

O/0639/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3998177

BY BC HILAMAX OY

TO REGISTER THE FOLLOWING TRADE MARK:

Nordic Smile

IN CLASSES 3, 5, 10 AND 35

AND

THE OPPOSITION THERETO UNDER NUMBER 447042

BY CARL ZEISS MEDITEC AG

Background and pleadings

1. On 4 January 2024, BC Hilamax Oy ("the applicant") applied to register the trade mark "Nordic Smile" in the UK. It was accepted and published in the Trade Marks Journal on 19 January 2024 in respect of the following goods and services:

Class 3: Stain removers; Beauty masks; Cosmetics; Cleaner for cosmetic brushes; Tooth cleaning preparations; Teeth cleaning lotions; Non-medicated mouthwashes; Tooth whitening pastes; Tooth whitening preparations; Moistened tooth powder; Dentifrices in the form of chewing gum; Non-medicated dental rinse; Toothpaste; Preparations for cleaning dentures; Breath freshening preparations for personal hygiene.

Class 5: Dental rinse; Pharmaceutical preparations for treating skin disorders; Medicated anti-cavity mouthwashes; Medicated mouthwashes; Pharmaceutical preparations; Eye drops; Medicines for human purposes; Medicinal hair growth preparations; Nutraceutical preparations for therapeutic or medical purposes; Medicated toothpaste; Transdermal patches; Dietetic products for medical purposes; Nutraceuticals for therapeutic purposes; Nutritional supplements; Materials for dental fillings.

Class 10: Surgical devices and instruments; Lamps for medical purposes; Massage apparatus; Medical apparatus and devices; Mercury arc lamp units for therapeutic purposes; Infrared radiator units for therapeutic purposes; Carbon arc lamp units for therapeutic purposes; Ultraviolet radiator units for therapeutic purposes; Physical therapy equipment; UV lamps for medical applications.

Class 35: Advertising relating to pharmaceutical products and in-vivo imaging products; Advertising; Presentation of goods on communications media, for retail purposes; Management of health care clinics for others; Assistance in franchised commercial business management; Marketing services; Import and export agencies; Sales promotion for others; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Retail services in relation to pharmaceutical preparations; Wholesale services

in relation to pharmaceutical preparations; Retail services in relation to medical instruments.

2. The following goods are opposed in this opposition:

Class 10: Surgical devices and instruments; Medical apparatus and devices.

Class 35: Retail or wholesale services for medical supplies; Retail services in relation to medical instruments.

3. On 19 April 2024, Carl Zeiss Meditec AG (“the opponent”) opposed the trade mark, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK trade mark:

Smile

International Registration designating the UK under no.: 1712027

Priority date: 25 May 2022

International registration date: 8 November 2022

Date designated for protection in the UK: 8 November 2022

Date protection granted in the UK: 20 July 2023

4. The following goods are relied on in this opposition:

Class 10: Ophthalmological apparatus and instruments; refractive lasers for medical purposes.

5. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act. In accordance with section 6A of the Act, the earlier mark is not subject to proof of use as it hadn’t been granted for over five years at the relevant date. The opponent may therefore rely upon all the goods for which the mark is registered.

6. Under section 5(2)(b), the opponent claims that the opposed goods are identical or highly similar to their relied upon goods and that the marks are similar. As such, it

claims that there will be a likelihood of confusion between the marks, which includes a likelihood of association with the earlier mark.

7. The applicant filed a counterstatement in which it states that whilst there is a possibility of some goods being deemed similar, some exhibit clear dissimilarities. The applicant states that there is no likelihood of confusion due to the earlier mark's low distinctiveness.

8. The opponent filed a witness statement and evidence, as well as written submissions. The applicant filed neither written submissions nor evidence in these proceedings. No hearing was requested. This decision is taken following a careful perusal of the papers.

9. The opponent is represented by Dehns. The applicant is represented by Paweł Wowra.

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

11. The opponent filed evidence in the form of a witness statement in the name of Clare Louise Mann. The witness statement is dated 4 August 2024. Ms Mann is a Chartered Trade Mark Attorney and Partner at Dehns. Ms Mann's statement is accompanied by four exhibits, those being Exhibit CLM1 to CLM4. The evidence relates to various websites providing information about ophthalmology and refractive surgery.

12. I do not intend to summarise the rest of the evidence at this stage, but this has been fully considered and will be referred to where necessary within my decision below.

Decision

Section 5(2)(b)

13. Section 5(2)(b) of the Act 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”.

Section 5A

14. 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.”

The principles

15. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 C120/04, *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 Page 5 of 17 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

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

17. 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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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.”

19. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

20. Further, in *Kurt Hesse v OHIM*,¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,² the General Court ("GC") stated that "complementary" means: "...there is 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."

¹ Case C-50/15 P

² Case T-325/06

21. The goods and services to be compared are shown in the table below:

The opponent's goods relied on	The applicant's contested goods and services
<i>Class 10: Ophthalmological apparatus and instruments; refractive lasers for medical purposes.</i>	<i>Class 10: Surgical devices and instruments; Medical apparatus and devices.</i> <i>Class 35: Retail or wholesale services for medical supplies; Retail services in relation to medical instruments.</i>

22. The applicant's counterstatement acknowledges that some of the goods be regarded as similar but submits that there are clear dissimilarities in some of the goods and services, particularly in class 35.

Surgical devices and instruments; medical apparatus and devices

23. The opponent's 'ophthalmological apparatus and instruments' and 'refractive lasers for medical purposes' fall within the scope of the above goods. These goods are therefore considered identical according to the principles set out in *Meric*.³

Retail or wholesale services for medical supplies; Retail services in relation to medical instruments

24. The opponent's 'ophthalmological apparatus and instruments' and 'refractive lasers for medical purposes' fall within the scope of 'medical supplies' and 'medical instruments'. I therefore will compare the opponent's goods with retail or wholesale services of said goods.

25. I remind myself of the relevant case law relating to comparing goods and the retail of said goods. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and

³ Case T-133/05

method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

26. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

27. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to

envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

28. Taking the above case law into consideration, I find the above services different in nature, purpose and method of use to the opponent's services. However, the users of the goods and services are the same as both will be used by medical professionals, and I consider the trade channels are likely to be shared. There is no competition. The retail of ophthalmological apparatus and refractive lasers for medical purposes requires the goods themselves and, it is my view it is likely that the consumer will think that the responsibility for the goods and services lies with the same undertaking. I therefore find complementarity between the goods and services. Overall, I find a medium level of similarity between the above services and the opponent's 'ophthalmological apparatus and instruments' and 'refractive lasers for medical purposes'.

Comparison of 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 Court of Justice of the European Union 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 dissect the trade marks artificially, 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 respective trade marks are shown below:

The opponent's earlier marks	The applicant's contested mark
Smile	Nordic Smile

Overall impression

32. The opponent's mark is a word-only mark consisting of the word "Smile". There are no additional elements that contribute to the overall impression of the mark, and it is in that element alone that the overall impression resides

33. The applicant's mark is a word-only mark consisting of the two words "Nordic" and "Smile". I note the word Nordic is at the beginning of the mark where the consumer tends to pay more attention, however, in my view, "Nordic" qualifies "Smile". Overall, it is therefore my view that both elements contribute relatively equally to the overall impression of the mark.

Visual comparison

34. The earlier marks coincide visually with the contested mark through the use of the word "Smile". However, the contested mark also comprises the word "Nordic" placed

before this, creating a clear difference between the marks. Overall, I consider the marks to be visually similar to a medium degree.

Aural comparison

35. The earlier mark comprises the word “Smile”, which will be pronounced in the known way. The contested mark comprises the words “Nordic” and “Smile”, which will also be pronounced in the known way. The overlap of the word “Smile” creates some aural similarity, but the presence of the two syllable word “Nordic” before the single syllable word “Smile” results in a significant aural difference between the marks. Overall, I consider the marks to be aurally similar to just below a medium degree.

Conceptual comparison

36. Both the earlier mark and the contested mark include the word “Smile”, meaning ‘to give to the features or face a look expressive of pleasure or amusement’.⁴ This is the only concept in the earlier mark.

37. The contested mark also comprises the word “Nordic”. The consumer will understand this word to mean ‘of or relating to a geographical or cultural region including Scandinavia, Finland, and Iceland’.⁵

38. Together, the words “Nordic Smile” convey the meaning of a pleased facial expression belonging to a person from Scandinavia.

39. The concept conveyed by the word “Smile” acts as a point of conceptual similarity between the marks, whilst the absence of the word “Nordic” acts as a point of conceptual difference. Overall, I find the marks to be conceptually similar to just above a medium degree.

Average consumer and the purchasing act

40. As the case law above indicates, it is necessary to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in

⁴ Oxford English Dictionary, https://www.oed.com/dictionary/smile_v?tab=meaning_and_use#22055432, accessed 3 July 2025.

⁵ Oxford English Dictionary, https://www.oed.com/dictionary/nordic_adj?tab=meaning_and_use#34171858, accessed 3 July 2025.

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. 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.”

41. The average consumer of the goods and services at issue will be in two groups: medical professionals and members of the general public. The opponent’s goods and the applicant’s ‘surgical devices and instruments’ and ‘retail services in relation to medical instruments’ will be purchased primarily by medical professionals. The applicant’s ‘medical apparatus and devices’ and ‘retail or wholesale services for medical supplies’ will be purchased both by members of the general public and medical professionals. In all cases, as the goods and services relate to the medical field, the consumer will pay a higher than average degree of attentiveness during the purchasing process.

42. The goods at issue will be purchased by the general public from pharmacies and by medical professionals from medical retailers and wholesalers. In both cases, visual considerations will play a dominant role, although aural considerations should not be discounted as advice may be sought from pharmacists and, particularly in the case of medical professionals, orders may be placed over the phone.

43. The services at issue will be purchased by the general public and by medical professionals over the phone, in person or online. When purchasing over the phone, aural considerations will dominate. When purchasing online, visual considerations will dominate. When purchasing in person, both aural and visual considerations will be taken into account.

Distinctive character of the earlier trade mark

44. 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).”

45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

46. There is no evidence regarding the use of the earlier mark. Consequently, I have only the inherent position to consider.

47. The applicant submits that the opponent's mark is a "very basic, simple, and laudatory term". I agree that the opponent's mark is basic and simple but I do not consider that it is entirely laudatory. I do consider "Smile" somewhat alludes to the fact that the goods and services may result in a positive outcome, i.e. one that may cause the consumer to smile. However, this is not particularly direct or pronounced, and I note the goods at issue relate to ophthalmological instruments rather than dental, in relation to which the meaning of the word SMILE would have a more significance.

48. Consequently, I find that the opponent's mark possesses a low to medium level of inherent distinctive character for all of the opponent's goods and services.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

49. 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 goods and services and vice versa (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and services and the nature of the purchasing act. 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

50. 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 goods down to the responsible undertakings being the same or related.

51. Earlier in this decision, I found the contested goods and services to either have a medium similarity or to be identical to the opponent's goods. I found the marks to have a just below a medium degree of aural similarity, a medium degree of visual similarity and a just above medium conceptual similarity. I found the earlier mark to possess a low to medium level of distinctive character. I identified the average consumer would

include both medical professionals and members of the general public, both paying a higher than average level of attention. I found that the goods would be selected by both visual and aural means.

52. As noted above, the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

53. Taking all of the above factors into account, particularly given the higher than average degree of attention paid by the consumer during the purchasing process, I am satisfied that the average consumer would not likely mistake the parties' marks for each other on the applied for goods and services. I therefore do not find there to be a likelihood of direct confusion between the parties' marks for the applicant's goods and services.

54. I will therefore proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, as James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16], "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion".

55. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr 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)."

56. I do not consider this case to fit neatly into one of the categories set out in *L.A. Sugar* above. However, I remind myself that these are not exhaustive. I also consider the relevance of *Medion vs Thomson*⁶ and the subsequent case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"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.

⁶ Case C-120/04

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.”

57. In its submissions in lieu, the opponent submits that there is a likelihood of indirect confusion between the marks because the word “Smile” plays an independently distinctive role in both marks. Earlier I found that both words of the contested mark “Nordic Smile” contribute equally to the impression of the mark and that combined they convey the meaning of a pleased facial expression belonging to a person from Scandinavia. Considering this combined meaning and the overall impression of the mark, I do not consider in this instance that either of the words of the contested mark has distinctive significance independently of the whole.

58. Further, the opponent refers to *Vitae Health Innovation, S.L. v Sed Swiss Engineering Developments AG* ([2022] O/1015/22), in which a likelihood of indirect confusion was found between “SWISSVITAE” and “VITAE HEALTH INNOVATION”, as the addition of the word “Swiss” appeared to be consistent with a variant brand or brand-extension, indicating the Swiss limb of the company. The opponent submits that the same assessment should be made in the present proceedings, where the addition of “Nordic” would be perceived as a sub-brand or brand extension, indicating geographical origin. I note this previous decision; however, this decision hinged on the earlier mark, by virtue of the element “VITAE”, being highly distinctive and, as such, consumers assuming that no one else other than the opponent would be using it in a trade mark. Further, I note in that case that SWISS and VITAE in the contested mark, did not offer a combined meaning. In the present proceedings, the earlier mark has a low to medium degree of distinctive character and the words “Nordic Smile” have a combined meaning. Due to this, I do not consider that a consumer would assume that no one else other than the opponent would be using the word “Smile” in a trade mark, particularly, that no one would be using it in the context of the contested mark.

59. I consider that a consumer who is aware of the opponent’s earlier mark may note the use of “Smile” in both marks. However, I do not see any logical reason for the consumer to conclude that the “Nordic Smile” mark is another brand of the owner of the earlier mark, or a brand extension. I note that the opponent has argued consumers might interpret the use of the contested sign as representing activities authorised by the opponent, stating that consumers would be likely to believe this to result from a licensing agreement with an entity i) connected to the Nordic countries, or ii) involved in producing the goods or rendering the services in a Nordic country. However, considering all of the circumstances of the case, this to me feels unlikely. I find it much more likely that any consumers noticing the use of “Smile” both as the opponent’s earlier mark and the contested mark, would simply assume that the marks represented goods deriving from two different entities, and put the use of “Smile” in both (if noticed) down to coincidence.

60. I therefore do not consider there to be a likelihood of indirect confusion in relation to the applicant’s goods and services.

Final Remarks

61. The opposition under Section 5(2)(b) has been unsuccessful in respect of all of the contested goods and services.

COSTS

62. The applicant has achieved partial success in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of £450 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the TM7 and statement of grounds and preparing and filing the TM8 and counterstatement:	£250
Considering the opponent's evidence:	£200 ⁷
Total:	£450

63. I therefore order Carl Zeiss Meditec AG to pay BC Hilamax Oy the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of July 2025

K HARBACH

For the Registrar

⁷ I have awarded under the scale costs as, although the opponent's evidence needed to be considered, the applicant neither filed their own evidence nor made any comments based on the opponent's evidence.