

BL O/0568/26

TRADE MARKS ACT 1994

TRADE MARK APPLICATION
NO. UK00003998177

Nordic Smile

IN THE NAME OF
BC HILAMAX OY

Applicant/Respondent

AND

OPPOSITION NO. OP000447042
BY
CARL ZEISS MEDITEC AG

Opponent/Appellant

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
CARL ZEISS MEDITEC AG
AGAINST DECISION BL O/0639/25
DATED 15th July 2025

*MR. ADRIAN DE FROMENT of Counsel (instructed by Dehns) appeared for the Appellant
The Respondent was not represented and took no part in the Appeal*

APPEAL DECISION

Introduction & Background

1. This is an appeal by Carl Zeiss Meditec AG from decision BL O/0639/25 of K Harbach, sitting as a Hearing Officer acting for the Registrar of Trade Marks ,dated 15th July 2025.
2. On 4th January 2024 the Applicant, BC Hilamax Oy, applied to register the trade mark Nordic Smile under No. UK00003998177 for various goods including:

Class 10: Surgical devices and instruments; Medical apparatus and devices.

Class 35: Retail or wholesale services for medical supplies; Retail services in relation to medical instruments.

3. On 19 April 2024, the Opponent opposed the registration of the Applicant's mark for those goods and services. The opposition was brought under section 5 (2)(b) the Trade Marks Act 1994 ("the Act"). The Opponent relied on its International Registration designating the UK under no. 1712027 SMILE ("the Opponent's mark"). The Opponent's mark had an effective priority date of 25th May 2022 and it became protected in the UK on 20th July 2023.

4. For the purposes of the opposition the Opponent relied on the following goods for which the Opponent's mark is protected:

Class 10: Ophthalmological apparatus and instruments; refractive lasers for medical purposes

5. Under section 5(2)(b), the Opponent claimed that the opposed goods were identical or highly similar to its relied upon goods and that the parties' marks are similar such that there was a likelihood of confusion between the marks.

6. The Applicant defended the opposition on the basis that that whilst some goods might be deemed similar, others were not. Further, the marks were sufficiently different and the Opponent's mark was of low distinctive character. Consequently the Applicant denied there was a likelihood of confusion.

7. The Opponent filed evidence and written submissions. Beyond filing its defence and counterstatement the Applicant took no further part in the matter, nor has it before me on this appeal. The Hearing Officer reached their Decision "on the papers", no hearing having been requested.

The Hearing Officer's Decision

8. In brief, the Hearing Officer's Decision was as follows:

- 1) The parties' class 10 goods were identical;
- 2) The Applicant's Class 35 services were of a medium degree of similarity to the Opponent's class 10 goods.
- 3) The overall impression of the Opponent's mark SMILE was confined to that word alone, whereas the overall impression of the Application "Nordic Smile" was that both words contributed to it in equal measure.

- 4) The marks were visually similar to a medium degree, aurally similar to “just below a medium degree” and conceptually similar to “just above a medium degree”.
- 5) The average consumer of the goods and services at issue would be both medical professionals and members of the general public, paying an above average degree of attentiveness when purchasing, visual/aural considerations dominating depending on the market environment.
- 6) The Opponent’s mark was “somewhat” allusive and possessed of a low to medium level of inherent distinctive character for the Opponent’s goods/services.
- 7) Taking all of the above matters into account, there was no likelihood of direct or indirect confusion. The opposition therefore failed, the Applicant being awarded costs of £450.

The Appeal

9. An Appeal was filed by the Opponent on Form TM55P on 12th August 2025. The grounds of appeal were:
 - 1) The Hearing Officer erred in finding that the Opponent’s Mark was allusive and of a low to medium level of inherent distinctive character. The Hearing Officer should instead have found that the Opponent’s mark had a high degree of inherent distinctive character for the Opponent’s goods and services.
 - 2) The Hearing Officer erred in treating NORDIC SMILE as a single unitary mark with a meaning greater than the sum of its parts, rather than a mark consisting of two separate elements in which SMILE retained an independent distinctive character.
 - 3) Finally, the Hearing Officer erred in their dismissal of the likelihood of indirect confusion.

Standard of Review

10. I understood the Opponent to be in agreement with me as to the relevant standard, which has been repeated many times albeit in various restated forms. An appeal is by way of review, not a rehearing. It is well established that before I can interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that

the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24] and re-stated by Arnold LJ in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262 at [110] where he said:

“The test on appeal

110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: Volpi v Volpi [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2] (v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare Magmatic Ltd v PMS International Group plc [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and Actavis Group PTC EHF v ICOS Corp [2019] UKSC 15, [2019] Bus LR 1318 at [78]-[81] (Lord Hodge), and see Re Sprintroom Ltd [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJ), which was cited with approval by the Supreme Court in Lifestyle Equities CV v Amazon UK Services Ltd [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin).”

11. Mr De Froment helpfully reminded me, in particular, that:

“In relation to evaluative decisions, the Supreme Court in Lifestyle Equities CV v Amazon UK Services Ltd [2024] UKSC 8, [49] stated that:

“...on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge’s treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.”

12. In *Axogen* the court said at 24 (vii):

“Another variable to be taken into account will be “the standing and experience of the fact-finding judge or tribunal”. Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law.”

And at [24 (viii)]:

“The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; “The duty to give reasons must not be turned into an intolerable burden”

(see REEF at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (English at [17], Fage at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (English at [19]).”

13. Further guidance has also been given by the Supreme Court in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25, in particular a warning at [114] that an appellate tribunal should not fall into the trap of thinking that the only reason a judge could have reached a firm view differing from their own was that he or she must have made errors of principle.

14. I bear these principles in mind.

Decision

Ground 1 – Error in finding that SMILE was allusive and therefore of low-medium inherent distinctive character

15. This Ground took up a substantial part of Mr. De Froment’s skeleton argument and his submissions before me.

16. The Hearing Officer set out the relevant law at [44] and there is no suggestion they did not instruct themselves correctly. They then continued (with my emphasis added) as follows:

“45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

46. There is no evidence regarding the use of the earlier mark. Consequently, I have only the inherent position to consider.

47. The applicant submits that the opponent’s mark is a “very basic, simple, and laudatory term”. I agree that the opponent’s mark is basic and simple but I do not

consider that it is entirely laudatory. I do consider “Smile” somewhat alludes to the fact that the goods and services may result in a positive outcome, i.e. one that may cause the consumer to smile. However, this is not particularly direct or pronounced, and I note the goods at issue relate to ophthalmological instruments rather than dental, in relation to which the meaning of the word SMILE would have a more significance.

48. Consequently, I find that the opponent’s mark possesses a low to medium level of inherent distinctive character for all of the opponent’s goods and services.”

17.Mr. De Froment challenged this finding in various ways, and at length. In essence, though, he submitted that:

- 1) Generally, there was no basis for the Hearing Officer to find that SMILE was allusive in the minds of the relevant specialized consumers.
- 2) The goods being so specialised and thus, presumably, outside the Hearing Officer’s own experience, it was not open to the Hearing Officer to find that SMILE was allusive without evidence to that effect. Indeed, Mr. De Froment went so far as to suggest that this was a matter that a Hearing Officer could *only* decide on the basis of expert evidence.
- 3) It was not open to the Hearing Officer to take the allusiveness of SMILE as a matter of judicial notice.

18.Taking the last point first, nowhere is there any suggestion the Hearing Officer was taking this as a matter of judicial notice, so this goes nowhere.

19.As to the first two points, beyond a general disagreement with the Hearing Officer’s finding, the thrust of Mr. De Froment’s challenge was that in this context the distinctive character of the Opponent’s mark was not a “jury” point for the Hearing Officer to determine as a notional juror. Instead, he submitted that for specialized goods such as those in issue, a Hearing Officer could not act as a notional juror at all because either a) a notional juror would lack the necessary knowledge, absent evidence; or b) if the Hearing Officer *did* have the necessary personal specialist knowledge, it precluded them from considering the matter, absent evidence, as a notional juror. Either way, the Hearing Officer was in error in reaching a finding that SMILE had a low-medium distinctive/allusive character without evidence.

20. I do not agree. The distinctive character of a mark, or the lack of it, is something a Hearing Officer must evaluate, for better or worse, on the basis of the materials before them. The Hearing Officer “is in the position of a notional juror, using his or her own common sense and experience of the world”: *GE Trade Mark* [1973] R.P.C. 297 , 321. The tribunal is an expert tribunal and the starting point is one of respect for its assessment. Further, As Mr. De Froment himself cited to me (albeit in support of his own argument) in *Major League Baseball Properties Inc. v Vinelight Holdings LLC* BL O/0662/25, Phillip Johnson AP stated:

21. In the absence of evidence, Hearing Officers have to make factual findings based on their own experience of the marketplace. The parties have an opportunity to file evidence and make submissions, but in most cases there will be things the Hearing Officer has to decide for which there is no evidence neither was the issue substantively addressed in submissions. In such cases, Hearing Officers simply have to do the best they can. A decision cannot be overturned merely because (in the absence of evidence) an appellate tribunal might have made a different factual finding from that of the Hearing Officer: O2 Holdings Ltd's Trade Mark Application [2011] RPC 22 at [60]. In any event, I am not sure I would make a different finding if it had been open to me to do so.”

21. Thus, it was open to the Hearing Officer to assess SMILE as having a degree of allusiveness, and as having a low-medium distinctive character, based on their own experience and impression. However it is framed contextually relative to goods or services, the word SMILE self-evidently has at least some inherently positive connotation and it was open to the Hearing Officer to assess the relevance and extent of that, with or without evidence. Furthermore, the Opponent’s argument on evidence cuts both ways. If the Opponent had wished to influence the assessment in its favour, it could have filed evidence, expert or otherwise.

22. In any event, the Hearing Officer emphasised that the allusive quality was not particularly direct or pronounced. Indeed, even if the mark had been found not to be allusive or vaguely laudatory, it is doubtful that would have elevated an ordinary dictionary word beyond a medium or ordinary level of inherent distinctive character (in contrast, say, to an invented word). Thus, like Mr Johnson, “*I am not sure I would make a different finding if it had been open to me to do so*”.

23. I detect no error of principle in the Hearing Officer’s approach. The first ground of appeal is dismissed.

Ground 2 – When assessing the likelihood of indirect confusion, the Hearing Officer erred in treating NORDIC SMILE as a single unitary mark with a meaning greater than the sum of its

parts, rather than as a mark consisting of two separate elements in which SMILE retained an independent distinctive character.

24. The Hearing Officer's Decision deals with this at [54 -57], introducing the relevant principles at [54-56] (and there is no suggestion the Hearing Officer did not instruct themselves correctly) and then applying these at [57]:

57. In its submissions in lieu, the opponent submits that there is a likelihood of indirect confusion between the marks because the word "Smile" plays an independently distinctive role in both marks. Earlier I found that both words of the contested mark "Nordic Smile" contribute equally to the impression of the mark and that combined they convey the meaning of a pleased facial expression belonging to a person from Scandinavia. Considering this combined meaning and the overall impression of the mark, I do not consider in this instance that either of the words of the contested mark has distinctive significance independently of the whole.

25. Mr. De Froment submitted that this analysis was flawed, in that the mere facts of equal contribution to overall impression taken with the composite meaning attributed to NORDIC SMILE did not, taken together, equate to the conclusion that SMILE had no independent distinctive role in that mark.
26. At first sight I have some sympathy with this. It could be said, persuasively, that both marks are essentially "smile" marks (although that is really more a point about the dominant effect of SMILE in the mark applied for).
27. However, notwithstanding the vigour with which Mr. De Froment pressed this submission, I cannot see that the conclusion is one with which I can interfere. The Hearing Officer considered the role SMILE played in the mark applied for. They concluded that SMILE itself as an earlier mark had only low to medium distinctive character, and taking all the factors into account, they concluded that in NORDIC SMILE, SMILE did not operate as an independently distinctive element but was subsumed into the whole. That is an evaluative assessment, and it is within the scope of matters on which judges might differ. Bearing in mind the appellate cautions (in particular that in *Iconix* warning against the trap of finding a decision to be unprincipled just because I might have an alternative view on the factual conclusion reached), I cannot interfere.

28. I do take the point that within NORDIC SMILE, “smile” contributes its meaning giving rise to the concept, overall, of *a pleased facial expression belonging to a person from Scandinavia*. However, the appeal on this issue is that SMILE should be considered, in effect, to stand alone, as per “LIFE” in *MEDION LIFE*. These are two different issues and in this respect the Hearing Officer was entitled to find as they did.

29. Ground 2 is dismissed.

Ground 3 – when assessing the likelihood of indirect confusion the Hearing Officer should have held that NORDIC SMILE would be seen as a brand extension of SMILE

30. This issue was dealt with by the Hearing Officer at [55], then [58-60]:

55. *In L.A. Sugar Limited v By Back Beat Inc, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:*

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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).”

56. I do not consider this case to fit neatly into one of the categories set out in L.A. Sugar above. However, I remind myself that these are not exhaustive....

58. Further, the opponent refers to Vitae Health Innovation, S.L. v Sed Swiss Engineering Developments AG ([2022] O/1015/22), in which a likelihood of indirect confusion was found between “SWISSVITAE” and “VITAE HEALTH INNOVATION”, as the addition of the word “Swiss” appeared to be consistent with a variant brand or brand-extension, indicating the Swiss limb of the company. The opponent submits that the same assessment should be made in the present proceedings, where the addition of “Nordic” would be perceived as a sub-brand or brand extension, indicating geographical origin. I note this previous decision; however, this decision hinged on the earlier mark, by virtue of the element “VITAE”, being highly distinctive and, as such, consumers assuming that no one else other than the opponent would be using it in a trade mark. Further, I note in that case that SWISS and VITAE in the contested mark, did not offer a combined meaning. In the present proceedings, the earlier mark has a low to medium degree of distinctive character and the words “Nordic Smile” have a combined meaning. Due to this, I do not consider that a consumer would assume that no one else other than the opponent would be using the word “Smile” in a trade mark, particularly, that no one would be using it in the context of the contested mark.

59. I consider that a consumer who is aware of the opponent’s earlier mark may note the use of “Smile” in both marks. However, I do not see any logical reason for the consumer to conclude that the “Nordic Smile” mark is another brand of the owner of the earlier mark, or a brand extension. I note that the opponent has argued consumers might interpret the use of the contested sign as representing activities authorised by the opponent, stating that consumers would be likely to believe this

to result from a licensing agreement with an entity i) connected to the Nordic countries, or ii) involved in producing the goods or rendering the services in a Nordic country. However, considering all of the circumstances of the case, this to me feels unlikely. I find it much more likely that any consumers noticing the use of “Smile” both as the opponent’s earlier mark and the contested mark, would simply assume that the marks represented goods deriving from two different entities, and put the use of “Smile” in both (if noticed) down to coincidence.

60. I therefore do not consider there to be a likelihood of indirect confusion in relation to the applicant’s goods and services.

31. Mr. De Froment submitted, first, that the Hearing Officer failed properly to consider whether the addition of ‘Nordic’ to the distinctive term ‘Smile’ was liable to be perceived as a brand extension, saying there was no proper basis for the Hearing Officer’s bare conclusion at [59] that “I do not see any logical reason for the consumer to conclude that the “Nordic Smile” mark is another brand of the owner of the earlier mark, or a brand extension”. To the contrary, he said, there were such logical reasons and the Hearing Officer ought to have considered them.

32. The difficulty here is that the Hearing Officer, albeit with perhaps compressed reasoning as is typical in Registry decisions, did explain their thinking in [58]. They said:

“In the present proceedings, the earlier mark has a low to medium degree of distinctive character and the words “Nordic Smile” have a combined meaning. Due to this, I do not consider that a consumer would assume that no one else other than the opponent would be using the word “Smile” in a trade mark, particularly, that no one would be using it in the context of the contested mark.

33. It therefore comes down to little more than a difference of opinion with which one can agree or disagree, but which is certainly not wrong or unprincipled.

34. Secondly, Mr. De Froment submitted that the Hearing Officer’s statement that “the words “Nordic Smile” have a combined meaning” did not support their conclusion that consumers would not perceive the compound mark as a brand extension. However, this is to take the statement out of context. Looked at in the round, it is consistent with the Hearing Officer’s view that given the

extent of the distinctive character of SMILE and its role in NORDIC SMILE, it simply did not function sufficiently independently to stand alone in such a way as to appear to be a brand extension as opposed to an ordinary “non-brand” usage of the word, even allowing for the level of conceptual similarity. Reasonable judges can differ about that, but that does not mean the decision was wrong.

35. Thirdly, Mr. De Froment argued that the Hearing Officer erred in law in considering the relevance of *Swiss Vitae*.

36. In *Swiss Vitae*, the Hearing Officer determined that there was a likelihood of indirect confusion under category (a) of *L.A. SUGAR*. However in the instant case it was relied on instead in support of the Opponent’s position under category (b) (that NORDIC SMILE would be seen as a sub-brand or brand extension of SMILE).

37. The Opponent argued that at [58]:

“The Hearing Officer erred in law in treating the question of whether “consumers may assume that no-one else other than the opponent would be using it in a trade mark” (addressed in in Vitae at §44) was a necessary element of the test for whether brand extension was likely”

As Mr. De Froment pointed out, this “assumption” test applies to *LA SUGAR* “category (a)” assessments rather than to category (b) “brand extension” assessments. It is not determinative of indirect confusion under a different category (whether or not expressly set out in *L.A. Sugar*).

38. However, I do not read the Hearing Officer’s passing reference to the category (a) test as undermining the overall assessment of whether or not NORDIC SMILE should be seen as a brand extension under category (b). In the first place, *Swiss Vitae* relied on its own specific facts – it did not bind the Hearing Officer in respect of the facts before them in this case.

39. Secondly, the Hearing Officer was clearly aware that whilst *Swiss Vitae* was relied on in support of the “category (b)” assessment, it was decided on the basis of category (a), and as such I read the reference to the “assumption” test as merely dismissing category (a) as being applicable here. I do not read it as transferring that test into the category (b) assessment, which the Hearing Officer carried out separately in [59].

40. Finally, Mr. De Froment submitted that insofar as it was implicit in this element of the Hearing Officer's decision at [58] to [59] that they considered that the Opponent's word mark for 'Smile' *solus* was incapable of performing the function of a trade mark, that was not a finding which was open to them. The Opponent's mark was registered and not subject to invalidity proceedings; and such a finding was inconsistent with her earlier finding that the Opponent's mark has a medium "low to medium" degree of distinctive character.

41. However, it was not implicit in the Decision that SMILE *solus* was incapable of performing the function of a trade mark. Rather, the Hearing Officer simply decided that it did not function in that way within NORDIC SMILE, having due regard to their findings on distinctive character and the composite meaning of that mark.

42. Thus, overall, I am satisfied that the Hearing Officer evaluated this issue in a properly principled and reasoned manner.

43. It follows that Ground 3 is dismissed.

Conclusion and Costs

44. The appeal has failed in its entirety. The Decision of the Hearing Officer stands and the Applicant's mark will proceed to registration for all the applied-for goods.

45. The Applicant took no part in the Appeal so I make no order as to costs.

46. I will make a separate formal order only if asked to do so.

Philip Harris

Appointed Person

30 June 2026