

**O-366-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3209059  
IN THE NAME OF AJ MOBILITY LTD  
IN RESPECT OF THE TRADE MARK:**



**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 501726 BY UNIVERSITY HOSPITALS BIRMINGHAM NHS  
FOUNDATION TRUST**

## Background and pleadings

1. The trade mark shown on the cover page of this decision stands registered in the name of AJ Mobility Ltd (“the proprietor”). It was applied for on 27 January 2017 and entered in the register on 21 April 2017. It is registered in class 44 for the services shown in paragraph 9 below.

2. On 17 July 2017, University Hospitals Birmingham NHS Foundation Trust (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if–

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes–

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“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.”

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, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

3. The applicant relies upon the services (shown in paragraph 9 below), in the following United Kingdom trade mark registration:

No. 2625784 for the trade mark **myhealth** which was applied for on 25 June 2012 and entered in the register on 9 November 2012.

4. The trade mark shown above qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years when the application for invalidation was filed, it is not subject to proof of use, as per section 47(2)(2A) of the Act. Consequently, the applicant is entitled to rely upon it in relation to the services claimed without having to establish genuine use; I shall return to this point below.

5. The applicant states:

“[The proprietor’s trade mark]...consists of the conjoined neologism myhealth, together with a heart device and the words Mobility & Independence Centre. The dominant and distinctive element of the mark in suit is the neologism myhealth. That is represented in much greater size characters to the words Mobility & Independence Centre. Furthermore, the words Mobility & Independence Centre are, we submit, non-distinctive in relation to the registered services. The heart device forms some role in the visual impression created by the mark, but would not be referred to orally or conceptually and merely reinforces the main mark myhealth. That element is identical to the [applicant’s trade mark]. The marks are therefore confusingly similar.

The class 44 services are all medical and healthcare services. These are identical to medical and healthcare services covered by the applicant’s registered mark.”

6. The proprietor filed a counterstatement in which the basis of the application is denied. It contains a number of submissions which I will return to later in this decision.

7. In these proceedings, the applicant is represented by Kilburn & Strode LLP; the proprietor represents itself. Although neither party filed evidence, the applicant filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

## DECISION

### Section 5(2)(b) – case law

8. The following principles are gleaned from the decisions of the courts of the European Union 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.

#### The principles:

(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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

9. The competing services are as follows:

<b>Applicant's services</b>	<b>Proprietor's services</b>
Medical services; health care services; health advice and information services; maintaining personal medical history	Health care relating to homeopathy; Health clinic services [medical]; Advisory services relating to health; Health care

records and files; provision of medical information; hygienic and beauty care for human beings or animals; dentistry services; medical analysis for the diagnosis and treatment of persons; pharmacy advice.	relating to remedial exercise; Consulting services relating to health care; Consultancy relating to health care; Managed health care services; Exercise facilities for health rehabilitation purposes (Provision of -);Advice relating to the personal welfare of elderly people [health];Medical health assessment services; Health risk assessment surveys; Medical and healthcare services; Medical and healthcare clinics; Health assessment surveys; Health care; Health-care; Human healthcare services.
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10. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union (“CJEU”) stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

11. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated:

“78....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale.

In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

12. In its counterstatement, the proprietor provides a detailed explanation of the actual services it provides. However, as I explained earlier, the applicant’s trade mark is not subject to the proof of use provisions. In those circumstances, what I must do is compare the competing specifications on the basis of fair and notional use i.e. by comparing the words as they appear in the competing specifications.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

14. The applicant’s specification includes the terms “Medical services”, “health care services” and “health advice and information services” which are either literally identical or broad enough to include all the services in the proprietor’s trade mark and, as a consequence, are to be regarded as identical on the principle outlined in *Meric*.

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

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

16. The average consumer of the services is, as the proprietor’s submissions suggest, either a professional user or member of the general public. As to how such services will be selected, the proprietor’s submissions contains references to “our three established retail shops...and our internet shopping facility...”. That suggests that visual considerations will be an important part of the selection process. Aural considerations in the form of, for example, word of mouth recommendations from one professional user or member of the general public to another must also be taken into account. Given the nature of the services at issue, the need to ensure the appropriate treatment is selected and the likely impact on the quality of life of the individual receiving the treatment, suggests both sets of consumers will exercise a fairly high degree of attention when selecting the services at issue.

## **Comparison of trade marks**

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

18. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The comparison is between:

Applicant’s trade mark	Proprietor’s trade mark
myhealth	

19. In its counterstatement, the proprietor states:

“The applicant’s registered trade mark “myheath”...is not being used, and we note the trade mark in use by the applicant is, in fact, “myhealth@QHEB” and “myhealth@QEHB unlocking your health records”, neither of which are registered.”

20. For the reasons I have already explained in relation to the comparison of services (i.e. the applicant’s registration not being subject to the proof of use provisions), it matters not that the applicant has not, it appears, used the trade mark upon which it relies in these proceedings. Once again what I must do is compare the

applicant's trade mark in the form in which it stands registered with the proprietor's trade mark.

21. The applicant's trade mark consists of the conjoined words "my" and "health" presented in lower case. Although consisting of two separate words, as both words will be very well-known to the average consumer, I have no doubt that is how they will interpret the applicant's trade mark. It is the combination of these words which conveys the overall impression and in which the distinctiveness of the applicant's trade mark lies.

22. The proprietor's trade mark consists of a number of components. In its counterstatement, it analyses its trade mark in the following terms:

- The words "My" and "Health" are not co-joined as in the applicant's trade mark, and therefore are normal words in the English language, whereas the applicant has asserted their mark is a neologism (i.e. a new word)."
- It's "My Health" mark in the registered text and logo, in addition to the space between, are capitalised conforming to the normal principles of English grammar, and fundamentally different to the applicant's all lowercase [trade mark]."
- It's trade mark "includes the words "Mobility & Independence Centre" which further distances from the applicant's mark as it is highly distinctive, and descriptive of the context in which it is used and the services provided. Despite being in a smaller font, it is still clearly legible."
- "The heart symbol within [its] logo has no bearing on the applicant's mark as they have no graphics or symbols to compare."
- It's "My Health" logo uses two different fonts; a unique graphic font for "My" and a plain font for "Health" which is highly distinctive and emphasises the separation between the two words."

- “The positioning of “My” and “Health” within the logo has been achieved without the same base line as seen in the applicant’s, i.e. the “My” is set at an angle of 30 degrees, and “Health” is horizontal i.e. zero degrees, giving a further distinctive and unique appearance and visual separation of the two words.”

23. The first component consists of the words “My” and “Health” presented in title case in the colour dark blue. The word “My” (underlined in dark blue) is, as the proprietor submits, presented at an angle; the degree of stylisation present in this word is, however, unremarkable. The words are much larger than the words which appear below them and the combination of these words makes an important contribution to the overall impression conveyed by the trade mark and its distinctive character. The second component, appears below these words and consists of the words “Mobility & Independence Centre” presented in title case in a bold font. In addition to the comment reproduced above i.e. that these words are:

“highly distinctive, and descriptive of the context in which it is used and the services provided”,

in its counterstatement, the proprietor further states:

“The use of the word “Centres” within our trade mark, reflects the premises locations where we provide these health services and equipment.”

24. These comments from the proprietor confirms how it expects the average consumer to understand these words i.e. as indicating a place where one can learn to regain their mobility and independence. Although the combination of these words will contribute to the overall impression conveyed, considered in the context of the proprietor’s own submissions, that contribution will be a descriptive one.

25. That leaves the device component to consider. This is presented in light blue, with three horizontal lines presented in white and blue radiating from the left hand side of the device. Although partially obscured by the word “My”, the device will contribute to the overall impression conveyed. However, as the device of a heart is,

in my experience, commonplace in the context of the provision of health related services, even the addition of the horizontal lines and colour, do little to imbue it with any more than the most modest level of distinctive character.

26. Overall, I consider the words “My Health” to be the dominant and most distinctive component in the proprietor’s trade mark and to play an independent and distinctive role in its trade mark.

27. The competing trade marks either consist of, or contain, the words “myhealth” or “My Health” as the only or dominant element. Although the device component and words “Mobility & Independence Centre” in the proprietor’s trade mark will contribute to the overall impression conveyed, the competing trade marks are still, in my view, visually similar to an above average degree.

28. Insofar as the aural comparison is concerned, the applicant’s trade mark will be referred to by the two syllable combination of which it consists. Turning to the proprietor’s trade mark, it is well established that when a trade mark consists of a combination of words and figurative elements, it is by the words that the trade mark is most likely to be referred i.e. the device of a heart in the proprietor’s trade mark will not be articulated. As the words “Mobility & Independence Centre” in the proprietor’s trade marks are descriptive, they too are, in my view, most unlikely to be articulated. Considered on that basis, the competing trade marks are aurally identical. However, even if that is considered to be incorrect and all of the words in the proprietor’s trade mark are articulated, as the words “My Health” would be spoken first, the competing trade marks are still to be regarded as aurally similar to a fairly high degree.

29. Finally, the conceptual comparison. The words “myhealth”/“My Health” may, for example, evoke the concept of an individual taking responsibility for managing their own health. Irrespective of what precise concept is evoked, the concept conveyed by these words in the competing trade marks will be the same. As the other components in the proprietor’s trade mark evoke analogous concepts of health and well-being and the location where the proprietor services are provided i.e. “Centre”, the competing trade marks are conceptually highly similar,

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

30. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

31. As the applicant has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. While the applicant's trade mark alludes to the type of concepts mentioned in paragraph 29, it does not consist of a description of such services. Considered on that basis, it is, in my view, a trade mark which, absent use, is possessed of a below average degree of inherent distinctive character.

### **Likelihood of confusion**

32. In determining whether there is a likelihood of confusion, 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the applicant's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and 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 he has retained in his mind.

33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

34. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the

components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

35. Earlier in this decision, I concluded that the competing services are identical and the average consumer is either a professional user or member of the general public who is likely to select the services at issue by a mixture of visual and aural considerations, paying a fairly high degree of attention during that process. Having assessed the competing trade marks and concluded the words “My Health” were dominant and played an independent and distinctive role in the proprietor’s trade mark, I found the competing trade marks to be visually similar to an above average degree, aurally similar to at least a fairly high degree (and more likely aurally identical) and conceptually highly similar. Finally, I concluded that absent use, the applicant’s trade mark is possessed of a below average degree of inherent distinctive character.

36. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers

would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

37. As the above case makes clear, the fact that the applicant’s trade mark only possesses a weak distinctive character does not preclude a likelihood of confusion.

38. The various differences between the competing trade marks combined with the fact that the average consumer will pay a fairly high degree of attention during the selection process (making them less prone to the effects of imperfect recollection), points away from direct confusion. 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 Q.C., as the Appointed Person, explained:

“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.”

39. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

40. Although I have found there will be no direct confusion, I am, however, satisfied that even for an average consumer paying a fairly high degree of attention when selecting the services, the identity in those services combined with the degree of visual, aural and conceptual similarity between the competing trade marks will result in a likelihood of indirect confusion. The fact that the words “My Health” constitute the dominant component of, and play an independent and distinctive role in the proprietor’s trade mark, is, given the other components of which its trade mark is composed, likely, in my view, to lead an average consumer to assume its trade mark is, for example, a variant or updated trade mark used by the applicant or by an undertaking economically linked to the applicant.

### **Overall conclusion**

**41. The application has succeeded and, subject to any successful appeal, the proprietor’s trade mark will be declared invalid and, under the provisions of section 47(6) of the Act, deemed never to have been made.**

### **Costs**

42. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. In its Form TM26(I) filed on 17 July 2017, the applicant indicated that it notified the proprietor of its intention to seek invalidation of its trade mark on 5 June 2017. The Form TM26(I) contains the following warning:

“Starting invalidation proceedings without giving the registered holder or the registered owner a reasonable opportunity to surrender the registration may result, (if the application for invalidation is undefended), in a successful applicant not being awarded costs.”

43. In its counterstatement, the proprietor stated:

“AJ Mobility Ltd did not receive any communication concerning the Invalidation Notice as stated on Section 8 of TM26(I). As a consequence, we understand that AJ Mobility Ltd will not incur any costs from the applicant resulting from a successful cancellation.”

44. Even if the applicant had not notified the proprietor of its intention to invalidate its trade mark prior to filing its application (which it indicates it did), the fact that the proprietor elected to defend rather than surrender its registration, means that the warning which appears in the Form TM26(I) does not apply and the applicant is, as a consequence, entitled to an award of costs in its favour. That being the case, and applying the guidance in the TPN, I award costs to the applicant on the following basis:

Preparing the application and reviewing the counterstatement:	£200
Written submissions:	£200
Official fee:	£200
<b>Total:</b>	<b>£600</b>

45. I order AJ Mobility Ltd to pay to University Hospitals Birmingham NHS Foundation Trust the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18<sup>th</sup> day of June 2018**

**C J BOWEN**

**For the Registrar**

**The Comptroller-General**