

O-653-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3319635

BY CHRIS MARCO FLORES

TO REGISTER THE FOLLOWING TRADE MARK:

W H EALTH

HEALTH IS THE REAL WEALTH

IN CLASSES 41 AND 44

AND

OPPOSITION THERETO UNDER NO. 413938

BY HEALTH IS WEALTH GROUP LTD.

BACKGROUND AND PLEADINGS

1. On 21 June 2018, Chris Marco Flores (“the applicant”) filed trade mark application number UK00003319635 for the mark detailed on the cover page of this decision. The application was accepted and published for opposition purposes on 20 July 2018, in respect of services in classes 41 and 44.¹

2. Health is Wealth Group Ltd. (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon United Kingdom trade mark (“UKTM”) no. UK00003240459, the pertinent details of which are as follows:

Representation: HEALTH IS WEALTH

Filing date: 29 June 2017

Registration date: 29 September 2017

Services: Class 44²

3. The opponent’s UKTM qualifies, under section 6 of the Act, as an earlier trade mark for the purpose of these proceedings. Given its registration date, it is not subject to the proof of use provisions contained in section 6A of the Act.

4. The opponent’s case under section 5(2)(b) is that the applied-for mark contains the same words as its earlier mark and is seeking registration for similar/identical services, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies a likelihood of confusion on the basis that the marks at issue are very different. The applicant does, however, state that the parties’ services are the same (albeit “[targeting] different demographics”).

¹ I will list these services when I come to the services comparison

² As above

6. Both parties filed evidence. Neither party requested a hearing. Only the applicant filed written submissions in lieu of a hearing. Both the opponent and the applicant represent themselves.

EVIDENCE

The opponent's evidence

7. The opponent's evidence takes the form of a witness statement and seventeen exhibits from Chloe Cunningham, co-founder of the opponent company. The evidence contains a mixture of submissions (which I will bear in mind when making my decision) and fact (relating to the opponent's business). The majority of the opponent's evidence appears to be 'proof of use' style evidence, which is not required in this case. Consequently, I only propose to briefly summarise what has been filed. The salient points from the witness statement are the following figures:

Annual sales of the goods/services (£)	
2016	0
2017	8,119
2018	24,759

Annual amounts spent on advertising (£)	
2016	300
2017	3,000
2018	8,000

8. Many of the exhibits (none of which are dated) are images showing use of the opponent's mark on the opponent's website, on various marketing materials, and featured in the press. Also contained within the exhibits are invoices, either for sales or PR services paid for by the opponent, or for services provided (in November 2017 and April 2018) by the opponent (totalling £4,461.76).

9. The opponent also filed evidence in reply to the applicant's evidence, which I will deal with in due course.

The applicant's evidence

10. The applicant's evidence takes the form of a witness statement and eighteen exhibits from Chris Marco Flores, the applicant. Again, the evidence contains a mixture of submissions (which I will bear in mind when making my decision) and fact (relating to the applicant's business). The applicant is not required to prove use of its mark and, as such, it is not clear why the evidence was filed and why it assists in these proceedings. If the applicant is claiming that it has used its mark before the opponent, then this is not a sustainable defence.³ Absent any clear impact on the proceedings, I will say no more about the applicant's evidence.

PRELIMINARY POINTS

11. A number of points have been raised by the applicant and the opponent, in their written submissions and evidence. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

i. Services comparison and the targeting of "different demographics"

The applicant, in its counterstatement, makes the following submission:

"Both our services are the same, however there is no room for confusion as we target different demographics.

I only target and focus on people who are obese."

Differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the list

³ See Tribunal Practice Notice 4/2009 titled "*Trade mark opposition and invalidation proceedings – defences*"

of services they have tendered for the purpose of registration of their marks. The opponent, on 29 June 2017, filed for registration of its mark to protect various services in class 44. Since the mark is not subject to proof of use, it is entitled to protection in relation to all the services for which it is registered. The applicant, on 21 June 2018, filed for registration of its mark to protect various services in classes 41 and 44. It is the services for which each mark has been filed for registration that I will be comparing, later in this decision. The assessment I must make between the services is a notional and objective assessment, rather than a subjective one. For example, marketing strategies, including the targeting of specific demographics, are temporal and may change over time. As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer is for the services at issue.

ii. 'Without prejudice' evidence

The opponent filed a copy of an email from the applicant to the opponent dated 9 August 2018 (exhibit CCR1). Given the applicant's opening line of his email: "I am writing to you to hopefully be able to come to an agreement regarding my Trade mark application ...", it is clear that the applicant was attempting to pursue negotiations and settlement. According to caselaw on the matter, the justification for the 'without prejudice' rule is that parties should be encouraged to settle their disputes and should not be discouraged by the knowledge that anything that is said in the course of such negotiations may be used to their prejudice. Further, any discussions between the parties for the purpose of resolving the dispute are not admissible, even if the words "without prejudice" are not expressly used.⁴ As such, the email at exhibit CCR1 is an inadmissible document and I will not be taking it into account in determining this opposition.

iii. 'State of the register' evidence

⁴ In *Unilever PLC v The Procter & Gamble Company*, Walker LJ quoted Lord Griffiths in *Rush & Tompkins v Greater London Council* (1989) AC 1280 at 1299

In its written submissions in lieu of a hearing, the applicant has identified five trade mark registrations (other than those of the applicant and the opponent) containing the words “health” and “wealth”. The applicant then goes on to make the following submission:

“11. It is unfair for my application to not be accepted as there have been multiple trademarks including ones that list of services [sic] are in the same class, that have been accepted before and after the opponent filled [sic] the trademark (UK00003240459) which all share the words ‘health’ and ‘wealth’ in one way or another. Just as the trademark I have filled [sic]. (UK00003319635)”

In relation to the registered trade marks referred to by the applicant, I bear in mind *Zero Industry Srl v OHIM*.⁵ The General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

⁵ Case T-400/06

Accordingly, the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks.

12. Having dealt with the necessary submissions made by the parties, I go on now to consider the opposition.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act states that:

“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.”

Relevant law

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 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 services

15. The competing services are shown in the table below:

Earlier mark	Applied-for mark
Class 44: Nutritional Guidance; Nutrition Consultancy; wellness advisor; life coach; Naturopathy, Nutritional Therapy, general health and wellness, Functional Testing; In Office Clinics; Wellness advice, Seminar Leaders, Dietary Advice, Guidance on nutrition and supplements; Complementary and alternative medicine; Nutrition and dietetic consultancy; Nutrition consultancy; Nutrition counselling; Nutrition counselling; Nutritional advice; Nutritional advisory and consultation services; Nutritional advisory services; Nutritional guidance; Advice relating to nutrition; Advisory services relating to nutrition; Consultancy services in the field of nutrition; Consultancy services	Class 41: Health and fitness club services; Health and fitness training; Health club [fitness] services; Health club services [health and fitness training]; Provision of educational health and fitness information. Class 44: Nutrition consultancy; Nutrition counselling; Nutrition counselling; Nutritional advice; Nutritional advisory and consultation services; Nutritional advisory services; Nutritional guidance; Advice relating to nutrition; Advisory services relating to nutrition; Consultancy in the field of nutrition; Consultancy relating to nutrition; Consultancy services in the field of nutrition; Consultancy services related to

<p>related to nutrition; Consultancy services relating to nutrition; Counselling relating to nutrition; Dietary and nutritional guidance; Food nutrition consultation; Guidance on nutrition; Information relating to nutrition; Providing information about dietary supplements and nutrition; Providing information relating to dietary and nutritional guidance; Providing information relating to dietary and nutritional supplements; Providing nutritional information about food; Medical testing services, namely, fitness evaluation.</p>	<p>nutrition; Consultancy services relating to nutrition; Counselling relating to nutrition; Dietary and nutritional guidance; Food nutrition consultation; Guidance on nutrition; Information relating to nutrition; Professional consultancy relating to nutrition; Providing information about dietary supplements and nutrition; Providing information relating to dietary and nutritional guidance; Providing information relating to dietary and nutritional supplements; Providing nutritional information about drinks for medical weight loss purposes; Providing nutritional information about food; Providing nutritional information about food for medical weight loss purposes; Provision of information relating to nutrition.</p>
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16. The General Court confirmed in *Gérard Meric v OHIM*⁶ that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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”.

⁶ Case T-133/05

17. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,⁷ the court stated at paragraph 23 of its judgment that:

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

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁸ 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.

⁷ Case C-39/97

⁸ [1996] R.P.C. 281

19. In *Kurt Hesse v OHIM*,⁹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,¹⁰ the General Court 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”.

Class 44

20. It is self-evident that the following terms of the parties’ specifications are, due to their identical wording, identical services:

“Nutrition consultancy; Nutrition counselling; Nutrition counselling; Nutritional advice; Nutritional advisory and consultation services; Nutritional advisory services; Nutritional guidance; Advice relating to nutrition; Advisory services relating to nutrition; Consultancy in the field of nutrition; Consultancy relating to nutrition; Consultancy services in the field of nutrition; Consultancy services related to nutrition; Consultancy services relating to nutrition; Counselling relating to nutrition; Dietary and nutritional guidance; Food nutrition consultation; Guidance on nutrition; Information relating to nutrition; Providing information about dietary supplements and nutrition; Providing information relating to dietary and nutritional guidance; Providing information relating to dietary and nutritional supplements; Providing nutritional information about food”.

21. In accordance with *Meric*, the applicant’s “Professional consultancy relating to nutrition; Providing nutritional information about drinks for medical weight loss purposes; Providing nutritional information about food for medical weight loss purposes; Provision of information relating to nutrition” fall within the scope of the opponent’s “Consultancy services related to nutrition; Providing information relating to

⁹ Case C-50/15 P

¹⁰ Case T-325/06

dietary and nutritional guidance; Providing nutritional information about food; Information relating to nutrition”, respectively.

22. The parties’ class 44 services are identical.

Class 41

23. Neither party has made submissions specifically relating to the applicant’s class 41 services.

24. Firstly, I deal with the applicant’s “Provision of educational health and fitness information”, which I will compare to the opponent’s “Providing information relating to dietary and nutritional guidance”. I am of the view that diet and nutrition fall within the scope of health and fitness and educational information falls within the scope of information. Accordingly, I find these services identical in accordance with *Meric*.

25. I turn now to the applicant’s “Health and fitness club services; Health and fitness training; Health club [fitness] services; Health club services [health and fitness training]”. I group these services together for the purposes of assessment in accordance with *Separode Trade Mark*.¹¹ I find these to be similar to the majority (if not, all) of the opponent’s services. Taking the opponent’s “Nutritional advice” as an example, whilst the nature and purpose of these services differ, the users are likely to overlap since those who attend health clubs often seek nutritional advice in addition to their training. It is also common for the providers of health clubs and health and fitness training facilities to offer nutritional advice to their members, meaning the trade channels of these services are often shared. Since it is reasonable to expect one undertaking to provide both of these services, I find that they are also complementary. However, they are unlikely to be in competition as consumers rarely choose between seeking nutritional advice and using health clubs. Overall, I find a medium degree of similarity between the applicant’s “Health and fitness club services; Health and fitness training; Health club [fitness] services; Health club services [health and fitness training]” and the opponent’s “Nutritional advice”.

¹¹ BL O/399/10

The average consumer and the nature of the purchasing act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.¹²

27. 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*,¹³ 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.”

28. The average consumer of the services at issue will be a member of the general public. Despite the applicant's submission that it targets “people who are obese”, the users of the services it has applied for and of the services covered by the opponent's earlier mark could include any member of the public who is interested in attending health clubs, participating in fitness training, or gaining knowledge in relation to health, fitness and/or nutrition. The services are not an everyday purchase, but are likely to be purchased frequently, via a monthly membership, for example. The cost of such services can vary quite significantly, however, they are not prohibitively expensive. Choosing which health club to attend or who to seek nutritional advice from is a fairly considered purchase, with the consumer taking into account a variety of factors, such as the cost and the particular facilities offered. I find that, taking all of these factors into

¹² Case C-342/97

¹³ [2014] EWHC 439 (Ch)

account, the level of care and consideration that will be adopted during the purchasing process would be at least average.

29. The consumer will, for the most part, encounter the marks visually, on the providers' premises, on websites, or on advertising material such as leaflets and brochures, for example. However, there is an aural element to the purchase with word of mouth recommendations playing a part in the selection, and with conversations taking place with professionals, such as fitness trainers, nutritionists and dieticians.

Comparison of marks

30. It is clear from *Sabel* 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

31. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

32. The trade marks to be compared are as follows:

Earlier mark	Applied-for mark
HEALTH IS WEALTH	

Overall impression

33. The earlier mark consists solely of the three words HEALTH IS WEALTH, with no stylisation or figurative elements. As this is a word mark, protection extends to the word in upper- or lower-case in any standard font. The overall impression of the mark rests in the words themselves.

34. The applied-for mark consists of what I consider to be three separate elements. The word WHEALTH is presented in upper case, in a standard typeface, with the letters W--E-A-L-T-H in black and the second letter, H, in bright green. The different colour of the letter H in the applied-for mark highlights the amalgamation of the ordinary words WEALTH and HEALTH. This is reinforced by the strapline, which contains both of those words. Below the word WHEALTH is a solid, black, horizontal line. Beneath the line are the words HEALTH IS THE REAL WEALTH. I consider that the word WHEALTH has the greatest impact in the overall impression, given its size and position. A slightly lesser role is played by the phrase HEALTH IS THE REAL WEALTH which, positioned beneath the word WHEALTH and in a smaller typeface, is likely to be seen as a strapline. However, I consider that the words do make a contribution to the overall impression of the mark. The black horizontal line is likely to be seen as little more than that; a line separating the two textual components.

Visual comparison

35. The words of the earlier mark appear in the same order in the applied-for mark, albeit, not successively, i.e. HEALTH IS WEALTH versus HEALTH IS **THE REAL WEALTH**, meaning the entirety of the earlier mark is visible in the applied-for mark. The differences are in the addition of “WHEALTH”, “THE REAL” and the black line in

the applied-for mark. Overall, I find at least a medium degree of visual similarity between the marks.

Aural comparison

36. The earlier mark will be articulated in its entirety. There are two possible scenarios in relation to the applied-for mark. Consumers will either articulate the mark in full (“WHEALTH HEALTH IS THE REAL WEALTH”) or will shorten the mark to “WHEALTH” (most likely pronounced as the ordinary word “WEALTH”). In either case, I consider the marks to be aurally similar to at least a medium degree.

Conceptual comparison

37. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM*.¹⁴ The assessment must be made from the point of view of the average consumer.

38. I have already found that the word “WHEALTH” in the applied-for mark will be considered a combination of the two ordinary words WEALTH and HEALTH. This is particularly so given the addition of the words “HEALTH IS THE REAL WEALTH”. “WEALTH” is an ordinary dictionary word meaning a large amount of money or valuable possessions that someone has.¹⁵ The phrase “HEALTH IS WEALTH” will be understood by consumers to refer to the importance of health and the notion that if we are not healthy, wealth means nothing. Both marks will conjure the same meaning in the mind of consumers. That the applied-for mark contains the words “THE REAL” does not create a material difference since their use is as an intensifier of the word “WEALTH”. I find the marks to be conceptually highly similar, if not identical.

¹⁴ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

¹⁵ www.dictionary.cambridge.org

Distinctive character of the earlier mark

39. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

40. The annual sales figures and annual amounts spent on advertising are fairly low. In addition, I have not been provided with figures relating to the market share of the services provided under the opponent's mark. I am not satisfied that the evidence shows use of the mark at a sufficient level to have enhanced its distinctive character. Consequently, I have only the inherent distinctiveness of the mark to consider.

41. I have already noted that it is likely consumers will recognise HEALTH IS WEALTH as a phrase referring to the importance of health. Subsequently, the mark is allusive

of the services for which it is registered. I find the earlier mark to have a low degree of inherent distinctiveness.

Likelihood of confusion

42. The factors assessed so far have a degree of interdependency (*Canon*); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel*). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

43. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods and services down to the responsible undertaking being the same or related).

44. The marks have been found to be visually and aurally similar to at least a medium degree and conceptually highly similar. The parties' goods have been found to be either identical or similar to a medium degree.

45. Notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual differences between the marks to avoid them being mistakenly recalled as each other. The additional words in the applied-for mark will not be overlooked by the average consumer. I do not consider there to be a likelihood of direct confusion.

46. I go on now to consider indirect confusion. This was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:¹⁶

“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

¹⁶ BL O/375/10

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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)."

47. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹⁷

¹⁷ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

48. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common elements of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

49. Although the differences between the marks are likely to be recognised, I consider that the concept that is conjured by the presence of the words HEALTH IS WEALTH in each of the marks (albeit interjected by the words “THE REAL” in the applied-for mark) and in relation to identical or similar services will lead the consumer to consider that the services are provided by the same or economically linked undertakings. That the word WHEALTH is an amalgamation of the common words in the marks, and that “THE REAL” acts as an intensifier of the word WEALTH, is likely to cause consumers to see the differences as logical with a re-branding or brand extension, for example. Notwithstanding the earlier mark’s low distinctiveness, I consider there to be a likelihood of indirect confusion.

CONCLUSION

50. The opposition under section 5(2)(b) has been successful and the application is refused registration.

COSTS

51. As the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. Since the opponent did not respond to that invitation within the timescale allowed (nor has any response been received from the opponent prior to the date of the issuing of this decision), it is not entitled to any costs other than the official fee for filing the notice of opposition.

52. I order Chris Marco Flores to pay Health is Wealth Group Ltd. the sum of £100 which, in the absence of an appeal, should be paid within 21 days of the expiry of the appeal period.

Dated this 28th day of October 2019

Emily Venables

For the Registrar

The Comptroller-General