

**O-441-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No.3299899  
BY OUTCOMES BASED HEALTHCARE LIMITED  
TO REGISTER IN CLASSES 9, 16, 35, 41, 42 & 44  
THE TRADE MARK**

**HEALTHSPAN**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 413279  
BY  
HEALTHSPAN LIMITED**

## **BACKGROUND**

1) On 27 March 2018, GOutcomes Based Healthcare Limited (hereinafter the applicant) applied to register the trade mark HEALTHSPAN in respect of the following goods:

In Class 9: Application software; Computer software platforms; Computer programs; Data encryption apparatus; Data processing equipment and computers; Data storage media; Data banks; Data conversion apparatus; Data networks; Data processing programs; Electronic publications (downloadable); Interface software; Measuring and testing apparatus and instruments; Teaching apparatus and instruments.

In Class 16: Books; Instructional and teaching materials (except apparatus); Paper; Periodicals; Photographs; Printed matter; Stationery.

In Class 35: Analysis of business data; Business data analysis; Business management; Business administration; Business consultancy; Business research and survey services; Compilation of statistics; Data processing; Database management; Opinion polling; Patient statistical information and analysis; Processing, collection, compilation, verification, preparation, retrieval, analysis, interpretation, management, comparison and dissemination of business information, data and statistics; Statistical analysis and reporting; Business information services provided online from a global computer network of the Internet.



In Class 41: Arranging and conducting of conferences, congresses and symposiums; Conducting courses, seminars and workshops; Education; Entertainment; Healthcare education; Providing of training; Providing electronic publications; Publishing and reporting; The provision of on-line electronic publications and digital music (not downloadable) from the Internet; Providing on-line electronic publication (not downloadable); Publication of electronic journals and books, reports and survey online; Publication of survey reports; Sporting and cultural activities; Training services.

In Class 42: Biological, research, clinical research and medical research; Scientific and technological services and research and design relating thereto; Clinical research; Maintaining databases; Research services; Preparation of scientific, technical and health service reports; Quality control; Technical project studies; Electronic storage of business information, data and statistics.

In Class 44: Medical services; Medical consultation; Medical diagnostic services; Medical analysis; Preparation of reports relating to medical matters, health care and medical examination; Professional consultancy relating to health; Healthcare services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 4 May 2018 in Trade Marks Journal No. 2018/018.

3) On 23 August 2018 Healthspan Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
	EU 11695855	27.03.13 05.08.13	35	Advertising; Business management; Business administration; Office functions
	EU 16262974	17.01.17 29.06.17	35	organisation, operation, supervision and management of customer loyalty programmes and frequent buyer schemes; consumer loyalty services for commercial, promotional, and advertising purposes; presentation of goods on communication media, for retail purposes; distribution of samples; procurement services (purchasing goods and services for other businesses); advertising services; business management services; information, advisory and consultancy services in relation to all of the foregoing.
Healthspan Go Me	UK 3211029	06.02.17 28.04.17	9	Multifunctional electronic devices for displaying, measuring, and uploading to the Internet information including time, date, body and heart rates, global

Healthspan GoMe  A series of two trade marks				positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, the temperature, wind speed, and the declination of body and heart rates, altitude and speed.
			41	Providing information in the fields of fitness and exercise; provision of information on fitness and exercise via a website.
			44	Health, fitness, exercise, and wellness monitoring and assessment services; providing information in the fields of health and wellness; provision of information on health and wellness via a website.
HEALTHSPAN NUTRITION EXPERT	UK 3015037	23.07.13 13.12.13	44	Nutrition advice and information services; nutrition counselling services; provision of nutritional advice, information, supervision and counselling via a website; providing consultation and advice in the fields of nutrition and health; provision of evaluations and assessments in the fields of nutrition and health; consulting, information and advisory services relating to human well-being, nutrition and health, dietary and lifestyle consultancy and analysis services.
HEALTHSPAN ELITE	UK 3003323	24.04.13 02.08.13	35	Advertising; Business management; Business administration; Office functions

- a) The opponent contends that the mark in suit and the opponent's marks shown above are similar and that the goods and services applied for are identical and/or similar to the goods for which the earlier mark is registered. EU 11695855, EU 16262974 and UK 3003323 are used to oppose the applicant's class 35 services only; UK 3015037 is used to oppose the class 44 services applied for; whilst UK 3211029 is used to oppose the applicant's goods and services in classes 9, 41 and 44. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent contends that it has used its trade mark EU16262974 Healthspan since 1996. It claims that it is the UK's leading direct supplier of vitamins & supplement via mail order and the internet. The opponent contends that: "It also provides health and wellness information and monitoring for its customers and any use of the name Healthspan by any other operator for any health-related goods or services would, we believe, give rise to a relevant consumer believing that such activity would emanate from the opponent. The applicant would be taking advantage of the substantial investment made in the Healthspan brand over 22 years, without having contributed to this. This is in addition to the reputation that the opponent's brand has in the market. Such advantage would be unfair to the opponent as it undermines this investment and creates an association between the two entities. The reputation of the opponent is directly with its consumers. No matter what sales channel the applicant intends to market its goods and services, the opponent's brand would suffer as a direct result of this use. The reason for this is that the goods and services offered by the applicant are far too similar to those offered by the opponent and, as such, any such use would cause damage to the opponent's reputation. Taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness, we believe that such a link exists between the earlier right and the applied for mark. As a result of this link, there exists the likelihood that damage and dilution to the earlier right will occur, with the resultant loss of reputation and negative financial effect to the earlier right holder's business and its reputation. The earlier mark's ability to identify the goods/services for which it is registered would be weakened as a result of the use of the later mark and the distinctive character and reputation of that mark would suffer as a result." It contends that the mark in suit offends against section 5(3) of the Act.
- 4) On 10 October 2019 the applicant filed a counterstatement basically denying all the grounds of

opposition. It accepts that there is similarity between the goods of the two parties but does not accept that the marks are similar. It put the opponent to proof of use for UK 2441708, EU 6273643 and EU 010608974, all of which were subsequently dropped from the opposition by the opponent.

5) Only the opponent filed evidence; both sides seek an award of costs in their favour. Neither side wished to heard and both sides provided submissions which I shall refer to as and when necessary.

## **OPPONENT'S EVIDENCE**

6) The opponent filed a witness statement, dated 16 January 2020, by David Anthony Evans the opponent's trade mark advisor. He states that the opponent is the market leader for the sale of vitamins and supplements direct to the consumer. He claims that in terms of brand size for vitamins, mineral and supplements the opponent is third behind Holland and Barrett and Boots in the UK. The opponent has a customer database of over 600,000 individuals and during the years 2015-2020 inclusive have spent over £44 million on marketing and advertising. He states that the opponent also offers "elite nutrition services primarily aimed at sportspeople and personalised nutrition and wellbeing advice services to the general public". He contends that the applicant is in the same business as the opponent and refers to extracts from the website of the applicant.

- DE7: An article from the Evening Standard dated 22 January 2018 which refers to an app offered by the opponent regarding measuring what your nutrition requirements are based on your diet and activity levels.
- DE8: Copies of screenshots regarding the opponent's app and also its supplements.
- DE9 & 10: Copies of pages from the applicant's website which shows a system for measuring health

## **DECISION**

7) The first ground of opposition is under section 5(2)(b) which reads:

"5.-(2) A trade mark shall not be registered if because -

(a) .....

- (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.”

8) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

9) The opponent is relying upon its trade marks shown in paragraph 3 above which are clearly earlier trade marks. The applicant did not put the opponent to proof of use of these marks.

10) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

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



## The average consumer and the nature of the purchasing decision

11) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12) The goods and services sought to be registered by the applicant are enormously varied ranging from, inter alia, computer software and hardware, to business management and administration services, to arranging seminars, workshops and conferences, to medical research and scientific services to medical services and diagnosis. The average consumer for such goods will be business and for some also the public at large. Such goods and services may be sold through a range of channels, including retail outlets (computers) and on the internet or via catalogues and print media (most of the services). The selection process will be primarily a visual one, although as many of the services will involve discussions with staff and as one might receive a recommendation, aural considerations must also be taken into account. These goods and services are usually expensive and not the type of thing chosen without careful thought and consideration and to my mind the consumer will pay a medium to **high level of attention to the selection of such goods and services.**

## Comparison of goods and services

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

14) 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.

15) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

16) 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."

17) In *Kurt Hesse v OHIM*, Case C-50/15 P, 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"...there is a 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".

18) As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

19) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

20) Thus, where the similarity between the respective goods / services is not self-evident, the opponent must show how, and in which respects, they are similar.

21) In relation to the similarity of the goods and services in question the opponent states:

“In each of the Earlier Rights there contains one or more classes of goods or services which can be considered to be the same or highly similar to the goods and services applied for in the Application. Even where the classes are not common to the Earlier Rights and those within the Application, there exists a crossover between the goods and services contained within the Application and those of the Earlier Rights, so as to render them confusingly similar. The Opponent also contends that the activities contained with the Application call to mind the activities of the Opponent in such a way as to make the relevant public and consumers imagine that the two undertakings are economically linked. The Opponent has diversified over the years into healthcare services and these services overlap with the activities of the Applicant.”

22) In its pleadings the opponent identified specific parts of its registered specification in respect of each earlier mark relied upon. The above comments are so generalised I do not find them useful in carrying out my comparison test. I shall first consider the goods of the two parties in class 9. For ease of reference these are:

Applicant's goods	Opponent's goods
In Class 9: Application software; Computer software platforms; Computer programs; Data encryption apparatus; Data processing equipment and computers; Data storage media; Data banks; Data conversion apparatus; Data networks; Data processing programs; Electronic publications (downloadable); Interface software; Measuring and testing apparatus and instruments; Teaching apparatus and instruments.	UK 3211029 Class 9: Multifunctional electronic devices for displaying, measuring, and uploading to the Internet information including time, date, body and heart rates, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, the temperature, wind speed, and the declination of body and heart rates, altitude and speed.

23) The applicant contends:

“4. The *wearable activity tracker* listed in the Opponent’s Class 9 specification describes the various data that is uploaded to the Internet from the device. There is a degree of similarity with the term *measuring and testing apparatus and instruments* in the Applicant’s Class 9 specification, although the similarity is low.

5. General terms in Class 9 cover a vast number of goods, and can differ significantly in nature, purpose, producers, distribution channels and relevant public. For example, a company that performs a scientific test would not normally manufacture apparatus and instruments that are used when performing the function. A company that produces an activity tracker, either through a computer app or wearable device would not also be the company that produces those goods. Although included in the general term, this should not render goods immediately similar.”

24) To my mind, the terms “Measuring and testing apparatus and instruments” found in the applicant’s specification are identical to the whole of the opponent’s goods set out above. Whilst the opponent’s device undoubtedly stores data it is highly specific data and very limited. Anyone considering purchasing data storage would not approach the makers of watches, cameras or calculators which would have the equivalent data storage of the opponent’s device. The opponent has also failed to set out why its goods should be regarded as similar to any of the other goods of the applicant. In the absence of such submissions I find that the balance of the applicant’s specification is not similar to the goods of the opponent.

25) I next turn to the class 35 services sought to be registered by the applicant. The opponent is relying upon three of its registered marks to oppose these services. For ease of reference the services to be compared are:

Applicant's services	Opponent's services
<p>In Class 35: Analysis of business data; Business data analysis; Business management; Business administration; Business consultancy; Business research and survey services; Compilation of statistics; Data processing; Database management; Opinion polling; Patient statistical information and analysis; Processing, collection, compilation, verification, preparation, retrieval, analysis, interpretation, management, comparison and dissemination of business information, data and statistics; Statistical analysis and reporting; Business information services provided online from a global computer network of the Internet.</p>	<p>EU 11695855 Class 35: Advertising; Business management; Business administration; Office functions.</p> <p>UK 3003323: Class 35: Advertising; Business management; Business administration; Office functions.</p> <p>EU16262974; Class 35: organisation, operation, supervision and management of customer loyalty programmes and frequent buyer schemes; consumer loyalty services for commercial, promotional, and advertising purposes; presentation of goods on communication media, for retail purposes; distribution of samples; procurement services (purchasing goods and services for other businesses); advertising services; business management services; information, advisory and consultancy services in relation to all of the foregoing.</p>

26) The applicant submitted:

“46. The services of this Earlier Mark cover “*Advertising; Business management; Business administration; Office functions*”. There is identity in respect of the terms “*business management*” and “*business administration*” included in the Application.

47. However, for such business management services, these are intended to help companies manage their business by setting out the strategy and/or direction of the company. They involve activities associated with running a company, such as controlling, leading, monitoring, organising, and planning. They are usually rendered by companies specialised in this specific field such as business consultants. They gather information and provide tools and expertise to

enable their customers to carry out their business or to provide businesses with the necessary support to acquired, develop and expand their market share. Examples of business management are business research and appraisals, cost-price analyses and organisation consultancy, since they are all intended to help with the strategy of a commercial undertaking. These services also include any 'consultancy', 'advisory' and 'assistance' activity that may be useful in the management of a business, such as how to efficiently allocate financial and human resources, improve productivity, increase market share, deal with competitors, reduce tax bills, develop new products, communicate with the public, carry out marketing, research consumer trends and launch new products; how to create a corporate identity, etc. (*Opposition No. B003070989 Super Health Direct v Superhealth, 28 January 2020*).

48. The overlap or complementarity of other services included in Class 35 of the Application are minimal, or non-existent.”

27) Clearly, the specifications contain identical wording such as “business management” which appears in all three of the opponent’s specifications as well as in the applicant’s specification; and “business administration” appears in the opponent’s specifications for trade marks EU 11695855 & UK 3003323 as well as in the applicant’s specification.

28) Using the applicant’s own submissions it would appear that it believes that the following terms in its specification are part and parcel of business management and administration: “Analysis of business data; Business data analysis; Business consultancy; Business research and survey services; Compilation of statistics; Data processing; Database management; Processing, collection, compilation, verification, preparation, retrieval, analysis, interpretation, management, comparison and dissemination of business information, data and statistics; Statistical analysis and reporting; Business information services provided online from a global computer network of the Internet.” These terms must therefore be regarded as similar to a medium to high degree to the opponent’s specification of “business management and administration”.

29) This leaves only “Opinion polling; Patient statistical information and analysis;”. I can see no reason why such specialised services would be regarded as similar or complementary to the opponent’s services set out above.

30) I next turn to the class 41 services of the applicant. The comparison here is with only one of the opponent's marks and for ease of reference the services concerned are:

Applicant's services	Opponent's services
In Class 41: Arranging and conducting of conferences, congresses and symposiums; Conducting courses, seminars and workshops; Education; Entertainment; Healthcare education; Providing of training; Providing electronic publications; Publishing and reporting; The provision of on-line electronic publications and digital music (not downloadable) from the Internet; Providing on-line electronic publication (not downloadable); Publication of electronic journals and books, reports and survey online; Publication of survey reports; Sporting and cultural activities; Training services.	UK 3211029: Class 41: Providing information in the fields of fitness and exercise; provision of information on fitness and exercise via a website.

31) The applicant submitted:

“36. For Class 41, the Opponent specifies information *in the fields of fitness and exercise*. Again, these services are quite limited and do not bear similarity with the entirety of the Application's Class 41 specification, which includes a range of education and healthcare services. As such, the similarity is low.”

32) The opponent's specification could mean as little as putting out, via the internet, a statement that exercise is good for one, and that keeping fit is a good idea. Whilst this, at a stretch, could be said to be educational it might also be said to be a statement of the obvious. Again, in the absence of any submissions from the opponent and as any similarity is not self-evident I find that there is no similarity between the services of the two parties.

33) Lastly, I turn to consider the services in class 44, for ease of reference these are:

Applicant's services	Opponent's services
In Class 44: Medical services; Medical consultation; Medical diagnostic services;	UK 3211029: Class 44: Health, fitness, exercise, and wellness monitoring and assessment services; providing information in the fields of health and wellness; provision of information on health and wellness via a website.



<p>Medical analysis; Preparation of reports relating to medical matters, health care and medical examination; Professional consultancy relating to health; Healthcare services.</p>	<p>UK 3015037: Class 44: Nutrition advice and information services; nutrition counselling services; provision of nutritional advice, information, supervision and counselling via a website; providing consultation and advice in the fields of nutrition and health; provision of evaluations and assessments in the fields of nutrition and health; consulting, information and advisory services relating to human well-being, nutrition and health, dietary and lifestyle consultancy and analysis services.</p>
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34) The applicant submitted that the opponent's services under UK 3211029 are "*health and wellness* services. There is some similarity with the health and medical services of the Application, but again, to a low degree". As to UK 3015037 it stated that the services "are nutrition related. As such, these form part of broader categories than those included in the Applicant's Mark and there is a degree of similarity. However, this does not apply across the full scope of Class 44; for example, there is no direct link between the *nutrition services* of the Opponent and the *medical services* of the Applicant."

35) To my mind, I am unsure what the difference is between health services and medical services. What is the National Health Service if not a medical service? In my view both of the opponent's specifications encompass the services of the applicant and so these services of both parties must be regarded as identical.

### **Comparison of trade marks**

36) 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

Opponent's trade marks		Applicant's trade mark
EU 11695855		<b>HEALTHSPAN</b>
EU 16262974		
UK 3211029	Healthspan Go Me Healthspan GoMe A series of two trade marks	
UK 3015037	HEALTHSPAN NUTRITION EXPERT	
UK 3003323	HEALTHSPAN ELITE	

38) Neither party has claimed that the term HEALTHSPAN has a meaning, although to my mind it relates to the length of time that a person is healthy rather than just alive as is indicated by the better-known term lifespan. Of the goods and services sought to be registered by the applicant only a few are specific to health and well-being. Although the mark alludes to the goods and services keeping one healthy, it cannot be said to be descriptive. As the applicant's mark is made up of the one word this is the dominant and distinctive element of the mark in suit. All five of the opponent's marks have device elements or other word elements in them. However, the two with device elements are such that although the device will not be ignored by the average consumer, undoubtedly the dominant and distinctive element of both marks is the word HEALTHSPAN. Visually these two marks are highly similar to the mark in suit whilst aurally they are identical. To my mind, neither of the device elements provides any conceptual input and so the marks must be considered conceptually identical. Overall both of the opponent's marks EU 11695855 and EU 16262974 are highly similar to the instant mark.

39) Turning to consider the opponent's marks which have additional words the first (UK 3211029) has the terms GO ME and GOME after the word HEALTHSPAN. There is no such word as "gome" and in my view the average consumer will still see the two words as separate GO and ME. However, the words are meaningless in terms of the goods and services and do not form a unit in themselves or

with the first word in the mark. They will be seen independent elements in addition to the first word HEALTHSPAN. There are obvious visual and aural differences because of the presence of the additional elements but also the similarity of the first word to the mark in suit. Conceptually the words GO ME do not really add much if anything to the conceptual meaning of the dominant element and so there is a medium degree of conceptual similarity. Overall, the marks are, in my opinion, similar to a medium degree.

40) Comparing the mark in suit to the opponent's mark UK 3015037, it is clear that they share the same first word but differ visually and aurally thereafter as the opponent's mark has two additional words. The words NUTRITION EXPERT combine, to my mind, to form a unit with the term HEALTHSPAN to suggest an individual who specialises in advising on nutrition in order to promote a healthy life. The conceptual messages are therefore different. Overall the marks are similar to a low degree.

41) Lastly, I turn to consider the opponent's mark UK 3003323 HEALTHSPAN ELITE. Comparing this to the mark in suit it is clear that they share the same first word but differ visually and aurally thereafter as the opponent's mark has the additional word ELITE. In my view, the two words form a unit to suggest a select group who enjoy particularly healthy lives. Overall, the marks are similar to a low degree.

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

42) 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).”

43) The opponent’s marks, whilst allusive of good health, have no meaning that I am aware of in respect of the goods and services for which they are registered. To my mind, they all **have an average degree of inherent distinctiveness**. The opponent has provided some evidence of use, but in a very cursory fashion and has failed to put the evidence of turnover into context of market share, or even to specify what mark or marks the turnover relates to and in regard of which of the goods and services the turnover accrued. Given that the marks are registered for a wide range of goods and services and that the marks differ significantly the opponent **cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods and services for which its marks are registered**.

### **Likelihood of confusion**

44) 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 goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a medium to high degree of attention to the selection of the goods and services in question.

- the opponent's marks EU 11695855 and EU 16262974 are similar to the mark in suit to a high degree; the opponent's mark UK 3211029 is similar to the mark in suit to a medium degree, and the opponent's marks UK 3015037 and UK 3003323 are similar to a low degree.
- the opponent's marks have an average degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the goods of the two parties range in similarity from identical to not similar, as shown below:

Applicant's specification	Opponent's mark	Outcome
<p>In Class 9: Measuring and testing apparatus and instruments;</p> <p>In class 9: Application software; Computer software platforms; Computer programs; Data encryption apparatus; Data processing equipment and computers; Data storage media; Data banks; Data conversion apparatus; Data networks; Data processing programs; Electronic publications (downloadable); Interface software; Teaching apparatus and instruments.</p>	UK 3211029: class 9	Identical  Not similar
<p>In Class 35: Business management;</p> <p>Business administration;</p> <p>Analysis of business data; Business data analysis; Business consultancy; Business research and survey services; Compilation of statistics; Data processing; Database management; Processing, collection, compilation, verification, preparation, retrieval, analysis, interpretation, management, comparison and dissemination of business information, data and statistics; Statistical analysis and</p>	<p>EU 11695855 UK 3003323: EU16262974; class 35</p> <p>EU 11695855 UK 3003323:</p> <p>EU 11695855 UK 3003323: EU16262974; class 35</p>	<p>Identical</p> <p>identical</p> <p>medium to high degree of similarity</p>

reporting; Business information services provided online from a global computer network of the Internet.  Opinion polling; Patient statistical information and analysis;	EU 11695855 UK 3003323: EU16262974; class 35	Not similar
In Class 41: Arranging and conducting of conferences, congresses and symposiums; Conducting courses, seminars and workshops; Education; Entertainment; Healthcare education; Providing of training; Providing electronic publications; Publishing and reporting; The provision of on-line electronic publications and digital music (not downloadable) from the Internet; Providing on-line electronic publication (not downloadable); Publication of electronic journals and books, reports and survey online; Publication of survey reports; Sporting and cultural activities; Training services.	UK 3211029: Class 41	Not similar
In Class 44: Medical services; Medical consultation; Medical diagnostic services; Medical analysis; Preparation of reports relating to medical matters, health care and medical examination; Professional consultancy relating to health; Healthcare services.	UK 3211029: Class 44: UK 3015037: Class 44:	Identical  Identical

45) I must also consider the issue of indirect confusion which was set out in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where 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.

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

47) Given the range of marks as well as goods and services to be compared I have set out in the table below the summary findings regarding the similarity between the opponent's various marks and the mark in suit and also the findings regarding the similarity of otherwise between the various goods and services relied upon by the opponent and sought to be registered by the applicant. I must also factor into my decision on the likelihood of confusion all of the other factors set out earlier in the decision.

Opponent's mark	Degree of similarity to instant mark	Class of goods and services applied for	Degree of similarity of Goods and services applied for
EU 11695855	High	Class 35 Class 35 Class 35	Identical medium to high Not similar
EU 16262974	High	Class 35 Class 35 Class 35	Identical medium to high Not similar
UK 3211029	Medium	class 9 class 9 Class 41 Class 44:	Identical Not similar Not similar Identical
UK 3015037	Low	Class 44:	Identical
UK 3003323	Low	Class 35 Class 35 Class 35	Identical medium to high Not similar

48) In view of all of the above, and allowing for the concept of imperfect recollection, when the applicant's mark is used on goods and services which are similar to at least a medium degree, there is

a likelihood of consumers being directly confused into believing that the goods and services applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it, even where the similarity between the marks is low. It stands to reason therefore that the goods and services which are highly similar or identical or where the marks have a high degree of similarity will also cause confusion. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods and services listed below:**

- Class 9: Measuring and testing apparatus and instruments;
- Class 35: Business management; Business administration; Analysis of business data; Business data analysis; Business consultancy; Business research and survey services; Compilation of statistics; Data processing; Database management; Processing, collection, compilation, verification, preparation, retrieval, analysis, interpretation, management, comparison and dissemination of business information, data and statistics; Statistical analysis and reporting; Business information services provided online from a global computer network of the Internet.
- Class 44: Medical services; Medical consultation; Medical diagnostic services; Medical analysis; Preparation of reports relating to medical matters, health care and medical examination; Professional consultancy relating to health; Healthcare services.

49) I also note that in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

50) Therefore, where I have found no similarity in the goods and services there can be no confusion. The opposition under section 5(2)(b) therefore fails in respect of the following goods and services:



- Class 9: Application software; Computer software platforms; Computer programs; Data encryption apparatus; Data processing equipment and computers; Data storage media; Data banks; Data conversion apparatus; Data networks; Data processing programs; Electronic publications (downloadable); Interface software; Teaching apparatus and instruments.
- Class 35: Opinion polling; Patient statistical information and analysis;
- Class 41: Arranging and conducting of conferences, congresses and symposiums; Conducting courses, seminars and workshops; Education; Entertainment; Healthcare education; Providing of training; Providing electronic publications; Publishing and reporting; The provision of on-line electronic publications and digital music (not downloadable) from the Internet; Providing on-line electronic publication (not downloadable); Publication of electronic journals and books, reports and survey online; Publication of survey reports; Sporting and cultural activities; Training services.

51) The last ground of opposition is under section 5(3) which reads:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

52) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to

exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

53) I must firstly consider whether the opponent has met the test for reputation. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

54) In its evidence the opponent contended that it was the third largest “direct” supplier of vitamins and supplements in the UK. It also gave a turnover figure for the last five years and a promotional spend. However, it did not identify precisely which of its marks the vitamins and supplements had been sold under. It has a number of marks registered for a range of goods and services but these figures were not broken down into mark or sectors such as electronic goods, business services etc.

As such the opponent has failed at the first hurdle in that it has not established that it has a reputation in a trade mark for a set of goods and/or services. **The opposition under section 5(3) fails.**

## CONCLUSION

55) The opposition under section 5(2)(b) has been partly successful, but the opposition under section 5(3) fails. The opposition succeeds in respect of the following goods and services:

- Class 9: Measuring and testing apparatus and instruments;
- Class 35: Business management; Business administration; Analysis of business data; Business data analysis; Business consultancy; Business research and survey services; Compilation of statistics; Data processing; Database management; Processing, collection, compilation, verification, preparation, retrieval, analysis, interpretation, management, comparison and dissemination of business information, data and statistics; Statistical analysis and reporting; Business information services provided online from a global computer network of the Internet.
- Class 44: Medical services; Medical consultation; Medical diagnostic services; Medical analysis; Preparation of reports relating to medical matters, health care and medical examination; Professional consultancy relating to health; Healthcare services.

56) The opposition failed in relation to a number of goods and services, in addition some goods and services were not the subject of this opposition. The mark in suit can therefore proceed to registration in relation to the following:

- Class 9: Application software; Computer software platforms; Computer programs; Data encryption apparatus; Data processing equipment and computers; Data storage media; Data banks; Data conversion apparatus; Data networks; Data processing programs; Electronic publications (downloadable); Interface software; Teaching apparatus and instruments.
- Class 16: Books; Instructional and teaching materials (except apparatus); Paper; Periodicals; Photographs; Printed matter; Stationery.

- Class 35: Opinion polling; Patient statistical information and analysis;
- Class 41: Arranging and conducting of conferences, congresses and symposiums; Conducting courses, seminars and workshops; Education; Entertainment; Healthcare education; Providing of training; Providing electronic publications; Publishing and reporting; The provision of on-line electronic publications and digital music (not downloadable) from the Internet; Providing on-line electronic publication (not downloadable); Publication of electronic journals and books, reports and survey online; Publication of survey reports; Sporting and cultural activities; Training services.
- Class 42: Biological, research, clinical research and medical research; Scientific and technological services and research and design relating thereto; Clinical research; Maintaining databases; Research services; Preparation of scientific, technical and health service reports; Quality control; Technical project studies; Electronic storage of business information, data and statistics.

## **COSTS**

57) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

**Dated this 11th day of September 2020**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**