

O/0621/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003748935
BY WELLTECH GROUP LIMITED TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASSES 9, 38, 41, 42 AND 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 435115 BY BESTWAY PANACEA HOLDINGS LIMITED**

Background and Pleadings

1. On 28 January 2022, Welltech Group Limited ('the Applicant'), filed an application to register the following trade mark:



2. The application was published for opposition purposes in the Trade Marks Journal on 29 April 2022. Registration is sought in respect of the following goods and services:

Class 9:	<i>Computer programs and software; downloadable software applications; electronic software for handheld devices and wireless devices; interactive multimedia computer programs; interactive multimedia software; interactive video software; software for use on mobile telephones and other portable computing devices; software applications for tracking tasks; software applications for the purpose of forming habits; software applications for the purpose of providing instruction in physical exercise; data processing software; media content, all of the aforementioned goods in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel.</i>
Class 38:	<i>Provision of access to content, platforms, databases, websites, and portals; provision of online communications links which transfer web site users to other local and global web pages; distribution of video content on the internet; providing access to computer databases in the fields of entertainment and education; providing telecommunication facilities that enable the creation and updating of personal electronic web pages; all of the aforementioned goods</i>

	<i>in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel.</i>
Class 41:	<i>Education, namely provision of educational information and instruction courses in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; providing of training and instruction courses in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; Providing of on-line electronic publications in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; provision of information in relation to the aforementioned services, via a website; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.</i>
Class 42:	<i>Creation, design and development of software and software applications for use in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; creation and development of software for handheld devices and wireless devices for use with sports, health, fitness, exercise and training; providing temporary use of non-downloadable software for use in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; provision of websites in relation to diet, weight control, weight loss, diet planning, and to the provision of health information; provision of an on-line computer database featuring information in relation to diet, weight control, weight loss, diet planning, and to the provision of health information; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or</i>

	<i>medical assistance consultancy provided by specialised medical personnel; none of the aforesaid being or related to medical research services.</i>
Class 44:	<i>Advisory services relating to diet, weight control and weight loss; diet planning; provision of health information; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel; none of the aforesaid relating to medical clinic services or medical nursing services.</i>

3. On 21 July 2022, the application was opposed by Bestway Panacea Holdings Limited ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act').¹ The Opposition is directed against all of the Applicant's goods and services. The Opponent relies on the following earlier registration:

UK00003372432

Series of 6 marks:



Filing date: 4 February 2019

¹ Initially, the Opponent also based its opposition on section 5(4)(a) of the Act. The pleading under this ground was subsequently withdrawn. The opposition now proceeds solely on the basis of section 5(2)(b) of the Act.

Date of entry in register: 21 June 2019

The marks are registered for a large number of goods and services in classes: 3, 4, 5, 8, 9, 10, 11, 12, 14, 16, 18, 20, 21, 24, 26, 28, 35, 39, 40, 41, 42 and 44. The Opponent relies on its goods and services in classes: 9, 41, 42 and 44 only:

Class 9:	<i>Spectacles, contact lenses; sunglasses; electrical and electronic apparatus, appliances and instruments; cameras; batteries; hip protectors; mouse mats, fridge magnets; leather and/or imitation leather mobile phone covers; downloadable mobile applications; mobile phone applications; downloadable applications; downloadable applications in the field of pharmacy services, pharmaceuticals, healthcare, prescription and medical services; electrical and electronic apparatus, appliances and instruments; data processing equipment; telecommunication equipment, apparatus and instruments; personal digital assistants; electronic organisers; electronic devices, portable electronic devices and software related thereto; computers, computer peripheral devices, computer terminals, computer hardware; computer networks; computer software and computer hardware apparatus with multimedia and interactive functions; handheld computers, tablet computers, electronic notepads, mobile digital electronic devices, mobile telephones; mobile, portable and handheld digital electronic devices for data processing, storing, displaying, transmitting and receiving data and enabling the transmission of data between computers and the software related thereto; mobile, portable and handheld electronic devices for data processing, storing, displaying, transmitting and receiving data and enabling the transmission of data between computers and the software related thereto; handheld computers, tablet computers, electronic devices, electronic digital devices, electronic notepads and mobile digital electronic devices used to order and dispense medicines and pharmaceuticals and to input patient data; apparatus for</i>
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dispensing medicines; data processing equipment; CD-ROMS, electronic data storage devices, magnetic data carriers; covers, bags and cases adapted to, or shaped to contain the aforesaid goods; downloadable computer software applications; recorded computer software; pre-recorded computer programs for personal information management, including storage, retrieval and editing of personal data and pharmaceutical and medical data; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; chargers; parts and accessories for all the aforesaid goods; electrical and electronic apparatus, appliances and instruments; data processing equipment; telecommunication equipment, apparatus and instruments; personal digital assistants; electronic organisers; electronic devices, portable electronic devices and software related thereto; computers, computer peripheral devices, computer terminals, computer hardware; computer networks; computer software and computer hardware apparatus with multimedia and interactive functions; handheld computers, tablet computers, electronic notepads, mobile digital electronic devices, mobile telephones; mobile, portable and handheld digital electronic devices for data processing, storing, displaying, transmitting and receiving data and enabling the transmission of data between computers and the software related thereto; mobile, portable and handheld electronic devices for data processing, storing, displaying, transmitting and receiving data and enabling the transmission of data between computers and the software related thereto; handheld computers, tablet computers, electronic devices, electronic digital devices, electronic notepads and mobile digital electronic devices used to order and dispense medicines and pharmaceuticals and to input patient data; apparatus for dispensing medicines; data processing equipment; CD-ROMS, electronic data storage devices, magnetic data carriers; covers, bags and cases adapted to, or shaped to contain the aforesaid

	<p><i>goods; downloadable computer software applications; recorded computer software; pre-recorded computer programs for personal information management, including storage, retrieval and editing of personal data and pharmaceutical and medical data; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; chargers; parts and accessories for all the aforesaid goods; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including websites); electronic publications (downloadable); animated cartoons; screensavers; video games; digital music (downloadable) from global computer networks; digital music (downloadable) from MP3 global computer network sites; multimedia recordings; media content; media software; multimedia software; interactive entertainment software; technology for use on mobile phones, computers and devices; ring tones and screen savers for mobile phones, computers and devices; software for mobile phones, computers and devices; application software for mobile phones, computers and devices.</i></p>
Class 41:	<p><i>Education services; health education services; provision of on-line publications concerning health and pharmaceutical services.</i></p>
Class 42:	<p><i>Providing medical and scientific research information in the field of pharmaceuticals; technical advice and information in the field of pharmaceuticals.</i></p>
Class 44:	<p><i>Healthcare services; pharmacy services; pharmacy advice; medical services; hygienic and beauty care for human beings; pharmaceutical services; pharmaceutical dispensing services; medicine dispensing services; prescription services; medicine checks; weight control evaluation; flu injections; medicine checks; blood pressure checks; medical assistance; pharmacy services,</i></p>

	<p><i>pharmaceutical, medical, healthcare and prescription services provided remotely through the internet and/or applications and mobile applications; consultancy, information, recommendation and advisory services relating to pharmaceuticals, pharmacy services and all the aforesaid including being provided via the internet and/or through applications and/or mobile applications.</i></p>
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4. The Opponent claims that:

- the parties' marks are similar;
- the word 'WELL' 'is the most important part of a [sic] mark for comparison purposes';
- the parties' goods and services are 'identical, similar and associated';²
and
- that there is a likelihood of confusion between the parties' marks.

5. The Applicant filed a Defence and Counterstatement in which it:

- denies that the parties' marks are similar;
- denies that the word 'WELL' is the most important part of a [sic] mark for comparison purposes;
- neither admits nor denies that the parties' goods and services are similar and puts the Opponent to strict proof of this claim;
and
- denies that there is a likelihood of confusion between the parties' marks.

6. The Opponent is represented by Murgitroyd & Company. The Applicant is represented by Novagraaf UK. Neither party has filed evidence. A hearing was neither requested nor thought necessary. Both parties have filed written submissions in lieu of a hearing. I will not summarise the parties' submissions here, but I confirm that I have read them and will refer to them where necessary in my decision. The following decision has been made after careful consideration of the papers before me.

² Opponent's Statement of Grounds at Q5, final paragraph.

Decision

Section 5(2)(b) of the Act and related case law

7. Section 5(2)(b) of the Act states:

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

(a) ...

(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.”

8. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark by virtue of its filing date (4 February 2019) which fell before the filing date of the Applicant’s mark (28 January 2022).

9. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the Opponent’s mark had been registered for less than 5 years on the date on which the Applicant filed its Application for the registration of its mark. The Opponent is therefore entitled to rely upon all of the goods and services that it seeks to rely upon.

10. The following principles are derived from the decisions of the Court of Justice of the European Union³ (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95; *Canon*

³ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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 C120/04; *Shake 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

11. 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.

12. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

"[23] "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".

13. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁴, identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

⁴ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

15. In making an assessment between the competing services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05:

“29. ... the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. In construing the terms used in the parties’ specifications, I will follow the guidance of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49].

Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods 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 in question."

17. The Applicant's goods and services can be found at paragraph [2] and the Opponent's goods and services can be found at paragraph [3].

Class 9

18. The Opponent has submitted that the Applicant's class 9 goods, which cover computer software, programs and applications, are identical to those of the Opponent because, despite the Applicant limiting its goods, the Opponent's specification contains broad 'software' terms that have not been limited. I agree.

19. I note that the Applicant has limited its specification by including the following wording in its specification: *'all of the aforementioned goods in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel.'*

20. I understand that 'computer programs' and 'applications' are pieces of software, i.e. sets of instructions according to which a computer or other device operates. I find the following of the parties' goods to be 'Meric' identical because the Opponent's broad terms *software for mobile phones, computers and devices* and *media content* have not been limited and will, therefore, encompass the Applicant's narrowed terms:⁵

Opponent's class 9 goods:	Applicant's class 9 goods
<i>software for mobile phones, computers and devices</i>	<i>Computer programs and software; downloadable software applications; electronic software for handheld</i>

⁵ I note that there are a number of other class 9 terms in the Opponent's specification which also encompass the Applicant's goods including, inter alia: *recorded computer software; electronic devices, portable electronic devices and software related thereto.*

<p><i>media content</i></p>	<p><i>devices and wireless devices; interactive multimedia computer programs; interactive multimedia software; interactive video software; software for use on mobile telephones and other portable computing devices; software applications for tracking tasks; software applications for the purpose of forming habits; software applications for the purpose of providing instruction in physical exercise; data processing software</i></p> <p><i>media content</i></p> <p><i>all of the aforementioned goods in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel.</i></p>
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Class 38

21. The Opponent has submitted that the Applicant's class 38 services 'are similar and associated with class 9 goods covered by the earlier mark' but without stating which particular goods and services it considers similar.⁶ It is presumed that what

⁶ Opponent's written submissions in lieu of a hearing, paragraph [2.24].

the Opponent means by its statement that the parties' offerings are 'associated' is that they are complementary.

Applicant's services: Provision of access to content, platforms, databases, websites, and portals; providing access to computer databases in the fields of entertainment and education; all of the aforementioned goods⁷ in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel.

22. The Applicant's services entail facilitating access to electronic material 'in the fields of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness'. I compare the Applicant's services to the Opponent's class 9 term *software for mobile phones, computers and devices*. In my view, the goods and services might overlap in purpose to the extent that the Opponent's term covers software whose specific purpose is to facilitate access to electronic material, in the fields to which the Opponent's services relate. However, the overlap will not be total, because many of the goods encompassed by the Opponent's term will have other purposes and relate to fields outside of the Applicant's limitation. Users will overlap where the Opponent's software fulfils the function of the Applicant's service in a field specified in the Applicant's limitation. I consider trade channel overlap to be possible; the same undertaking might offer both the Applicant's services and software products that might fulfil the same function within the fields set out in the Applicant's limitation. The parties' offerings will differ in nature; one being a good (albeit a non-physical entity) and the other being acts of service. I do not find the parties' offerings to be in competition. I do, however, find complementarity between the parties' offerings; software will be necessary to enable the Applicant to perform its services and the average consumer may presume both to originate from the same undertaking. In the light of the foregoing, I find the parties' goods and services to have a low to medium level of similarity.

⁷ The word 'goods' is presumed to be a drafting error because class 38 comprises services.

Applicant's services: *provision of online communications links which transfer web site users to other local and global web pages; in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel.*

23. I understand that the Applicant's 'provision of online communications links' entails the provision of 'gateways' from one web page to another in the course of using an online communication channel. To my mind, an example might be an online 'discussion board' located on one web page which is accessed via a link from another web page. I compare the Applicant's services to the Opponent's class 9 goods *software for mobile phones, computers and devices*. The specific purposes of the parties' goods and services might overlap in purpose where the Opponent's term covers software designed to enable online communications links to transfer web site users to other web pages, in a field set out in the Applicant's limitation. My comments on the above comparison at [22] apply equally here. I find the parties' goods and services to have a low to medium level of similarity.

Applicant's services: *distribution of video content on the internet; in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness*

24. The Applicant's services, to my mind, entail the making available, and dissemination of, video content, in the fields set out in the limitation, to online viewers. I compare the Applicant's services to the Opponent's class 9 goods *computer software with multimedia functions*. I understand that the Opponent's goods cover software that relates to visual and audio material. The Opponent's goods are not subject to limitation and may therefore be used in any of the fields to which the Applicant's services relate. It is my view that the Opponent's term could cover software which enables video content to be distributed on the internet. To that extent, the parties' offerings might overlap in purpose. The overlap will not, however, be total, because the Opponent's term will also encompass software designed for other purposes. Users will therefore overlap to the extent that the

Opponent's goods cover software to enable distribution of video content online. I consider that trade channel overlap is possible. The same undertaking might offer the service of facilitating the distribution of video content online as well as the specific software designed to achieve this end. The parties' offerings will differ in nature; one being a good (albeit a non-physical entity) and the other being acts of service. Methods of use will also therefore differ. I find the parties' offerings to be in competition where the Opponent's software has the same purpose and is (or could be used) in the same field as the Applicant's services. A prospective purchaser might deliberate over whether to engage a service or purchase a piece of software to achieve the same end. I also find complementarity between the parties' offerings; software will be necessary to enable the Applicant to perform its services and the average consumer may presume both to originate from the same undertaking. I find the parties' goods and services to have a low to medium level of similarity.

Applicant's services: providing telecommunication facilities that enable the creation and updating of personal electronic web pages; in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness

25. I compare these services to the Opponent's class 9 term *software for mobile phones, computers and devices*. The Applicant's services will, in my view, entail providing the telecommunications infrastructure to facilitate the creation or editing of web pages, in the fields set out in the limitation. I consider that the Opponent's software could include software specifically for building and editing web pages and could be used in the fields to which the Applicant's services have been limited. The parties' offerings will therefore overlap to the broad extent that both are ultimately aimed at enabling web pages to be created or edited. However, the specific purposes will differ; the Applicant's services provide the telecommunications infrastructure, i.e. the channels, through which the web-editing/creation can occur as opposed to the Opponent's software which is the tool to perform the web-editing task. Users will overlap to the extent that the Opponent's goods cover software for creation and editing web pages. I consider trade channel overlap to be possible. The parties' offerings will differ in nature; one being a good (albeit a non-physical entity) and the other being acts of service. Methods of use will also therefore differ.

I do not find the parties' offerings to be in competition, neither good nor service being substitutable for the other. I do not find complementarity, either; although the Applicant's services might be important to enable the user of the Opponent's software to create/edit web pages, the average consumer would unlikely presume both to originate from the same undertaking. I find the parties' respective goods and services to be dissimilar. If I am wrong about that, then the level of similarity will be very low.

Class 41

26. The Opponent has submitted that:

- the Applicant's 'education services', although subject to limitations, are identical to the Opponent's *Education services*;⁸
and
- that the Applicant's 'providing of on-line electronic publications in the field of health' is identical to the Opponent's 'provision of on-line electronic publications concerning health'.

Applicant's services: Education, namely provision of educational information and instruction courses in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.

27. I agree with the Opponent's submission. I find that the above-mentioned Applicant's services are encompassed by the Opponent's broad term *education services*. The parties' services are therefore 'Meric' identical.

Applicant's services: Providing of on-line electronic publications in the field of health; none of the aforesaid relating to prescriptions, pharmaceutical services,

⁸ Opponent's written submissions in lieu of a hearing, paragraph [2.25].

medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.

28. I agree with the Opponent that the Applicant's services are identical to the Opponent's class 41 service *provision of on-line publications concerning health.*

Applicant's services: Providing of on-line electronic publications in the field of, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.

29. The Opponent has submitted that the Applicant's above-mentioned services are similar to the Opponent's *provision of on-line publications concerning health.*⁹ I therefore compare the Applicant's services to this term. The purposes of the respective services will overlap to the extent that both parties' offerings aim to inform the reader in matters related to wellbeing. In my view, the topics covered by the Applicant's publications can be said to relate to health because they focus on activities aimed at improving or maintaining health. I consider that users will therefore likely overlap. Trade channels may also overlap; the same undertaking might provide online publications in health as well as the topics set out in the Applicant's term. Methods of use and the nature of the parties' services will be identical. The respective services will, to my mind, be in competition in certain instances, e.g. an electronic publication on 'health' might also contain articles in each of the fields specified by the Applicant. I do not find complementarity between the services; neither service is necessary or important for the other, even if the average consumer presumed both to originate from the same undertaking. In the light of the foregoing, I find the parties' services to be highly similar.

Applicant's services: Providing of on-line electronic publications in the field of sports; none of the aforesaid relating to prescriptions, pharmaceutical services,

⁹ Opponent's written submissions in lieu of a hearing, paragraph [2.28].

medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.

30. The Opponent has submitted that the Applicant's above-mentioned services are similar to the Opponent's *provision of on-line publications concerning health*.¹⁰ I therefore make this comparison. In my view, there might be occasions when the topics of sport and health overlap, but I do not consider this to happen with any great frequency. I find that the parties' services overlap in terms of purpose to the broad extent that both services seek to impart information to the reader. The specific purposes of the services will often differ; sport is most often concerned with competition and performance and will not always be discussed in relation to health. It is possible that both services might provide health-related information, but this will not, in my view, happen with great frequency. Users will in most cases be distinct, although overlap is possible. Trade channel overlap is, to my mind, unlikely but not impossible. Methods of use and the nature of the parties' services will be identical. I consider the respective services to be neither competitive nor complementary. I find the parties' services to have a low level of similarity.

Applicant's services: providing of training and instruction courses in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.

31. The Opponent submits that the Applicant's above-mentioned services are similar to the Opponent's *Education services*.¹¹ The Applicant submits that there is no similarity, arguing that "Education" under a fair specification is schooling or vocational training and not the same or similar to instruction courses enjoyed in personal time in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness'.¹² I disagree with the Applicant's argument. In my view, 'education' will encompass training and instruction courses, the aim of

¹⁰ As above.

¹¹ Opponent's written submissions in lieu of a hearing, paragraph [2.26].

¹² Applicant's written submissions in lieu of a hearing, paragraph [34].

both being to teach, 'teaching', to my mind, being synonymous with 'educating'. I note, however, that the Opponent has not pleaded that the respective services are identical. I find the parties' services to be highly similar. The parties' offerings will overlap in purpose to the extent that the aim of both is to teach/inform/instruct. Users, trade channels, methods of use and the nature of the services will be the same. The services will be in competition. The Opponent's 'Education services' at large could cover any field of knowledge and will therefore encompass *sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness*. I find the parties' services to be highly similar. The presence of the Applicant's limitation does not prevent this finding because the Opponent's services have not been limited.

Applicant's services: provision of information in relation to the aforementioned services,¹³ via a website; all of the aforementioned goods [sic] in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance or medical assistance consultancy; none of the aforesaid being or relating to medical education services or medical tuition services.

32. The Opponent has argued that the above-mentioned services are similar to those of the Opponent but has not specified where the similarity lies. Without any submission to guide me, I compare the Applicant's services to the Opponent's *provision of on-line publications concerning health*. The purposes of the parties' services will overlap to the broad extent that both services aim to impart information. The specific purposes of the services will, however, differ; the Applicant's services are intended to give information about each of its services set out in its specification, whereas the Opponent's services provide publications specifically on health in general. Users may overlap somewhat where the Applicant's services provide information about its other services in the fields of health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness. Trade channels may overlap to the extent that the Applicant's services provide information about online electronic publications in *health, fitness, exercise, training,*

¹³ This term relates to all of the services set out in the Applicant's specification preceding it.

nutrition, weight loss and lifestyle wellness. The nature of the parties' respective acts of services will differ in that the Applicant's services provide information about its other services, whereas the Opponent's offering involves providing online publications. In my view, there is no competition between the parties' services; neither being substitutable for the other. I do not find complementarity, either; I do not consider that the Applicant's services are necessary or important for the Opponent's provision of online publications, even if the average consumer were to presume both to originate from the same undertaking. I find the parties' services to have a low level of similarity.

Class 42

Applicant's services: Creation, design and development of software and software applications for use in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; creation and development of software for handheld devices and wireless devices for use with sports, health, fitness, exercise and training; providing temporary use of non-downloadable software for use in the field of sports, health, fitness, exercise, training, nutrition, weight loss and lifestyle wellness; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel; none of the aforesaid being or related to medical research services.

33. The Opponent has submitted that the Applicant's 'software services' are similar to the Opponent's 'computer software' goods in class 9. I will therefore make this comparison. I compare the Applicant's services to the Opponent's class 9 term *software for mobile phones, computers and devices*. The Applicant's services entail the creation of software limited to the particular areas specified whereas the Opponent's goods comprise 'ready-built' software that has not been limited. The parties' respective offerings will coincide in terms of their broad purpose to the extent that the provision of software is at the core of each, and software enables computers and other devices to operate. Because the Opponent's goods have not been limited, the Opponent's term will cover software for use in the fields specified by the Opponent. The goods/services will have different specific purposes,

however; the aim of the Applicant's services is the creation/design/development of software for use in certain fields, whereas the Opponent's goods are 'ready-built' and intended for immediate use. Users will likely overlap where the Opponent's software is for use in the fields to which the Applicant has limited its specification. Trade channels may also overlap; the same undertaking might offer both software in the Applicant's specified fields and the Applicant's services. The parties' offerings will differ in nature; one being a good (albeit a non-physical entity) and the other being acts of service. Methods of use will also therefore differ. I find the parties' offerings to be in competition where the Opponent's software has the same purpose and is (or could be used) in the same field as the Applicant's services. A prospective purchaser might deliberate over whether to engage a service or purchase a piece of software to achieve the same end. I also find complementarity; the aim of a software design service is the creation of a piece of software and the average consumer would likely presume both the service and the software to originate from the same undertaking. I find the parties goods and services to be similar to a medium degree.

Applicant's services: provision of websites in relation to diet, weight control, weight loss, diet planning, and to the provision of health information; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel; none of the aforesaid being or related to medical research services.

34. The Opponent has submitted that the Applicant's above-mentioned services are similar to the Opponent's: *health education services* and *provision of on-line publications concerning health and pharmaceutical services* (class 41); and the Opponent's services in class 44. I first compare the Applicant's services to the Opponent's *health education services* in class 41. I consider that diet, weight control, weight loss and diet planning are matters that would be encompassed by the broad topic of 'health'. The parties' services will, in my view, overlap somewhat in terms of purpose to the extent that both are intended to inform the consumer about health matters. The Applicant's limitation does not, in my view, prevent this finding because the Opponent's term 'health education services' is not subject to

limitation. Users may also overlap. Trade channels will likely overlap; the same undertaking might provide health education services as well as online information on the health-related matters set out in the Applicant's specification. Methods of use might overlap in some instances e.g. when use of the Opponent's service entails reading information online. However, in many instances, methods of use will diverge; e.g. the Opponent's services might take the form of talks, paper-based literature, audio-visual content. Differing methods of use for the respective services will translate into differences in the nature of the acts of service. Methods of use may coincide where delivery of the Opponent's health education service entails the provision of online information or advice. There may be competition between the parties' services in some cases; a consumer might deliberate over whether to consult the Applicant's online information on one the specified topics or whether to engage one of the Opponent's services where they relate to that topic. I find the parties' services to have a medium level of similarity. In my view, comparison of the Applicant's services with other of the terms as submitted by the Opponent will not improve the Opponent's position.

Applicant's services: provision of an on-line computer database featuring information in relation to diet, weight control, weight loss, diet planning, and to the provision of health information; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel; none of the aforesaid being or related to medical research services.

35. The Opponent has submitted that the Applicant's above-mentioned service is similar to the Opponent's services in classes 41 and 44, but has not specified where the similarity lies. I compare the Applicant's services to the Opponent's class 41 term *provision of on-line publications concerning health*. As noted above at [34], 'diet, weight control, weight loss, diet planning' are subjects related to 'health'. I consider that the parties' services will overlap in terms of purpose to the broad extent that both aim to inform the user on the topic of health. The specific purposes of the respective services will coincide to the extent that the Opponent's publications cover the topics to which the Applicant's services relate. Users will

likely overlap somewhat; a user seeking information on dieting and weight control might consult the online database and/or online publications where both services relate to those areas. Trade channels may also overlap: the same undertaking might provide both an online database and online publications, both of which cover dieting and weight control. Methods of use will often differ; users of the Applicant's services will typically input search terms to 'interrogate' the database whereas the Opponent's online publications will typically be accessed via a hyperlink. That said, there may be instances where publications, such as articles in journals or magazines, are accessed from a database in the way just described. The nature of the acts of service will coincide to the extent that the Opponent's online publications are accessed via a database but will differ where they are not so accessed. I consider the parties' services to be in competition; one might deliberate over whether to seek information on dieting and weight control via the Applicant's database or by consulting the Opponent's online publications. I find the parties' services to be similar to a medium degree.

Class 44

36. The Opponent has submitted that the following of the Applicant's services are identical to the Opponent's class 44 terms *weight control evaluation* and *Healthcare services*:¹⁴

Advisory services relating to diet, weight control and weight loss; diet planning; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel; none of the aforesaid relating to medical clinic services or medical nursing services.

37. I disagree with the Applicant's submission that the Applicant's services are identical to the Opponent's class 44 term *weight control evaluation*. In my view, the Applicant's services will entail the provision of advice, which is different to an

¹⁴ Opponent's written submissions in lieu of a hearing, paragraph [2.33].

evaluation. To my mind, an evaluation entails providing an assessment or appraisal of something rather than suggesting what a person should do. However, I agree with the Opponent's submission that the Applicant's services are identical to the Opponent's *Healthcare services*. I find that the Applicant's services will be encompassed by the Opponent's broader term. I find the parties' services to be 'Merik' identical.

Applicant's goods: *provision of health information; none of the aforesaid relating to prescriptions, pharmaceutical services, medical assistance, medical assistance consultancy provided by doctors, or medical assistance consultancy provided by specialised medical personnel; none of the aforesaid relating to medical clinic services or medical nursing services.*

38. The Opponent has submitted that the Applicant's above-mentioned services are identical to the Opponent's class 44 terms *Healthcare services and consultancy, information, recommendation and advisory services relating to pharmaceuticals, pharmacy services and all the aforesaid including being provided via the internet and/or through applications and/or mobile applications*. I agree that the Applicant's 'provision of health information' will be encompassed by the Opponent's broader term *Healthcare services*. The parties' services are therefore 'Merik' identical.

Average consumer and the purchasing act

39. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

Class 9

40. The average consumer of the majority of the class 9 goods that come into play in this opposition will be, in my view, predominantly the general public; i.e. consumers

with an interest in health and fitness who, for example, might wish to use 'Apps' etc to track their progress. I recognise that a number of purchasers will be the professional public, e.g. professionals working in sports, health, fitness, exercise, training, nutrition, weight loss and wellness. The purchasing act will likely be primarily visual to the extent that the consumer will first encounter the goods either online (e.g. an 'App' would be downloaded from the seller's site) or in a physical shop selling the software. There will be an aural aspect to the purchasing process where the prospective purchaser seeks advice from retail staff before transacting. To my mind, the average consumer will likely take some measure of care before purchasing the goods. I find that a medium level of attention will be paid during the purchasing process; factors considered will likely include, *inter alia*: whether the software/App/media content, as the case may be, meets the purchaser's needs.

41. I consider that the Applicant's *data processing software* will be purchased predominantly by the professional public, i.e. professionals in the fields of sports, health, fitness, exercise, training, nutrition, weight loss and wellness. The purchasing act will likely be primarily visual in the manner described above. I consider that there will often be an aural aspect to the purchasing process and that many transactions might be preceded by discussions of the purchaser's business needs. I consider that a higher level of attention would be paid during the purchasing act where the purchaser is a professional. I find that *data processing software* will be purchased with a level of attention in the *medium to high range*. Factors considered will likely include, *inter alia*: the business needs; compatibility with existing hardware.

Class 38

42. The class 38 services that come into play, broadly speaking, facilitate access to online content by providing the infrastructure (e.g. portals, channels, links) which enables such engagement. To my mind, the average consumer will include members of both the general and professional public seeking access to online content relating to sports, health, fitness, exercise, training, nutrition, weight loss and wellness. For both consumer groups, I consider the purchasing act to be primarily visual to the extent that the prospective purchaser will likely first encounter

the services on a website; access to online content is typically purchased online. There might be some instances where the prospective purchaser has a query about the services offered and wishes to speak to the provider before making a payment. In my view, purchasers will display a measure of care when deciding whether to purchase the services, particularly if payment of a monthly subscription is required, for instance. Factors influencing the purchasing decision will likely include, *inter alia*, whether the service serves the purchaser's business or personal requirements. I find that the average consumer will display a medium to high level of attention during the purchasing act.

Class 41

43. I consider that both parties' services will be engaged by both the general and professional public. Although the Applicant has limited its specification to exclude services relating to 'medical education services' or 'medical tuition services', it is my view that this does not rule out services aimed at professionals such as personal trainers or sports instructors, for example. The purchasing act will be primarily visual to the extent that the prospective purchaser will likely encounter the services being advertised online or, where the education/training takes place in a physical venue, on signage at physical premises. There will be an aural aspect to the purchasing process where the consumer seeks information or advice prior to committing to a transaction. I find that professional consumers will pay a level of attention in the medium to high range when engaging the services. Factors taken into account will include whether the education/training/online publications are suitable for their professional requirements. I find that the general consumer will also be fairly attentive when engaging the services, pay at least a medium level of attention during the purchasing act. Factors influencing the purchasing decision might include the level or ability of the consumer (where instruction courses concern sports, fitness and exercise) or their health status.

Class 42

44. The average consumer of the class 42 services concerned with design, creation and development of software will, in my view, most likely be members of the

professional public. It would be unusual for a member of the general public to engage these services. The purchasing act will, to my mind, be primarily visual to the extent that the prospective purchaser will likely encounter the services being advertised online. I consider that, in most cases, the purchaser would engage with the provider to discuss its needs before committing to a transaction. In my view, the purchaser will be fairly prudent when engaging these services. I find that the average consumer would pay a level of attention in the high range when purchasing these services.



45. I now consider the class 42 services providing websites and online databases. The end user of the websites and databases provided will be both the general and professional public with a personal or professional interest in the areas of sports, health etc. specified. The purchasing act will be primarily visual to the extent that the services will be encountered online. It is my understanding that many websites are free to access but that others must be subscribed to by paying a fee. Generally, I consider that the decision to access a particular website or online database would be taken in a fairly casual manner and without a particularly high level of care. Where access to the online content must be purchased, however, I consider that the average consumer would be more prudent. The consumer would likely pay at least a medium level of attention during the purchasing act. Factors considered will likely include the subject area of the content being accessed.

Class 44

46. The average consumer of the class 44 services that come into play will, in my view, be predominantly the general public. The consumer may access the services in a number of ways, including: reading information online or conversing with a staff member of the service provider 'face-to-face' or remotely (e.g. via a videocall) or via telephone. A smaller number of consumers will, to my mind, be professionals in the fields of health, diet and weight control. The purchasing act will be primarily visual to the extent that the services will be encountered online or advertised in physical premises. There may be an aural aspect where the services have been recommended to the purchaser or heard about 'by word of mouth'. I consider that a consumer would exercise some measure of care when seeking advice to do with

health, diet and weight control. I find that both professional and general consumers would likely pay at least a medium level of attention when engaging the services.

Comparison of the marks

Opponent's marks:	Applicant's mark:
	

47. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

48. It would be wrong, therefore, to artificially 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.

49. The Opponent has relied on its series of 6 earlier marks. In my view, the iteration of the mark that is rendered in black, i.e. the second mark in the series, provides the strongest case for the Opponent because it has fewer points of difference when compared to the Applicant’s mark.

Overall impression of the marks

50. The Opponent’s mark comprises the word ‘well’ rendered in a plain black emboldened typescript. A small cross (+) symbol appears as a superscript just before the ‘w’ of ‘well’. The overall impression resides in the mark as a whole, with the ‘well’ element playing a greater visual role owing to its much larger size relative to the ‘+’ element which is presented as a superscript.

51. The Applicant’s mark comprises a word element and a figurative element. The word ‘welltech’ is rendered in a plain black emboldened typescript. A solid black semi-circle is positioned at the beginning of the mark, before the word ‘welltech’. The overall impression resides in the mark as a whole, with the ‘welltech’ element playing a greater visual role owing to its much larger size relative to the figurative element.

Visual comparison

52. Both parties’ marks include the word ‘well’, which appears as the first part of the word element of the Applicant’s mark. Both marks feature a plain typeface. In both marks, the ‘well’ element is preceded by a figurative element: i.e. a cross ‘+’ in the Opponent’s mark; and a solid black semi-circle in the Applicant’s mark. Both marks

are relatively short and it is my view that the fact that the word element in the Applicant's mark is twice as long as the Opponent's mark (well v welltech) will be registered visually by the average consumer.

53. Other points of visual difference are:

- the presence of the word element 'tech' which is conjoined with 'well' to form 'welltech' in the Applicant's mark, which is absent from the Opponent's mark;
- the placement of the small '+' as a superscript preceding the 'well' element of the Opponent's mark, which is absent from the Applicant's mark;
- the presence of the solid black semi-circle preceding the 'welltech' element of the Applicant's mark, which is absent from the Opponent's mark.

54. Taking all of this into account, I find the parties' marks to have a medium level of visual similarity.

Aural comparison

55. The Applicant has submitted that the inclusion of 'tech' gives 'the contested mark a distinct phonetic impression' which makes it 'aurally dissimilar' to the Opponent's mark.¹⁵ I disagree with this argument. The Applicant's mark will be articulated as 'WELL-TEK' and the Opponent's mark will be articulated as 'WELL'. Both marks contain the word element 'well', which will be articulated in the same way for each mark. Generally, the beginnings of words tend to have more of a visual and aural impact than the ends of words, although this is not an absolute rule.¹⁶ I consider it unlikely that the '+' element in the Opponent's mark would be articulated, and neither party has submitted otherwise. The only aural difference between the marks is the presence of the 'TEK' sound in the Applicant's mark. I consider that the fact that the Applicant's mark is twice as long as the Opponent's mark (one syllable v two syllables) will be discerned aurally by the average consumer.

¹⁵ Applicant's written submissions in lieu of a hearing, paragraph [18].

¹⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, at [81]; *CureVac GmbH v OHIM*, T-80/08, at [42].

56. In the light of the foregoing, I find the parties' marks to have a medium level of aural similarity.

Conceptual comparison

57. I first consider the Opponent's mark. I am of the view that the word 'well' will be understood as meaning healthy or 'without illness'. I note the Opponent's pleading that the '+' sign placed before 'well' 'will be recognised by the general public universally used to denote pharmacy services and pharmacy products' and that the average consumer would not therefore accord to it any trade mark significance.¹⁷ It is my view that, although a number of average consumers might understand '+' in this way, it would more likely be seen as denoting 'plus' or 'extra'. That said, I consider that the placement of the '+' as a mere superscript, and its small size relative to the much larger 'well' component mean that it may go unnoticed by a large proportion of average consumers.

58. I now consider the Applicant's mark. The word element 'welltech' will, to my mind, be perceived by the average consumer as an invented word created from the amalgamation of the words 'well' and 'tech'. I am of the view that, although the word will be seen as invented, its constituent parts will convey a meaning to the average consumer. I consider that the 'well' element of the word will be perceived in the same way as described above for the Opponent's mark, in the context of the goods and services being opposed. The 'tech' element will, to my mind, be understood as an abbreviation of the word 'technology' and will likely conjure notions of electronic devices and media, i.e. computers, tablets, smartphones, websites etc. The overall conceptual message that will be understood by the average consumer will likely be 'technology relating to wellbeing/wellness'.

59. In the light of the foregoing, I find the parties' marks to have no more than a medium level of conceptual similarity.

¹⁷ Opponent's Statement of Grounds, at Q5, first paragraph.

Distinctive character of the earlier marks

60. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

61. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

62. The word ‘well’ is a word in the English language frequently used in everyday parlance. My view is that the Opponent’s mark will be perceived by the average consumer as meaning the state of being healthy or devoid of illness. Although the word ‘well’ cannot be said to be descriptive of any of the registered goods or

services that come into play in these proceedings, I find that the mark is somewhat allusive for those of the Opponent's services in classes 41 and 44 that are connected with health. I find that the mark will have a low level of inherent distinctive character for these services.

63. I am of the view that the mark will be neither descriptive nor allusive for the Opponent's class 41 *Education services* and the relevant class 9 goods. I nevertheless recognise that the Opponent's *software for mobile phones, computers and devices* is a broad term that will encompass software for use in any field, including the fields of health and wellbeing. I find that the mark will have a level of inherent distinctive character slightly higher than that found in relation to the services considered above at [62], but that the level will still be in the low range owing to the ubiquity of the word 'well' in everyday parlance.

64. The Opponent has not adduced any evidence in these proceedings. I am therefore unable to make an assessment as to whether the earlier mark enjoys an enhanced level of distinctive character.

Likelihood of confusion

65. Confusion can be direct or indirect. Mr Iain Purvis QC, (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*¹⁸. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them,

¹⁸ Case BL O/375/10 at [16].

¹⁹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

combined with the goods at issue, leads them to conclude that the goods are the responsibility of the same or an economically linked undertaking.

66. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [10]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

67. With the exception of the Applicant’s class 38 term *providing telecommunication facilities that enable the creation and updating of personal electronic web pages*, I have found the opposed goods and services to bear levels of similarity to the Opponent’s goods and services ranging from low to identical. However, I am of the view that the net effect of the visual, aural and conceptual differences between the parties’ marks is sufficient to prevent the average consumer from mistaking one party’s mark for the other. Despite both parties’ marks containing the element ‘well’, I consider that the differences that I have identified between the marks will be noticed by the average consumer. Both parties’ marks are fairly short, making the differences in their lengths, both visually and aurally, particularly apparent; the Applicant’s mark has twice the number of characters and syllables as the Opponent’s mark. I find that there is no likelihood of direct confusion. I find this to be the case, even where a high level of attention is paid during the purchasing act.

68. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing 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.

69. I have borne in mind *Whyte and Mackay*²⁰ in which it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. I note that the shared element ‘well’ appears at the beginning of the Applicant’s mark conjoined to which is the word element ‘tech’. This ‘add-on’ is somewhat descriptive of the goods and services in respect of which registration is sought. I have borne in mind the low distinctive character of the ‘well’ element, and of the earlier mark as a whole. However, just because the shared element of the marks is low in distinctive character, it does not necessarily follow that there cannot be a likelihood of confusion.²¹ That said, it is my view that the word elements of the Applicant’s mark form a unit; i.e. the word ‘well’ qualifies the word ‘tech’ to convey the idea of ‘technology relating to wellness/health’. I find that the distinctive character of the mark resides in the combination of words, i.e. in the mark as a whole, rather than in the element ‘well’. I find that the element ‘well’ does not enjoy a distinctive significance independently of the Applicant’s mark as a whole. I find that there is no likelihood of indirect confusion.

70. The Opposition has failed in its entirety. Subject to a successful appeal, the Application may proceed in respect of all of the goods and services for which protection is sought.

COSTS

71. The Applicant is the successful party and is entitled to a contribution of £400 to its costs based upon the scale published in Tribunal Practice Notice 2/2016, calculated as follows:

Consideration of Opposition and preparation of Defence and Counterstatement	£200
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²⁰ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

²¹ Case BL O/331/23, at [10] and [11].

Preparation of submissions	£200 ²²
Total:	£400

72.I therefore order Bestway Panacea Holdings Limited to pay to Welltech Group Limited the sum of £400. 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 30th day of June 2023

N. R. Morris

**For the Registrar,
the Comptroller-General**

²² I have awarded a sum below the minimum threshold because the Applicant's submissions regarding the efficacy of the limitations to its specification are fundamentally misconceived. The limitations are insufficient to prevent the findings of similarity between the respective goods and services because the Opponent's specification contains broad terms which are not so limited.