must consider. As pointed out by the opponent in its submissions, the opponent's specification is qualified by the following limitation "*all of the aforesaid goods being organic produce or made from organic produce for human consumption; none of the aforesaid goods relating to dentifrices and bleaching preparations for the teeth*". As set out in the Tribunal Practice Notice (TPN) 1/2012, there are instances whereby a limitation to the list of applied for goods may be sufficient to avoid a likelihood of confusion. Therefore, for the benefit of the applicant, who is not professionally represented, I shall consider whether a limitation (to the applied for specification) is possible.

18. Leaving aside the limitation "*none of the aforesaid goods relating to dentifrices and bleaching preparations for the teeth*", which has no impact on the matter I have to consider, the limitation "*all of the aforesaid goods being organic produce or made from organic produce for human consumption*" is more problematic. This is because that limitation raises the issue of i) whether the opponent's goods are effectively limited to goods for human consumption and if so, ii) whether I should give some thoughts to limiting the specification applied for to food supplements for animals (as opposed to food supplements for human consumption) so that it would exclude confusion on the part of the consumer. Neither parties have made submissions on the point. Having carefully considered the matter, I do not consider a fall-back position, which avoids a likelihood of confusion, to be possible for the following reasons.

19. The starting point in my consideration is that the opponent's specification includes goods for animals and veterinary use, namely *dietetic food and substances adapted for [...] veterinary use* and *dietary supplements for [...] animals*. This is followed by the limitation "*all of the aforesaid goods being organic produce or made from organic produce for human consumption*". The effect of this limitation means that the goods

are not limited to goods for human consumption, otherwise the specification would be nonsensical because, quite obviously, dietetic food and substances adapted for veterinary use and dietary supplements for animals could not be for human consumption. It makes no sense to interpret the limitation and the specification to contradict each other. In my view the use of the preposition “or” renders possible to interpret the phrase “*all of the aforesaid goods being organic produce or made from organic produce for human consumption*” so as to limit the opponent’s goods to products for human consumption only where the goods are not explicitly qualified as goods for animals.

20. On that basis, I find that the best case for the opponent rests on *dietary supplements for humans and animals* (to which the limitation “*all of the aforesaid goods being [...] made from organic produce for human consumption*” does not apply)¹. The only effect of the limitation in relation to those goods is to limit them to *goods being organic produce*. Therefore, a limitation to the applied for goods that they are *organic produce* still results in the respective goods being at least highly similar.

The average consumer and the nature of the purchasing act

21. As the case law cited in paragraph 13 indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected 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. 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

¹ Although the opponent’s specification contains the term *food supplements*, it could be argued that those goods are limited to goods for human consumption.

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”


22. The average consumer of food supplements is the general public. The goods will be self-selected from a retail shelf or from a website, so the visual aspects of the marks are more important, although I do not discount aural considerations in the form, for example, of word-of-mouth recommendations. As regards the level of attention that is likely to be paid, given that the goods are purchased for some health purpose and concern the health of the final consumers, they will be selected with, at least, an average degree of attention.

Comparison of marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. 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.”

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

Earlier mark	Applied-for mark
EVOLUTION	

Overall impression

25. As the opponent's mark consists of the single ordinary English-language word EVOLUTION, presented in upper case, no part of which is highlighted or emphasised in any way, that word is the overall impression it will convey and where its distinctiveness lies.

26. The applied for mark is a composite mark. It consists of the words 'evolution' and 'slimming', presented in blue, in lower case and in a slightly stylised (and bold) typeface. Between these two words, there is a heavily stylised, semi-abstract device; this is intended to illustrate a person adopting a pose designed to convey the concept of vitality, with a swirl around its waist. The swirl is likely to be seen as a decorative element or, perhaps more likely, as a stylised letter 'e', signifying the initial letter of the word 'evolution'.

27. Though the applied for mark is made up of a number of elements, looking at the totality created by the overall impression, I consider that it is likely to be generally remembered as an 'evolution' mark. This is because the word 'evolution' is placed at the beginning of the mark² and is not descriptive; further, the average consumer will be alive to the fact that the word 'slimming' designate a specific characteristic of the goods concerned, i.e. goods that help consumers to control or lose weight. Thus, the focus of the mark will be the word 'evolution', with the word 'slimming' unlikely to feature as strongly in the average consumer's perception and recollection of the mark.

² There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027, *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España*, that the first parts of words (and consequently, first words of marks) catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes.

As regards the device element, whilst the concept of a person in active pose is likely to be perceived as directly related to the products concerned, which are intended to give or contribute to a healthy lifestyle, the average consumer is also likely to see the combination and arrangement of the figurative elements of the mark as distinctive. In my view, the word 'evolution' and the device are the dominant and distinctive components of the applied for mark, though the word 'evolution' has slightly greater relative weight in the overall impression than the device, given its distinctiveness and the principle that "words speak louder than devices".

28. The marks share the first identical word EVOLUTION/evolution. Since notional and fair use of a mark registered in block capitals will include the word being presented in a variety of typescripts, in upper and lower-case letters and in colour, notional and fair use of the opponent's mark could include the word EVOLUTION presented in a get up similar to that of the applicant. The marks are visually different in respect of the device and the word 'slimming'; those elements have no counterpart in the earlier mark. Weighing the similarities and differences, and bearing in mind my assessment of the overall impression, I find the marks to be visually similar to a medium degree.

29. Aurally, the marks will be verbalised as EVOLUTION and 'evolution slimming', respectively. The device element in the applied for mark will not be vocalised. Even if the words 'slimming' introduces a difference, the shared and distinctive word EVOLUTION/evolution is vocalised first. In my view, the marks are aurally similar to degree between medium and high.

30. So far as the conceptual position is concerned, the word EVOLUTION/evolution in each mark will be perceived as having the same meaning, i.e. a process of gradual change. As I have already said, the additional concept of a person in active pose, which is conveyed by the device in the applied for mark, is not very distinctive in the context of goods which are intended to give or contribute to a healthy lifestyle. As to the word 'slimming' in the applied for mark, it will be perceived by the average consumer, but little weight will be attached to it, over and above the obvious descriptive message relating to the proprieties of the goods, i.e. goods which help consumer to control or lose weight. In my view, the marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

32. As no evidence of use has been filed by the opponent, I have only the inherent distinctive character to consider. The applicant submits that “the word Evolution is a common word with many brand name uses”, however, it has provided no evidence to support its claim. The word EVOLUTION has a well-known meaning which can be said to have no particular association with the goods at issue. In my view the earlier mark has a normal degree of distinctive character.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

34. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods/services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.

35. Earlier in my decision, I found that the respective goods are identical (or highly similar), which is a factor in favour of the opponent. The goods will be selected with an average degree of attention, predominantly by visual means. The marks are visually

similar to a medium degree, aurally similar to degree between medium and high and conceptually similar to a high degree. Whilst the device is a distinctive element of the applied for mark, the fact remains that the two marks share the distinctive and dominant component EVOLUTION/evolution; this is the only component of the earlier mark and the component which must be accorded the greatest weight in the applied for mark. The addition of the device and the word 'slimming' in the applied for mark, whilst sufficient to avoid direct confusion, will not, in my view, prevent the average consumer from indirectly confusing the two marks. In my opinion, a consumer familiar with the earlier mark, when faced with the applied for mark used in relation to identical goods, is likely to consider that the later mark merely communicates a special range of products, i.e. those with weight control properties. **There is a likelihood of indirect confusion.**

36. In reaching my decision I have not overlooked the applicant's submission that it has been trading under the applied for mark since 2007. I can deal with this point very briefly. Firstly, there is no evidence to support the applicant's claim of earlier use; secondly, as far as I am aware, at no time did the applicant seek to invalidate the opponent's earlier mark³, thus, the existence of a prior right is irrelevant to the issue I have to decide.

CONCLUSION

37. The opposition against the Class 5 goods succeeds and the application will be refused in relation to these goods. The opposition was not directed at the applied for goods in Class 3, so the application can proceed to registration in relation to these goods.

³ TPN 4/2009

COSTS

38. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in Fast Track opposition proceedings are governed by TPN 2/2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Written submissions:	£200
Total:	£500

39. I order Evolution Slimming Limited to pay Core Evolution Limited the sum of £500 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 22nd day of August 2018

**Teresa Perks
For the Registrar
The Comptroller – General**