BL O/0909/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3784435
BY NEWCROSS NURSING GROUP LTD
TO REGISTER THE SERIES OF TRADE MARKS:

Snap Nurse

SnapNurse

(SERIES OF 2)

IN CLASSES 35 & 44

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 437153
BY SNAP LIFE LIMITED

Background and pleadings

1. On 5 May 2022, NEWCROSS NURSING GROUP LTD ("the applicant") applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 July 2022. Registration is sought for the following services:

> Class 35: Employment agency services.
>
> Class 44: Provision of health care services in domestic homes; Home-visit nursing care; Nursing home services; Hospital nursing home services.

2. The application was opposed by Snap Life Limited ("the opponent") on 27 October 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") against all of the services applied for.

3. The opponent relies on the following trade mark:

UK3424399

SNAP

Filing date: 28 August 2019
Registration date: 27 December 2019

Relying upon the following services:

> Class 44: Healthcare consultancy services; professional consultancy relating to health; health advice and information services; advisory services relating to health; advice relating to osteoporosis; provision of medical and healthcare information and advice; providing medical information in the healthcare sector; healthcare information services; healthcare services; collation of information in

the healthcare sector; consultancy services relating to healthcare information; all the aforesaid used for or in relation to the provision of advice, education and information related to osteoporosis.

Class 45: Providing online personal support for individuals relating to healthcare; providing personal and emotional support to osteoporosis patients and their families; all the aforesaid used for or in relation to the provision of advice, education and information related to osteoporosis.

4. The opponent claims that the marks are highly similar as they all consist of the word 'SNAP'. It argues that its own mark is reproduced entirely within the applicant mark and that the addition of the word 'NURSE' does not change the overall effect as it is descriptive of the class 44 services. The opponent further states that the applicant's services are identical or similar to their own.

5. The applicant filed a counterstatement where they accept there is an overlap of the class 44 'Healthcare Services' but denies all other claims.

6. The applicant is unrepresented and the opponent is represented by Veale Wasbrough Vizards LLP.

7. The opponent filed evidence in chief. Neither party requested a hearing nor filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

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 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.

Evidence

9. The opponent's evidence consists of a witness statement by Catherine Louise Shaw, who is the sole director of the opponent company, together with eighteen accompanying exhibits.

10. I have read all of the evidence which is mainly in regard to osteoporosis and undertakings who provide assistance and care in relation to this, and I consider that it is of limited assistance to the opponent's case. The comparisons I must undertake in this decision are based on the application and registration as they appear on the papers. The operations of third party organisations do not hold any weight here as they have different marks and different registrations.

DECISION

11. Section 5(2)(b) is being relied upon and is 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".

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6. (1) In this Act an "earlier trade mark" means -
>
> > (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

13. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Case law

14. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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

15. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 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.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

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

18. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

Applicant's services	**Opponent's services**
Class 35: Employment agency services.	
Class 44: Provision of health care services in domestic homes; Home-visit nursing care; Nursing home services; Hospital nursing home services.	Class 44: Healthcare consultancy services; professional consultancy relating to health; health advice and information services; advisory services relating to health; advice relating to osteoporosis; provision of medical and healthcare information and advice; providing medical information in the healthcare sector; healthcare information services; healthcare services; collation of information in the healthcare sector; consultancy services relating to healthcare information; all the aforesaid used for or in relation to the

	provision of advice, education and information related to osteoporosis.
	Class 45: Providing online personal support for individuals relating to healthcare; providing personal and emotional support to osteoporosis patients and their families; all the aforesaid used for or in relation to the provision of advice, education and information related to osteoporosis.

Class 35

19. The opponent has stated within their statement of grounds that "the application's class 35 employment agency services clearly related to nursing/healthcare recruitment/staffing and are therefore complementary to the Registration's class 44 healthcare services.' However, there is no such limitation or stipulation within the application. I must consider 'employment agency services' as a whole.

20. I consider that the opponent's services are healthcare related and provided by healthcare professionals. The applicant's 'employment agency services' are organisations which match employees to employers, and therefore, the nature of the services are different. Although it is possible that the opponent's services could relate to healthcare, this is not sufficient to consider there to be an overlap in use or user. The trade channels will also differ, and they do not share a purpose- one is to provide employees and one is to provide healthcare to those who need it. They are also not in competition.

21. I understand the opponent has argued that these services are complementary. For there to be complementarity, two things must happen: firstly, there should be a close connection between the services so they are indispensable or important for the use of

the other and secondly, consumers must think that the responsibility of both lies with the same undertaking.[1] Even if it were to be argued that employment agency services are indispensable for the provision of health care services (which I do not believe they are), the average consumer would not believe that the responsibility would lie with the same undertaking for both services. Therefore, I do not find there to be complementarity between them and subsequently find these services to be dissimilar.

Class 44

22. I consider that 'healthcare services' in the opponent's specification is a very wide term which would cover all of the services found in the applicant's class 44 specification. I therefore consider them to be identical using the *Meric* principles.

23. 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."

24. I have found no similarity in respect of the class 35 services from the applicant's specification and therefore, the opposition relating to them fails at this stage. I will continue the opposition in relation to the applicant's class 44 services only.

Average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion,

[1] *Boston Scientific Ltd v OHIM,* Case T-325/06

it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

26. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

27. I find that the services at issue are all medical and would relate to the user's health. Therefore, the average consumer can be said to be paying a higher than medium degree of attention during the selection process. I consider that for these services, the consumer is most likely to be a member of the public, however, I also do not discount that a medical professional could be looking for such services on behalf of a patient.

28. The selection process is likely to predominantly involve a visual aspect such as perusing a specialist website or application. There may also be advertisements or presentations of the services that the consumer will be exposed to as well as being able to visit providers such as care homes or clinics. I do not however, discount that there may also be an aural component through word-of-mouth recommendations or orders which may be placed by telephone.

Comparison of the marks

29. 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."

30. 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.

31. The parties respective marks are shown below:

Contested marks	**Earlier mark**
Snap Nurse SnapNurse	SNAP

32. The earlier mark is a word mark consisting of the word SNAP, and therefore, the overall impression lies in that word.

33. The contested marks are two words Snap and Nurse- one with a space between them and one where they are conjoined. The opponent argues that the word 'NURSE' is descriptive and as I will come to discuss in the conceptual comparison, I agree for the applicant's services it will be descriptive or, at the very least, it will be allusive. Therefore, I consider that 'SNAP' will be the more dominant and distinctive part of the mark, with the word NURSE playing a lesser role.

34. Visually, the earlier mark simply comprises of one word which is four letters. The word is found identically at the beginning of the contested marks. The contested marks contain a further word (either with a space between them or conjoined) which is not replicated in the earlier mark. However, in *El Corte Inglés, SA v OHIM,* Cases T-183/02 and T-184/02, the General Court noted that the beginnings of marks tend to have more impact than the ends. Therefore I consider the marks to be visually similar to a medium degree.

35. Next, I turn to the aural comparison of the marks. The earlier mark will be given its ordinary everyday pronunciation of the word which is one syllable. The contested marks will be two syllables, the first syllable will have identical pronunciation to the earlier mark with the addition of 'NURSE' (also given its ordinary pronunciation) immediately thereafter. I therefore find the marks to be aurally similar to a medium degree.

36. Conceptually, I believe the earlier mark will be assigned one of its ordinary dictionary definitions such as a sharp noise or something breaking. The contested marks will be viewed as two words which both have dictionary definitions. For the word 'SNAP' the same meaning will be assigned as that of the opponent's mark. A nurse is a medical professional and therefore, the word can be said to be descriptive or allusive of the services in question as they will be undertaken by a medical professional such as a nurse. Indeed, the applicant has 'nursing homes services' in their specification as an example. I therefore find the marks to be conceptually similar to at least a medium (but not the highest) degree.

Distinctive Character of the Earlier Marks

37. 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 WindsurfingChiemsee 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)."

38. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up 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. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier registration and therefore I must rely on its inherent distinctiveness.

39. The earlier registration is comprised of an ordinary dictionary word. The mark is not descriptive or allusive of the services registered by the opponent. However, it is not an invented word which would usually attract the highest degree of distinctive character. Therefore, I find the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

40. 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 exists between the marks and the services down to the responsible undertakings being the same or related. 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 trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the 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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

41. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's mark consists of the word SNAP. I consider that the overall impression lies in the word itself.
- The applicant's marks consist of the words SNAP and NURSE which is either conjoined or separated by a space. I consider that the word SNAP is the more dominant and distinctive element.
- I have found the marks to be visually and aurally similar a medium degree and conceptually similar to at least a medium (but not the highest) degree.

• I have found the opponent's mark to be inherently distinctive to a medium degree.
• I have identified the average consumer to mostly likely be the general public seeking health care related services although they could also be medical professionals, all of whom will select the services primarily by visual means, although I do not discount an aural component.
• I have concluded that a higher than normal degree of attention will be paid during the purchasing process.
• I have found the parties' services to be identical.

42. Taking all of the above into account, I consider that as the word 'Nurse' in the applicant's marks is descriptive or allusive of the services provided, then this will easily be overlooked by consumers, particularly as they rarely have the opportunity to make direct comparisons between trade marks. The beginning element of the contested mark 'SNAP' is identical to the opponent's mark, as are the remaining services at issue. Therefore, even though the average consumer might be paying higher than a medium degree of attention, there is a likelihood of direct confusion between the marks.

43. In the event that I am wrong in finding there to be a likelihood of direct confusion, I will now go on to consider whether there could be indirect confusion. Mr Iain Purvis Q.C. said further in *L.A. Sugar Limited v Back Beat Inc*:

> "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).”

44. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

> “This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be and exhaustive definition.”[2]

45. In the case of indirect confusion, the average consumer has noticed the differences between the marks but still believes them to be linked. The difference that the average consumer might notice is the additional word ‘NURSE’. As previously mentioned, I have found this element to be descriptive/allusive and not as distinctive as the ‘SNAP’ element. The average consumer, seeing that the extraneous matter in the mark as being of lower distinctiveness and descriptive or allusive will likely see the contested marks as an updated version of the earlier mark. Therefore, I find that indirect confusion is likely to occur.

Conclusion

46. The opposition fails in respect of the applicant’s class 35 services.

47. The opposition is successful and the application is refused for the class 44 services.

[2] Paragraph 12

Costs

48. The guidance for awards of costs are set out in TPN 2/2016.

49. On reviewing the matters at hand, I consider that both parties have had some level of success and some failure. It is my view that on this occasion, the fairest basis to deal with costs is for each party to bear their own in this matter.

50. I therefore make no award of costs in this matter.

Dated this 25th day of September 2023

L Nicholas
For the Registrar