

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NOS**

**3558039, 3770221, 3770226, 3770239 & 3770232**

**IN THE NAME OF HELIOS MEDICAL COMMUNICATIONS LIMITED**

**AND**



**OPPOSITION THERETO UNDER NOS**




**424467, 434927, 434928, 434929 & 434931**

**IN THE NAME OF HELIOS KLINIKEN GMBH**

## **Background and pleadings**

1. This decision concerns five trade mark applications in the name of Helios Medical Communications Limited (“the applicant”) and an opposition against each of those applications by Helios Kliniken GmbH (“the opponent”). These are the applications in issue (“the contested marks”):

<b>Trade mark number &amp; relevant dates</b>	<b>Representation</b>
3558039 (“UK039”)  Filed: 19 November 2020	
3770221 (“UK221”)  Filed: 25 March 2022	

<p>3770232 (“UK232”)</p> <p>Filed: 25 March 2022</p>	
<p>3770226 (“UK226”)</p> <p>Filed: 25 March 2022</p>	
<p>3770239 (“UK239”)</p> <p>Filed: 25 March 2022</p>	

2. The contested marks have identical specifications in classes 9, 16, 35, 38, 41, 42 and 44.

3. The oppositions are based on grounds under s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and, in relation to UK221 only, s. 3(6). Under each of these grounds, the oppositions are directed against all of the goods and services other than those in class 9; the contested goods and services are listed in full at annexe 1.

4. For the opposition against UK039, the opponent relies upon the following trade mark:

European Union trade mark 16797375



Filed 2 June 2017, registered 2 July 2018 for services in classes 35, 37, 38, 41, 42, 43 and 44.

5. The oppositions against the remaining four contested marks are based upon this trade mark:

Comparable trade mark (EU) number 916797375



Filed 2 June 2017, registered 2 July 2018 for services in classes 35, 37, 38, 41, 42, 43 and 44.

6. All five oppositions are based on the following services for which the earlier marks are registered:

Class 35: Drawing up and management of medical and administrative data; Professional business consultancy (other than business consultancy) with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds.

Class 38: Communications services provided over the Internet; Providing of access to internet platforms for exchanging digital data between hospitals, clinics and rehabilitation and nursing facilities, or to others.

Class 41: Training and tuition.

Class 42: Medical and bacteriology laboratories.

Class 44: Hospitals; Healthcare information, namely exchange of digital data between hospitals and clinics and rehabilitation and nursing facilities or to

others, services provided by rehabilitation and nursing facilities; Medical services.

7. The opponent says that the competing trade marks are highly similar and that the goods and services are identical or similar, such that there will be a likelihood of confusion, including the likelihood of association. Consequently, it asks that the applications be refused under s. 5(2)(b).

8. The opponent also says that UK221 was applied for in bad faith because it is identical to UK039 apart from its colour and the applications are for the same goods and services. It is alleged that UK221 is a repeat application, filed to undermine the opposition process and/or cause the opponent to incur additional costs. The opponent requests that UK221 be refused under s. 3(6) of the Act.

9. The applicant filed counterstatements denying the grounds. I will return to the detail as necessary but note at this juncture that the applicant disagrees with the opponent's assessment of the similarity between and the dominant components of the respective trade marks and that it denies that the opponent has established facts which would give rise to a prima facie inference of bad faith.

10. As neither earlier mark had been registered for more than five years by the date of application for the contested marks, they are not subject to the use requirements at s. 6A of the Act and the specifications may be relied upon without evidence of use.

11. Neither party filed any evidence in these proceedings. Nor did either party request to be heard orally. Both, however, filed written submissions in lieu of a hearing, which I have read and will refer to as appropriate in the course of this decision.

12. The opponent is represented by Withers & Rogers LLP. The applicant's representatives are Squire Patton Boggs (UK) LLP.

### **Preliminary point**

13. The reason for a different mark being relied upon to oppose UK039 is because UK039 was filed before IP Completion date, namely 11pm on 31 December 2020. The other contested marks were filed after that date. Under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, UK039 is subject to

the provisions of the Act as they stood at IP Completion date, whilst the law governing the other applications is the Act as it was amended after IP Completion date. Relevant to the s. 5(2)(b) grounds is that up to IP Completion date, the definition of an “earlier trade mark” at s. 6 of the Act included European Union trade marks, whereas after IP Completion date the definition was changed so that EU trade marks were excluded but “a comparable trade mark (EU)” was added. These comparable trade marks are the clones of existing EU trade marks which were created after IP Completion date under Schedule 2A, part 1, paragraph 1 of the Act. Under those provisions, the trade marks, their specifications and their relevant dates are identical. As the earlier marks relied upon by the opponent are identical save for the trade mark number, I will refer to them in the singular from this point on, save where it is necessary to distinguish between them.

### **Section 5(2)(b)**

14. The relevant parts of s. 5 of the Act read as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[...]

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. The principles relevant to the global assessment of the likelihood of confusion are identified in the EU court judgments in *Sabel BV v Puma AG*, C-251/95, EU:C:1997:528; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, EU:C:1998:442; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, C-342/97, EU:C:1999:323; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, C-

425/98, EU:C:2000:339; *Matratzen Concord GmbH v OHIM*, C-3/03, EU:C:2004:233; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, C-120/04, EU:C:2005:594; *Shaker di L. Laudato & C. Sas v OHIM*, C-334/05P, EU:C:2007:333; and *Bimbo SA v OHIM*, C-591/12P, EU:C:2016:591. The principles are:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

#### **Average consumer and the nature of the purchasing act**

16. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik*.

17. The opponent submits that the average consumer “includes hospitals, health clinics, educational institutions, medical practitioners and professionals, and scientists”. It submits that the average consumer will pay at least an average level of attention. I have no specific submissions from the applicant regarding the identity of the average consumer or their level of attention.

18. Some of the competing goods and services, such as the business advice and consultancy services in class 35 of the contested specifications, or the laboratory services in class 42 of the earlier mark's specification, will be used by professionals. Others, such as teaching materials, communication services, training and education services or medical consultancy may be used by both the general public and professionals. The precise identity of professional consumers will depend on the

services but may include people in business, education providers and healthcare professionals. I agree with the opponent that the average consumer will pay at least a medium level of attention: none of the goods or services is a casual, everyday or particularly frequent purchase; on the contrary, all of the goods and services will require some consideration of factors such as subject matter, suitability of the goods/services for the user's precise needs or the reputation and/or reliability of the provider. In my view, the general public is likely to pay a medium degree of attention to the selection of the goods or services in classes 16 and 38, a reasonably high level of attention to the services in class 41, which are less frequently purchased and have a lasting impact, and a high level of attention to medical consultancy services in class 44, given that these are concerned with and may be critical to their health. The professional user's level of attention will be reasonably high (e.g., business advisory services) or high (e.g., bacteriology services/laboratories, medical research) because of the importance of the services to a business/institution and/or the potential for serious adverse consequences, including harm to patients or reputational damage, if an inadequate provider is selected.

19. All of the goods and services will be subject to a purchasing process dominated by visual exposure to the marks, including through websites, catalogues (including course catalogues), printed marketing material and tenders. There may be an aural element to the selection of any of the goods or services. For some of the services it is likely that there will be oral discussions about the service on offer and aural considerations may be reasonably important, though not to such a degree that they are more important than visual considerations.

### **Comparison of goods and services**

20. In the judgment of the Court of Justice in *Canon*, the court stated at [23] of its judgment 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.”

21. Complementarity may be the sole basis for the existence of similarity between goods: *Kurt Hesse v OHIM*, C-50/15 P, EU:C:2016:34. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, T-325/06, EU:T:2008:338, the General Court said that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

22. Words in specifications must be given their ordinary and natural meaning: *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12]. Where services are concerned, Jacob J. (as he then was) warned in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 against construing specifications for services too widely, saying:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23. It is well established that goods are considered identical when a wider term covers a narrower subset of goods included in the general class: *Gérard Meric v Office for Harmonisation in the Internal Market*, T-133/05, EU:T:2006:247. The same applies to services.

24. The applicant denies in its written submissions that certain of the contested services have any similarity with the services of the earlier mark. I infer that it accepts that the remainder of the contested specification has some degree of similarity with the earlier services. I bear this in mind.

## Class 16

*Teaching manuals; paper teaching materials; printed teaching material; printed training materials*

25. The opponent submits that these goods are similar to “training and tuition” services in class 41 of the earlier mark’s specification. I agree that the above goods are frequently important to the provision of training and tuition and that they are liable to be regarded as the responsibility of the same undertaking. Consequently, there is a reasonable complementary relationship between the goods and services. They will be used by the same consumers and will reach those consumers through the same channels of trade. These goods and services are similar to a medium degree.

## Class 35

*Business advice [twice]; business advisory and consultancy services; business advisory services; business consultancy; business consultancy and advisory services; business consultancy services; business consultancy (professional -); business consultation; business consultation services; business consulting; business consulting services; business expertise; business expertise services; consultancy (professional business-); professional business consultations; professional business consulting*

26. The opponent relies upon all of the services in class 35 in respect of the above services. The earlier business consultancy services appear to be the closest to those above but the term as it appears in the earlier specification is “professional business consultancy (other than business consultancy) with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds”. There is an obvious tension as the term purports to be business consultancy while at the same time disclaiming that it is business consultancy.

27. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin JSC set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible

meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

28. It is unclear to me how “other than business consultancy” could be taken, by the average consumer and in context, as carving out any particular professional business consultancy services. Neither party has addressed the point in submissions. My view is that the words “other than business consultancy” must be disregarded as they disclaim the entire category of services which the term identifies. In the comparison, the terms “advice” and “consultancy” are synonymous, and services providing “expertise” are consultancy services described in a different manner. My primary conclusion is that the services listed above are identical to “professional business consultancy [...] with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds” based on the principle outlined in *Meric*.

29. If that is wrong, however, confining the term to the core of its possible meanings, it appears to include consultancy, though not “business” consultancy, about purchasing for hospital and rehabilitation supplies and for nursing facilities. This would appear to cover matters such as how to run a procurement exercise or advice about contract negotiations. There is at least a reasonable degree of overlap in nature and purpose, because both services entail the consideration of a business’s existing arrangements and needs and the provision of advice relating to future plans, all aimed at the effective and efficient use of resources. The users of the services are the same, namely business owners or management, and the services are likely to be provided through the same channels of trade by the same companies. The services have at least a medium degree of similarity.

30. Furthermore, the contested services have a degree of overlap in purpose with the earlier mark's "drawing up and management of [...] administrative data", as they are both ultimately aimed at the smooth and efficient running of a business. The services have differences in nature but they are used by the same consumers and are provided by the same entities through the same channels of trade. These services are similar to a low degree.

*Business inquiries or information; business information*

31. The above services are, if not identical to the earlier mark's "professional business consultancy (other than business consultancy) with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds" on the basis identified in *Meric*, similar to at least a low degree to both of the earlier mark's terms in class 35 as they will share a high-level overlap in purpose, be directed at the same consumers and be offered through the same channels by the same providers.

*Business strategic planning; business strategic planning services; business strategy and planning services; business strategy development services; business strategy services; consultancy relating to business analysis; consultancy services regarding business strategies; preparation of expert evaluations and reports relating to business matters; research for business purposes; strategic business planning*

32. These services are concerned with the gathering of information about a business and analysis of that information. Leaving aside "research for business purposes", the services also entail the giving of advice and the provision of recommendations, for example to advance a company's market position and/or profitability. The nature and purpose of these services overlap with the nature and purpose of the earlier mark's "professional business consultancy [...] with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds" (even construed at its narrowest), which also entails advice and recommendations about business decisions, albeit purchasing-related decisions. The users of the services are the same and the services are likely to be provided through the same channels of trade by the same companies. The services have a medium degree of similarity.

33. Although the overlap in nature and purpose is less pronounced for “research for business purposes”, as “research” involves investigation and analysis but not the giving of advice, business research has some complementarity with the earlier “professional business consultancy [...] with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds”. As with the other services considered above, users, service providers and channels of trade will intersect. These services are also similar to a medium degree.

34. Furthermore, all of the above services fall within the broader categories of business management and business administration services. They have the aim of enhancing the functioning of a company, such as through its organisation, planning and efficiency. These services are likely to be provided by the same companies as the earlier mark’s “drawing up and management of [...] administrative data”, which are used by businesses in managing their affairs. There is some overlap in purpose and the services are provided to the same users, reaching the market through the same channels. They are similar to a low degree.

*Brand evaluation services; brand positioning services; brand strategy services; business advice relating to marketing; business advice relating to marketing management consultations; business advice relating to strategic marketing; business advisory services relating to product development; business assistance relating to business image; business consultancy services relating to product development; business marketing consultancy; business marketing consultation services; consultancy services related to communications; investigations of marketing strategy; marketing consultancy; marketing (business advice relating to-)*

35. The above are or may be marketing services which provide advice about positioning or reinforcing the market position of a business, its brands or its products. There is an overlap in purpose but the earlier mark’s “professional business consultancy (other than business consultancy) with regard to purchasing for hospital supplies, rehabilitation supplies and nursing facilities of all kinds” is a specific type of consultancy relating to purchasing and would not include marketing-related advice. However, firms offering professional (business) consultancy might reasonably be expected to offer some advice about improving the performance or market position of a company or its products, albeit as part of a wider remit. There is therefore also some

overlap in providers, channels of trade and users. These services are similar to a low degree.

36. Additionally, services such as social media marketing advice are likely to be offered by the same businesses as “drawing up and management of [...] administrative data”. There is a high-level overlap in purpose, and users and channels of trade are shared. There is a low degree of similarity overall.

*Arranging and conducting of business meetings; arranging of presentations for business purposes; arranging of displays for business purposes*

37. Whilst there is an overlap in purpose at a general level, these services have a different specific purpose from “drawing up and management of [...] administrative data”. They are different in nature but are likely to be offered to the same users by the same providers and will coincide in channels of trade. They are similar overall to a low degree.

*Strategic medical communications consultancy*

38. The opponent submits that these services relate to medical business management and that they share the same end user and trade channels as both of the earlier services in class 35. I accept that submission. However, apart from a high-level overlap in purpose, the services are otherwise different. Consequently, I do not accept that the services are highly similar but consider that the overlap is quite limited and there is a low degree of similarity.

39. I do not agree that the above services are highly similar to the earlier services in class 38. The explanatory note for class 38 says that it includes mainly services that allow at least one party to communicate with another, as well as services for the broadcasting and transmission of data. As I understand it, this relates to the provision of technical facilities and/or infrastructure for enabling parties to communicate. The contested services are communications services concerned with the content of communications messages and, for example, the selection of the channels through which they should be conveyed to the targeted consumers, such as television or different social media platforms. They are a different service entirely from the technical process of the transmission of messages.

## Class 38

*Communications services; digital communication services*

40. These services encompass the earlier mark's "communications services provided over the internet" and they are therefore identical under the principle explained in *Meric*.

*Communications consultancy; advisory services relating to communications*

41. The earlier mark's "communications services provided over the internet" is, in my view a very wide term which would include all manner of communications services (i.e., the provision of methods of communication covered by class 38), including consultancy about such communications services. There is no reason why the contested services would not include services provided over the internet. Consequently, these services are also identical under *Meric*.

## Class 41

*Advanced training; arranging of presentations for training purposes; arranging of seminars relating to training; arranging teaching programmes; business training; business educational services; business training services; conducting educational support programmes for healthcare professionals; conducting educational workshops in the field of business; conducting of educational courses in business; conducting of educational courses relating to business; education and training services; education and training services relating to healthcare; education, teaching and training; educational and training services relating to healthcare; educational services in healthcare sector; educational training services; medical education services; medical training and teaching; organisation of training seminars; providing courses of training; providing of training; provision of education and training; provision of online training; provision of training; provision of training and education; provision of training courses; provision of training facilities; provision of training services for business; staff training services; training and education services; training courses (provision of-); training in the field of medicine; training services for medical visitors; training services in the field of medical disorders and their treatment; training services related to business*

42. The earlier mark includes, in class 41, “training and tuition”. It is a wide term and the services identified above are identical to the earlier mark’s services on the basis set out in *Meric*.

*Advice relating to medical training; business training consultancy services; consultancy services relating to the development of training courses; consultation services relating to business education; education and training consultancy; educational consultancy; provision of information relating to training; training and further training consultancy; training consultancy*

43. The opponent’s position is not entirely consistent. It submits that some of the above services (e.g., advice relating to medical training, training consultancy) are identical to the earlier mark’s services but that others (e.g., business training consultancy, education and training consultancy) are only highly similar. Although expressed differently, all of the services cover the provision of advice about training, in various guises, and the basis on which the opponent draws a distinction between these services is not apparent to me. I will therefore approach the matter on the basis least favourable to the opponent, i.e., that it says that the services listed above are highly similar to the earlier specification. The services are said to be related to training and education and share the same purpose, users and trade channels. I agree. They are also likely to be offered by the same providers and are complementary. They are highly similar. For the avoidance of doubt, I would have accepted that the services are identical to “training and tuition” services, on the basis that the earlier term includes training-related advice and consultancy and that education(al) consultancy provides training consultancy services under a different name.

*Conducting of business conferences*

44. The opponent submits that these services are highly similar to training and tuition because they share the same end purpose, users and trade channels. I agree that “conducting of business conferences” includes business conferences the primary aim of which is training and that there is a significant overlap in purpose. I also agree that the services may be provided by the same entities through the same trade channels, and that the users will be the same. They are similar to a medium degree.

### *Educational research*

45. This service is said to be highly similar to “training and tuition”. They are both, broadly, educational services concerned with furthering knowledge through the acquisition of information. However, the specific purpose of research is to discover more about a subject, whilst training and tuition involve imparting knowledge to others. I agree with the opponent that the users are likely to be the same and that these services will be provided through the same entities and channels of trade. There is a medium degree of similarity.

*Production of training films; production of training videos; publication of medical texts; publication of training manuals*

46. The above services are likely to be used by the same consumers as training and tuition services and be offered by the same providers through the same channels. Further, the above services are important for training and tuition and are likely to be seen as the responsibility of the same undertakings. They are thus complementary. They are similar to a medium degree.

### *Training related sales*

47. On its face, this appears to be a service selling training or goods/services related to training. That is not a service proper to class 41. However, without reading words into it (e.g., training related to sales), I do not see how I can construe the term otherwise. On that basis, the likely consumers of training-related sales services are education providers rather than those seeking education, who are the users of “training and tuition” services, and the only point of overlap appears to be a fairly superficial similarity in purpose. The applicant, however, has not submitted that these services are dissimilar and appears to accept some similarity. Accordingly, I proceed on the basis that there is a low degree of similarity.

### Class 42

*Biological research; biotechnology research; clinical research; medical research; research on disease; research services; scientific research [twice]; scientific research*

*for medical purposes; scientific research for medical purposes in the field of disease; scientific research and analysis*

48. The opponent says that these services are identical to the earlier mark's "medical and bacteriological laboratories". I disagree. In my view, medical and bacteriological laboratory services, at their core, are the provision of laboratory services such as laboratory testing of blood samples for hospitals. The above research services may undoubtedly be carried out in laboratories using the same equipment and they have a broad shared purpose of attaining scientific knowledge but the specific purpose is not identical. The users of the services will overlap and they are likely to be made available by the same entities and through the same channels. Further, the services are important for one another and there is a complementary relationship. The services are similar to a reasonably high degree.

*Bacteriology consultancy; biology consultancy; consultancy in the field of biotechnology; scientific consultancy*

49. These services have an overarching similarity of purpose to "medical and bacteriology laboratories" but the contested services are advisory services whilst laboratory services concern the practical application of knowledge, so there is a difference at a more granular level. However, the services share users, trade channels and providers and there is complementarity. They are similar to a reasonably high degree.

*Brand design services*

50. I have no submissions from the opponent on its best case or why these services are similar to those of the earlier mark. I cannot see that there is any point of intersection. The contested services are design services and would be used by businesses to create, for example, logos. They have a different purpose from all of the earlier services and there is no obvious crossover in nature, channels of trade or providers. Any overlap in users due to both having businesses as consumers is too superficial to be meaningful. There is no similarity with any of the earlier services.

### *Industrial research; technical research*

51. The opponent says that these services are identical to “medical and bacteriological laboratories”. I dismiss that claim. Industrial and technical research are concerned with, for example, investigation into industrial processes, industrial machinery, technology and processes. There is no relevant point of similarity with “medical and bacteriological laboratories”; any overlap in user is simply that the respective users are professionals but there is no specific overlap which would give rise to overall similarity between the services. They are not similar.

52. There is, however, some similarity between these services and the earlier “tuition” services in class 41, since that term includes higher education tuition and institutions providing such tuition will carry out industrial and technical research. There is an overlap in purpose (acquiring and disseminating knowledge) as well as in providers and channels of trade. There is a medium degree of similarity.

### Class 44

*Collation of information in the healthcare sector; health consultancy; healthcare advisory services; healthcare consultancy services; healthcare information services; human healthcare services; providing medical information in the healthcare sector; health consultancy; medical consultancy services; consultancy relating to health care; technical consultancy services relating to medical health; consultancy services in relation to diseases*

53. The earlier mark includes “medical services”, which is one of the class headings. It is a very wide term encompassing all manner of medical services. The contested services are identical to “medical services” on the basis outlined in *Meric*.

### **Distinctive character of the earlier trade mark**

54. In *Lloyd Schuhfabrik*, the Court of Justice said, at [22], that the court must make an overall assessment of a mark’s capacity to distinguish the goods or services of one undertaking from those of others. It continued:

“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).”

55. The opponent submits that the earlier mark is distinctive to a very high degree. It acknowledges that “Helios” is the name of the Greek god of the Sun but submits that the name has no connection to the services and is not in common parlance. The applicant complains that the opponent has filed no evidence to substantiate its claim to a highly distinctive character.

56. Consideration of the distinctiveness of the earlier mark is an intrinsic part of the global assessment. There is no obligation on parties to file any evidence to assist the tribunal in determining how inherently distinctive a trade mark is. Of course, they may do so, and they may also file evidence to support a claim to additional distinctiveness acquired through use but if the mark is highly distinctive on its face, no evidence is required to support that proposition: it is a finding I can reach unaided.

57. In relation to the distinctiveness of the mark, my view is that some consumers may recognise that “Helios” means the Greek god of the Sun but a significant proportion, if not most average consumers, are unlikely to attribute any meaning to the word. I accept that for people who do recognise “Helios” as having a meaning it is a fairly unusual word. The device is distinctive but no more than the word “Helios”. Overall, the mark is distinctive to at least a reasonably high degree and for most consumers it is highly distinctive.

58. I have not overlooked the register evidence filed by the applicant in its written submissions which shows a number of “Helios” marks. However, it is well established that the mere existence of trade marks on a register is not sufficient to establish that

the distinctiveness of a word has been weakened: *Zero Industry Srl v OHIM*, T-400/06, EU:T:2009:331. This evidence has no weight.

### **Comparison of marks**

59. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice stated at paragraph 34 of its judgment in *Bimbo* that:

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

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

61. For convenience, this is the earlier trade mark:



62. The mark consists of the word “Helios” in an unremarkable bold typeface in green. To the left of the word is a device consisting of two hooked shapes presented as the mirror image of one another on a diagonal axis. One shape is in dark green, the other in the same lighter green as the word. The word “Helios” plays a greater role in the overall impression of this mark because of its size relative to the device, because of the tendency of humans to focus on words, which applies in this case, and because

the word is itself distinctive to at least a fairly high degree. The device is not negligible but is secondary in importance to the word.

### Comparison with UK039

63. This is UK039:



64. There are three elements to the mark. The first is the word “HELIOS”, presented in a plain typeface in capital letters, in black. The second is a large circular device inside which the word “HELIOS” is placed off-centre. The device consists of many circular lines, none of which forms a complete circle, and there are therefore patches of white, particularly in the right-hand half of the circular device. The lines are multicoloured. The third element is the words “MEDICAL COMMUNICATIONS” which are placed under the word “HELIOS” and are much smaller and fainter; it is difficult to tell whether they appear fainter because they are in a lighter colour or whether it is a combination of their size and a font which is not bold.

65. The opponent submits that “HELIOS” is dominant in the mark. I do not agree. The circular device is much larger than the word “HELIOS” and is visually striking. Although circular, it is a fairly complex device. Notwithstanding the tendency for humans to focus on words, I consider that the device and the word “HELIOS” make a broadly equal contribution to the overall impression of the mark. The words “MEDICAL COMMUNICATIONS” are very small and faint. They are also non-distinctive for the goods and services. They will play a weak role at best.

66. Turning to the comparison, there are significant visual differences between the competing trade marks because of the devices in the respective marks. The different

uses of colour—two shades of green in the earlier mark, many different colours and black letters in UK039—are noticeable. There is a less significant difference because of “MEDICAL COMMUNICATIONS”. However, there is also a clear point of similarity because of the word “HELIOS”/“Helios”. In my judgement, the marks are visually similar to a medium degree.

67. The earlier mark will be spoken as “Helios” in three syllables: HE-LI-OS. The first syllable may be pronounced with a long “e” as in “heel” or a short “e” as is “hell”. The second syllable will have a long “e” and the third will rhyme with “floss”. However the word is articulated, it will be pronounced in the same way in UK039. Given their limited significance in the overall impression of UK039, it is unlikely that the words “MEDICAL COMMUNICATIONS” will be spoken. If they are, the marks have a lower than average degree of aural similarity because of the additional, and lengthy, words in UK039, even though the first word is identical. For the significant part of consumers who will not articulate “MEDICAL COMMUNICATIONS”, the marks are aurally identical.

68. “HELIOS” will have no meaning for most consumers and is conceptually neutral. For those who do recognise its meaning, the word will have an identical meaning in both marks. There is some conceptual difference arising from “MEDICAL COMMUNICATIONS” but this is a non-distinctive, or at best very weakly distinctive, difference, as it is difficult to see how normal and fair use would encompass use of the mark in relation to goods or services unconnected with medical communications without being deceptive.

#### Comparison with UK221

69. This is UK221:



70. As is evident, UK221 is very similar to UK039 and contains broadly the same elements. Instead of multicoloured lines, the colours of the circular device are all in tones of yellow, orange, red and brown. The words “MEDICAL COMMUNICATIONS” are in black and more easily legible, though they remain much smaller than the word “HELIOS”. I consider that the device and the word “HELIOS” make a broadly equal contribution to the overall impression of the mark, for the same reasons given above, and that the words “MEDICAL COMMUNICATIONS” play a weak role on account of their small size and lack of distinctiveness.

71. For essentially the same reasons as with UK039, whilst noting the different colour scheme of UK221, my assessment of the level of similarity between the competing marks is that they are visually similar to a medium degree and aurally identical for at least a significant proportion of average consumers. The conceptual comparison is identical to that for UK039.

#### Comparison with UK232

72. UK232 is reproduced below:



73. This mark includes the same circular device as UK039 and the word “HELIOS”, in the same configuration. My comments in relation to those elements are the same for this mark. In UK232, the words “GLOBAL GROUP” appear below the word “HELIOS”, in a much smaller typeface. These words are likely to be perceived as a reference to the business structure of the entity using the mark. I consider that the overall impression mainly resides in the device and the word “HELIOS” and that the words “GLOBAL GROUP” have a much weaker role.

74. For reasons similar to those given above, I consider that the differences arising from the devices in the competing marks, the use of colour and the words “GLOBAL GROUP”, when set against the presence of the identical word “HELIOS”, result in a medium degree of visual similarity. I am doubtful that “GLOBAL GROUP” will be spoken. If it is, there is a medium degree of aural similarity; if it is not, the marks are aurally identical. “HELIOS” will be either conceptually neutral or convey an identical meaning, as described above; there is a conceptual difference because “GLOBAL GROUP” conveys the message of a group of companies but this is, at best, a conceptual message of limited distinctiveness.

#### Comparison with UK226

75. This is UK226:



76. UK226 consists of the word “HELIOS” placed above the words “MEDICAL COMMUNICATIONS”. These verbal elements are presented in black capital letters, in an entirely ordinary typeface and font. The word “HELIOS” is much bigger than “MEDICAL COMMUNICATIONS”, the latter being sized to sit completely within the length of the single word “HELIOS”. There is also a device element. It consists of a number of interrupted curved lines mainly in tones of yellow and amber. This device is placed to the top left of the word “HELIOS”. In this mark, the word “HELIOS” plays the greater role in the overall impression. The device plays a part but it is not equal to “HELIOS”. The words “MEDICAL COMMUNICATIONS” have a much weaker role on account of their size and limited, if any, distinctive character.

77. The competing marks have differences because they each contain a device and those devices are different. There are differences in colour. UK226 also includes the words “MEDICAL COMMUNICATIONS”, which have no counterpart in the earlier mark, although the impact of those words is limited, for the reasons I have explained. There is, however, a significant point of similarity because of the word “HELIOS”,

which is prominent in both marks. Bearing in mind my assessment of the overall impressions of the marks, I consider that these marks are visually similar to a high degree.

78. As with the marks I considered earlier, I think that a significant part of consumers will not articulate “MEDICAL COMMUNICATIONS”, for the same reasons. For these consumers, the marks are aurally identical; otherwise they are similar to a lower than average degree.

79. For the same reasons I have already given, the shared word “HELIOS” is conceptually neutral or identical but there is a difference because of the meaning of “MEDICAL COMMUNICATIONS” in UK226.

#### Comparison with UK239

80. This is UK239:



81. This mark comprises a multicoloured device of curved lines placed at the top left of the word “HELIOS”, which is presented in black capital letters in a plain typeface. Beneath “HELIOS” are the words “GLOBAL GROUP”, again in black upper case but in a smaller font. The most important element in the overall impression is the word “HELIOS”. The device plays a lesser but still important role, whilst the words “GLOBAL GROUP” play a weak role, for the reasons I have given above.

82. The devices in the competing marks are different, the marks are in different colours (though the device in UK239 does contain some green) and UK239 contains the additional words “GLOBAL GROUP”. In contrast, the identical word “HELIOS” plays a significant part in each of the marks. Overall, there is a high degree of visual similarity. If the words “GLOBAL GROUP” are spoken, there is a medium degree of aural similarity; if they are not, the marks are aurally identical. As with UK232, any

conceptual difference arises from “GLOBAL GROUP” and is a weakly distinctive difference at most.

### **Likelihood of confusion**

83. Confusion may be direct or indirect. Direct confusion is where the average consumer simply mistakes one mark for another. Indirect confusion is where the average consumer notices that the two marks are not the same but where the common elements lead them to conclude that the later mark is another brand of the owner of the earlier mark: see the comments of Iain Purvis QC, as the Appointed Person, in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10 at [17]. Mr Purvis QC also gave some non-exhaustive examples of how indirect confusion may occur:

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

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

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

84. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ pointed out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

85. I have found “brand design services” in class 42 dissimilar to the earlier mark’s services. Under s. 5(2)(b), there can be no likelihood of confusion without some similarity between the services: *Waterford Wedgwood plc v Assembled Investments (Proprietary) Ltd and OHIM*, C-398/07P, EU:C:2009:288. The oppositions are dismissed to the extent that they are directed at these services.

86. The remaining goods and services in the contested specifications are similar to at least a low degree to the services of the earlier mark. The average consumer will pay a medium to high degree of attention, depending on their particular characteristics and the services they are purchasing. The earlier mark is highly distinctive for the relevant public who attributes no meaning to “HELIOS”. These average consumers are a significant proportion of the relevant public and the s. 5(2)(b) grounds will be made out if I find that there is confusion among these consumers. I will start with them.

87. I will consider UK039, UK221 and UK232 first, as although they are all slightly different, I have found the same level of similarity for these marks with the earlier mark. I do not consider that there is a likelihood of direct confusion: the differences in presentation, particularly the different devices in the competing marks, are too great for the consumer in either group to mistake one trade mark for the other. However, I consider that there is a likelihood of indirect confusion for these marks, even for those services which are only similar to a low degree. I bear in mind that the average consumer’s attention will, for some of the services, be reasonably high or high, though the highest level of attention will be reserved for services which are similar to at least a medium degree. In my view, the word “HELIOS” is sufficiently distinctive, and sufficiently prominent in the competing marks, that the consumer will think that these are different marks being used by the same undertaking, for example that there has been a redesign of the existing mark (or vice versa). There is no conceptual hook, other than a weakly distinctive one at best, which will enable the consumer to distinguish between the marks and to attribute them to different undertakings. I do not think that the elevated level of attention is sufficient to dispel confusion, nor do the services have such limited similarity that confusion will be avoided.

88. As for UK226 and UK239, these marks are visually highly similar to the earlier mark. The other factors in the comparison are the same as for the marks considered above. In principle, there is a greater risk of direct confusion for these trade marks,

owing to the lesser role of the device in the contested marks and the dominance in the competing marks, though not to the exclusion of all the other elements, of the identical word “HELIOS”. Bearing in mind that the average consumer recalls trade marks imperfectly, they are more likely simply to misremember the elements other than the word “HELIOS” and to mistake one mark for another. However, the devices in the competing marks are not banal shapes which will be easily forgotten. On the contrary, they are distinctive in their own right. I think the devices are sufficiently complex that, even if they are not recalled with precision, the average consumer is likely to recognise that there are differences between the marks and they will not be directly confused. However, I do consider that there is a likelihood of indirect confusion. Whilst I have borne in mind that there is at least a medium and in some cases a high level of attention, and that there is a range of levels of similarity between the goods and services, the distinctiveness of the earlier mark and the common highly distinctive word “HELIOS” are likely to lead consumers to believe that these are different marks used by the same undertaking. Although there are other elements in the marks, they are not sufficient to dispel confusion. There is a likelihood of indirect confusion.

89. Accordingly, the s. 5(2)(b) grounds are made out, save for “brand design services”.

### **Bad faith: s. 3(6)**

90. Bad faith is provided for at s. 3(6) of the Act, which states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

91. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin JSC considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able

to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...]."

92. Lord Kitchin summarised the general principles applicable to bad faith, at [240] of his judgment, as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaeonet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*"), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

93. The relevant date for assessing bad faith is the date of application for the trade mark, namely 25 March 2022.

94. The opponent’s case is that UK221 is to all intents and purposes the same as UK039 and that UK221 was filed in the full knowledge that UK039 was opposed. This, the opponent says, forced the opponent to file a new opposition against UK221. The opponent says that the filing of UK221 constitutes a repeat application for an identical or very similar mark and this shifts the burden to the applicant to explain the commercial rationale behind its application. Further, the opponent claims that the applicant has deliberately filed UK221 to undermine the opposition process for UK039, forcing the opponent to oppose UK221.

95. In terms of the correct approach in law, it is clear from paragraph (vii) of Lord Kitchin’s summary that the burden for establishing bad faith remains on the opponent. It is only once the opponent has established circumstances which lead to a rebuttal of the presumption of good faith that an applicant must provide an explanation of its rationale for filing the trade mark.

96. The first question is therefore whether the facts alleged by the opponent rebut the presumption of good faith (i.e., establish a prima facie case of bad faith). There is no evidence to support the claim and therefore the only material to consider is the pleadings. In *Hasbro*, the trade mark proprietor had made repeated applications for the same trade mark, some of which had broader specifications than others. The General Court considered the law in relation to re-filing applications as follows:

“70. In that regard, it must be stated there is no provision in the legislation relating to EU trade marks which prohibits the re-filing of an application for registration of a trade mark and that, consequently, such a filing cannot, in itself, establish that there was bad faith on the part of the trade mark applicant, unless it is coupled with other relevant evidence which is put forward by the applicant for a declaration of invalidity or EUIPO.”

97. It is clear from this reasoning that more than simply re-filing an application is required in order for it to be established that an application was filed in bad faith. On the facts, *Hasbro* is readily distinguishable from the present case because, in *Hasbro*, the proprietor admitted re-filing the marks partly to avoid having to prove use when enforcing its marks. There is no similar allegation here and certainly no such evidence.

98. I accept that repeat filings of a trade mark may amount to bad faith but I do not consider that there is sufficient relevant evidence to establish bad faith in the present case. UK221 is doubtless very similar to UK039 but it is not identical. There may be many legitimate reasons why the applicant decided that a registration in different colours was necessary, including that it has used the mark in those colours and wanted to ensure it was fully protected. I do not think that the mere fact of the filing of a similar mark is a fact which is any more consistent with bad faith than with good faith, and a claim of bad faith is not made out by establishing facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

99. The opponent relies on the fact that UK039 was opposed. However, the application for UK221 had and could have had no impact on the opposition process already under way for UK039. There is no evidence to suggest that the applicant was seeking to circumvent the opposition process by filing a second mark in the hope that the

opponent would not notice and the application would proceed to registration unopposed. I do not think that the fact of the filing, on its own, is sufficient to justify such an inference.

100. Nor does the fact of the application for UK221 disclose that the applicant was deliberately trying to increase the opponent's costs by filing repeat applications. If there was an increase in the opponent's costs, there would also be an increase in the applicant's costs, as it attempted to defend any opposition. It is therefore not clear that the applicant would gain any advantage, still less an improper one. It is true that an application may be filed vexatiously, which may include causing the other side to incur costs. If there were evidence of antagonism between the parties, that may go some way to establishing ulterior motives of this nature but there is none.

101. The opponent points in its written submissions to another application, UK4040311, filed in April 2024. That application appears to be identical to UK221 and covers some of the same goods and services. It is, however, not part of the opponent's pleaded case and there has been no application to amend the pleadings. In any case, I accept that an opponent may establish a pattern of filing behaviour on the part of an applicant which may indicate bad faith. However, I do not consider that the opponent in this case has presented facts and evidence which rebut the presumption of good faith at the application date for UK221. There had been only one earlier application, for a colourably different trade mark and there is no evidence to support a claim that the application was for illegitimate means. The mere fact that UK4040311 has been filed since the relevant date is not strong evidence to support an inference that the applicant's intention in 2022 was improper, though of course that says nothing about the purpose behind the application for UK4040311 in 2024. The claim that UK221 was filed in bad faith is dismissed.

### **OVERALL CONCLUSION**

102. The oppositions have succeeded under s. 5(2)(b) for all of the contested goods and services except "brand design services". Subject to appeal, the applications will be registered for all of the goods in class 9, which were not opposed, and for "brand design services" in class 42.

## **COSTS**

103. The opponent has had the lion's share of success and is entitled to a contribution towards its costs. I make an allowance for the limited success of the applicant and for the fact that the pleadings overlapped. I calculate costs to the opponent as follows:

Preparing and considering notices of opposition and counterstatements:	£650
Preparing written submissions in lieu of a hearing:	£400
Official fee (x5):	£1,000
Total:	£2,050

104. I therefore order Helios Medical Communications Limited to pay Helios Kliniken GmbH the sum of £2,050. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 8<sup>th</sup> day of January 2026**

**Heather Harrison**

**For the Registrar**

## ANNEXE 1

### **UK3558039, UK3770221, UK3770232, UK3770226 and UK3770239: contested goods and services**

Class 16: Teaching manuals; paper teaching materials; printed teaching material; printed training materials.

Class 35: Arranging and conducting of business meetings; arranging of presentations for business purposes; arranging of displays for business purposes; brand evaluation services; brand positioning services; brand strategy services; business advice; business advice relating to marketing; business advice relating to marketing management consultations; business advice relating to strategic marketing; business advice, inquiries or information; business advisory and consultancy services; business advisory services; business advisory services relating to product development; business assistance relating to business image; business consultancy; business consultancy and advisory services; business consultancy services; business consultancy services relating to product development; business consultancy (professional -); business consultation; business consultation services; business consulting; business consulting services; business expertise; business expertise services; business information; business marketing consultancy; business marketing consultation services; business strategic planning; business strategic planning services; business strategy and planning services; business strategy development services; business strategy services; consultancy relating to business analysis; consultancy services regarding business strategies; consultancy services related to communications; consultancy (professional business-); investigations of marketing strategy; marketing consultancy; marketing (business advice relating to-); preparation of expert evaluations and reports relating to business matters; professional business consultations; professional business consulting; research for business purposes; strategic business planning; strategic medical communications consultancy.

Class 38: Communications consultancy; communications services; digital communication services; advisory services relating to communications.

Class 41: Advanced training; advice relating to medical training; arranging of presentations for training purposes; arranging of seminars relating to training; arranging teaching programmes; Business training; business educational services; business training consultancy services; business training services; conducting educational support programmes for healthcare professionals; conducting educational workshops in the field of business; conducting of business conferences; conducting of educational courses in business; conducting of educational courses relating to business; consultancy services relating to the development of training courses; consultation services relating to business education; education and training consultancy; education and training services; education and training services relating to healthcare; education, teaching and training; educational consultancy; educational and training services relating to healthcare; educational research; educational services in healthcare sector; educational training services; medical education services; medical training and teaching; organisation of training seminars; production of training films; production of training videos; providing courses of training; providing of training; provision of education and training; provision of information relating to training; provision of online training; provision of training; provision of training and education; provision of training courses; provision of training facilities; provision of training services for business; publication of medical texts; publication of training manuals; staff training services; training and education services; training and further training consultancy; training consultancy; training courses (provision of-); training in the field of medicine; training related sales; training services for medical visitors; training services in the field of medical disorders and their treatment; training services related to business.

Class 42: Bacteriology consultancy; biological research; biology consultancy; consultancy in the field of biotechnology; biotechnology research; brand design services; clinical research; medical research; research on disease; research services; scientific consultancy; scientific and industrial research; scientific research; scientific research for medical purposes; scientific research for medical purposes in the field of disease; scientific research and analysis; technical research.

Class 44: Collation of information in the healthcare sector; health consultancy; healthcare advisory services; healthcare consultancy services; healthcare information

services; human healthcare services; providing medical information in the healthcare sector; health consultancy; medical consultancy services; consultancy relating to health care; technical consultancy services relating to medical health; consultancy services in relation to diseases.