

O/0652/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003731693
BY INFERVISION MEDICAL TECHNOLOGY CO., LTD
TO REGISTER**

InferCare

**AS A TRADE MARK IN CLASSES 9, 10, 35, 38, 42 AND 44
AND
THE OPPOSITION THERETO UNDER NO. 433963
BY INFERMEDICA SPOLKA Z OGRANICZONA ODPOWIEDZIALNOSCIA**

Background and pleadings

1. On 10 December 2021, Infervision Medical Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 04 March 2022. The goods and services for which registration is sought are as follows:

Class 9: *Data processing apparatus; Computer memory devices; Computer operating programs, recorded; Downloadable cloud-computing software; Diagnostic apparatus, not for medical purposes; Computer software, recorded; Downloadable computer programs; Electronic publications, downloadable; Computer software platforms, recorded or downloadable; Computer programs, recorded.*

Class 10: *X-ray diagnostic apparatus; Medical apparatus and instruments; Magnetic resonance imaging [MRI] apparatus for medical purposes; Suture materials; Bracelets for medical purposes; Surgical robots; Apparatus for use in medical analysis; Diagnostic apparatus for medical purposes; Surgical implants comprised of artificial materials; Body rehabilitation apparatus for medical purposes.*

Class 35: *Business management assistance; Business management consultancy; Compilation of information into computer databases; Systemization of information into computer databases; On-line advertising on a computer network; Data search in computer files for others; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Updating and maintenance of data in computer databases; Providing business information via a web site; Registration of written communications and data.*

Class 38: *Message sending; Transmission of telegrams; Computer aided transmission of messages and images; Rental of message sending apparatus; Providing internet chatrooms; Providing access to databases; Transmission of digital files; Providing online forums; Video-on-demand transmission; Transmission of podcasts.*

Class 42: *Technical research; Computer software design; Maintenance of computer software; Conversion of data or documents from physical to electronic media; Installation of computer software; Software as a service [SaaS]; Clinical trials; Computer technology consultancy; Software development in the framework of software publishing; Medical research.*

Class 44: *Medical clinic services; Health care; Medical assistance; Rental of sanitation facilities; Telemedicine services; Therapy services; Medical equipment rental; Alternative medicine services; Health counseling; Medical analysis services for diagnostic and treatment purposes provided by medical laboratories.*

2. On 31 May 2022, Infermedica spolka z ograniczona odpowiedzialnoscia (“the opponent”) opposed the application. The opposition is based on Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following trade mark:

UK registration number: UK00801437639¹

INFERMEDICA

Filing date: 13 August 2018

Registration date: 13 May 2019

Priority date: 17 April 2018; Priority country: Poland; TM from which priority claimed: Z.484938

Relying on all goods and services, namely:

Class 9: *Firmware; computer application software; computer software for data compression; computer software for transmission of data; computer software to enable searching of data; computer software for document management; computer software for wireless content delivery; interactive computer software which allows to exchange information; computer software which allows sharing of information through network communication; computer software for use as application programming interface (API); computer software for use in system supporting*

¹ The opponent’s mark is a comparable trade mark. It is based on the opponent’s earlier EUTM, being registration number 01437639. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

medical decision - making; software for searching and finding information through network; software based on artificial intelligence technology for use in providing IT solutions in the field of medicine and medical services; software for remote diagnostics; computer software capable to understand and analyze human questions and to formulate answers to these questions; computer software based on artificial intelligence for formulating conclusions based on available data; software based on artificial intelligence used for support decision making process for use in the field of medicine; computer program to support decision making process in the field of medicine, which is based on artificial intelligence.

Class 42: *Computer diagnosis services; design and development of data processing programs; computer software rental; design, installation, updating and rental of computer software in the field of medical solutions; design, installation, updating and rental of application programming interface (API) for use with information technology equipment in the field of medical solutions; computer software design; computer software installation; computer software updating; diagnosis of errors in the computer software; design and development of diagnostics apparatus; design of diagnostics devices and equipment; design and development of medical diagnostic apparatus; design, installation, updating and implementation of computer software capable to understand and analyze human questions and formulate answers to these questions.*

Class 44: *Performing diagnosis of disease; medical services for diagnosis of human body diseases; analysis of behavior for medical purposes; medical analysis for the diagnosis and treatment of persons; advisory regarding health; medical information; medical consultation; organizing of medical treatment; medical guidance; professional advice regarding health; professional advice regarding health protection; providing medical information; providing information concerning medicine; providing information related to medical services; medical analysis services related to patients treatment; consulting and information services in the field of health; medical treatment services; consulting services in the field of health; consulting services in the field of health care; consulting services related to medical services; medical information services provided through the Internet; information*

services in the field of health care; medical guidance services; telemedicine services; medical analysis services; medical information services; medical analysis services for diagnosis of neoplasms; medical screening.

3. The opponent claims that the dominant and distinctive element of its mark, namely the term 'infer' is wholly contained in the applicant's mark and that the term 'care' in the applicant's mark is merely descriptive of the goods and services for which protection is sought, meaning that the term 'infer' is also the dominant and distinctive element of the applicant's mark. The opponent claims that the marks are phonetically, visually and conceptually highly similar and that the goods and services are identical or similar, giving rise to a likelihood of confusion.

4. The mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the mark had not completed its registration process more than five years before the application date of the mark at issue, it is not subject to proof of use. Consequently, the opponent can rely upon the goods and services it has identified.

5. The applicant filed a defence and counterstatement, denying the claims made.

6. The opponent is represented by Beck Greener LLP and the applicant is represented by Bird & Bird LLP. Only the opponent filed evidence. I will not summarise the opponent's evidence here, but I will refer to it where necessary in my decision. No hearing was requested, but both parties filed written submissions in lieu of a hearing. I make this decision following a careful consideration of the papers.

THE EVIDENCE

7. The opponent's evidence consists of the witness statement of Kashif Syed dated 28 November 2022, accompanied by five exhibits (KS1 to KS5). Mr Syed is a UK Chartered Trade Mark Attorney employed by the opponent's firm of professional representatives, and gives evidence about the meaning of the word 'medica/medico'.

EU Law

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 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.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) of the Act is as follows:

“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”.

10. Section 5A of the Act is as follows:

“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.”

11. 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

12. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“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 complementary.”

13. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

(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. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

15. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that 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 or vice versa.

16. The goods and services to be compared are as follows:

The applicant's goods and services	The opponent's goods and services
<p>Class 9: <i>Data processing apparatus; Computer memory devices; Computer operating programs, recorded; Downloadable cloud-computing software; Diagnostic apparatus, not for medical purposes; Computer software, recorded; Downloadable computer programs; Electronic publications, downloadable; Computer software platforms, recorded or downloadable; Computer programs, recorded.</i></p>	<p>Class 9: <i>Firmware; computer application software; computer software for data compression; computer software for transmission of data; computer software to enable searching of data; computer software for document management; computer software for wireless content delivery; interactive computer software which allows to exchange information; computer software which allows sharing of information through network communication; computer software for use as application programming interface (API); computer software for use in system supporting medical decision - making; software for searching and finding information through network; software based on artificial intelligence technology for use in providing IT solutions in the field of medicine and medical services; software for remote diagnostics; computer software capable to understand and analyze human questions and to formulate answers to these questions; computer software based on artificial intelligence for formulating conclusions based on available data; software based on artificial intelligence used for support decision making process for use in the field of medicine; computer program to support decision making process in the</i></p>

	<i>field of medicine, which is based on artificial intelligence.</i>
Class 10: <i>X-ray diagnostic apparatus; Medical apparatus and instruments; Magnetic resonance imaging [MRI] apparatus for medical purposes; Suture materials; Bracelets for medical purposes; Surgical robots; Apparatus for use in medical analysis; Diagnostic apparatus for medical purposes; Surgical implants comprised of artificial materials; Body rehabilitation apparatus for medical purposes.</i>	
Class 35: <i>Business management assistance; Business management consultancy; Compilation of information into computer databases; Systemization of information into computer databases; On-line advertising on a computer network; Data search in computer files for others; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Updating and maintenance of data in computer databases; Providing business information via a web site; Registration of written communications and data.</i>	
Class 38: <i>Message sending; Transmission of telegrams; Computer aided transmission of messages and images; Rental of message sending apparatus; Providing internet chatrooms; Providing access to databases;</i>	

<p><i>Transmission of digital files; Providing online forums; Video-on-demand transmission; Transmission of podcasts.</i></p>	
<p>Class 42: <i>Technical research; Computer software design; Maintenance of computer software; Conversion of data or documents from physical to electronic media; Installation of computer software; Software as a service [SaaS]; Clinical trials; Computer technology consultancy; Software development in the framework of software publishing; Medical research.</i></p>	<p>Class 42: <i>Computer diagnosis services; design and development of data processing programs; computer software rental; design, installation, updating and rental of computer software in the field of medical solutions; design, installation, updating and rental of application programming interface (API) for use with information technology equipment in the field of medical solutions; computer software design; computer software installation; computer software updating; diagnosis of errors in the computer software; design and development of diagnostics apparatus; design of diagnostics devices and equipment; design and development of medical diagnostic apparatus; design, installation, updating and implementation of computer software capable to understand and analyze human questions and formulate answers to these questions.</i></p>
<p>Class 44: <i>Medical clinic services; Health care; Medical assistance; Rental of sanitation facilities; Telemedicine services; Therapy services; Medical equipment rental; Alternative medicine services; Health counseling; Medical analysis services for diagnostic and</i></p>	<p>Class 44: <i>Performing diagnosis of disease; medical services for diagnosis of human body diseases; analysis of behavior for medical purposes; medical analysis for the diagnosis and treatment of persons; advisory regarding health; medical information; medical</i></p>

<p><i>treatment purposes provided by medical laboratories.</i></p>	<p><i>consultation; organizing of medical treatment; medical guidance; professional advice regarding health; professional advice regarding health protection; providing medical information; providing information concerning medicine; providing information related to medical services; medical analysis services related to patients treatment; consulting and information services in the field of health; medical treatment services; consulting services in the field of health; consulting services in the field of health care; consulting services related to medical services; medical information services provided through the Internet; information services in the field of health care; medical guidance services; telemedicine services; medical analysis services; medical information services; medical analysis services for diagnosis of neoplasms; medical screening.</i></p>
--	---

17. In its submissions in lieu the applicant admits that there are some goods and services in the applied-for specification that are identical or similar to those covered by the opponent’s earlier mark. However, it also states that a large percentage of the applicant’s goods and services are dissimilar to those covered by the opponent’s mark. It states:

“The Applicant admits that there are some goods and services covered in the Application that are identical or similar to those covered by the Opponent’s Earlier Mark. However, the Applicant disagrees with the Opponent’s statement in its Opposition at paragraph 7 that: “The goods & services claimed in the

Application are either identical or similar to the goods & services protected by the Opponent's registration and asserted herein". There are clearly a large percentage of the goods and services applied for that are fundamentally different and dissimilar to those covered by the Opponent's Earlier Mark.

Relevant factors for assessing similarity were identified in the *Treat* case (*British Sugar Plc v James Roberston & Sons Ltd* [1996] R.P.C. 281) and the application of these factors demonstrates the lack of similarity between some of the Application Goods and Services, and the Opponent's Goods and Services as follows [...]"

18. Although the applicant did not specify which goods and services in the contested specification it concedes are similar to the opponent's goods and services, it then proceeded to list the goods and services that it considers to be dissimilar and concluded as follows:

"It is therefore submitted that the Opponent's argument that all of the respective goods and services are identical or similar is incorrect. As has been explained above, a high percentage of the goods and services covered in the Application are neither identical nor similar to those covered in the Opponent's Trade Mark".

19. I read the applicant's submissions in terms that the applicant lists the goods and services that it considers to be dissimilar in an *exhaustive* manner. It follows that where the applicant did not expressly claim that the goods and services are dissimilar, it conceded, admittedly by implication, that they are similar (and I will proceed on the basis that they are similar to, at least, a low degree). I will therefore limit my comparison to the goods and services in relation to which similarity is disputed.

Class 9

20. The only goods in Class 9 in relation to which the applicant disputes that there is a degree of similarity with the opponent's goods and services are *Electronic publications, downloadable*. The applicant states that these goods are not similar because the opponent's goods and services do not cover any terms relating to online

or electronic publications or any other related goods or services that would be considered to be similar. The applicant also argues that these goods are not in competition with, or complementary to, any of the opponent's goods and services, that they do not share trade channels, and that they have different users and uses.

21. The opponent's goods in Class 9 include various computer software and computer programmes. *Electronic publications, downloadable* in the applicant's specification are electronic versions of traditional media such as e-books, electronic journals, online magazines, online newspapers etc. It is common to distribute books, magazines and newspapers to consumers in the form of electronic publications through tablet reading devices by means of computer software applications which are covered by the opponent's *computer application software*. Consequently, there exists a complementary relationship between these goods. Furthermore, their distribution channels and consumers can be the same. Therefore, **I consider those goods to be similar to a low degree.**

Class 10

22. The applicant states that its goods in Class 10 are dissimilar to the opponent's goods and services, because the opponent's specification does not cover goods in Class 10 and the opponent's goods and services are not complementary or in competition with the applicant's goods, the physical nature and intended purpose of the respective goods and services are different, and they are not offered to the same relevant public.

23. The opponent's states that the applicant's goods in Class 10 are either identical or highly similar to its goods and services because they relate to the same medical field; for example, the earlier services in Class 44 would be performed by way of the applicant's goods in Class 10; thus, the goods and services are of the same or a similar nature and highly complementary.

24. The closest clash I can see here is between the applicant's medical apparatus and equipment in Class 10 and the opponent's *design of diagnostics devices and equipment; design and development of medical diagnostic apparatus* in Class 42,

insofar as a producer who manufactures the following medical goods of the applicant's Class 10 specification might also design and develop the goods:

X-ray diagnostic apparatus; Medical apparatus and instruments; Magnetic resonance imaging [MRI] apparatus for medical purposes; Surgical robots; Apparatus for use in medical analysis; Diagnostic apparatus for medical purposes; Body rehabilitation apparatus for medical purposes

25. The goods and services would therefore target the same users, for example, hospitals and healthcare clinics, share trade channels, and be complementary. **I consider these goods and services to be similar to a low degree.**

26. This leaves *Suture materials; Bracelets for medical purposes; Surgical implants comprised of artificial materials*. Although the nature and purpose of these goods are different from those of the opponent's medical services in Class 44, the goods and services are complementary since medical services generally use *Suture materials; Bracelets for medical purposes* and *Surgical implants comprised of artificial materials* when those services are offered. In *Emcur v EUIPO - Emcure Pharmaceutical*, case T-165/17, the GC found that the Board of Appeal erred in finding that there was no similarity between '*pharmaceutical products, veterinary products, preparations for healthcare, dietetic substances for medical purposes and food supplements*' in Class 5 and '*nasal douches*' in Class 10 and medical services in Class 44. It stated:

"In the third place, as regards the assessment made by the Board of Appeal that the goods and services at issue are not complementary, it should be noted that, as the applicant correctly argued, the goods in question may be the subject of the services in Class 44 covered by the mark applied for to the extent that those services are important, even indispensable, for the use of those goods. Similarly, administering pharmaceutical products is important, even indispensable, in providing the services in question. It follows that, if the pharmaceutical products under the name EMCUR were to be distributed in the context of services in Class 44 provided under the name EMCURE, the relevant public would be likely to believe that the same undertaking is responsible for manufacturing those goods and providing those services.

61. In light of the foregoing, and in so far as the pharmaceutical products covered by the earlier marks and the services in Class 44 covered by the mark applied for are aimed at the same public, pursue the same aim, can share the same distribution channels and are complementary, the Board of Appeal erred in finding that the services in Class 44 and the goods covered by the earlier German mark were not similar.

62. Such a finding is consistent with the case-law which accepted that 'pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, material for dental fillings and dental impressions' in Class 5 and 'medical and veterinary services' in Class 44 are similar (judgment of 26 March 2015, *Radecki v OHIM — Vamed (AKTIVAMED)*, T-551/13, not published, EU:T:2015:191, paragraph 35). Furthermore, it has previously been held that medical services in Class 44 are complementary to pharmaceutical products in Class 5 (judgment of 2 June 2010, *Procaps v OHIM — Biofarma (PROCAPS)*, T-35/09, not published, EU:T:2010:220, paragraphs 43 to 45). They are therefore connected to those goods by some degree of similarity (see judgment of 3 June 2015, *Pensa Pharma v OHIM — Ferring and Farmaceutisk Laboratorium Ferring (PENSA PHARMA and pensa)*, T-544/12 and T-546/12, not published, EU:T:2015:355, paragraph 134 and the case-law cited).

27. Whilst the GC referred to, *inter alia*, substances and preparations for medical use and material for dental fillings and dental impressions (in Class 5), the same considerations apply to the opponent's goods *Suture materials; Bracelets for medical purposes; Surgical implants comprised of artificial materials* (in Class 10), which are surgical and medical articles used in the provision of medical services in Class 44. **I consider these goods and services to be similar to a low degree.**

Class 35 and 38

28. The opponent states that the applicant's services in class 35 and 38 are highly similar to its goods and services as they have a similar nature and method of use,

target the same users and are either in competition or are complementary. These are very general statements, and it is not obvious to me how the services overlap. I therefore agree with the applicant that the competing services are dissimilar. As the applicant states, the contested services in Class 35 relate to business management services and advertising, which have nothing to do with the opponent's goods and services in Classes 9, 42 and 44. The same goes for the applicant's telecommunication services in Class 38. The services have a different nature and purpose, they do not share trade channels and are neither complementary nor in competition. **These services are dissimilar.**

29. Lastly, the applicant's specification in Class 35 includes the term *retail of pharmaceutical, veterinary and sanitary preparations and medical supplies* in relation to which I adopt the same reasons I have outlined in the previous paragraph in relation to *suture materials; bracelets for medical purposes; surgical implants comprised of artificial materials*. **I consider these services to be similar to a low degree.**

Class 42

30. The only services in Class 42 in relation to which the applicant disputes that there is a degree of similarity with the opponent's goods and services are *technical research; clinical trials; medical research*. The applicant argues that the opponent's goods and services do not cover any terms relating to research services or clinical trials, or any terms that would likely be considered similar. The applicant also states that these services are highly technical and specialised, that they are offered to and target different consumers to those relevant to the opponent's goods and services and would employ different trade channels.

31. The opponent states that the contested technical research and medical research have a highly similar nature and/or end users to those of the opponent's goods and services and are either in competition or are complementary.

32. The closest clash I can identify here is between the applicant's *technical research; clinical trials; medical research* in Class 42 and the opponent's *medical services for diagnosis of human body diseases* in Class 44, since the latter include scientific

laboratory services. To this extent, these services may be rendered by the same undertakings, for example, the NHS providing both the services, and for the same relevant public. I also note that the nature of the services will be shared to an extent, with the applicant's *technical research; clinical trials; medical research* involving overseeing the administration of medical care and treatment. The same qualified health professionals will likely be involved in the offering of both services. I note that the continued practice of medical services will be reliant on the continuation of new research and trials, and also that a large portion of research and trials may not be conducted without medical services being administered, so there is a degree of complementarity between the services involved. **Overall, I find these services to be similar to the opponent's services in Class 44 to a medium degree.**

Class 44

33. The only services in Class 44 in relation to which the applicant disputes that there is a degree of similarity with the opponent's goods and services are *rental of sanitation facilities; medicine equipment rental*. The applicant argues that there is no similarity between these services and any of the opponent's goods and services because these services relate to the rental of sanitation facilities and medical equipment, which is different from the opponent's goods and services that are offered to patients for health reasons. The applicant also states that the services would target businesses and professionals within the medical and healthcare industry and so the respective goods and services target different users and are neither complementary nor in competition.

34. The opponent's specification in Class 44 covers various medical services, including *medical services for diagnosis of human body diseases*. These opponent's services and the applicant's *rental of sanitation facilities; medicine equipment rental* have the same nature (medical services), purpose or intended use (treatment of human health problems), consumers (medical professionals and patients) and distribution channels (hospitals and clinics). Even though they are not, strictly speaking, medical services, *rental of sanitation facilities* and *medicine equipment rental* are inherent to the opponent's medical services, which are carried out by means of medical instruments and equipment that are hired or rented. In particular, the applicant's services are provided in the course of medical services, by the same

persons or establishments whose aim is to give medical care to patients so there is a degree of complementarity. Further, the users of *medicine equipment rental* might be not only healthcare professionals but also patients who may hire or rent medical instruments and equipment in the course of their medical treatment, such as heart monitoring systems, infusion pumps, ventilators, and so on. **I consider these services to be similar to a low degree.**

35. Overall, my findings are as follows:

- 1) I consider the applicant to have conceded that the following goods and services in the application are similar (to at least a low degree) to the opponent's goods and services:

Class 9: *Data processing apparatus; Computer memory devices; Computer operating programs, recorded; Downloadable cloud-computing software; Diagnostic apparatus, not for medical purposes; Computer software, recorded; Downloadable computer programs; Computer software platforms, recorded or downloadable; Computer programs, recorded.*

Class 42: *Computer software design; Maintenance of computer software; Conversion of data or documents from physical to electronic media; Installation of computer software; Software as a service [SaaS]; Computer technology consultancy; Software development in the framework of software publishing.*

Class 44: *Medical clinic services; Health care; Medical assistance; Telemedicine services; Therapy services; Alternative medicine services; Health counseling; Medical analysis services for diagnostic and treatment purposes provided by medical laboratories.*

- 2) Of the goods and services in relation to which the applicant denies any similarity, I found that the following are similar to various degrees to the opponent's goods and services:

Class 9: *Electronic publications, downloadable.*

Class 10: *X-ray diagnostic apparatus; Medical apparatus and instruments; Magnetic resonance imaging [MRI] apparatus for medical purposes; Suture materials; Bracelets for medical purposes; Surgical robots; Apparatus for use in medical analysis; Diagnostic apparatus for medical purposes; Surgical implants comprised of artificial materials; Body rehabilitation apparatus for medical purposes.*

Class 35: *Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies.*

Class 42: *technical research; clinical trials; medical research.*

Class 44: *rental of sanitation facilities; medicine equipment rental.*

- 3) Of the goods and services in relation to which the applicant denies any similarity, I found that the following are dissimilar to the opponent's goods and services

Class 35: *Business management assistance; Business management consultancy; Compilation of information into computer databases; Systemization of information into computer databases; On-line advertising on a computer network; Data search in computer files for others; Updating and maintenance of data in computer databases; Providing business information via a web site; Registration of written communications and data.*

Class 38: *Message sending; Transmission of telegrams; Computer aided transmission of messages and images; Rental of message sending apparatus; Providing internet chatrooms; Providing access to databases; Transmission of digital files; Providing online forums; Video-on-demand transmission; Transmission of podcasts.*

36. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

37. As some similarity of goods and services is essential for a claim under Section 5(2)(b) to succeed, the opposition fails in relation to the services which I have found to be dissimilar.

Average consumer

38. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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. (as he then was) 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.”

39. The average consumer of the parties' goods and services is either a hospital or a health clinic (Class 10 and Class 44), or a member of the general public or a business user (Class 9, 35 and 42), or a patient seeking to purchase medical healthcare

services (class 44). The goods and services are likely to be selected mainly visually from shops, healthcare clinics and hospitals, pharmacies, catalogues or websites or are likely to be purchased through a hospital procurement process. Hence, aural considerations, in the form of, for example, word of mouth recommendation and enquiries over the phone, may play a part. The level of attention is likely to range from medium (class 9 and 35) to high (class 10, 42 and 44) depending on the goods and services sought, as various factors will need to be taken into account, including, safety, reliability, cost and technical requirements.


Comparison of marks

40. 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.”

41. 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.

42. The respective marks are shown below:

The applicant's mark	The opponent's mark
	INFERMEDICA

Overall impression

The applicant's mark

43. The applicant's mark consists of a single word, 'InferCare' presented in grey with the first letter 'I' and the sixth letter 'C' in upper-case, and the remaining letters in lower-case, and the element 'Care' in a slightly thicker bold script.

44. The opponent states that the term "Infer" is the dominant and distinctive element of the applicant's mark because it is placed at the beginning of the mark, and it has no meaning in relation to the goods and services at issue.

45. The applicant states that the overall impression of its mark is *"of a stylised word mark where the word 'CARE' draws the eye of the consumer given its visual dominance through its bold font"*. I disagree. First, the word 'Care' is only slightly thicker than the word 'Infer', and this fact alone is not sufficient to offset the general principle that consumers tend to focus on the beginning of marks – which, in this case, is the word 'Infer'. Second, the word 'Care' is weakly distinctive because either it is directly descriptive in relation to some of the contested goods and services (those that are related to healthcare), or the terms in the contested specification notionally cover goods and services which might find application in healthcare and medical settings.

46. Taking into account the following: (a) the principle that when perceiving a verbal sign, the average consumer will break it down into elements that suggest a concrete meaning, or that resemble words that they already know,² (b) that although the mark

² T-256/04, *Respicur*, § 57; T-146/06, *Aturion*, § 58

is presented as a single word, the way the letters are presented creates a separation between the element 'Infer' and the element 'Care' and (c) that the words 'Infer' and 'Care' are words in their own right, the applicant's mark will be broken down into the two elements 'Infer' and 'Care'.

47. Although there is no mechanical test to determine the dominant element of a mark, consumers would be more likely to perceive a distinctive term, rather than an allusive or descriptive term, as the element identifying the commercial origin of the goods and services. Consequently, although the mark 'INFERCARE' will be perceived as a whole, my conclusion is that the word 'INFER' is more distinctive than the word 'CARE' because it is placed at the beginning of the mark and has no meaning in relation to the goods and services at issue. The stylisation of the letters is minimal and will play a lesser role.

The opponent's mark

48. The opponent's mark consists of the single word 'INFERMEDICA'. There are no other elements which contribute to the overall impression of the mark which lies in the word itself.

49. The opponent has filed evidence concerning the meaning of the words 'medica', 'medico' and 'materia medica' as well as print-outs of a Google search for 'medica clinic' with search results limited to the UK and up to 9 December 2021 (before the filing date of the application of 10 December 2021). The aim of this evidence is to show that the meaning of the word 'medica' is well-known in the UK and that there are numerous businesses using the word 'medica' in connection with their clinics and medical/healthcare practices, further showing that the word is well-known in the medical and healthcare industry, and it has widespread UK use in a medical context.

50. The applicant criticises the opponent's evidence because, it says, it refers to the meaning of the word 'medica' in Italian, Spanish and Portuguese, which the applicant states, should be disregarded, because the perception of the mark must be assessed from the perspective of the average consumer in the UK who speaks English.

51. I agree with the applicant that the opponent's evidence relating to the meaning of the word 'medica' in Italian, Spanish and Portuguese is not relevant. However, the opponent's evidence includes an extract from the Cambridge online dictionary showing the meaning of the word 'medico' in English as "a doctor" and an extract from the British Medical Journal referring to 'materia non-medica'. Whilst I also note that the term 'materia medica' is defined by the Cambridge online dictionary as having the meaning of "the branch of medical science concerned with the study of drugs used in the treatment of disease: includes pharmacology, clinical pharmacology, and the history and physical and chemical properties of drugs" in British English, I accept that the words 'medico' or 'materia medica' are not frequently used in the UK. Nevertheless, the word 'MEDICA' is very close to the word 'medical' which is an adjective commonly used in the UK as shown by the following dictionary definition and examples:

medical

Adjective

related to the treatment of illness and injuries

medical advice, medical books, a medical team, medical workers

Fewer examples

A person's medical records are confidential.

Without more food and medical supplies, these people will surely not survive.

The medical tests showed some variation in the baby's heart rate.

Recent advances in medical science mean that this illness can now be cured.

If symptoms persist seek medical attention.

52. Accordingly, whilst the word 'MEDICA' may not, of itself, exist in English dictionaries, I find that it will be understood as deriving from the word 'medical' and will be seen as having regard to the goods and services which are, in broad terms, medical in nature. It follows from this that the opponent's mark will be seen to combine the two elements 'INFER' and 'MEDICA', with the element 'INFER' contributing to the overall

impression to a greater extent due to its stronger inherent distinctive character and position at the beginning of the mark.

Visual and aural similarity

53. The earlier mark is the single word 'INFERMEDICA' in standard characters. The applicant's mark is the word 'INFERCARE' in slightly stylized letters. The term 'INFER', which is the shared element, is the dominant portion of the opponent's mark and is identical to the first and dominant portion of the applicant's mark. The marks are visually and aurally similar to a medium to high degree.

Conceptual similarity

54. The applicant states that conceptually, the words 'INFERMEDICA' and 'INFERCARE' do not possess any particular ordinary meaning; therefore, the conceptual comparison is neutral.

55. I have already concluded that the marks will be broken down into their constituting elements, namely, the words 'INFER' and 'CARE' in the applicant's mark and 'INFER' and 'MEDICA' in the opponent's mark. The word 'INFER' is a dictionary word meaning *"to form an opinion or guess that something is true because of the information that you have"* and will have the same meaning in both marks. The word 'CARE' in the applicant's mark will be understood as referring to the nature of the goods and services, which relate to healthcare. Likewise, the word 'MEDICA' in the opponent's mark will be understood as referring to a similar concept, namely the medical nature of the goods and services. The marks are conceptually similar to a high degree.

Distinctive character of earlier mark

56. In *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).”

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

58. The opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, therefore I only have the inherent distinctiveness of the mark to consider. The earlier mark consists of the word ‘INFERMEDICA’. Whilst the word ‘MEDICA’ will be understood as referring to the medical nature of the goods and services, the word ‘INFER’ is neither descriptive nor allusive, and the mark as a whole is distinctive to a medium degree.

Likelihood of confusion

59. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

60. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

61. For procedural economy, I have taken the approach that some of the goods and services at issue are similar to, at least, a low degree, whilst I found other goods and services to be similar to a medium degree. The goods and services will be selected mainly visually, although aural considerations may play a part. The degree of attention will range from medium to high.

62. In my view, this is a case where even considering the best case scenario for the applicant of a low degree of similarity between the goods and services and a high degree of attention, it can still be safely concluded that the marks are sufficiently close to cause confusion, given the medium to high degree of visual and aural similarity, the high degree of conceptual similarity, and the medium degree of distinctiveness of the earlier mark. Accordingly, because (a) the marks share the dominant, distinctive and identical term ‘INFER’ followed by a word which refers to the healthcare and medical nature of the goods and services concerned, and (b) this creates marks with a common distinctive element and very similar structures and (c) the goods and services are related, as they belong to the medical field (or the specifications notionally cover goods and services that might find application in the medical field), it is likely that the average consumer will be directly confused, mistaking one mark for the other or, alternatively,

will assume that the applicant's mark is a brand extension of the opponent's mark (falling squarely under the example provided at paragraph 17 (b) of *L.A. Sugar*).

63. There is a likelihood of confusion in relation to the goods and services which I found to be similar.

Conclusion

64. The opposition is partially successful. It succeeds in relation to the following goods and services. Subject to any appeal, the application will be refused for the following goods and services:

Class 9: *Data processing apparatus; Computer memory devices; Computer operating programs, recorded; Downloadable cloud-computing software; Diagnostic apparatus, not for medical purposes; Computer software, recorded; Downloadable computer programs; Electronic publications, downloadable; Computer software platforms, recorded or downloadable; Computer programs, recorded.*

Class 10: *X-ray diagnostic apparatus; Medical apparatus and instruments; Magnetic resonance imaging [MRI] apparatus for medical purposes; Suture materials; Bracelets for medical purposes; Surgical robots; Apparatus for use in medical analysis; Diagnostic apparatus for medical purposes; Surgical implants comprised of artificial materials; Body rehabilitation apparatus for medical purposes.*

Class 35: *Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies.*

Class 42: *Technical research; Computer software design; Maintenance of computer software; Conversion of data or documents from physical to electronic media; Installation of computer software; Software as a service [SaaS]; Clinical trials; Computer technology consultancy; Software development in the framework of software publishing; Medical research.*

Class 44: *Medical clinic services; Health care; Medical assistance; Rental of sanitation facilities; Telemedicine services; Therapy services; Medical equipment rental; Alternative medicine services; Health counseling; Medical analysis services for diagnostic and treatment purposes provided by medical laboratories.*

65. The opposition fails in relation to the following services. Subject to any appeal, the application will proceed to registration for the following services:

Class 35: *Business management assistance; Business management consultancy; Compilation of information into computer databases; Systemization of information into computer databases; On-line advertising on a computer network; Data search in computer files for others; Updating and maintenance of data in computer databases; Providing business information via a web site; Registration of written communications and data.*

Class 38: *Message sending; Transmission of telegrams; Computer aided transmission of messages and images; Rental of message sending apparatus; Providing internet chatrooms; Providing access to databases; Transmission of digital files; Providing online forums; Video-on-demand transmission; Transmission of podcasts.*

COSTS

66. As the opponent has enjoyed the greater degree of success, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, to reflect the degree of the applicant's success in defending part of the claim against it, I have reduced the costs award by 25%.

67. I award the opponent the sum of **£850** as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the
applicant's counterstatement:

£ 300

Filing of evidence:	£400
Submissions in lieu:	£300
Total:	£1,000
<i>Reduction of 25%</i>	<i>-£250</i>
Official fee (not subject to reduction)	£100
Total:	£850

68. I therefore order Infervision Medical Technology Co., Ltd to pay Infermedica spolka z ograniczona odpowiedzialnoscia the sum of £850. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 11 day of July 2023

Teresa Perks
For the Registrar