

O-374-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2544349
BY TUNSTALL HEALTHCARE GROUP LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASSES 9 & 44

AND:

**OPPOSITION THERETO UNDER NO. 103439
BY ANDREW AZZOPARDI**

BACKGROUND

1. On 9 April 2010, Tunstall Healthcare Group Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 9 March 2012 for a range of goods and services in classes 9 and 44.

2. On 8 June 2012, Mr Andrew Azzopardi filed a notice of opposition. The opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the services in class 44 of the application i.e.

Healthcare support and information services; services for the receipt of information and data relating to the healthcare and medical requirements of individuals and more than one person and subsequent transfer of such information and data to appropriate parties for relevant action; obtaining information and data for the purpose of determining and designing the residential requirements of individuals or more than one person in connection with their healthcare; medical and healthcare services, namely the transfer of information and data to appropriate parties for relevant designing and/or adaptation of residences for the benefit of healthcare; determining and designing residential requirements of individuals or more than one person in connection with their healthcare; medicine management; medical and healthcare services, namely, provision of medication and/or healthcare aids; gathering, sorting, filtering and organising healthcare information; analysis and assessment of healthcare data; assessing healthcare needs and the organisation of a priority order for the treatment of more than one patient; advisory and information services relating to medical and healthcare services, requirements, products, apparatus, instruments and preparations; compilation of medical reports; location of medical facilities for emergency and medical treatment; medical analysis services; medical information retrieval services; preparation of reports relating to medical matters; provision of information relating to medical specialists and practitioners; advisory, consultancy and information services relating to the aforesaid services; information services relating to the diagnosis and treatment of medical conditions and/or needs

Mr Azzopardi relies upon the following trade mark registration in respect of the following services:

UK TM no. 2536260 for the trade mark: **My L.I.F.E** applied for on 13 January 2010 and which completed its registration procedure on 30 April 2010:

Residential care, day care, nursing care, respite care; convalescent homes; nursing homes; care homes; rest homes; provision of health care and day care services in domestic homes; nursing home services; convalescent home services; care home services; provision of health care services; arranging of

accommodation in rest, nursing, care and convalescent homes; advisory, consultancy and information services relating to the above.

3. On 22 August 2012, the applicant filed a counterstatement in which it denies Mr Azzopardi's claim. Whilst Mr Azzopardi elected to file written submissions instead of evidence, the applicant filed evidence in the form of a witness statement from its professional representative, Mr Nicholas Preedy, of HallMark IP Limited. For reasons which will become apparent, it is not necessary for me to summarise this evidence here. I have, of course, read all the evidence and submissions and will comment upon them as necessary below. At the completion of the evidence rounds neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

DECISION

4. Section 5(2)(b) of the Act reads 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, or

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

5. 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.”

6. In these proceedings, Mr Azzopardi is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which Mr Azzopardi's trade mark completed its registration procedure, his earlier trade mark is not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

7. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The correct approach

8. Although it is clear that the applicant appreciates that the trade mark upon which the opposition is based is the word only trade mark My L.I.F.E, in both its counterstatement and evidence, it comments upon both the services upon which Mr Azzopardi uses his trade mark and the form in which his trade mark is actually used; this is the wrong approach. As Mr Azzopardi's trade mark is not subject to the proof of use requirements, the services upon which he may be using his trade mark or the form in which his trade mark may be used is not relevant. In reaching a conclusion, what I must do is compare: (i) the services for which the earlier trade mark is registered to the opposed services in class 44 and (ii), the earlier trade mark in the form in which it is registered to the trade mark the subject of the application.

The average consumer and the nature of the purchasing process

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services and then to determine the manner in which these services will be selected by the average consumer in the course of trade. The services at issue consist of a wide range of health care related services which will be provided to both members of the general public and (as the applicant puts it in its submissions), services which occur “behind the scenes”, which I take to mean services provided to undertakings which themselves are engaged in providing healthcare related

services. I will return to the average consumer and purchasing process later in this decision when I consider the likelihood of confusion.

Comparison of services

10. I have identified the competing services in paragraph 2 above.

11. In reaching a conclusion, I must keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“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).”

12. As Mr Azzopardi points out in his submissions, his registration contains a number of broad terms including: “Provision of health care services” and “advisory, consultancy and information services relating to the above.” In my view, the first of these terms is sufficiently broad to encompass all of the services in the application. As a consequence, the applicant’s services must, on the principle outlined above, be regarded as identical to those of Mr Azzopardi.

Comparison of trade marks

13. The competing trade marks are as follows:

Mr Azzopardi’s trade mark	The applicant’s trade mark
My L.I.F.E	

14. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective trade marks.

15. Mr Azzopardi's trade mark consists of the word "My" presented in title case accompanied by the letters "L.I.F.E" presented in upper case with full stops after the letters "L", "I" and "F". The word "My" will be well known to the average consumer. Although the second element of Mr Azzopardi's trade mark is presented as individual letters with full stops after the first three letters, as the word "LIFE" will also be well known to the average consumer, this is how the second element of the trade mark, in my view, will be construed i.e. as a word rather than as individual letters. Because, in my view the combination "hangs together", and, most likely, would be interpreted by the average consumer as a reference to his or her life, there are no distinctive or dominant elements; the distinctiveness lies in the trade mark as a whole.

16. Turning to the applicant's trade mark, this consists of two elements. The first, is a device presented in two shades of green (which the applicant describes as giving the impression of a "collection of leaves"). As far as I am aware, this device is distinctive. The second element of the trade mark is the words "mylife" presented in lower case in black and grey respectively. As the presentation of this element of the trade mark serves to separate the words "my" and "life" this is how it will be seen by the average consumer i.e. as two separate words. Although forming the second element of the trade mark, given its size in relation to the first (device) element, it is this element which, in my view, dominates the trade mark and, given what I consider to be its allusive rather than descriptive qualities in relation to the services at issue, it is also, in my view, a distinctive element.

The visual, aural and conceptual comparison

17. Both parties' trade marks consist of or contain an element which, despite the varying presentations, will, in my view, be seen as the words "My Life". Notwithstanding the presence in the applicant's trade mark of a distinctive device element, this still results in a reasonably high degree of visual similarity between them. It is, of course, well established that when a trade mark consists of a word and device it is the word element that the average consumer will most likely use to refer to the trade mark. As both trade marks will be referred to by the average consumer as "My Life", this renders them aurally and, given my findings above, conceptually identical.

Distinctive character of Mr Azzopardi's earlier trade mark

18. I must now assess the distinctive character of Mr Azzopardi's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the services for which it is registered 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. In reaching a conclusion, I have only the inherent characteristics of Mr Azzopardi's trade mark to consider. I have already concluded that, when considered in relation to the services at issue, the words "My Life" have allusive rather than descriptive qualities. Keeping in mind the manner in which the trade mark is presented, it is, in my view, possessed of a normal degree of inherent distinctive character.

Likelihood of confusion

19. 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 factor in the distinctive character of Mr Azzopardi's earlier trade mark as the more distinctive this trade mark 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 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.

20. Earlier in this decision I concluded that: (i) the average consumer is either a member of the general public or an undertakings engaged in providing healthcare related services, (ii) the competing services are identical, (iii) the distinctiveness of Mr Azzopardi's trade mark lies in its totality, (iv) that although the device element in the applicant's trade mark is distinctive, the words "my life" are the dominant and distinctive element of the applicant's trade mark, (v) the competing trade marks are visually similar to a reasonably high degree and aurally and conceptually identical, and (vi) Mr Azzopardi's trade mark is distinctive to a normal degree.

21. In reaching a conclusion, I shall assume in the applicant's favour that irrespective of whether the services are selected by visual or oral means (or more likely a combination of the two), the average consumer will, given the nature of the services at issue, pay a high degree of attention to their selection, thus making them less susceptible to the effects of imperfect recollection. Even adopting that approach, however, the overall degree of similarity I have identified, in circumstances in which the services at issue are identical and the earlier trade mark distinctive to a normal degree, will still, in my view, result in (at the very least) a likelihood of indirect confusion i.e. where the average consumer assumes that the services provided under the competing trade marks come from undertakings which are economically linked.

Conclusion

22. As a consequence of the above conclusion, Mr Azzopardi's opposition succeeds, and, subject to any successful appeal, the application will be refused in respect of the services in class 44. The class 9 element of the application which was not opposed will, in due course, proceed to registration.

Costs

23. As Mr Azzopardi has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Mr Azzopardi on the following basis:

Preparing a statement and considering the applicant's statement:	£200
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Opposition fee:	£200
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Filing written submissions and considering the applicant's evidence:	£400
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Total:	£800
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24. I order Tunstall Healthcare Group Limited to pay Andrew Azzopardi the sum of **£800**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of September 2013

C J BOWEN
For the Registrar
The Comptroller-General