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VITAKRAFT mark owner fails in opposition to VITACOAT

IIn Vitakraft-Werke Wührmann & Sohn GmbH & Co KG v Office for Harmonization in the Internal Market (OHIM) the European Court of First Instance (CFI) has upheld the decision to dismiss an opposition filed by the owner of earlier VITAKRAFT marks against the registration of the mark VITACOAT.

UK company VITACOAT Ltd applied to register VITACOAT as a Community trademark for goods in Classes 3, 5 and 21 of the Nice Classification, covering various pet healthcare products. During the application process VITACOAT Ltd assigned the application to UK company Johnsons Veterinary Products Ltd.

Based on its four German trademark registrations for VITAKRAFT in relation to, among other things, "feeding dishes for birds, dogs and cats; non-pharmacy-restricted veterinary preparations for toy fishes and birds, domestic birds; preparations for body and beauty care of pets as well as shampoos for pets, sanitary preparations for pets", German company Vitakraft-Werke Wührmann & Sohn GmbH & Co KG filed an opposition to the VITACOAT application.

The Opposition Division at OHIM dismissed the opposition as did the Board of Appeal.

The board noted a partial identity/similarity between the respective goods covered by the marks, but stated that there was only a small degree of similarity between the marks themselves. Among other things, it observed that the VITAKRAFT marks had low levels of inherent distinctive character in relation to most of the claimed goods since the German word 'kraft' (meaning 'strength or power' in English) merely underlined the idea of 'vitality' (vitalität in German) suggested by the 'VITA' element of the marks.

The board was unconvinced by evidence submitted by Vitakraft-Werke relating to the alleged highly distinctive character of its earlier marks. The evidence consisted of two surveys from 1992 and 1997 as well as a price list of goods carrying the VITAKRAFT marks dating from 1994.

On appeal, the CFI upheld the board's finding in relation to the survey evidence. It stressed that the distinctive character of a mark cannot be assessed purely through the percentages of consumer recognition expressed in a survey. All relevant facts of a case must be taken into consideration, in particular the market share held by the mark, how intensive, geographically wide spread and long-standing the use of the mark has been and the amount invested by the mark owner in promoting the mark.

The CFI also questioned the evidential value of the 1997 survey as the interviewees were not allowed to answer spontaneously, but were instead confronted with the mark and the relevant goods. In relation to the 1992 survey, the CFI held that the Board of Appeal rightly noted its limited evidential strength since it was carried out roughly four years prior to the filing date of the marks and had the same methodology as the 1997 survey. Moreover, the 1992 survey dealt with the mark VITA only and not with the VITAKRAFT marks.

On the assessment of likelihood of confusion, the CFI held, among other things, that the word element 'VITA' would be understood by the relevant public as referring to German words such as 'vital' and 'vitalität'. Additionally, it reasoned that 'vita-' is a commonly used prefix and, thus, is not particularly distinctive. Examining both the visual and phonetic similarities of the signs, the CFI concluded that despite the identical 'VITA' element at the beginning of each of the parties' marks, the difference between the elements 'KRAFT' and 'COAT' eliminated any likelihood of confusion.

Thus, Vitakraft-Werk's action was dismissed.

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