

**O/0070/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001703558**

**IN THE NAME OF SOLEM S.A**

**FOR THE FOLLOWING TRADE MARK:**

**LUNA**

**IN CLASSES 9, 42 AND 45.**

**AND IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 441625**

**BY MBI HEALTHCARE TECHNOLOGIES LIMITED**

## BACKGROUND AND PLEADINGS

1. On 11 October 2022, SOLEM S.A (“**the holder**”) registered the International trade mark found on the front cover of this page, under number WO0000001703558 (“**the IR**”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 14 April 2022 from the French Patent and Trademark Office.<sup>1</sup>
2. The IR was accepted for protection in the UK and published in the Trade Marks Journal on 31 March 2023 in respect of the following goods and services:<sup>2</sup>

Class 9: Security and monitoring apparatus; sensors, detectors and monitoring instruments; alarm monitoring systems; surveillance robots for security; monitoring apparatus other than for medical use; wearable activity trackers with heart-rate monitoring function; smartwatches that communicate data to personal digital assistants [PDAs]; virtual personal assistant software; downloadable virtual assistant software; software for monitoring, analyzing, controlling and running physical network operations; wireless control units for the control and remote control of the operation and status of security systems; connected bracelets [measuring instruments]; computer platforms; computer platforms in the form of downloadable software for hosting computer sites; remote control telemetering machines and instruments; downloadable software for remote monitoring and analysis; scientific apparatus and instruments; photographic apparatus and instruments; optical apparatus and instruments; measuring apparatus and instruments; signaling apparatus and instruments; checking (monitoring) apparatus and instruments; sound recording apparatus; sound transmission apparatus; sound reproduction apparatus; image recording equipment;

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<sup>1</sup> Priority claimed from the French Trade mark no. 4861420

<sup>2</sup> The specification has been amended subject to a change to the limitation at the WIPO and this was confirmed to the parties on 18 July 2025. Following which the parties were granted the opportunity to file further submissions.

image transmission apparatus; image reproduction apparatus; digital recording media; data processing equipment; computers; tablet computers; smartphones; electronic book readers; software (recorded programs); computer peripherals; detectors; protection devices for personal use against accidents; 3D spectacles; virtual reality headsets; eyewear; spectacle cases; memory cards or integrated circuit cards; smart watches; electric batteries; diagnostic apparatus, not for medical use; any of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.

Class 42: Development of computer platforms; hosting of platforms on the Internet; testing of alarm and monitoring systems; testing of computer hardware and software used with alarm and monitoring systems; technical assessments concerning design (engineers' services); engineering; technical project planning in the field of engineering; scientific and technical research; design of computers for third parties; computer development; software design; software development; research and development of new products for third parties; conducting of technical project studies; software development (design); software installation; software maintenance; updating of software; software rental; programming for computers; computer system analysis; computer system design; consultant services with respect to computer hardware design and development; digitization of documents; Software as a Service (SaaS); cloud computing; advice regarding information technology; server hosting; architecture; design of interior decor; graphic arts design services; styling (industrial design); energy auditing; electronic data storage; any of the above services related to video games; all the above services exclusively in connection with remote assistance services.

Class 45: Monitoring services; monitoring of alarms; medical alarm monitoring; monitoring of burglar alarms; monitoring of fire alarms; rental of security surveillance apparatus other than security drones and surveillance

drones; provision of reconnaissance and surveillance services; monitoring services relating to the security of physical assets; monitoring services relating to the physical safety of persons; electronic monitoring services being security monitoring services relating to the physical safety of persons and the security of physical assets; video surveillance of facilities, viewable through a global computer network [online surveillance services]; monitoring of computer systems as monitoring services for building security; monitoring of telephone calls from subscribers and triggering of emergency response services; monitoring of computer systems as monitoring services for the physical safety of persons and security of physical assets; security services for protection of property and individuals; legal services; mediation; night guard services; monitoring of burglar alarms; services provided by consultants relating to physical security; opening of security locks; rental of domain names on the Internet; online social networking services; companionship services for the elderly and disabled; babysitting; concierge services; any of the above services related to video games.

3. On 28 June 2023, MBI Healthcare Limited (“**the opponent**”) filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed **against the goods and services in class 42 of the IR only**, which are set out in the table at paragraph 31 below.<sup>3</sup>
4. In support of its claim the opponent relies upon the following trade mark from its series of trade marks:<sup>4</sup>



UK trade mark number: UK00003718399

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<sup>3</sup> Initially the opponent opposed all the goods and services of the application, however, on 1 August 2025, the opponent wrote to the Tribunal and confirmed that it no longer wished to oppose the holder's class 45 services.

<sup>4</sup> Within its statement of grounds at paragraph 2 it says it relies on the second, black and white version of the Earlier Right, which was filed as a series of two marks in colour and in black and white.

Filing date: 5 November 2021

Registration date: 6 May 2022

Goods and services relied upon:

Class 9:

Computer software for use in the management of patient data, health information, patient records, medical records and treatment plans; downloadable computer application software for the management of patient data, health information, patient records, medical records and treatment plans; downloadable software enabling the production and sending of confidential communications relating to the treatment and monitoring of patients.

Class 42:

Software as a service (SAAS) for use in the management of patient data, health information, patient records, medical records and treatment plans; software as a service (SAAS) for the provision of access to patient data, health information, patient records, medical records and treatment plans; software as a service (SAAS) enabling the production and sending of confidential communications relating to the treatment and monitoring of patients.

5. Given the respective priority/filing dates of the competing marks, the opponent's mark is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been registered for five years or more at the priority filing date claimed by the IR, it is not subject to the proof of use requirements specified within Section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services identified, without having to demonstrate genuine use.
6. The opponent argues that the competing trade marks are highly similar as they share the identical word "LUNA", and that the competing goods and services are either identical or highly similar. It is these factors, that the opponent contends gives rise to a likelihood of confusion.
7. The holder filed a counterstatement denying the ground of opposition.

8. The opponent is professionally represented by Venner Shipley LLP; the holder is professionally represented by Sonder & Clay. Only the opponent chose to file evidence during the evidence rounds. Neither party asked for an oral hearing, but both parties elected to file written submissions which are discussed below in further detail.

### **Relevance of EU law**

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **Evidence and submissions**

10. The opponent's evidence comprises a witness statement of Barry Mulholland signed on 6 November 2023 and amended on 4 November 2024. Mr Mulholland is the company secretary, and former director of the opponent's subsidiary company, MBI Healthcare Limited, together with Exhibits BM1 to BM3. The purpose of the opponent's evidence is to show the history and activities under the earlier mark.
11. Neither party requested a hearing, however both parties elected to file written submissions in lieu.
12. I have read and considered all the papers and will refer to relevant points from the parties' evidence and submissions as and where necessary in this decision.

### **Preliminary issues**

13. The holder raised for the first time within its initial submissions that the opponent is not the owner of the mark and that only the owner of the mark can rely on the earlier mark to bring an opposition. The Tribunal wrote to the parties on 17

October 2024 putting the submission to the opponent and asking it to clarify its position on this point.

14. On 6 November 2024, the opponent provided an explanation confirming that it was a typographical error and provided an amended witness statement correcting such for that date. However, the explanation also confirmed that since the signing of the original witness statement the company name has changed from BMI Healthcare Technologies Limited to BMI Health Limited.

15. I am satisfied that despite the name change, the opposition is still brought by the registered owner of the mark and the register has been updated to reflect the change of name of the registered owner.

16. Turning to the evidence filed by the opponent, this provides examples of how the goods and services are used in reality on the market. Given that the opponent's mark is less than five years old, the reliance I can place on the evidence is somewhat limited as I must take into account notional use of the specification rather than how the goods and services are currently being used on the market. That said, it does go some way in providing an understanding of the nature of the opponent's goods and services and how they would be distributed, along with identifying who the potential users of the earlier goods and services would be.

## **DECISION**

### **Legislation**

17. Sections 5(2)(b) and 5A 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.”

### **Case law**

18. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by

the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

## **Comparison of goods and services**

19. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

20. All relevant factors relating to the goods should be taken into account, which include, inter alia:<sup>5</sup>

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods or services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves;
- whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors); and

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<sup>5</sup> See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “Treat” case.

- whether they are complementary to each other. Complementary signifying that “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”.<sup>6</sup> Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>7</sup>

21. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the category of goods and/or services in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods and/or services in question.<sup>8</sup>

22. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin 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

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<sup>6</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13

<sup>7</sup> *Kurt Hesse v OHIM*, Case C-50/15 P, see also *Sanco SA v OHIM*, Case T-249/11

<sup>8</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

23. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*,<sup>9</sup> the General Court held that goods can be considered as identical when the goods designated by an earlier mark are included in a more general category, designated by the trade mark application and vice versa.

24. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.<sup>10</sup>

25. The goods and service to be compared are set out in the table below:

The opponent's goods and services	The holder's goods and services
<p>Class 9: Computer software for use in the management of patient data, health information, patient records, medical records and treatment plans; downloadable computer application software for the management of patient data, health information, patient records, medical records and treatment plans; downloadable software enabling the production and sending of confidential communications relating to the treatment and monitoring of patients.</p>	<p>Class 9: Security and monitoring apparatus; sensors, detectors and monitoring instruments; alarm monitoring systems; surveillance robots for security; monitoring apparatus other than for medical use; wearable activity trackers with heart-rate monitoring function; smartwatches that communicate data to personal digital assistants [PDAs]; virtual personal assistant software; downloadable virtual assistant software; software for monitoring, analyzing, controlling and running physical network operations;</p>

<sup>9</sup> Case T-133/05, paragraph 29

<sup>10</sup> See *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

	<p>wireless control units for the control and remote control of the operation and status of security systems; connected bracelets [measuring instruments]; computer platforms; computer platforms in the form of downloadable software for hosting computer sites; remote control telemetering machines and instruments; downloadable software for remote monitoring and analysis; scientific apparatus and instruments; photographic apparatus and instruments; optical apparatus and instruments; measuring apparatus and instruments; signaling apparatus and instruments; checking (monitoring) apparatus and instruments; sound recording apparatus; sound transmission apparatus; sound reproduction apparatus; image recording equipment; image transmission apparatus; image reproduction apparatus; digital recording media; data processing equipment; computers; tablet computers; smartphones; electronic book readers; software (recorded programs); computer peripherals; detectors; protection devices for personal use against accidents; 3D spectacles; virtual reality headsets; eyewear;</p>
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	<p>spectacle cases; memory cards or integrated circuit cards; smart watches; electric batteries; diagnostic apparatus, not for medical use; any of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.</p>
<p>Class 42:  Development of computer platforms; hosting of platforms on the Internet; testing of alarm and monitoring systems; testing of computer hardware and software used with alarm and monitoring systems; technical assessments concerning design (engineers' services); engineering; technical project planning in the field of engineering; scientific and technical research; design of computers for third parties; computer development; software design; software development; research and development of new products for third parties; conducting of technical project studies; software development (design); software installation; software maintenance; updating of software; software rental; programming for computers; computer system analysis; computer system design; consultant services</p>	<p>Class 42:  Software as a service (SAAS) for use in the management of patient data, health information, patient records, medical records and treatment plans; software as a service (SAAS) for the provision of access to patient data, health information, patient records, medical records and treatment plans; software as a service (SAAS) enabling the production and sending of confidential communications relating to the treatment and monitoring of patients.</p>

<p>with respect to computer hardware design and development; digitization of documents; Software as a Service (SaaS); cloud computing; advice regarding information technology; server hosting; architecture; design of interior decor; graphic arts design services; styling (industrial design); energy auditing; electronic data storage; any of the above services related to video games; all the above services exclusively in connection with remote assistance services.</p>	
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26. I note that the most recent written submissions filed by the holder on 30 May 2025 refer to the following limitations for classes 9 and 42:

“none of the aforesaid goods relating to video-on demand games; none of the aforesaid goods intended for medical use or for use by professionals in the medical sector; all the above mentioned products exclusively in connection with remote assistance services.” In relation to class 9 and,

“none of the aforesaid services relating to video-on demand games; none of the aforesaid services intended for medical use or for use by professionals in the medical sector; all the above mentioned services exclusively in connection with remote assistance services.” In relation to class 42.

27. However, the parties were informed by the Tribunal in a letter dated 18 July 2025 of the final version of the limitations applying to the holder’s specification. Following which the holder chose not to file final written submissions addressing the similarity of the goods and services for the applied for specification as it now stands. Neither did it query the limitation set out in that official letter to indicate that the limitation was wrong.

28. As it stands at the date of this decision, the applied for goods and services as registered with WIPO and the UKIPO do not contain an exclusion or restriction in relation to medical use or use by professionals in the medical sector. Therefore, any submissions relying on such a limitation will have no bearing. However, notwithstanding the lack of limitation, I still must take into account the NICE classification and guidance notes when comparing the goods and services at issue. In particular, I note that class 9 goods do not appear to include medical apparatus and equipment for diagnosis, treatment or improving the function or conditions of a person's health. Instead, these types of goods are found in class 10.

29. As for the opponent's position, I have replicated the opponent's submissions in relation to the bulk of the applied for class 9 goods, below:

"13. The following goods, having the same intended purpose, that being for monitoring purposes, and also complementary insofar that consumers know that monitoring equipment will often be offered by the monitoring software providers in today's digital society, are similar to the Earlier Right's class 9 goods to a high degree:

Security and monitoring apparatus; sensors, detectors and monitoring instruments; alarm monitoring systems; surveillance robots for security; monitoring apparatus other than for medical use; wearable activity trackers with heart-rate monitoring function; smartwatches that communicate data to personal digital assistants [PDAs]; virtual personal assistant software; downloadable virtual assistant software; software for monitoring, analyzing, controlling and running physical network operations; wireless control units for the control and remote control of the operation and status of security systems; connected bracelets [measuring instruments]; remote control telemetering machines and instruments; downloadable software for remote monitoring and analysis; scientific apparatus and instruments; photographic apparatus and instruments; optical apparatus and instruments; measuring apparatus and instruments; signalling apparatus and instruments; checking (monitoring) apparatus and instruments; sound recording apparatus; sound

transmission apparatus; sound reproduction apparatus; image recording equipment; image transmission apparatus; image reproduction apparatus; digital recording media; data processing equipment; computers; tablet computers; smartphones; software (recorded programs); computer peripherals; detectors; protection devices for personal use against accidents; 3D spectacles; virtual reality headsets; smart watches; diagnostic apparatus, not for medical use.

14. The Applicant has amended the specification of the Application in Class 9 to add the limitation "none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services" but this does not make a material difference to the assessment of similarity since the similarity arises from the goods being intended for monitoring purposes and the complementarity in the monitoring software sector, of which assistance services forms a part."

30. However, I disagree with the opponent's suggestion that the limitation will not make a material difference to the assessment of similarity of the class 9 goods. Rather, I understand the effect of the limitation to be that all of the goods are either hardware used in the operation of remote assistance services, or software used by the consumer to facilitate the remote operation of hardware. This is a distinction I will keep in mind when assessing the similarity of the goods in class 9.

31. I have no submissions regarding the scope of the opponent's software terms: *"Computer software for use in the management of patient data, health information, patient records, medical records and treatment plans; downloadable computer application software for the management of patient data, health information, patient records, medical records and treatment plans; downloadable software enabling the production and sending of confidential communications relating to the treatment and monitoring of patients"*. Nevertheless, in light of the evidence provided and in the absence of any submissions to the contrary, I understand these terms to cover software used by clinicians in medical settings to manage patient data/health information and records and to produce and send confidential communications

either internally to other clinicians or externally to patients relating to patient monitoring and treatment.

32. When making the comparison, I keep in mind it is the opponent's duty to adequately particularise its claim and provide solid reasoning for the basis on which the competing goods and services are similar. If the opponent fails to detail its rationale for similarity appropriately, then Hearing Officers cannot be expected to consider arguments that have not been placed before them. I say this as the main basis for which the opponent argues similarity is that the goods are both for monitoring purposes and that there is complementarity insofar that consumers know that monitoring equipment will often be offered by the monitoring software providers in today's digital society. However, this is a very broad scope for finding similarity and fails to take into account the specific nature and exact intent of the competing goods.

#### Class 9 goods

*Software (recorded programs); computer platforms; computer platforms in the form of downloadable software for hosting computer sites; none of the above products related to video games; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

33. Given what I have set out above regarding the effect of the limitation on the goods and my understanding of the opponent's specific software, I find that the goods differ in nature, method of use and intended purpose. The applied for goods are software and computer platforms used for hosting computer sites in relation to remote assistance services, which is very different to the opponent's specialised software. The users of the opponent's software are likely to be medical professionals, clinicians or those in procurement of medical organisations such as the NHS, which differ to users of the holder's goods. Trade channels will also differ as the holder's goods will be offered by web hosting software providers or cloud software distributors whereas the opponent's software will be provided by specialist medical software providers. The goods are not complementary as they have different specific purposes and are not needed to ensure the use of one another.

i.e. software for hosting an intranet for remote assistance devices does not require software for managing patient software or sending confidential communication for its use, and vice versa. Neither are the goods in competition as they perform different functions and are used to meet different needs. As such, I find that the goods are dissimilar.

*Security and monitoring apparatus; sensors, detectors and monitoring instruments; alarm monitoring systems; surveillance robots for security; monitoring apparatus other than for medical use; wireless control units for the control and remote control of the operation and status of security systems; detectors; remote control telemetering machines and instruments; scientific apparatus and instruments; photographic apparatus and instruments; optical apparatus and instruments; measuring apparatus and instruments; signaling apparatus and instruments; checking (monitoring) apparatus and instruments; sound recording apparatus; sound transmission apparatus; sound reproduction apparatus; image recording equipment; image transmission apparatus; image reproduction apparatus; digital recording media; diagnostic apparatus, not for medical use; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

34. Taking into account that medical diagnostic devices are found within class 10 of the NICE classification, and the effect of the limitation on the holder's goods, I understand that the above terms are all physical equipment/devices for security, surveillance or monitoring environments remotely from a distance, without needing a person physically present with the device, rather than medical devices. For example, this includes goods such as, cameras, remote trigger alarm sensors, or devices that measure temperature that can feed data back to a monitoring centre. As can be seen above, the opponent claims that these goods are similar to the opponent's software goods as they have the same intended purpose, that being for monitoring purposes, and are also complementary insofar that consumers know that monitoring equipment will often be offered by the monitoring software providers in today's digital society. However, these submissions fail to take into account the specific nature of the opponent's software which is software for managing patient data/medical records and treatment plans as well as software for

producing and sending confidential communication about the treatment and monitoring of patients, i.e. software that allows for G.P surgeries or hospitals to generate and send confidential letters to one another, such as referrals, or to send text messages about appointments or test results to patients. Therefore, the competing goods do not have the same nature, method of use or intended purpose. As for complementarity, even though the remote assistance devices will require software to feed the data back to a monitoring centre, this will not be the same type of software as the opponent's which is to manage patient data and send confidential communications about patient treatment. As such, they are not important or indispensable to one another. Trade channels are also likely to differ as companies specialising in providing medical software for managing patient data and sending confidential communications about patient treatment and monitoring, are unlikely to provide physical devices for the purpose of security, surveillance and monitoring physical environments from afar. Users of the opponent's goods are likely to be medical professionals unlike users of the holder's goods. Finally, the goods will not be in competition as they cannot perform the function of the other. As such the respective goods are not similar.

*Protection devices for personal use against accidents; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

35. This term would typically be interpreted to include personal protection equipment such as hard hats or safety goggles, however, this does not make much sense in relation to the remote assistance limitation as these goods would need to be worn by people in hazardous environments. Rather, I interpret the term as more likely to refer to goods that are used specifically as part of a system that provides remote assistance, such as wearable fall-detection devices worn by the elderly, which do not necessarily prevent the person from a fall or accident, but can alert others when such an event occurs. Comparing this to the opponent's software goods, I do not consider the nature, method of use, or indeed, the intended purpose to be the same. The holder's goods are tangible items worn to alert others to accidents whereas the opponent's goods are software for the purpose of managing patient data and medical records, or to send confidential communications about patient

treatment between hospitals and G.P surgeries. The users differ as users of the protection devices will be the elderly and their families or carers whereas users of the opponent's software will be clinicians or healthcare administrators entering, managing or communicating health information. The trade channels do not obviously overlap, and they are not in competition as they have different methods of use and different purposes and cannot be used to carry out the role of the other. Neither are the goods complementary as they are not important or essential to the use of the other. Whilst personal protection devices will trigger an alert or call to a remote device centre through the use of software, this will not be the same type of software as the opponent's which is used to manage patient records and to produce medical letters for clinicians to send either internally to one another, or to patients. Consequently, I find these goods to be dissimilar.

*Wearable activity trackers with heart-rate monitoring function; smartwatches that communicate data to personal digital assistants [PDAs]; connected bracelets [measuring instruments]; smart watches; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

36. The above goods are all wearable activity trackers that are typically used to track an individual's activity and fitness levels. These differ in nature, method of use and intended purpose to the opponent's computer software which is clinical information management software which is for use by medical professionals to store and maintain clinical history and manage patient information and health records or to produce and send secure communications about patient appointments or results. I do not consider the goods to be complementary as the opponent's software has a very specific purpose that is not the kind that would be needed in the use of wearable activity trackers. Further, the trade channels would differ as it is unlikely that the same companies would offer both the holder's wearable activity trackers and the opponent's specialised medical software. Users also differ as users of the opponent's software will be clinicians and administrators whereas users of wearable activity trackers would be the general public. Overall, I find that the goods are dissimilar.

*Virtual personal assistant software; downloadable virtual assistant software; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

37. Whilst the applied for goods and the opponent's goods are both software, they are considerably different in their specific nature, method of use and purpose. The applied for software is used to deliver automated or AI driven support for remote assistance services, conversely the opponent's software is highly specialised medical/patient management software for handling patient records and medical information or for sending confidential communication about patient treatment and monitoring. Trade channels and users are also likely to differ given the different functions of the competing software. The opponent's software will usually be offered by medical software specialists and used by healthcare professionals, whilst the applied for software may be used by businesses offering remote assistance services and could be offered through more generic software providers and app stores. The goods are not complementary as virtual assistant software for remote assistance services is not essential for the use of the opponent's specific medical software. Neither are the software goods in competition as they cannot be used interchangeably for one another. Overall the competing software goods are dissimilar due to their specific nature and purpose.

*Software for monitoring, analyzing, controlling and running physical network operations; downloadable software for remote monitoring and analysis; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

38. The above remaining software are all different types of software that have distinct specific purposes. When comparing these against the opponent's software although they are similar in nature to the extent that they are both types of software this is not enough under case law for a finding of similarity. Taking the core purposes of the competing software, the above software is for remotely monitoring, analysing, controlling and running physical network operations, conversely, the opponent's software is for the purpose of managing patient records and producing confidential communications to send either internally or externally to patients

regarding their treatment; as such the core intended purpose differs. The users are also likely to differ, as the opponent's software is likely to be used by clinicians and health administrators, whereas the holder's software is unlikely to be used by clinicians. Trade channels are likely to differ as the opponent's software is likely to be targeted at healthcare providers. The software is not likely to be in competition nor complementary as the software is not needed for the use of the other. Consequently, the goods are dissimilar.

*Data processing equipment; computers; tablet computers; smartphones; computer peripherals; memory cards or integrated circuit cards; electric batteries; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

39. The above are all types of computer hardware or computer peripheral hardware and electric batteries for remote assistance services, i.e. computer devices and peripherals used to deliver or receive remote support. The nature, method of use and intended purpose differ to the opponent's specialist medical software terms. The trade channels and users also differ as the applied for goods would be offered by specialist producers and used by businesses in the remote assistance support services, unlike the opponent's services. The goods are not in competition as the hardware for remote assistance cannot carry out the function of the opponent's software. Neither are the goods complementary as although computer hardware requires software for its use, they do not require the same type of specialist software as the opponent's. The goods are, therefore, dissimilar.

*3D spectacles; virtual reality headsets; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

40. These are all virtual reality apparatus that are used for remote assistant services. There is no obvious similarity between these goods and the opponent's software. They are different in nature, method of use, intended purpose, trade channels and users. Further they are neither competitive nor complementary. As such these goods are dissimilar.

*Electronic book readers; eyewear; spectacle cases; none of the above products related to video games; all the above mentioned products exclusively in connection with remote assistance services.*

41. Although these goods are limited, the limitations do not make sense in the context of the goods, eyewear and accessories have the same nature and function irrespective of how they are used. Equally, the limitation does not make sense in relation to 'electronic book readers'. As such, I will proceed to make the comparison without any restrictions of the goods. These goods are not similar to the opponent's specialist medical software, they are different in nature, method of use, intended purpose, trade channels and users. They have no overlap in complementarity and neither are they competitive.

42. For completeness, I have considered whether there would be any closer similarity between the applied for goods in class 9 and the opponent's specialist software as a services found in class 42. The only difference between the class 9 specialist software and the class 42 software services is that the services are accessed and used online rather than downloaded on computers. Given that the purpose will be the same and the nature and method of use will be less similar, I do not consider the opponent's software services to be any more similar that the opponent's class 9 software which I have compared with the applied for goods above.

#### Class 42 services

*Scientific and technical research; conducting of technical project studies; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

43. Applying the limitation, I understand these to be services for scientific and technical research and technical studies that involve research, investigation, development or evaluation of remote assistance technologies or systems. These differ in nature, method of use and intended purpose to the opponent's software services which are ready to use medical online software for clinicians to input patient medical data

or generate and send confidential communications to other professionals and patients. Trade channels will differ as the applied for services will be offered by engineers, scientists, or technical analysts unlike the opponent's medical software services; users will also differ. The services are not complementary as there is no obvious reason why the holder's services which are for research, investigation, development or evaluation of remote assistance technologies or systems would be needed for the use of the opponent's specialist software services and vice versa. Neither are the services in competition as they cannot meet the needs of the other. Therefore, overall, these services are dissimilar.

*Testing of alarm and monitoring systems; testing of computer hardware and software used with alarm and monitoring systems; Technical assessments concerning design (engineers' services); engineering; technical project planning in the field of engineering; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

44. These are all services for testing alarm and monitoring systems used for remote assistance services, or types of engineering services. They have a very different nature, method of use and intended purpose to the opponent's specialist software in class 9 and specialist software as a service in class 42. Furthermore, the trade channels and users of the competing goods and services differ as the applied for services will be provided by engineers for businesses whilst the opponent's goods as discussed above will be provided by specialist software providers for clinicians. The goods and services are neither competitive as they cannot perform the role of the other, nor complementary as they are not important or indispensable for the use of the other. Consequently, the goods and services are dissimilar.

*Design of computers for third parties; computer development; software design; software development; research and development of new products for third parties; software development (design); software installation; software maintenance; updating of software; programming for computers; computer system analysis; computer system design; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

45. The above are all services for the design, development, programming, installation, and maintenance of computer software, and the analysis and design of computer systems in connection with remote assistance services, i.e. backend software that runs behind the scenes. Given the limitation to the applied for services they differ in nature, method of use and intended purpose from the opponent's software and software services which are for the purpose of managing patient data and ensuring confidential communication. Trade channels and users will also differ with the applied for software services offered by software developers targeting remote assistance businesses whereas the opponents software services will be provided by software developers specialising in the medical field. The services are neither competitive nor complementary as they cannot be used to satisfy the needs of the other, and are not important or indispensable for the use of one another. Therefore, the services are dissimilar.

*Development of computer platforms; hosting of platforms on the Internet; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

46. The same reasoning as set out in the above paragraph for services for the design, development, programming, installation, and maintenance of computer software, (amongst others), also applies to the development and hosting of computer and internet platforms for remote assistance services. As a result, it follows that I find these services are also dissimilar.

*Architecture; design of interior decor; graphic arts design services; styling (industrial design); none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

47. These are all services for design and architecture for remote assistance services. There is no obvious overlap in nature, method of use, intended purpose, trade channels and users between these services and the opponent's specialised medical software services. Neither are they likely to be competitive or complementary. As such, the services are dissimilar.

*Software rental; server hosting; Software as a Service (SaaS); cloud computing; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

48. The above are all software as a service, software rental or hosting services for remote assistance services, i.e. backend software that runs behind the scenes. Whilst the competing services are both for software as a service, that by itself, is not enough for a finding of similarity. Absent any evidence or detailed submissions to the contrary, I find that the precise nature, method of use and purpose differ as one is used by clinicians for inputting and managing patient data and allowing the sending of confidential communications about patient treatment, conversely the other is for the purpose of enabling remote assistance services. The trade channels and users will differ depending on their exact purposes. The services are not complementary as they are not important or indispensable for the use of the other, nor are they in competition. I find the services to be dissimilar.

*Consultant services with respect to computer hardware design and development; advice regarding information technology; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

49. The holder's IT consultancy and advice services are specifically in relation to remote assistance services and therefore are likely to include consultations in relation to remote assistance computer systems. Given the specific nature and core purposes of the respective services, they differ in nature, method of use and intended purpose. Trade channels and users also differ, with the holder's services being offered by IT consultancy firms specialising in systems for remote assistance services for companies seeking remote assistance solutions, in contrast, the opponent's services would be offered by specialist medical software developers and aimed at medical professionals. The services are not in competition as they have different specific purposes and neither are the services complementary as they are not important or essential to the use of the other as consultancy services for remote assistance systems are unlikely to be able to provide advice in relation to specialist medical software services. The services are consequently dissimilar.

*Digitization of documents; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

50. I understand these services in the context of the limitation to be services that convert paper documents into digital files, but only when those digitisation services are performed as part of, or in support of, remote assistance services and are not in relation to video games. For example, such as, services for scanning technical diagrams needed by remote technicians. The nature, method of use and purpose differ to that of the opponent's software services. The trade channels and users differ on account of the holder's restrictions on its services and the opponent's very specific type of software services. The services are not complementary as services for the digitalisation of documents in connection with remote assistance services are not required for the use of the opponent's online medical software services. Neither are the services competitive as one cannot carry out the role of the other. As a result the competing services are dissimilar.

*Energy auditing; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

51. There is no obvious reason why services for energy auditing in relation to remote assistance services, which would cover analysing the energy consumption of remote-assistance infrastructure (servers, remote-support devices, sensors) and auditing energy efficiency of equipment used in remote monitoring systems, is similar to the opponent's software services, or goods for that matter. They differ in nature, method of use, intended purpose, trade channels and users. The services are also neither competitive nor complementary. I therefore find the services are not similar.

*Electronic data storage; none of the above services related to video games; all the above services exclusively in connection with remote assistance services.*

52. I understand this term when used in conjunction with the limitation to be referring to services for storing digital data, but only where that storage is part of delivering

remote assistance services, i.e. retaining data from devices in class 9 of the holder's specification such as security cameras for remote monitoring. I see no obvious connection between these services and the opponent's particular medical software services for managing patient data and sending confidential communications regarding patient monitoring and treatment. There is no overlap in the nature, method of use, intended purpose, trade channels or use. Further, the services are not complementary nor are they competitive. Consequently, the services are dissimilar.

53. Consequently, as a level of similarity is required between the competing goods and services in order for there to be a likelihood of confusion<sup>11</sup> under section 5(2)(b) of the Act, the opposition would fail irrespective of whether the competing marks were found to be identical or similar.

## CONCLUSION

54. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal, the application will proceed to registration.

## COSTS

55. As the holder has been successful, it is entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 1 of 2023. Applying this guidance, I award the holder the sum of **£900**, which I calculate as follows:

Considering the notice of opposition and filing a defence and counterstatement	£250
Considering the opponent's evidence	£300
Preparing written submissions	£350

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<sup>11</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

**Total**

**£900**

56. Accordingly, I hereby order MBI Healthcare Limited to pay SOLEM S.A the sum of **£900**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29<sup>th</sup> day of January 2026**

**Sarah Wallace**

**For the Registrar**