

O/0631/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3698164  
IN THE NAME OF HOWDEN BROKING GROUP LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK:

**BE WELL WORLD**

IN CLASSES 9, 41, 42 & 44

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 431496  
BY VISIOMED GROUP

## **Background and pleadings**

1. On 21 September 2021, Howden Broking Group Limited (“the applicant”) applied to register the trade mark **BE WELL WORLD** in the UK, under number 3698164 (“the contested mark”). Details of the application were published for opposition purposes on 3 December 2021. Registration is sought for the following goods and services:<sup>1</sup>

Class 9: Computer software; computer programs; mobile applications; artificial intelligence and machine learning software; electronic publications (downloadable) from databases or the Internet; downloadable electronic forms; digital media and recordings; pre-recorded digital media and recordings; downloadable digital media and recordings containing sounds, images, text, information, signals or software; electronically recorded data; electronic files; downloadable software platforms; all in the field of health, wellbeing, insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid relating to pharmacy services.

Class 41: Education; training; arranging and conducting of workshops [training], conferences, seminars and training courses; provision of online electronic publications; information, consultancy and advisory services all relating to the aforesaid; all in the field of health, wellbeing, insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid services including or relating to coaching,

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<sup>1</sup> Although the applicant originally sought registration for a broader list of goods and services, these were restricted by way of a Form TM21B filed on 5 May 2022. As the opponent did not confirm whether the amendments would allow the opposition to be withdrawn, on 12 July 2022, the Tribunal confirmed that the proceedings would continue.

lifecoaching, wellbeing coaching, health coaching, coaching training or any form of coaching services and/or training in the field of wellbeing; none of the aforesaid relating to pharmacy services.

Class 42: Research, design and development of computer hardware and software; installation, updating and maintaining computer software; advisory and consultancy services relating to computer software; advisory and consultancy services relating to computer software design; leasing of computer software; design of on-line databases and directories; software as a service [SaaS]; software as a service [SaaS] featuring software for machine learning; software as a service [SaaS] featuring computer software platforms for artificial intelligence; platform as a Service [PaaS]; providing artificial intelligence computer programs on data networks; hosting services, software as a service [SaaS]; rental of software; cloud computing services; cloud hosting provider services; consulting services in the field of cloud computing; design and development of operating software for accessing and using a cloud computing network; application service provider (ASP) services, namely hosting computer software applications for others; webhosting and server hosting; hosting of Access Control as a Service (ACaaS) servers and software; creating and maintaining technology platforms and websites; provision and hosting of non-downloadable software platforms; programming of software for information platforms on the Internet; operation of search engines; information, consultancy and advisory services all relating to the aforesaid; all in the field of health, wellbeing, insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management.

Class 44: Health counselling services; provision of information in the field of well-being.

2. On 2 March 2022, VISIOMED GROUP (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies

upon its comparable UK registration number 801299461,<sup>2</sup> which consists of the following:

**bewell  
connect**

(“the earlier mark”)

3. The earlier mark was filed on 16 December 2015 and became registered on 21 November 2016 in respect of a wide range of goods and services covering ten classes. For the purposes of its claim, the opponent relies upon some of those goods and services, namely:

Class 9: Computer software applications for mobile devices for use in recording, organizing, transmitting, and receiving analysis of texts, data, images and files in particular in the field of health;<sup>3</sup> computer software applications for mobile apparatus for the transmission, the wireless reception of data, processing and the transmission and display of information relating to heart rate; electric or electronic sensors for detecting, processing, measuring, collecting, recording and transmitting variables in connection with health, namely, in particular for blood sugar; mobile devices software applications for wireless data transmission, reception, processing and information relating to blood sugar transmission and display; measuring apparatus and instruments, in particular baby scales and personal scales; scales; baby scales; electric measuring apparatus; personal electronic devices for measuring, displaying, organizing, recording, handling, analysis and reception of data, texts, images and audio

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<sup>2</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing IREU. As a result of the opponent’s IREU number 1299461 being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

<sup>3</sup> This term is listed twice.

files in particular in the field of health; electric or electronic sensors for detecting, processing, measuring, collecting, recording and transmission of general information related to weight and body mass; computer software applications for mobile apparatus for the transmission, the wireless reception of data, processing and the transmission and display of information relating to weight and body mass; managing personal information software; apparatus for recording, transmission and presentation of medical data.

Class 41: Education; training; correspondence courses; practical training [demonstration]; organization of exhibitions for cultural or educational purposes; organization and conducting of training workshops; organization and conducting of colloquiums; organization and conducting of conferences; organization and conducting of congresses; organization and conducting of seminars; organization and conducting of symposiums; electronic publication of books and periodicals on-line; publication of texts other than advertising texts; correspondence courses.

Class 42: Scientific and technological services as well as research and design relating thereto, namely evaluations, assessments and research in the fields of science and technology provided by engineers; medical analysis and research services; design and development of computers and software; computer system analysis; consultancy in the design and development of computers; conversion of computer programs and data, other than physical conversion; conversion of data or documents from physical to electronic media; software development (design); technical project study; maintenance of computer software; updating of software; programming for computers; research and development of new products for others; recovery of computer data; design and development of computer hardware and software for use in the medical field; design and development of medical technologies; design and development of medical diagnostic apparatus; computer services, namely provision of a website featuring technology for facilitating monitoring and controlling, remote communication via wireless or not, devices for monitoring and controlling the environment, smoke detectors, carbon monoxide alarms, fire alarms, detectors environmental hazard equipment, lighting and security alarms, sensors;

computer services, namely, providing a website featuring technology enabling the automatic control and monitoring devices for monitoring and controlling the environment, smoke detectors, carbon monoxide alarms, fire alarms, detectors environmental hazard equipment, lighting and security alarms, sensors; measuring apparatus and instruments design; technical support services, assistance and research use services; meteorological information services; provision of a website featuring information on weather and air quality; weather forecast; provision of current and future historical meteorological information for data management.

Class 44: Evaluation and monitoring of health, provision of information in the field of health and well-being; provision of information in the field of health and well-being through a website; medical and diagnostic services; consultancy in the field of diagnostic medicine; health evaluation and monitoring.

4. Given the respective filing dates, the opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all the goods and services identified, without having to demonstrate genuine use.

5. The opponent contends that the contested mark is similar to its earlier mark and has been applied for in respect of goods and services which are identical or similar to the goods and services of the earlier mark. On this basis, the opponent claims that there is a likelihood of confusion, including the likelihood of association.

6. The applicant filed a counterstatement, denying the ground of opposition. The applicant denies that the competing marks are similar, and that the parties' goods and services are similar. Based upon these factors, the applicant disputes that there is a likelihood of confusion.

7. Both parties are professionally represented; the opponent by Ladas & Parry LLP and the applicant by Stobbs IP. Only the applicant filed evidence. Neither party

requested a hearing. Neither party filed written submissions in lieu of attendance, though I note that the applicant filed written submissions during the evidence rounds. This decision is taken following careful consideration of all the papers before me.

8. 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 Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **Evidence and submissions**

9. The applicant's evidence is given in the witness statement of Sarah Fellows, dated 12 December 2022, and four accompanying exhibits (SF1 to SF4). Ms Fellows is a Solicitor at Stobbs IP. She gives evidence as to the opponent's use of the earlier mark, the meaning of the phrase 'BE WELL', as well as third-party use of the phrase.

10. As noted above, the applicant also filed written submissions during the evidence rounds.

11. I have read all the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

### **Decision**

#### **Section 5(2)(b) – legislation and case law**

12. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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

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

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

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

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

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

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

## Comparison of goods and services

14. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

15. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

- (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.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

17. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

“29. [...] goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the 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”.

18. The goods and services to be compared are outlined at paragraphs 1 and 3.

### My approach

19. Some of the parties’ health and well-being related goods and services, such as, for example, the applicant’s *‘computer software; all in the field of health, wellbeing’* and the opponent’s *‘computer software applications for mobile devices for use in recording, organizing, transmitting, and receiving analysis of texts, data, images and files in particular in the field of health’* are clearly identical. Therefore, insofar as the applied-for goods and services relate to these fields, I will proceed on the basis that they are all identical to those of the earlier mark. If the opposition fails, even where the goods and services are identical, it follows that the opposition will fail where the goods and services are only similar.

20. For the avoidance of doubt, my assessment below will focus upon the applied-for goods and services which do not relate to the fields of health and well-being.

## Class 9

*'Computer software; computer programs; mobile applications; artificial intelligence and machine learning software; downloadable software platforms; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid relating to pharmacy services'*

21. Although the nature of the above goods and *'design and development of [...] software'* in class 42 of the earlier mark differ in nature, method of use and intended purpose, the design and development of software is essential to it as a finished product. It is also not uncommon for undertakings who offer computer software to also offer design and development services relating thereto. Moreover, particularly given the opponent's services are not limited to any field of application, they could relate to the fields listed in the applicant's specification. In this context, it is likely that consumers will believe that the responsibility for the respective goods and services lies with the same undertaking. They are, therefore, complementary. There is also a degree of competition between them, since a consumer could reasonably select to have bespoke software created for them over purchasing a finished product, or vice versa. The respective goods and services are likely to reach the market through shared channels of trade and may share users. In light of all this, I find that there is a medium degree of similarity between the respective goods and services.

*'Electronic publications (downloadable) from databases or the Internet; downloadable electronic forms; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid relating to pharmacy services'*

22. Whilst the nature, intended purpose and method of use are clearly different, it is my view that the above goods and *'publication of texts other than advertising texts'* in class 41 of the earlier mark are likely to reach the market through shared trade channels and providers. The opponent's services may be provided via online channels and cover the texts referred to in the applicant's specification; an undertaking who offers electronic publications and forms is also likely to publish them online. The respective goods and services may share users. Moreover, the electronic publications are important to the operation of the opponent's publishing service and consumers are likely to believe that the responsibility for them lies with the same undertaking. As such, there is a degree of complementarity between them. Overall, I find that they are similar to a medium degree.

*'Digital media and recordings; pre-recorded digital media and recordings; downloadable digital media and recordings containing sounds, images, text, information, signals or software; electronically recorded data; electronic files; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid relating to pharmacy services'*

23. The opponent has not indicated which goods or services of the earlier mark it considers the above terms to be similar or identical to, or why. In the absence of such an explanation or evidence before me, I do not consider there to be any clear overlap in nature, method of use or intended purpose between them and any of the opponent's goods or services. The respective goods and services are unlikely to reach the market through shared trade channels or be provided by the same undertakings. There is no material competition between them. Notwithstanding that the applicant's recordings may eventually be stored on some of the opponent's devices in class 9, I do not consider the respective goods and services to be important or indispensable to one another in such a way that consumers would believe that the responsibility for them lies with the same undertaking; the relationship between them is insufficiently

proximate. Taking all the foregoing into account, I find that these goods in the application are dissimilar to the opponent's goods and services.

#### Class 41

*'Education; training; all in the field [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid services including or relating to coaching, lifecoaching, wellbeing coaching, health coaching, coaching training or any form of coaching services and/or training in the field of wellbeing; none of the aforesaid relating to pharmacy services'*

24. The applicant's services fall within the scope of the opponent's broad terms 'education; training' in class 41 of the earlier mark, which are not limited to any field of application. They are, therefore, to be regarded as identical in accordance with *Meric*.

*'Arranging and conducting of workshops [training], conferences, seminars [...]; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid services including or relating to coaching, lifecoaching, wellbeing coaching, health coaching, coaching training or any form of coaching services and/or training in the field of wellbeing; none of the aforesaid relating to pharmacy services'*

25. The above services are encompassed by the opponent's broad terms 'organization and conducting of training workshops; organization and conducting of conferences; organization and conducting of seminars'. As such, they are identical under the principle outlined in *Meric*.

*'Arranging and conducting of [...] training courses; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid services including or relating to coaching, lifecoaching, wellbeing coaching, health coaching, coaching training or any form of coaching services and/or training in the field of wellbeing; none of the aforesaid relating to pharmacy services'*

26. The opponent's term *'training'* is not limited by reference to any particular fields. Accordingly, the applicant's term falls within its scope, rendering the respective services identical under the *Meric* principle.

*'Provision of online electronic publications; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid services including or relating to coaching, lifecoaching, wellbeing coaching, health coaching, coaching training or any form of coaching services and/or training in the field of wellbeing; none of the aforesaid relating to pharmacy services'*

27. The opponent's *'publication of texts other than advertising texts'* would incorporate the applied-for services, as they are not limited to any field of application or method of delivery, i.e. they could cover the same fields of application and be published online. Consequently, they are identical under the principle outlined in *Meric*.

*'Information, consultancy and advisory services all relating to the aforesaid'*

28. I have found that each of the applicant's services in this class are identical to the opponent's class 41 services. Although the information, consultancy and advisory services relating to the applicant's services in this class differ in nature, intended purpose and method of use when compared with the opponent's services, they are likely to reach the market through shared trade channels and be provided by the same

undertakings. The opponent's services are important to the provision of information relating to identical services and, therefore, they are also complementary. The respective services will also share users. In light of this, I find that the applicant's information, consultancy and advisory services are similar to the opponent's class 41 services to a medium degree.

#### Class 42

*'Research, design and development of computer hardware and software; installation, updating and maintaining computer software; design and development of operating software for accessing and using a cloud computing network; programming of software for information platforms on the Internet; information, consultancy and advisory services all relating to the aforesaid; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management'*

29. To my mind, the above services would fall within the opponent's broader terms *'design and development of computers and software; maintenance of computer software; updating of software'*. They are to be regarded as identical in accordance with *Meric*. If I am wrong in respect of the applicant's research and installation services, it remains the case that the respective services will overlap in trade channels and users. They may also be provided by the same undertakings, and there is a degree of complementarity between them. Therefore, if they are not identical, they are similar to a medium degree.

30. It is considered that the information, consultancy and advisory services relating to the applicant's services differ in nature, intended purpose and method of use when compared with the opponent's services. Nevertheless, they are likely to reach the market through shared channels of trade and be provided by the same undertakings. The opponent's services are important to the provision of information relating thereto and, as such, they are also complementary. The respective services also share users. Overall, I find that the applicant's information, consultancy and advisory services are

similar to the opponent's services to a medium degree. If I am wrong to find the applicant's research and installation services identical to the opponent's services, there would be no complementary relationship between the information, consultancy and advisory services relating to those research and installation services and the opponent's services. As a consequence, those services would only be similar to a low degree.

*'Advisory and consultancy services relating to computer software; advisory and consultancy services relating to computer software design; consulting services in the field of cloud computing; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management'*

31. The applicant's services differ somewhat in nature and intended purpose with the opponent's *'consultancy in the design and development of computers'* in that the former relates to computer software in specific fields and the latter relates to hardware. However, they both involve the provision of information with closely related subject matter (as the opponent's services could relate to the same fields of application); therefore, they also overlap. The method of use will be the same as users will engage with the service provider to receive the information. Users are likely to overlap. The respective services are likely to reach the market through the same trade channels and may be provided by the same undertakings. There is no material competition between them, given the different subject matter. Neither are they complementary, as they are not important or indispensable to one another. Overall, I find that the respective services are similar to a medium degree.

*'Leasing of computer software; software as a service [SaaS]; software as a service [SaaS] featuring software for machine learning; software as a service [SaaS] featuring computer software platforms for artificial intelligence; providing artificial intelligence computer programs on data networks; [...] software as a service [SaaS]; rental of software; cloud computing services; creating and maintaining technology platforms [...]; provision [...] of non-downloadable software platforms; information, consultancy*

*and advisory services all relating to the aforesaid; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management'*

32. Although the above services have a different nature, intended purpose and method of use when compared with the opponent's '*design and development of computers and software*', they may reach the market through overlapping channels of trade and share users. They may also be provided by the same undertakings. There is a degree of complementarity between the respective services as the opponent's design and development services are important to, for example, the provision of the resulting software, and consumers may believe that the responsibility for the services lies with the same undertakings. There is also a degree of competition between them. For example, a user could choose to have bespoke software created for them or, instead, pay for access to centrally hosted software. Overall, I find that there is a medium degree of similarity between the respective services.

33. It is considered that the information, consultancy and advisory services relating to the applicant's services differ in nature, intended purpose and method of use when compared with the opponent's services. They are neither complementary nor in competition. However, they may reach the market through shared channels of trade and may be provided by the same undertakings. Overall, I find that the applicant's information, consultancy and advisory services are similar to the opponent's services to a low degree.

*'Platform as a Service [PaaS]; hosting services [...]; cloud hosting provider services; application service provider (ASP) services, namely hosting computer software applications for others; creating and maintaining technology [...] websites; [...] hosting of non-downloadable software platforms; design of on-line databases and directories; webhosting and server hosting; hosting of Access Control as a Service (ACaaS) servers and software; operation of search engines; information, consultancy and advisory services all relating to the aforesaid; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services,*

*insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management'*

34. In the absence of any evidence or submissions to assist me, there does not appear to be any obvious overlap in nature, method of use or intended purpose between the above services and any of the opponent's goods or services. To my mind, the respective goods and services are not likely to reach the market through shared channels of trade, and I do not consider it typical for them to be provided by the same undertakings. There is no material competition between them. Neither do they appear to be complementary in the sense outlined in case law. There may be an overlap in user, though I do not consider that to be sufficient to engage any similarity between them. Overall, I find that the respective goods and services are dissimilar.

35. Some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.<sup>4</sup> My findings above mean that the opposition must fail against the goods and services of the application that I have found to be dissimilar, namely:

Class 9: Digital media and recordings; pre-recorded digital media and recordings; downloadable digital media and recordings containing sounds, images, text, information, signals or software; electronically recorded data; electronic files; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management; none of the aforesaid relating to pharmacy services.

Class 42: Platform as a Service [PaaS]; hosting services [...]; cloud hosting provider services; application service provider (ASP) services, namely hosting

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<sup>4</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

computer software applications for others; creating and maintaining technology [...] websites; [...] hosting of non-downloadable software platforms; design of on-line databases and directories; webhosting and server hosting; hosting of Access Control as a Service (ACaaS) servers and software; operation of search engines; information, consultancy and advisory services all relating to the aforesaid; all in the field of [...] insurance, reinsurance, insurance broking, risk management, underwriting, actuarial services, insurance actuarial services, reinsurance actuarial services, business analytics, data analytics, data integration, data automation, predictive analytics, business intelligence, analysis of business data, finance, business management, financial management.

### **The average consumer and the nature of the purchasing act**

36. The average consumer is deemed to be reasonably well informed, observant and circumspect. 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.<sup>5</sup>

37. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

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<sup>5</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

38. The applicant has submitted that the goods and services are directed to the general public as well as medical professionals. I agree, though would add that relevant consumers are also likely to include a wider range of businesses and professionals.

39. In respect of the general public, the frequency at which the goods and services are purchased is likely to vary. However, overall, they are likely to be neither extremely frequent nor infrequent purchases. The associated cost will, again, vary. Overall, it is my view that they are likely to be relatively inexpensive. The importance of the selection is also likely to vary, with inexpensive software applications, electronic publications and the like at one end of the spectrum and health-related services at the other. However, none of the goods or services will be a merely casual purchase. The general public will consider factors such as functionality, compatibility and subject matter when purchasing the parties' goods in class 9; cost and prior outcomes when purchasing the parties' services in class 41; ease of access, functionality and the expertise of the provider when purchasing the parties' services in class 42; and will be conscious of the importance of their own health and whether the provider is able to meet their needs when purchasing the parties' services in class 44. The level of attention paid by the general public is likely to vary depending on the particular good or service being purchased. For example, it will be lower when selecting a mobile software application, higher when selecting an education provider, and higher still when selecting a counselling service. Overall, the general public is likely to demonstrate a medium level of attention during the purchasing process. The goods are likely to be purchased from retailers and websites after viewing information on shelves or on the internet. Visual considerations will dominate the purchasing process, though I do not exclude aural considerations entirely in the form or, for example, discussions with sales assistants or word of mouth recommendations. The services are likely to be purchased directly from the provider, after viewing information in brochures or on the internet. Again, visual consideration will dominate. However, I do not discount aural considerations entirely; for instance, it is possible that the purchasing of these services will involve verbal consultations.

40. As for businesses and professional users, the goods and services may be more frequent purchases. The associated cost will, again, vary. However, it is possible that

some (such as, for example, commissioning an undertaking to create complex computer software for the business) may attract a significant outlay. In addition to the factors considered by the general public, these relevant consumers will be alive to the potentially negative impacts of selecting the wrong product or service provider on their business or professional operation. Overall, I find that businesses and professional users will demonstrate a higher than medium level of attention during the purchasing process. The goods are likely to be purchased from specialist retailers and websites after viewing information on shelves or on the internet. The services are likely to be purchased directly from the provider, after viewing information in brochures, at trade shows or on the internet. It is considered that the purchasing process will be predominantly visual in nature. However, I do not exclude aural considerations entirely in the form of, for example, verbal consultations with the provider or word of mouth recommendations.

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

41. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee*, paragraph 51).”

42. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

43. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use; accordingly, I have only the inherent position to consider.

44. The earlier mark consists of the words ‘bewell connect’ in a standard typeface, the former in bold. Although they are conjoined, given that they are common, dictionary words, it is my view that consumers will readily identify the words ‘be’ and ‘well’, i.e. they will perceive this element as the words ‘be well’. The applicant has provided a dictionary definition which suggests that these words mean to be healthy or feel good.<sup>6</sup> This supports, rather than contradicts, my original impression of the meaning of the words. In relation to health and well-being related goods and services, such as, for example, *‘electric or electronic sensors for detecting, processing, measuring, collecting, recording and transmitting variables in connection with health, namely, in particular for blood sugar’*, *‘personal electronic devices for measuring, displaying, organizing, recording, handling, analysis and reception of data, texts, images and audio files in particular in the field of health’* and *‘provision of information in the field of health and well-being through a website’*, the words are strongly allusive of a characteristic of the goods and services, e.g. monitoring devices and health information that enable or assist the user to be healthy or feel good. In my view, this meaning is clear when considering the natural and ordinary meaning of the words in

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<sup>6</sup> Exhibit SF3

the context of those goods and services; the printouts provided which show third-party use of the words add very little.<sup>7</sup> In relation to goods and services not related to health or well-being, the phrase does not have the same allusive message. The word 'connect' will be understood as meaning link, bring together or associate. It is not directly descriptive or allusive of any of the goods and services, though is not a particularly unusual word. Overall, it is my view that, in relation to goods and services in the fields of health and well-being, the mark has between a low and medium degree of inherent distinctive character. Where there is no association with health and well-being, the mark is more distinctive, though to no more than a medium degree.

### **Comparison of trade marks**

45. It is clear from *Sabel* 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 *Bimbo* that:



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

46. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

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<sup>7</sup> Exhibit SF4

47. The competing trade marks are as follows:

The earlier mark	The contested mark
	

### Overall impressions

48. The earlier mark consists of the words 'bewell connect'. As noted above, the first element will be perceived as the words 'be well'. As they appear at the beginning of the mark, and are presented in bold, it is my view that these words are slightly more dominant in the overall impression of the mark. The word 'connect', whilst still contributing, plays a slightly lesser role in the overall impression. The font used is fairly standard and plays a minimal role in the overall impression.

49. The contested mark is in word-only format and consists of the words 'BE WELL WORLD'. Given they appear at the beginning of the mark, the words 'BE WELL' are slightly more dominant in its overall impression. The word 'WORLD' also contributes but plays a slightly lesser role.

### Visual comparison

50. The opponent has provided evidence which, it argues, demonstrates that the words 'be well' in the earlier mark will be perceived, visually, as a reference to a subsidiary of the opponent, rather than the words 'be well'.<sup>8</sup> However, I must undertake a notional assessment based upon the visual similarities/differences between the marks as applied-for and registered. Moreover, the opponent's use of its mark is not

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<sup>8</sup> Exhibit SF1; applicant's written submissions, §3

in issue in these proceedings. As such, I place no weight on whether the earlier mark is listed as a subsidiary of the opponent on its website in the following assessment.

51. The competing marks are visually similar in that they share the identical words ‘be well’/‘BE WELL’ at their respective beginnings, a position which is generally considered to have more impact.<sup>9</sup> These words are also slightly more dominant in the overall impression of the marks. The difference in letter case is not significant, since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.<sup>10</sup> Clearly, the competing marks visually differ in that the earlier mark contains the word ‘connect’, whereas the contested mark contains the word ‘WORLD’. However, I have found that these words play slightly lesser roles in the respective overall impressions. The earlier mark is also presented in a slightly stylised font, though this plays a minimal role in its overall impression. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

#### Aural comparison

52. The earlier mark consists of four syllables, i.e. “BE-WELL-CON-NECT”, whilst the contested mark comprises three syllables, i.e. “BE-WELL-WORLD”. The competing marks aurally coincide in their identical first two syllables and differ in their remaining syllables. Overall, I find that there is a medium degree of aural similarity between them.

#### Conceptual comparison

53. The words which comprise the competing marks are all ordinary, dictionary words. In relation to goods and services in the field of health and well-being, the words ‘be well’/‘BE WELL’ will be understood as a strongly allusive reference to characteristics of those goods and services, e.g. they enable you to remain healthy. As for goods and services which do not relate to health and well-being, the words will be perceived as a non-specific encouragement to be healthy or feel good; the message is less direct.

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<sup>9</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>10</sup> *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

The word 'connect' in the earlier mark will be understood as meaning link, bring together or associate. The word 'WORLD' in the contested mark will be understood as referring to the earth and all the people, places, and things on it. It is possible that the contested mark, as a whole, will be taken as an encouragement for the world to be healthy or feel good, or referring to a place for all your health or well-being needs. However, for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.<sup>11</sup> As these potential meanings are rather ambiguous and not entirely logical, the words 'BE WELL' and 'WORLD' do not combine to form a unit with a different meaning than the two elements taken separately. The competing marks conceptually overlap to the extent that they both convey the concept of being healthy. They differ in that they both convey a concept not replicated by the other, i.e. the meanings associated with the words 'connect' and 'WORLD'. Bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually similar to a medium degree.

### **Likelihood of confusion**

54. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

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<sup>11</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

exists between the marks and the services down to the responsible undertakings being the same or related.

56. Earlier in this decision, having proceeded on the basis that all the parties' health and well-being related goods and services are identical, I concluded that:

- There is a medium degree of similarity between the applicant's goods in class 9 and the opponent's services in classes 41 and 42;
- The parties' services in class 41 are either identical or similar to a medium degree;
- The parties' services in class 42 services are either identical or similar to at least a low degree;
- Relevant consumers of the goods and services are likely to include members of the general public, as well as businesses and professionals, the former demonstrating a medium level of attention and the latter demonstrating a higher than medium level of attention;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;
- The earlier mark possesses between a low and medium degree of inherent distinctive character where it relates to goods and services in the health and well-being fields, and a medium degree where it does not;
- The words 'be well' are slightly more dominant in the overall impression of the earlier mark, whilst the word 'connect' plays a slightly lesser role;
- The words 'BE WELL' are slightly more dominant in the overall impression of the contested mark, whilst the word 'WORLD' plays a slightly lesser role;

- There is a medium degree of visual, aural and conceptual similarity between the competing marks.

57. I note that the applicant has submitted that there are “numerous marks on the Register containing the string of words “BE WELL” in relation to goods and services in classes 9, 41,42 and 44”, and has provided a list of some examples.<sup>12</sup> The applicant has not explained what relevance these are to the present proceedings but, presumably, it is intended to be a point in its favour. However, the existence of these registrations will have no bearing on whether there is a likelihood of confusion. This is because there is no evidence that any of those marks are in use or that consumers have become accustomed to differentiating between them. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

58. I acknowledge that the competing marks share the words ‘be well’/‘BE WELL’; these words are slightly more dominant in the overall impressions of the marks and appear at their beginnings. Nevertheless, the earlier mark contains the word ‘connect’ and the contested mark contains the word ‘WORLD’; although these words play a slightly lesser role in the overall impressions of the marks, they are not negligible. In

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<sup>12</sup> Applicant’s written submissions, §5

my view, it is highly unlikely that these words, and the differences they create, will be overlooked by relevant consumers. I accept that these differing words appear at the end of the competing marks and the common element appears at their beginnings. However, the proposition that the beginnings of trade marks have more impact than their endings is a general rule that is not always decisive.<sup>13</sup> In this case, it is considered that the differing words ‘connect’ and ‘WORLD’ are likely to be sufficient for consumers – even paying no more than a medium level of attention – to distinguish between the competing marks and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to identical goods and services. For the avoidance of doubt, this finding applies irrespective of whether the goods and services relate to health and well-being. This is because, even where they do, the earlier mark possesses no more than a medium level of distinctive character; in the circumstances, I do not consider this to be sufficient to cause consumers to mistake or misremember the marks for one another.

59. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting 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.”

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<sup>13</sup> *CureVac GmbH v OHIM*, T-80/08

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).”

60. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>14</sup> I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>15</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>16</sup>

61. I will first consider circumstances wherein the words ‘be well’ in the earlier mark have no obvious association with the goods and services as this renders the earlier mark more distinctive. Having noticed the differences between the competing marks,

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<sup>14</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

<sup>15</sup> *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

<sup>16</sup> *Liverpool Gin Distillery*

I do not believe that consumers will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that consumers would assume a commercial association or licencing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared words 'be well'/'BE WELL'. Although this common element is moderately distinctive in respect of goods and services unrelated to the fields of health and well-being, it is not so strikingly distinctive that consumers would assume that only the opponent would be using it in a trade mark. Moreover, the differences between the competing marks are not simply adding or removing non-distinctive elements of the kind which consumers would expect to find in a sub-brand or brand extension. Whilst I have found that these elements play slightly lesser roles in the overall impressions, this was largely on the basis of their respective positions within the competing marks; the words 'connect' and 'WORLD' are not extremely unusual but do not lack distinctive character. In addition, the differences do not appear to be logical or consistent with a brand extension exercise; I can see no reason why an undertaking would remove the word 'connect' and replace it with the word 'WORLD'. I have acknowledged that the categories outlined in *L.A. Sugar* are not exhaustive. However, to my mind, there is no other basis for concluding that consumers – even those paying only a medium level of attention during the purchasing process – would assume an economic connection between the parties. The contested mark may bring the earlier mark to mind. However, as noted above, that is not sufficient. Taking all of this into account, I do not consider there to be a likelihood of indirect confusion, even in respect of identical goods and services.

62. As for circumstances wherein the words 'be well' have a direct meaning in relation to the fields of health and well-being, I find it even less likely that consumers will assume that the opponent and the applicant are economically linked undertakings. This is because, in addition to the reasons provided above, the common element is strongly allusive and, therefore, low in distinctive character. Accordingly, it is my view that consumers will attribute its common usage to mere coincidence, even in relation to identical goods and services. At best, the contested mark may bring the earlier mark to mind, which is not sufficient for a finding of indirect confusion.

## Conclusion

63. The opposition under section 5(2)(b) of the Act has failed.

## Costs

64. As the applicant has been successful, it is entitled to a contribution towards its costs. These proceedings were commenced after 1 July 2016 but before 1 February 2023, meaning that the appropriate scale is that published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£700**, which has been calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£200
Preparing evidence and written submissions	£500
<b>Total</b>	<b>£700</b>

65. I hereby order VISIOMED GROUP to pay Howden Broking Group Limited the sum of **£700**. 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 the proceedings if any appeal against this decision is unsuccessful.

**Dated this 3<sup>rd</sup> day of July 2023**

**James Hopkins**  
**For the Registrar**