

O/0402/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. W0000001595388

DESIGNATING THE UK

IN THE NAME OF SPIC CORPORATION

FOR THE FOLLOWING TRADE MARK:

L y p o C a p s u l e

IN CLASSES 5 AND 35

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431444

BY LIVON LABORATORIES, INC.

BACKGROUND AND PLEADINGS

1. International trade mark 1595388 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is SPIC Corporation. The IR is registered with effect from 15 April 2021. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 18 March 2021 (Japan). The holder seeks protection for the IR in relation to the following goods and services:

Class 5 Dietary supplements for human consumption; vitamin supplements; vitamin preparations; vitamin C preparations; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes.

Class 35 Retail services in relation to dietary supplements.

2. The request to protect the IR was published on 26 November 2021. On 28 February 2022, LivOn Laboratories, Inc. (“the opponent”) opposed the protection of the IR in the UK based upon sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”). On 15 August 2022, the opponent withdrew the section 3(6) ground and, consequently, the opposition proceeds on the basis of the section 5(2)(b) ground only. Under section 5(2)(b), the opponent relies upon the following trade marks:

LYPO C

UKTM no. 917894291¹

Filing date 30 April 2018; registration date 9 January 2019

(“the First Earlier Mark”)

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having EUTMs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here (the First, Third, Fourth, Fifth and Sixth Earlier Marks) are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

LYPO GSH

UKTM no. 3307663

Filing date 30 April 2018; registration date 5 October 2018

("the Second Earlier Mark")

LYPO-SPHERIC

UKTM no. 917894288

Filing date 30 April 2018; registration date 29 November 2018

Priority date claimed: 7 November 2017 (United States of America)

("the Third Earlier Mark")

LYPO MAG

UKTM no. 917894289

Filing date 30 April 2018; registration date 26 December 2018

("the Fourth Earlier Mark")

LYPO ALC

UKTM no. 917894298

Filing date 30 April 2018; registration date 9 January 2019

("the Fifth Earlier Mark")

LYPO B

UKTM no. 917894292

Filing date 30 April 2018; registration date 9 January 2019

("the Sixth Earlier Mark")

(together "the earlier marks")

3. The opponent relies upon all goods and services for which the earlier marks are registered, as set out in the Annex to this decision. The opponent claims that there is a likelihood of confusion because the marks are similar and the goods and services are identical or similar. I note that the opponent originally relied upon a 'family of marks' argument, but as no evidence of use was filed, this has (rightly) been withdrawn.

4. The holder filed a counterstatement denying the claims made.
5. The opponent is represented by Mishcon De Reya LLP and the holder is represented by CSY Herts.
6. Both parties filed evidence in chief. The opponent filed evidence in reply. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

7. The opponent's evidence in chief consists of the first witness statement of Eloise Beatrice Harding dated 11 August 2022, a Managing Associate at the opponent's representative. Ms Harding's statement is accompanied by 5 exhibits (EH1-EH5).
8. The applicant filed evidence in chief in the form of the witness statement of Alicia Claire Instone dated 17 October 2022, accompanied by 8 exhibits. Ms Instone is a Chartered Trade Mark Attorney acting on behalf of the applicant.
9. The opponent's evidence in reply consists of the second witness statement of Ms Harding dated 15 December 2022, accompanied by two exhibits (EH6-EH7), and the witness statement of Lucina Nachman dated 15 December 2022. Ms Nachman is the President and co-founder of the opponent.
10. The applicant and the opponent both filed written submissions in lieu dated 8 February 2023.
11. I have taken the evidence and submissions into account and will refer to them below where necessary.

RELEVANCE OF EU LAW

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

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

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

(a)...

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

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

14. Section 5A of the Act is as follows:

“5A 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.”

15. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. Although the holder requested proof of use, as the earlier marks had not completed their registration process more than 5 years prior to the designation date of the IR in issue, they are not subject to proof of use, pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services identified.

16. 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

17. In its written submissions in lieu, the opponent identified the First and Third Earlier Marks as its best case. I agree. Consequently, I will assess the decision based upon those marks in the first instance, returning to the others only if it is necessary to do so.

Comparison of goods and services

18. I have only reproduced those goods and services in the table below that I consider represent the opponent's best case. With that in mind, the competing goods and services are as follows:

Opponent's goods and services	Holder's goods and services
The First Earlier Mark	<u>Class 5</u>
<u>Class 35</u>	Dietary supplements for human consumption; vitamin supplements; vitamin preparations; vitamin C
Online, wholesale, and retail store services featuring vitamin supplements,	

<p>vitamin preparations, vitamin-enriched preparations for medical use, food supplements, nutritional supplements in the form of food bars, dietary supplements, dietary supplement drink mixes.</p> <p>The Third Earlier Mark</p> <p><u>Class 5</u></p> <p>Vitamins; vitamin tablets; multi-vitamins; vitamin supplements; vitamin preparations; preparations containing vitamins; vitamin food additives; food supplements; mineral food supplements; homeopathic supplements; nutritional supplements; nutritional supplements in the form of food bars; dietary supplements; dietary supplement drink mixes; meal replacement drink mixes.</p> <p><u>Class 35</u></p> <p>Online, wholesale, and retail store services featuring vitamin supplements, vitamin preparations, vitamin-enriched preparations for medical use, food supplements, nutritional supplements in the form of food bars, dietary supplements, dietary supplement drink mixes.</p>	<p>preparations; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes.</p> <p><u>Class 35</u></p> <p>Retail services in relation to dietary supplements.</p>
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19. 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:

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

20. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 for 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.”

22. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

23. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

24. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford*

Wedgewood Plc v. Assembled Investments (Proprietary) Ltd Case C-398/07P, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

Class 5

25. The holder's goods will overlap in trade channels and users with the services in the opponent's First Earlier Mark because the same businesses that sell the goods are likely to offer the corresponding retail services, to the same customers. The goods and services will clearly differ in nature, method of use and purpose. They will not be in competition. However, they will be complementary as one is important or indispensable for the other and the average consumer would conclude that they originate from the same or economically linked undertakings. Consequently, I consider the goods and services to be similar to a medium degree.

26. I note the holder's submission that none of the opponent's goods are limited to being adapted for medical use. That's not entirely correct as the opponent's specification includes, inter alia, "vitamin-enriched preparations for medical use". However, in any event, given that goods adapted for medical use could be incorporated by the equivalent broader term (which would include goods both adapted and not adapted for medical use), I do not consider that this assists the holder. In my view, the holder's goods are either self-evidently identical or identical on the principle outlined in *Meric* to "dietary supplements", "vitamin supplements", "vitamin preparations", "vitamin-enriched preparations for medical use", "preparations containing vitamins", "dietary supplement drink mixes" and "nutritional supplements in the form of food bars" in the specification of the Third Earlier Mark. If I am wrong in this finding, then the goods will overlap in user, nature, method of use, purpose and trade channels. They will also be in competition. Consequently, they will be highly similar.

Class 35

27. The holder's class 35 services are self-evidently identical to "online, [...] and retail store services featuring dietary supplements" in the specifications of the First and Third Earlier Marks.

The average consumer and the nature of the purchasing act

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29. The average consumer for the goods and services will be either a member of the general public with an interest in dietary supplements and associated goods/services or a medical/healthcare professional who will be selecting the goods for the benefit of a patient. The goods and services are unlikely to be particularly expensive and may be reasonably frequent purchases. However, various factors are likely to be taken into account such as nutritional content and flavour, for the goods, or speed of service and ease of use, for the services. Consequently, I consider that a medium degree of attention is likely to be paid during the purchasing process. However, I recognise that where a medical professional is purchasing the goods or they are being taken to target a particular medical condition, the level of attention paid may be higher.

30. The goods and services are likely to be purchased following perusal of signage at physical premises, online, in catalogues or on packaging. Consequently, visual considerations are likely to dominate the selection process. However, given that advice may be sought from retail assistants or recommendations may be made, I do not discount an aural component.

Distinctive character of the earlier trade marks

31. 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-2779, 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).”

32. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of them.

33. The opponent’s evidence is directed at the inherent meaning of the word LYPO, in answer to the holder’s submission that it is descriptive/non-distinctive. There is no evidence that the earlier marks have acquired enhanced distinctive character through use. Consequently, I have only the inherent position to consider.

34. In its counterstatement, the holder submits as follows:

“9. LYPO enjoys a very low distinctiveness in the context, where the goods and services include liposomes, LYPO being a shortened form of liposome. The Opponent cannot expect to enjoy a monopoly throughout the UK for LYPO simply being a shortened form of liposomes, which is a feature of the goods and services.

10. Other marks exist on the UK register presently that are prefixed with LYPO in classes 5 and 35 wherein the Opponent is not the proprietor.”

35. It appears to be common ground between the parties that lipase is an enzyme which assists with the digestive process.² The holder has not been able to put forward any evidence to suggest that LYPO is short for LIPASE or LIPOSOME. Most dictionaries return no meaning for the word LYPO.³ However, both parties have filed evidence to show that it is an abbreviation for the cosmetic procedure, liposuction.⁴ I note that Ms Harding's second statement includes an exhibit from Wikipedia which suggests that LIPO may be an abbreviation for lipids. However, given that Wikipedia can be amended by any user, I am not convinced about the reliability of that document.⁵ Given that the word LYPO does not appear to have any meaning (or at best, is an abbreviation for liposuction), I can see no reason to conclude that it is descriptive for the goods and services in issue. I note that evidence has been filed of another business using the word LYPO in relation to dietary supplements, but this is use as part of a trade mark and so does not demonstrate any use of the word in a descriptive sense. In any event, section 72 provides that registration is prima facie evidence of validity and no application has been made by the holder to invalidate the earlier marks on the basis that they are descriptive/non-distinctive.⁶

36. The holder has made reference, in their counterstatement, to other trade marks on the Register. Ms Harding states that she conducted a search for marks registered prior to the relevant date (i.e. the IR's priority date). This returned 21 search results, 13 of which are owned by the opponent.⁷ Only 4 of those marks not owned by the opponent appear in classes 5 or 35. They are for the following trade marks:

Lypo-Microsomes

Class 5: Vitamins; minerals; lipids; phytonutrients; probiotics; nutritional preparations and dietary supplements.

LYPOWAKE

² See the witness statement of Ms Nachman and Exhibit ACI1

³ Exhibit EH3

⁴ Exhibits EH4 and ACI17

⁵ Exhibit EM7

⁶ Section 72 of the Act.

⁷ Exhibit EH1

Class 5: Gummy vitamins; vitamin drinks; vitamin tablets; vitamin supplements; vitamin preparations; effervescent vitamin tablets; vitamin and vitamin preparations; mixed vitamin preparations; vitamin D preparations; vitamin C preparations; vitamin B preparations; vitamin A preparations; vitamin and mineral supplements; vitamins for animals' health food supplements made principally of vitamins; vitamin preparations in the nature of food supplements.



Class 5: Stem cells; stem cells for medical purposes; surgical implants grown from stems cells [living tissues].

lypo-c

Class 5 Mixed vitamin preparations; health food supplements made principally of vitamins; preparations of vitamins; vitamin and mineral supplements; vitamin effervescent tablets; vitamin drinks; vitamins for animals; vitamin preparations; vitamin preparations in the form of food supplements; vitamin supplements; vitamin supplements for animals; health food supplements made principally of minerals.

37. Ms Harding notes that the goods for which the third of these marks is registered are quite different to those covered by the opponent's specification. In relation to the first and fourth marks listed above, Ms Harding could identify no use on the marketplace following an internet search. In relation to the second of these marks, although a website was identified, Ms Harding states that it appeared to be blocked to users in the UK.⁸ I note that the Instagram account for the second of these marks does

⁸ Exhibit EH3

identify UK-based team members, although no further information is identifiable about the extent of the use made of that mark in the UK (if at all) prior to the relevant date.

38. Nothing in the holder's evidence challenged the position as put forward by Ms Harding in relation to the use of these marks. I bear in mind the decision of the GC in *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, when it was stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71)."

Given the limited use of these marks (if any) identified by the opponent, and that no evidence of use has been put forward by the holder, I do not consider that this line of argument is of assistance to the holder.

39. Although not pleaded by the holder, for the sake of completeness, to the extent that their evidence is intended to demonstrate that use of the word LYPO has become commonplace in the market in relation to the relevant goods and services, I do not consider that it has done so. The holder has only been able to identify one other business actually trading with the word LYPO displayed on its goods.⁹ I note that Ms Harding has conducted searches of nutritional supplement suppliers, national

⁹ Exhibits ACI to ACI4 and Exhibit ACI8

supermarkets and well-known health and beauty retailers for goods bearing the name LYPO, and no applicable results were returned.¹⁰ The evidence before me is, in my view, far from sufficient to demonstrate that use is commonplace in the market.

40. However, some of the evidence does align with my own view that, the word LYPO (as a misspelling of LIPO) is likely to be seen as referring to the cosmetic procedure, liposuction. In my view, the majority of average consumer will be familiar with this meaning. To the extent that the goods and services are, or relate to, goods intended to assist in slimming down or burning excess fat, I accept that there may be some allusion. This will, in itself, result in the common word LYPO being distinctive to only between a low and medium degree. In the First Earlier Mark, this word is followed by the letter C. I do not consider that this increases the distinctiveness of the mark to any material degree. In the Third Earlier Mark, the word LYPO is followed by -SPHERIC. Spheric means that something is round (or spherical).¹¹ In my view, this is likely to be seen as referring to a characteristic of the goods (or the goods to which the services relate). Consequently, I do not consider that it increases the distinctiveness of the Third Earlier Mark to any material degree.

Comparison of trade marks

41. It is clear from *Sabel BV 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. 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

¹⁰ Exhibit EH6

¹¹ Spherical definition and meaning | Collins English Dictionary (collinsdictionary.com)

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.”

42. 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 trade marks.

43. The respective trade marks are shown below:

Opponent’s trade marks	The IR
<p style="text-align: center;">LYPO C (the First Earlier Mark)</p>	<p style="text-align: center;">L y p o C a p s u l e</p>
<p style="text-align: center;">LYPO-SPHERIC (the Third Earlier Mark)</p>	

Overall Impression

44. The IR consists of the words LYPO CAPSULE, presented in a standard title case font. The overall impression of the mark lies in the combination of these words, with the word LYPO being more distinctive due to CAPSULE simply describing the vessel through which the goods (or the goods to which the services relate) are provided. The First Earlier Mark consists of the words LYPO C. The overall impression of the mark lies in the combination of these elements. The Third Earlier Mark consists of the words LYPO-SPHERIC. The overall impression lies in the combination of these elements, with the word LYPO being more distinctive due to the word SPHERIC being descriptive of a characteristic of the goods (or the goods to which the services relate).

Visual Comparison

45. Visually, the First Earlier Mark and the IR overlap to the extent that both contain the word LYPO. They differ in the letter C at the end of the First Earlier Mark and the word CAPSULE at the end of the IR. The letter C is, of course, the first letter of the word CAPSULE, which does create some visual similarity. I consider them to be visually similar to between a medium and high degree.

46. Visually, the Third Earlier Mark and the IR overlap to the extent that both contain the word LYPO. However, they differ in the word CAPSULE at the end of the IR and the suffix -SPHERIC at the end of the Third Earlier Mark. In my view, they are visually similar to a medium degree.

Aural Comparison

47. Aurally, the word LYPO will be articulated identically in the First Earlier Mark and the IR. The letter C and the word CAPSULE will act as points of aural difference. Whilst I note that the letter C is the first letter of the word CAPSULE, it will be pronounced KAA when part of the word CAPSULE, but the letter C on its own will be pronounced SEE. Consequently, I consider the marks to be aurally similar to a medium degree.

48. The word LYPO in the Third Earlier Mark and the IR will be articulated identically. However, the word -SPHERIC and the letter C will act as points of aural difference. Consequently, I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

49. Conceptually, as I have already discussed above, the word LYPO is likely to be seen as an abbreviation of (or a misspelling of the abbreviation for) the cosmetic procedure, liposuction. Consequently, it is likely to allude to goods (or goods to which the services relate) that are intended to assist in slimming down or the breaking down of fats. The same meaning will apply in the First Earlier Mark and the IR. The letter C will not contribute to the conceptual meaning conveyed by the First Earlier Mark and the word CAPSULE will be a non-distinctive point of difference. Consequently, the

conceptual message conveyed will be highly similar, with any differences being non-distinctive.

50. The word LYPO will, as above, convey an identical meaning in both the Third Earlier Mark and the IR. The words CAPSULE and the IR convey similar (albeit not the same) messages of a round or cylindrical object. They are likely, in my view, to be seen as indicating a characteristic of the goods i.e. the shape of the goods/how they are conveyed (and for the services, will be seen as descriptive of the goods to which the services relate). Consequently, I consider the marks to be conceptually highly similar.

Likelihood of confusion

51. 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 and services 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the nature of the purchasing process and the average consumer for the goods and services. 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 he has retained in his mind.

52. I have found as follows:

- a) The goods and services vary from being identical to similar to a medium degree.

- b) The average consumer is a member of the general public or a medical/healthcare professional who will pay a medium degree of attention, although I recognise that in some cases the level of attention will be higher.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and the IR are visually similar to between a medium and high degree, aurally similar to a high degree and conceptually highly similar (with any differences being non-distinctive).
- e) The Third Earlier Mark and the IR are visually and aurally similar to a medium degree and conceptually highly similar.
- f) The earlier marks are inherently distinctive to between a low and medium degree.

53. I bear in mind that the First and Third Earlier Marks are inherently distinctive to a relatively low degree and that this is a factor directly relevant to the global assessment as, the more distinctive a mark, the more likely it is that confusion will arise. However, it is also important to remember that the weak distinctive character of the earlier trade marks does not preclude a likelihood of confusion and the First and Third Earlier Marks are not at the lowest end of the scale in terms of distinctiveness.¹²

54. Given the visual similarities between the First Earlier Mark and the IR, and the predominantly visual purchasing process, I consider that there is potential for the marks to be mistakenly recalled or misremembered as each other. Taking all of the above factors into account, I consider that there is a likelihood of direct confusion.

55. Although the Third Earlier Mark and the IR are less visually similar, I still consider that there is potential for them to be mistakenly recalled or misremembered as each other. The words CAPSULE and -SPHERIC are both likely to leave the consumer with

¹² *L'Oréal SA v OHIM*, Case C-235/05 P

an image in their mind of the way in which the goods are likely to be conveyed i.e. that one is round and one is in capsule form, or that the services in issue relate to goods of this nature. This highly similar conceptual message may result in one mark being mistaken for the other. Consequently, I consider there to be a likelihood of direct confusion.

56. Even where the additional components are recalled, I consider that they are likely to be seen as indicating different products/services sold by the same undertaking. For example, the holder's goods may be seen as a product range provided in capsule form by the opponent or services that specialise in these goods. Consequently, taking all of the above factors into account, I consider there to be a likelihood of indirect confusion.

57. As I have found in favour of the opponent based upon the First and Third Earlier Marks, I do not need to return to consider the Second, Fourth, Fifth and Sixth Earlier Marks.

CONCLUSION

58. The opposition is successful, and the application is refused.

COSTS

59. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Whilst the opponent paid an opposition fee of £200 because it originally pleaded an additional section 3(6) ground, it only pursued its section 5(2)(b) ground which would have attracted the lower opposition fee of £100. Consequently, I will make an award for the lower official fee only. Similarly, I make no award for time spent preparing the section 3(6) pleading. In the circumstances, I award the opponent the sum of **£1,700**, calculated as follows:

Preparing a Notice of opposition and considering the holder's counterstatement	£250
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Considering the holder's evidence and preparing and filing evidence	£1,000
Written submissions in lieu	£350
Official fee	£100
Total	£1,700

60. I therefore order SPIC Corporation to pay LivOn Laboratories, Inc. the sum of £1,700. This 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 2nd day of May 2023

S WILSON
For the Registrar

ANNEX

The First, Fourth, Fifth and Sixth Earlier Marks

Class 30

Rice; flour and preparations made from cereals; Bread, pastries and confectionery; Ice (frozen water); Breakfast cereals; Processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food; Oatmeal; Muesli; Cereal-based snack foods; Grain-based snack foods; Crackers; Cookies; Cereal bars; Cereal-based food bars; Granola bars; Tea, cocoa and artificial coffee; Tea bags; Infusions (not medicinal); Herbal infusions.

Class 32

Fruit beverages and fruit juices; Syrups and other preparations for making beverages; isotonic beverages; Fruit-flavored beverages; Fruit-based beverages; Protein-enriched sports beverages; Sports drinks; Nutrient enhanced sports drinks; Nutrient enhanced performance drinks; Energy drinks; Concentrates for making soft drinks; Powders used in the preparation of isotonic sports drinks and sports beverages; Mineral and aerated waters and other non-alcoholic beverages; Drinking waters; Drinking water with vitamins; Hydration beverages.

Class 35

Online, wholesale, and retail store services featuring vitamins, vitamin tablets, multi-vitamins, vitamin supplements, vitamin preparations, preparations containing vitamins, vitamin-enriched preparations for medical use, vitamin food additives, food supplements, mineral food supplements, homeopathic supplements, nutritional supplements, nutritional supplements in the form of food bars, dietary supplements, dietary supplement drink mixes, meal replacement drink mixes, tea, cocoa, and artificial coffee, rice, flour and preparations made from cereals, bread, pastries and confectionery, ice (frozen water), breakfast cereals, processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food, oatmeal, muesli, cereal-based snack foods, grain-based snack foods, crackers, cookies, cereal bars, cereal-based food bars, granola bars, snack foods, tea bags, infusions (not medicinal), herbal infusions, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for

making beverages, isotonic beverages, fruit-flavored beverages, fruit-based beverages, protein-enriched sports beverages, sports drinks, nutrient enhanced sports drinks, nutrient enhanced performance drinks, energy drinks, concentrates for making soft drinks, powders used in the preparation of isotonic sports drinks sports beverages, drinking waters, drinking water with vitamins, and hydration beverages.

The Second Earlier Mark

Class 30

Rice; flour and preparations made from cereals; Bread, pastries and confectionery; Ice (frozen water); Breakfast cereals; Processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food; Oatmeal; Muesli; Cereal-based snack foods; Grain-based snack foods; Crackers; Cookies; Cereal bars; Cereal-based food bars; Granola bars; Snack foods in this class; Tea, cocoa and artificial coffee; Tea bags; Infusions (not medicinal); Herbal infusions.

Class 32

Rice; flour and preparations made from cereals; Bread, pastries and confectionery; Ice (frozen water); Breakfast cereals; Processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food; Oatmeal; Muesli; Cereal-based snack foods; Grain-based snack foods; Crackers; Cookies; Cereal bars; Cereal-based food bars; Granola bars; Snack foods in this class; Tea, cocoa and artificial coffee; Tea bags; Infusions (not medicinal); Herbal infusions.

Class 35

Online, wholesale, and retail store services connected with the sale of vitamins, vitamin tablets, multi-vitamins, vitamin supplements, vitamin preparations, preparations containing vitamins, vitamin-enriched preparations for medical use, vitamin food additives, food supplements, mineral food supplements, homeopathic supplements, nutritional supplements, nutritional supplements in the form of food bars, dietary supplements, dietary supplement drink mixes, meal replacement drink mixes, tea, cocoa and artificial coffee, rice, flour and preparations made from cereals, bread, pastries and confectionery, ice (frozen water), breakfast cereals, processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food, oatmeal, muesli, cereal-based snack foods, grain-based snack foods,

crackers, cookies, cereal bars, cereal-based food bars, granola bars, snack foods in this class, tea bags, infusions (not medicinal), herbal infusions, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, isotonic beverages, fruit-flavored beverages, fruit-based beverages, protein-enriched sports beverages, sports drinks, nutrient enhanced sports drinks, nutrient enhanced performance drinks, energy drinks, concentrates for making soft drinks, powders used in the preparation of isotonic sports drinks sports beverages, drinking waters, drinking water with vitamins, and hydration beverages.

The Third Earlier Mark

Class 5

Vitamins; vitamin tablets; multi-vitamins; vitamin supplements; vitamin preparations; preparations containing vitamins; vitamin food additives; food supplements; mineral food supplements; homeopathic supplements; nutritional supplements; nutritional supplements in the form of food bars; dietary supplements; dietary supplement drink mixes; meal replacement drink mixes.

Class 30

Rice; flour and preparations made from cereals; bread, pastries and confectionery; ice (frozen water); breakfast cereals; processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food; oatmeal; muesli; cereal-based snack foods; grain-based snack foods; crackers; cookies; cereal bars; cereal-based food bars; granola bars; tea, cocoa and artificial coffee; tea bags; infusions (not medicinal); herbal infusions.

Class 32

Fruit beverages and fruit juices; syrups and other preparations for making beverages; isotonic beverages; fruit-flavored beverages; fruit-based beverages; protein-enriched sports beverages; sports drinks; nutrient enhanced sports drinks; nutrient enhanced performance drinks; energy drinks; concentrates for making soft drinks; powders used in the preparation of isotonic sports drinks and sports beverages; mineral and aerated waters and other non-alcoholic beverages; drinking waters; drinking water with vitamins; hydration beverages.

Class 35

Online, wholesale, and retail store services featuring vitamins, vitamin tablets, multivitamins, vitamin supplements, vitamin preparations, preparations containing vitamins, vitamin-enriched preparations for medical use, vitamin food additives, food supplements, mineral food supplements, homeopathic supplements, nutritional supplements, nutritional supplements in the form of food bars, dietary supplements, dietary supplement drink mixes, meal replacement drink mixes, tea, cocoa and artificial coffee, rice, flour and preparations made from cereals, bread, pastries and confectionery, ice (frozen water), breakfast cereals, processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food, oatmeal, muesli, cereal-based snack foods, grain-based snack foods, crackers, cookies, cereal bars, cereal-based food bars, granola bars, snack foods in this class, tea bags, infusions (not medicinal), herbal infusions, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, isotonic beverages, fruit-flavored beverages, fruit-based beverages, protein-enriched sports beverages, sports drinks, nutrient enhanced sports drinks, nutrient enhanced performance drinks, energy drinks, concentrates for making soft drinks, powders used in the preparation of isotonic sports drinks sports beverages, drinking waters, drinking water with vitamins, and hydration beverages.