

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS IN  
PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for the registration of Trade Mark No. 255060 and in the matter of an Opposition thereto.

**NURITAS LIMITED**

**Applicant**

**AURIVO CO-OPERATIVE SOCIETY LIMITED**

**Opponents**

**The Application**

1. On 5 May 2016 Nuritas Limited (hereinafter “the Applicant”) of 3 Westland Court, Cumberland Street South, Dublin 2 made application (No. 2016/00925) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register NURITAS as a trade mark in respect of the following goods:

Class 1: Protein hydrolysates; protein hydrolysate powders; vegetable protein hydrolysate powders; dairy protein hydrolysate powders; peptide preparations; protein hydrolysates for use in making food products, nutritional supplements, cosmetics, personal care products and pharmaceuticals.

Class 3: Personal care preparations; cosmetics; make-up; skin creams, gels and lotions; shampoo; conditioner; shower gel; body wash; soap; liquid soaps; hair gel and mousse; hairspray; suntan lotion; emollients; skin lubricants; perfume; aftershave; deodorant; mouthwash; toothpaste; dental floss.

Class 5: Food supplements; nutritional supplements; dietetic food and beverages; infant formula; food for special medicinal purposes; wound dressings; plasters; pharmaceutical, medical and veterinary preparations; sanitary preparations for medical purposes.

Class 29: Milk and milk products; meat, fish and poultry; edible oils and fats; jellies, jams and compotes; eggs.

Class 30: Breakfast cereals; products made from cereal; rice; flour; bread; pastries; confectionary; sauces; tea; coffee; ice cream; condiments.

Class 31: Foodstuffs for animals.

Class 32: Beer; non-alcoholic beverages; syrups and other preparations for making beverages.

2. The application was accepted and published in Journal No. 2312 on 27 July 2016. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 30 August 2016 by Aurivo Co-operative Society Limited (hereinafter “the Opponent”) of Finisklin Business Park, Finiskin, County Sligo, Ireland.
3. The Applicant filed a counter-statement on 15 November 2016 and evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). The Applicant attended a hearing on the matter on 18 July 2018, while the Opponent elected not to attend the Hearing and not to file written submissions in lieu of attending.
4. Acting for the Controller, I decided to uphold the opposition in part and to refuse to allow the application to proceed to registration in respect of the following:
  - (a) All goods in Class 31; and
  - (b) Food supplements; nutritional supplements; dietic food and beverages; veterinary preparations in Class 5;

I also decided to limit the registration in respect of “food for special medicinal purposes” and “pharmaceutical and medical preparations” in Class 5 to include a qualification that such goods are exclusively for human use. Furthermore, I decided to allow the mark to proceed to registration in respect of all other goods.

5. The parties were informed of my decision by way of letter dated 23 July 2018. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent, pursuant to Rule 27(2) of the Rules.

### **Grounds of the Opposition**

6. In its Notice of Opposition, the Opponent identifies itself as the proprietor of two Irish Trade Mark Registrations, the first (No. 248142, with an application date of 16 March, 2012) in respect of the word NUTRIAS and the second (No. 249637, with an application date of 1 February, 2013) in respect of a series of two combined marks (comprising verbal and figurative elements) shown below.



7. Trade mark no. 248142 is registered in respect of “*Foodstuffs and food additives, all for animals; additives to fodder; bran, garlic, herbs and yeast, all for animal consumption; treats and snacks for animals; nutritional supplements for animals; food supplements for animal feeds; grains and seeds*” in Class 31; while trade mark no. 249637 concerns “*Food additives, all for animals; additives to fodder; nutritional supplements for animals; food supplements for animal feeds*” in Class 5 and “*Foodstuffs, all for animals; bran, garlic, herbs and yeast, all for animal consumption; treats and snacks for animals; grains and seeds*” in Class 31.
8. The Opponent states it has used its marks in Ireland for many years and consequently the marks have acquired a substantial reputation. It then raises objections to the application under certain provisions of Section 10 of the Act, which I summarise as follows:

Section 10(2)(b) – *a likelihood of confusion on the part of the public, and the likelihood of association with the Opponent’s earlier marks.*

Section 10(3) – *use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s earlier marks.*

Section 10(4)(a) – *use of the applied for mark is prohibited by virtue of the law of passing off.*

### **Counter Statement**

9. In its Counter Statement the Applicant states its application complies with all the provisions of the Act. The Applicant states the respective marks are sufficiently different to avoid any likelihood of confusion or association even if used for the same goods. It also states the goods on which the Opponent’s marks are alleged to be used are not identical or similar to those for which the Applicant is seeking registration.
10. The Applicant states it does not admit the Opponent has used its marks in Ireland in connection with the goods for which they are registered, and even if there was any use it is recent and of such a small extent that it has not established any reputation in Ireland.

## Rule 20 Evidence

11. Evidence filed by the Opponent under Rule 20 consists of a Statutory Declaration, dated 10 February 2017, of Stephen Blewitt, General Manager of Agribusiness of the Opponent, and seven exhibits labelled “Nuritas 1” to “Nuritas 7”.

12. Mr. Blewitt states the Opponent has been using the trade mark NUTRIAS since November 2013 in relation to animal feed and turnover under the trade mark up to the end of 2015 amounted to €58,142,806, broken down as follows:

2013	€6,806
2014	€29,321,000
2015	€28,815,000

13. He states his company’s trade marks NUTRIAS have been widely used, primarily in the west and northwest, particularly in Donegal, Leitrim, Roscommon, Mayo, Galway, Longford and Westmeath. He attaches at exhibit “Nuritas 1” an information page from the Opponent’s website showing the manner in which the trade mark NUTRIAS is used.

14. Mr. Blewitt provides details of the advertising and marketing undertaken by the Opponent which consist of print advertising in The Farmers Journal and in most regional newspapers circulated in the counties mentioned above. He says the Opponent also advertised on local radio, at agricultural events and through social media. Between its foundation in November 2013 and the end of 2015 the Opponent spent €72,900 on advertising, broken down as follows:

2013	€9,900
2014	€51,000
2015	€12,000

15. To support these statements Mr. Blewitt attaches at exhibit “Nuritas 2” copies of advertisements placed in a number of publications and invoices in respect of same, all dating from before the relevant date for these proceedings. He states the advertising resulted in the NUTRIAS brand becoming one of the best-known brands in the west and northwest of Ireland in relation to animal feed.

16. Mr. Blewitt then conducts a comparison between the goods specified in the opposed application and the goods for which his company's earlier marks are registered. He identifies some goods in Classes 1, 5 and 29 of the opposed application that he considered to be dissimilar goods (cosmetics, personal care products, in Class 1; infant formula, wound dressings and plasters in Class 5; jellies, jams, compotes and eggs in Class 29) and states that other goods in these three classes would be considered dissimilar if they were specifically excluded from being used for or by animals, though he does not identify which other goods fall into this category. He states that all other goods would be similar to animal feedstuffs.
17. Turning specifically to the contested goods in Class 1, Mr. Blewitt states protein hydrolysates can be used in animal feed and he attaches as exhibit "Nuritas 3" an extract from a website stating that salmon protein hydrolysate is used as a protein source in feed for young pigs.
18. Mr. Blewitt states protein hydrolysates powders are widely used in food processing and can be used in animal feed. In support of this statement he attaches as Exhibit "Nuritas 4" an extract from a website which confirms the first part of his claim, but there is no mention of animal feed, though the extract shows pictures of a cow grazing and chickens.
19. He makes similar statements regarding protein hydrolysate powders, vegetable protein hydrolysate powders, dairy protein hydrolysate powders and peptide preparations, and attaches as exhibits Nuritas 4 to Nuritas 7 respectively, extracts from internet pages supporting his claims. He adds that by their very nature, protein hydrolysates are used to make food products, nutritional supplements are also used in food products and pharmaceuticals can be used for veterinary use.
20. Mr. Blewitt says "*food supplements; nutritional supplements; dietetic food and beverages; food for special medicinal purposes; pharmaceutical, medical and veterinary preparations; and sanitary preparations for medical purposes*" in Class 5 can all be used for or on animals.
21. As regards goods in Class 29, Mr. Blewitt states "*Milk and milk products; meat, fish and poultry; edible oils and fats*" can all be fed to animals and that without the qualification "none being for animals", could be regarded as an animal foodstuff.

## **Rule 21 Evidence**

22. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 14 August 2017, of Greg Stafford, Chief Financial Officer of Nuritas Limited, of Cumberland

Street South, Dublin 2 and one accompanying exhibit marked “GS1”, which he states provides evidence of the exposure and reputation of his Company.

23. Exhibit “GS1” contains the following:

- a. An article from [www.irishtimes.com](http://www.irishtimes.com) relating to an investment in his Company by Bono and The Edge – two members of the world-famous U2 band.
- b. An article from [www.independent.ie](http://www.independent.ie) relating to some of the activities of his Company.
- c. An article from [www.irishtimes.com](http://www.irishtimes.com) relating to funding of his Company.
- d. An article from Women Mean Business concerning a collaboration between his Company and BASF.
- e. An article from [www.techcentral.ie](http://www.techcentral.ie) relating to the founder of his Company being awarded the woman of the decade in business and leadership award at the Women Economic Forum EU event in The Hague in January 2017.
- f. An article from [www.rte.ie](http://www.rte.ie) relating to the collaboration between his Company and BASF.
- g. Articles from Fortune relating to the investment in his Company by Bono and The Edge.
- h. An article from Fortune relating to the ground-breaking activities of his Company.
- i. An article from Wired Magazine relating to the activities of his Company.
- j. An article from The Sunday Times (UK) regarding his Company’s involvement in a key roundtable with Canadian Prime Minister, Justin Trudeau and Ireland’s An Tánaiste and Minister for Jobs, Enterprise and Innovation, Frances Fitzgerald.
- k. An article from [www.irishtimes.com](http://www.irishtimes.com) naming his Company as one of the 2016 Winners in Business.
- l. An article from [www.irishtimes.com](http://www.irishtimes.com) relating to his Company founder’s nomination by the Department of Jobs, Enterprise and Innovation to compete for Ireland at the 2016 TEDx event “Made in Europe” organised by the European Union.
- m. An article from [www.irishtimes.com](http://www.irishtimes.com) relating to his Company’s receipt of the 2015 SVG Thrive Accelerator Award from Forbes.
- n. An article from [www.independent.ie](http://www.independent.ie) relating to the activities of his Company.
- o. A URL link to a 2013 TEDxUCD talk which relates to his Company.
- p. A URL link to a TEDxBinnenhof talk which relates to his Company and took place in The Hague in 2016.

q. A URL link to a 2016 Data Summit Dublin presentation which relates to the activities of his Company.

24. Mr. Stafford states that the exposure and coverage of his Company in these articles built up a reputation such that the name and trade mark NURITAS would be readily recognised as identifying his Company and the goods and services provide by his Company.

25. He concludes his declaration by arguing there is no similarity between his Company's mark and those of the Opponent and therefore consumers would not be confused as to the origin of goods bearing either parties' marks.

### **Rule 22 Evidence**

26. Evidence filed by the Opponent under Rule 22, in response to Mr. Stafford's declaration, consists of a second Statutory Declaration, dated 8 December 2017, of Stephen Blewitt.

27. Mr. Blewitt states he is unaware of both the Applicant and the trade mark NURITAS and unaware of any reputation or goodwill which the Applicant claims to have in the that trade mark, especially in relation to goods in Classes 1, 5, 29 and 31.

28. He says the disputed mark was filed on 5 May 2016 and most of the articles that I listed in paragraph 23 above (namely those at a, b, d, e, f, g, h, j, k and n) all post-date the date of application. He says the links to another three articles (o, p and q) do not work. Thus, only 4 of the articles I mention in paragraph 23 (those at c, i, l and m) pre-date the application.

29. Mr. Blewitt goes on to analyse the content of the articles lodged by Mr. Stafford and highlights the lack of mention of the trade mark NURITAS, the relevance of the mention of winning an award in California, USA, or that of competing in an event in Luxembourg. He says much of the content describes the Applicant as a "start-up" and relates to the Applicant's involvement in "molecular analysis of foodstuffs to search for hidden health benefits", "food bioinformatics at a molecular level" and the Applicant's "proprietary technology" using "big data techniques" to "discover novel peptides", none of which the Applicant has specified in its trade mark application.

30. He says the Applicant's evidence has not established any reputation in the trade mark, as most of the articles refer to the securing of funding or investments for the Applicant and its

research. Furthermore, there is no mention of the sale of any of the opposed products under the name NURITAS.

31. The remainder of Mr. Blewit's second declaration contains argument about the similarity between the respective marks and the impact that registration of the disputed mark would have on the Opponent's business. As regards the former, he says the marks are visually almost identical in that they consist of the same letters, each has seven letters, the same initial two letters and the last two letters. Neither mark has any conceptual meaning, but this does not mean they are conceptually different. He also argues there is only a slight phonetic difference between the marks and as a result of the overall similarity between the marks there would be confusion if used on the same or similar products. As regards the latter, he says use of the trade mark NURITAS by the Applicant would weaken the Opponent's mark and lead to dispersion of the identity of the Opponent's trade mark NUTRIAS and the hold it has in the public mind.

### **The Hearing**

32. The Opponent decided not to attend a Hearing or to file written submissions in lieu of so attending and informed the Controller that it was resting its case on its position which was clearly expounded in its two Statutory Declarations filed under Rules 20 and 22.

33. At the Hearing, the Applicant was represented by Mr. Paul Kelly, Trade Mark Attorney of FRKelly.

### **Section 10(2)(b)**

34. Mr. Kelly addressed each ground of opposition, commencing with Section 10(2)(b). He outlined the well-established factors to be considered when assessing the similarity between the respective party's goods. In summary he argued the Applicant's goods in Classes 1, 3, 5, 29, 30 and 32 were all different to goods for which the Opponent's mark was registered, in that they were not in competition with or complimentary to the Opponent's goods, and that the nature, use and the trade channels through which the parties sell their goods are different.

35. Mr. Kelly did accept that the Applicant's goods in Class 31 were contained in the list of goods protected by the Opponent's earlier marks, but that the significant differences between the respective marks rendered any such similarity insignificant.



36. Turning to the comparison of the marks, Mr. Kelly again identified the well-established principles upon which such an exercise should be conducted and the factors to be considered. He argued the marks are different in respect of the prefixes and middle of each mark, resulting in the respective marks being readily distinguishable from a visual perspective. He argued there were also aural differences between the marks in that one would be pronounced NUUREETAS and the other NEWTRIAS. He maintained the Applicant's mark had no conceptual meaning, whereas the Opponent's mark is likely to be understood as relating to nutrition or nutrients.

37. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, is written in the following terms:

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

*(a) ....*

*(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.*

38. The principles to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the Court of Justice of the European Union (CJEU)<sup>1</sup> and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischalteprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*<sup>2</sup>. In summary, the principles are:

- (i) the likelihood of confusion must be appreciated globally, having regard to all the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be

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<sup>1</sup> including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;

- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely instead on the imperfect picture of them that he keeps in his mind;
- (iv) 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, because the average consumer normally perceives a mark as a whole and does not analyse its various details;
- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

39. There are four basic requirements which must be met for an objection under Section 10(2)(b) to succeed. The first of these conditions is there must be an earlier mark. The Opponent relies on marks filed with the Controller in March 2012 and February 2013 and they are therefore earlier marks – the relevant date for the purposes of these proceedings being 5 May 2016.

40. The second requirement is there must be identity or similarity between the goods. The Applicant seeks registration for its mark in respect of a range of goods particular to Classes 1, 3, 5, 29, 30, 31 and 32. However, the Opponent has not raised any objection to the application in respect of the goods specified in Classes 3, 30 and 32, for the obvious reason that the goods in these three classes are clearly dissimilar to the goods covered by the Opponent's earlier registered trade marks.

41. As far as they are relevant to these proceedings the Opponent's goods can be described as foodstuff, food additives, nutritional supplements and food supplements all strictly and expressly for animal consumption in Classes 5 and 31.

42. Having conducted a comprehensive comparison between the respective goods in the relevant classes I have reached the following conclusions:

- a. The Applicant's goods in Class 1 are chemicals (proteins and peptides) used in making food products. They are not the end-product and therefore not food per se, whether for

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<sup>2</sup> Unreported decision dated 14 June, 2007

human or animal consumption. Accordingly, I find they are dissimilar to the actual animal feed for which the Opponent's earlier marks are registered.

- b. The “*food supplements; nutritional supplements; dietetic food and beverages; veterinary preparations*” in Class 5 of the Applicant's application are identical to the Class 5 goods for which the Opponent's earlier trade mark No. 249637 is registered.
- c. While the Opponent argues that some of the Applicant's goods in Class 29 (milk and milk products; meat, fish and poultry; edible oils and fats) can be fed to animals, in my opinion, these products are not animal feed per se. They are everyday human food items offered for sale in any supermarket where they are displayed away from the pet or animal food section. Though domesticated animals may be the beneficiaries of the leftovers of these products, the products themselves cannot be considered as animal feed. Typical consumers of these products would never consider that they are eating animal feed.
- d. The “*foodstuffs for animals*” in Class 31 of the Applicant's application are identical to the Class 31 goods for which both of the Opponent's earlier marks are registered.

### **Similarity of the marks**

43. Turning now to the third requirement: the mark applied for must be similar to the earlier mark. I have compared the respective marks on the criteria of visual, aural and conceptual similarity and have made an overall assessment of the extent to which they should be regarded as similar or different. I stress this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant seeks registration. I must also be mindful that the CJEU has noted in *Sabel*<sup>3</sup> that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

44. In doing so, I must look at each of the Opponent's mark separately as there are distinct differences between them and they are registered for difference lists of goods, with the NUTRIAS simpliciter mark (No. 248142) being registered only in respect of Class 31 goods, which I have already found to be identical to the Applicant's goods in that class.

45. The Opponent's word only mark and the disputed mark are clearly similar in some respects. Visually, both have seven letters and begin with the letters N-U and end with the letters A-S. The middle three letters of each are I-R-T though in different sequences. Simply by changing

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<sup>3</sup> *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*

the position of the letter T in the Opponent's mark NUTRIAS from the third letter to the fifth letter, the word becomes NURITAS – the Applicant's mark. Therefore, I am satisfied the Opponent's word-only mark and the Applicant's mark share an extremely high level of visual similarity.

46. Aurally both marks contain three syllables. I would pronounce the Opponent's mark as NUTRI-AS and the Applicant's as NUR-I-TAS. I find that while there is not an exact match in the individual syllables, there is an aural similarity in that "NU" is not a million miles from "NUR", the "I" is pronounced "ai" and has a similar sound to "TRI" and "AS" sounds similar to "TAS". This produces an overall impression that the marks share a high degree of aural similarity.
47. There is a lot more going on with the Opponent's series of two logo marks, which as well as containing the word NUTRIAS, also contain a figurative element comprising a circle within which there are the sun, sun rays, grain, and a green segment, which conveys an image of grain growing in a sun-drenched field. The mark also contains the tagline "*The science of animal nutrition*".
48. The figurative element and tagline are not present in the opposed mark, which must render the Opponent's logo mark to be less similar to the disputed mark than the Opponent's word only mark. Nonetheless, in my opinion, the presence of the word NUTRIAS, means some similarity between the marks exists. I find the Opponent's logo mark has a low to medium overall level of visual similarity to the Applicant's mark.
49. The respective parties' marks contain invented words NUTRIAS and NURITAS so neither have a specific conceptual meaning. However, the Opponent's NUTRIAS marks suggest it relates to nutrition. This link is strengthened by the use of the tagline "*The science of animal nutrition*" in the Opponent's logo mark. It is not beyond the possibility that some people might associate the Applicant's mark with the words nourishment or nurture, but that association is not obvious. I find the marks are different from a conceptual viewpoint.
50. Having compared the marks from a visual, aural and conceptual perspective I find they are far more similar than dissimilar. I would rate the overall level of similarity as high.
51. The basic ingredients of an objection under Section 10(2)(b) of the Act are present because there is a degree of similarity between the marks and the goods. Before reaching a

determination on whether, as a consequence, there is a likelihood of confusion on the part of the purchasing public, I must consider the average consumer of the goods in question and the typical purchasing scenario.

### **The average consumer**

52. It is well established that the average consumer is a legal construct, but nonetheless is deemed to be reasonably well informed and observant, and views things with a healthy level of circumspection. The term "average" does not denote some form of numerical mean, mode or median. It denotes the typical person who purchases the goods in question. Therefore, the average consumer's level of attention varies according to the category of goods being purchased.

53. In the present proceedings there are differences between the average consumers of the different goods covered by the Opponent's marks (in Classes 5 and 31) and the Applicant's goods that are under attack (those in Classes 1, 5, 29 and 31). Looking at the advertising undertaken by the Opponent it appears to me the average consumer of the Opponent's goods are farmers alone. The average consumer of the Applicant's goods comprises food producers (Class 1), the general public and medical specialists (Class 5), the general public (Class 29) and animal owners, including farmers (Class 31).

54. It appears the Opponent sells its goods directly to the farming community and perhaps through specialist agricultural suppliers. The Applicant's goods in Class 31 could be sold in specialist agricultural suppliers, but few if any of the Applicant's other goods would be sold through that channel.

### **Likelihood of confusion**

55. The kind of confusion that Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods, whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the goods offered under the disputed mark the qualities and characteristics that he associates through experience with the goods offered under the earlier mark. The question is whether the average person, who knows of goods sold under the Opponent's trade mark and who then encounters the Applicant's identical or similar goods offered under the disputed trade mark, would assume that the latter goods were connected to the former in the sense that they were both put on the market by the same undertaking or by commercially linked undertakings.

56. The criteria against which that question should be answered has been established in several decisions of the CJEU<sup>4</sup> include the following:

- i. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
- ii. The more distinctive the earlier mark, the greater will be the likelihood of confusion;
- iii. In determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings;
- iv. In making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
- v. A global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed;
- vi. The assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- vii. The likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case.

57. In applying those criteria to the present case, I have reached the following conclusions:

- (a) The overall impression created by the Applicant's mark and the Opponent's word only mark is that they are highly similar.

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<sup>4</sup> Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- (b) The respective goods in Class 31 are identical as are some of the goods in Class 5. There is no similarity between the goods in other classes.
- (c) The Opponent's marks have a high level of inherent distinctiveness and they have the capacity to identify these goods as being those of a particular undertaking and thus to distinguish them from goods offered by other undertakings.
- (d) The Opponent mark has been advertised, though such advertising was aimed specifically at the farming community, delivered through the farming press, agricultural shows and via local newspapers and radio.
- (e) The Opponent's marks are known in farming communities in the west and parts of the northwest and midlands, namely in counties Donegal, Leitrim, Roscommon, Mayo, Galway, Longford and Westmeath, but there is no evidence to suggest they are known elsewhere in the State.
- (f) The Opponent has not provided details of market share, but it is a relatively young company with an increasing market presence.

58. Therefore, it is clear to me that, if a consumer was familiar with the Opponent's trade marks NUTRIAS in respect of goods in Class 5 and 31 and encountered the Applicant's trade mark NURITAS in respect the identical or highly similar Class 5 and 31 goods, they would be likely to believe the goods emanate from the Opponent or from an undertaking that was economically linked to the Opponent, i.e. that both parties were under the same ownership or the mark was being used by the Applicant with the consent of the Opponent. This is precisely the scenario that would inevitably lead to the type of confusion that Section 10(2)(b) seeks to avoid.

59. Having considered all the evidence and arguments put forward by both sides, and having carried out the assessment required to determine oppositions under Section 10(2)(b) of the Act, I find that use by the Applicant of the mark NURITAS would be likely to lead to confusion as to the origin of the goods bearing that mark that are identical to the goods sold by the Opponent under its highly similar earlier NUTRIAS marks. This is most certainly the case with "*Foodstuffs for animals*" in Class 31. Accordingly, I have no hesitation in refusing registration in respect of those goods.

60. Some of the Applicant's goods in Class 5, namely "*Food supplements; nutritional supplements; dietetic food and beverages; veterinary preparations*" are similar to the Opponent's "*food additives, all for animals; additives to fodder; nutritional supplements for*

*animals; food supplements for animal feed*” in Class 5 to the extent that the aforementioned Applicant’s goods are not specific to human use only and could be understood to be for animal use. The Opponent’s goods in Class 5 are registered under the Opponent’s logo mark, which is more distant from the Applicant’s mark than the Opponent’s word-only mark. Nonetheless, the respective marks contain a degree of similarity that, in my opinion, would be likely to lead consumers to be confused, if encountering both parties’ similar goods under their respective marks. Accordingly, I also refuse to allow the Applicant’s mark to proceed to registration in respect of “*Food supplements; nutritional supplements; dietetic food and beverages; veterinary preparations*”.

61. There are other goods in Class 5 that are unlikely to be seen as being targeted towards animal owners and are therefore unlikely to cause the confusion that Section 10(2)(b) seeks to avoid, namely, “*food for special medicinal purposes*” and “*pharmaceutical and medical preparations*”. I have decided to allow the disputed mark to proceed to registration in respect of these goods, but with a qualification that these goods are exclusively for human use. The remaining goods in Class 5, namely “*infant formula; wound dressings; plasters; sanitary preparations for medical purposes*” are dissimilar to the Opponent’s goods and can be registered without limitation.
62. In summary, I have refused to allow the application to proceed to registration in respect of all goods in Class 31 and “*food supplements; nutritional supplements; dietic food and beverages; veterinary preparations*” in Class 5, because it offends against Section 10(2)(b) of the Act. I have decided to allow the mark to be registered for all other goods, some in Class 5 being limited to human use.

### **Section 10(3) – unfair advantage and detrimental to the Opponent’s marks**

63. The Opposition was also grounded on Section 10(3) of the Act provides as follows:

*“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 State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.”*

The purpose and effect of Section 10(3) is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks.



64. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, the earlier mark(s) must have a reputation in the State; thirdly, the use of the later trade mark must be without due cause; and fourthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.
65. I have already found there is a level of similarity between the Applicant's mark and the Opponent's marks, so the first condition has been met. Turning now to reputation. The Opponent has made claims to use of its mark, backing up those claims with turnover figures and evidence of advertising. However, there is a complete lack of evidence of any sales. Not a single invoice was adduced to support the claimed turnover figures. In his Statutory Declarations Mr. Blewitt mentions use of the mark "*primarily in the West and Northwest*" and the invoices for advertising in provincial newspapers point to the Opponent's business being focused in those regions. The only evidence that the Opponent's marks may have been seen outside of the West and Northwest is an advertisement in the nationally-circulated Farmers Journal, though proof of advertising cannot be taken as proof of sales or reputation.
66. I am satisfied the evidence does not prove the Opponent's marks are known throughout the State. I find the Opponent's mark is not entitled to protection as a well-known trade mark as it did not, at the relevant date, enjoy the type of reputation that Section 10(3) seeks to protect. Such a reputation would be expected to extend way beyond the limited exposure of consumers to the Opponent's goods and to penetrate the consciousness of the wider public, such that a substantial number of people would know and recognise the mark even if they had never used the Opponent's goods. The Opponent's reputation does not come anywhere near that level. Accordingly, I must dismiss the opposition under Section 10(3) and can do so without considering the other two conditions (whether the Applicant has due cause to use its mark and whether use would be injurious to the distinctive character or reputation of the Opponent's earlier marks).

**Section 10(4)(a) – passing off.**

67. The final ground of opposition that falls to be considered is Section 10(4) of the Act, the relevant part of which reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented – by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

68. There is no law which specifically excludes the mark NURITAS from registration. So, I will consider this ground under the common law right of passing off. The determination of the objection requires consideration of whether, on 5 May 2016, the Opponent would have been able to establish the basic elements required to be shown to ground an action for passing off if the Applicant had used the mark propounded for registration as a trade mark for any of the goods covered by the application. Adopting the test as enunciated by Lord Oliver in the House of Lords<sup>5</sup>, and expressing it in the terms of this case, the questions to be considered are:

- i. Did the Opponent have a goodwill or reputation attached to goods which it supplies under its NUTRIAS marks?
- ii. If so, would the sale by the Applicant under the mark applied for of any goods covered by the application for registration have constituted a misrepresentation leading or likely to lead the public to believe that those goods were the goods of the Opponent?
- iii. If so, would the Opponent suffer damage by reason of that erroneous belief?

69. When considering the opposition under Section 10(3) I found the Opponent’s marks did not have a reputation throughout the State. But a nationwide reputation is not required when considering the matter under passing off. Nonetheless, the Opponent’s case fails the first test because the Opponent has not adduced evidence to support it having earned any kind of a reputation under its marks. Though the Opponent claimed sales in the tens of millions of euro, I cannot draw any inference from this regarding reputation in the absence of real and substantive evidence. I am completely satisfied that grounds for refusal relied upon by the Opponent on the basis of a claim to passing off are unsustainable. Accordingly, I must reject the opposition under Section 10(3).

Dermot Doyle  
Acting for the Controller  
6 March 2019

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<sup>5</sup>In *Reckitt & Colman Products Ltd. v Borden Inc. & Ors.* [1990] RPC 406