

BL O/0081/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3446275

BY

AVIV SCIENTIFIC LTD.

TO REGISTER THE TRADE MARK:

AVIV

IN CLASSES 9, 35, 41, 42 AND 44

-AND-

THE OPPOSITION THERETO UNDER No. 420085

BY

AXEL SPRINGER SE

Background and pleadings

1. Aviv Scientific Ltd. (“**the Applicant**”) applied to register the trade mark ‘AVIV’ (“**the Contested Mark**”) in the UK on 22 November 2019 in respect of goods and services in Classes 9, 35, 41, 42 and 44. The application was published for opposition purposes in the Trade Marks Journal on 17 January 2020. The goods and services for which registration is sought are laid out in their entirety at **Annex 1** to this decision.¹
2. On 16 March 2020, Axel Springer SE (“**the Opponent**”) opposed the Contested Mark on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is directed at all the goods and services applied for.
3. For the purposes of this opposition, the Opponent relies on three earlier EU trade marks (“**EUTM**”), details of which are set out in the following paragraphs. Although the UK has left the EU (and the EUTMs relied upon by the Opponent now enjoy protection in the UK as comparable trade marks),² the filing date of the Opposition pre-dates ‘IP Completion Day’ (i.e. it was filed before 11:00pm of the 31 December 2020).³ Therefore, I am obliged to decide the opposition on the basis of the law as it stood at the filing date of the Contested Mark, and the EUTMs remain the relevant rights on which the Opponent can base its opposition.

Sections 5(1) and 5(2)(a)

4. Under its sections 5(1) and 5(2)(a) claims, the Opponent relies on the EUTM shown in the table below (“**the Earlier Word Mark**”). The Opponent relies upon

¹ See the ‘Preliminary Issues’ section of this decision with regard to the Applicant’s specification, my paragraphs 11-21.

² As a result of the ‘Withdrawal Agreement’, all EUTMs registered before 1 January 2021 were recorded as comparable UK marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law).

³ Tribunal Practice Notice 2/2020 provides that for oppositions filed on, or after, IP Completion Day against trade mark applications filed before IP Completion Day, as in this case, proceedings should continue to be dealt with under the Act as it existed before IP Completion Day. In other words, the old law continues to apply.

all the services covered by the Earlier Word Mark,⁴ namely, the services in Classes 35, 41, 42 and 45 which are laid out in their entirety at **Annex 2** to this decision.⁵

Representation of the Earlier Word Mark:	AVIV
Registration No.:	EU17995378
Filing Date:	4 December 2018 ⁶
Registration Date:	8 September 2020

5. The Opponent claims that the respective marks are identical and that, all the services covered by its earlier mark are identical (as per its section 5(1) claim) or similar (as per its section 5(2)(a) claim) to all the goods and services applied for; and under its section 5(2)(a) claim, that the identity of the marks and the similarity of the goods and services gives rise to a likelihood of confusion.

Section 5(2)(b)

6. Under its section 5(2)(b) claim, the Opponent relies on two figurative EUTMs shown in the tables below.⁷ The Opponent relies upon all the services covered by the two marks,⁸ namely, the services in Classes 35, 41, 42 and 45 which are laid out in their entirety at **Annex 2** to this decision.⁹

⁴ As the Earlier Word Mark had not been registered for five years or more at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent does not need to show any use at all of the services upon which it relies.

⁵ See the 'Preliminary Issues' section of this decision with regard to the Opponent's specification, my paragraphs 22-26.


⁶ Given the respective filing dates, the Opponent's mark is an earlier trade mark in accordance with section 6 of the Act.

⁷ Given the respective filing dates, the Opponent's EUTMs are earlier trade marks in accordance with section 6 of the Act.

⁸ As these marks had not been registered for five years or more at the filing date of the application, they are not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent does not need to show any use at all of the services upon which it relies.

⁹ See the 'Preliminary Issues' section of this decision with regard to the Opponent's specification, my paragraphs 22-26.

Representation of the mark (“the Group Mark”):	aviv group —
Registration No.:	EU18093284
Filing Date:	10 July 2019
Registration Date:	5 November 2019

Representation of the mark (“the Figurative Mark”):	
Registration No.:	EU17995544
Filing Date:	4 December 2018
Registration Date:	3 September 2020

7. The Opponent claims that the respective marks are similar and that the goods and services applied for are identical or similar to the services covered by its earlier marks, giving rise to a likelihood of confusion.
8. The applicant filed a counterstatement denying the claims made under sections 5(1), 5(2)(a) and 5(2)(b) of the Act. In its later submissions, the Applicant accepted that the Contested Mark is identical to the Earlier Word Mark.¹⁰
9. Neither party filed written submissions nor elected to file evidence during the evidence rounds in these proceedings. Neither party made any request to be heard, instead, both parties elected to file written submissions in lieu of a hearing. I have taken the parties’ submissions into consideration and will refer to them as and where appropriate during this decision. This decision has been taken following a careful perusal of the papers.

¹⁰ See the Applicant’s submissions dated 1 September 2022, paragraph 23.

10. In these proceedings the Opponent is represented by Dehns and the Applicant is represented by HGF Limited.

Preliminary issues

The Applicant's specification

11. These proceedings were initiated on 16 March 2020 by the Opponent's filing of Form TM7 'Notice of Opposition and Statement of Grounds'. Before the filing of the Applicant's Form TM8 'Notice of Defence and Counterstatement', the parties agreed to enter into a cooling off period and the request was filed by the Applicant on 13 July 2020 (the period was set to expire on 12 February 2021). The parties agreed to an extension of that cooling off period and a request for the extension was filed by the Opponent on 11 February 2021, stating that the reason for the request was to *"allow the parties further time to negotiate a settlement of the opposition proceedings"* (the extension period was set to expire on 12 November 2021).

12. On 4 November 2021, whilst still in the cooling off period, the Applicant filed Form TM21B 'Change of Details to an application', amending the specification of Classes 9, 41 and 42 by applying a limitation to them and by removing terms from Classes 41 and 42 as follows:

Limitation: *"none of the aforesaid provided in relation to publishing services, digital classified advertisements or marketing outside the medical field"*

Class 41 terms removed: *"Education; providing of training"*

Class 42 terms removed: *"Research and development services; scientific research and development"*

13. On 12 November 2021 the Applicant filed its Form TM8.
14. On 7 December 2021, despite the amendments made to the Applicant's specification, the Opponent confirmed it wished to proceed with the Opposition.
15. After due course, as neither party requested an oral hearing, the parties were given the deadline of 1 September 2022 by which they should file their final

written submissions in these proceedings. In its letter notifying the Applicant of this deadline, the Tribunal stated that if the Applicant considered it had “*a fall-back position in the form of a limited specification, it should make this clear to the Hearing Officer as part of written submissions [and that] a fall-back specification will not represent a binding restriction and no inference will be made by the Hearing Officer, if such a limitation is, or is not, offered.*” The Tribunal’s letter also clarified that a limited specification should not be submitted for the first time at any appeal hearing.

16. The Opponent filed its submissions on 31 August 2022 and the Applicant filed theirs on 1 September 2022. The Applicant’s submissions did not include a fall-back position.
17. On 31 August 2022, the Applicant filed a second Form TM21B to amend its trade mark application. However, this second TM21B was not filed in relation to these proceedings – it was filed in relation to separate opposition proceedings. The Applicant requested the following limitation be applied to all the Classes in its application:

“none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only”.
18. The Tribunal queried whether this form was filed as a fall-back position. The Applicant confirmed in writing (on 22 September 2022) that the Tribunal should process the amendments at that particular stage in these current opposition proceedings. As a consequence, the amendments to the specification were made subsequent to the filing of the Opponent’s final written submissions.
19. Given that the amendment to the specification may also have affected these proceedings, the Tribunal wrote to the Opponent requesting whether, as a result of the amendments to the Applicant’s specification, it would wish to withdraw its opposition. On 11 November 2022 the Opponent confirmed that it wished to proceed with the opposition.

20. Although the parties' final written submissions pre-date the amendments made to the Applicant's specification, I am satisfied that it does not have any material effect in relation to those submissions. I am also satisfied that the Opponent has been given the opportunity to consider the amendments and provide its response, i.e. that it wished to proceed with the opposition regardless.
21. The Applicant's specification put forward for me to consider in these proceedings is therefore the specification (as amended by both Form TM21Bs) as set out at **Annex 1** to this decision.

The Opponent's specification

- Limitations:

22. The Opponent's three EUTMs are: (1) the Earlier Word Mark; (2) the Group Mark; and (3) the Earlier Figurative Mark.

23. Marks (1), (2) and (3) all contain the following limitation in respect of Classes 35, 41 and 42 services (my emphasis):

"None of the aforesaid services relating to or used in connection with insurance and/or monetary affairs."

24. Therefore, this limitation is, broadly, excluding the same 'subject matter' (i.e. insurance and monetary affairs) as the limitation that applies to the Applicant's Classes 9, 35, 41, 42 and 44 goods and services (insofar as that limitation excludes services connected with 'insurance' and 'financial or monetary matters'). For the purposes of the goods and services comparison, I shall proceed on the basis that the respective specifications, in essence, exclude services relating to 'insurance and monetary affairs'.

- Wording of the specifications:

25. Marks (1), (2) and (3) contain identical wording, save for a slight variation in the following term in Class 45:

- (a) marks (1) and (2) contain the term: “*advisory, consulting and information services regarding the forgoing in this class*”; and
- (b) mark (3) contains the term: “*consulting and information services relating to the above mentioned services, (included in Class 45)*”.

These terms are self-evidently identical with the exception that marks (1) and (2) also include ‘advisory’ services, which mark (3) does not. However, this difference does not materially affect the term since ‘consultancy’ services could also encompass ‘advisory’ services.

26. I shall therefore proceed on the basis that all three of the specifications for the Opponent’s EUTMs are identical. The Opponent’s specification is therefore as set out in its entirety at **Annex 2** to this decision.

DECISION

Legislation and Case Law

27. Sections 5(1), 5(2)(a), 5(2)(b) and 5(A) of the Act are as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...]
- (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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

28. I am guided by 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Approach

29. Given that the specifications of all three of the Opponent's EUTMs are in essence identical, by carrying out the goods and services comparison for the one, I am also carrying out the goods and services comparison for the others, therefore I shall only carry out one goods and services comparison in this decision (as opposed to separate comparisons for each EUTM).

30. I shall firstly consider the claims under sections 5(1) and 5(2)(a) of the Act. If the opposition under these sections is entirely successful, then it follows (given the identity between all three earlier specifications) that there will be no need to consider the claim under section 5(2)(b) as it would not materially improve the Opponent's position.

Comparison of goods and services

31. In *Gérard Meric v Office for Harmonisation in the Internal Market*,¹¹ (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

32. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

33. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:¹²

(a) the physical nature of the goods or acts of service;

(b) their intended purpose;

(c) their method of use / uses;

¹¹ Case T- 133/05

¹² See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

- (d) who the users of the goods and services are;
- (e) the trade channels through which the goods or services reach the market;
- (f) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (g) whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)

or

- (h) whether they are complementary to each other. 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”*.¹³ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.¹⁴

34. When interpreting the terms in a specification I bear in mind:

- (a) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“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 [and services] in question”*,¹⁵
- (b) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be*

¹³ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

¹⁴ *Kurt Hesse v OHIM*, Case C-50/15 P

¹⁵ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

*used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”;*¹⁶

(c) the following applicable principles of interpretation:

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

*(4) A term which cannot be interpreted is to be disregarded.”*¹⁷

35. The goods and services to be compared are set out in **Annexes 1 and 2** to this decision. For ease of reference, I have inserted the Class numbers of the goods and services being compared in the table below:

Opponent	Applicant
	9
35	35
41	41
42	42
	44
45	

¹⁶ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

¹⁷ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

36. Both parties' specifications contain a large number of terms, and what is particularly discernible is that both specifications contain, inter alia, broad terms that cover a wide range of goods and services that would transcend any one particular field and/or any one particular market sector. For example, the Applicant's 'computer software' in Class 9, the Opponent's 'business management' in Class 35 and 'education' services in Class 41, and the Applicant's 'design and development of computer hardware and software' in Class 42, to name a few.
37. I am generalising (and do not intend to characterise either party's specification) when I note that what is also discernible after reading the parties' specifications as a whole, is that the Opponent's specification does not appear to be anchored to a particular field or market sector per se, and that the Applicant's specification includes, inter alia, terms that have a medical connotation and/or are anchored in the medical field/medical sector.
38. For example, both parties have terms in Class 35 that relate to the compilation of data. Generally, Class 35 services include services rendered with the object of helping with the working or management of a commercial undertaking, or helping in the management of business affairs or commercial functions of an industrial or commercial enterprise. Essentially both parties' services can broadly be described as business administration services within the parameters of Class 35, however, the Applicant's term specifies that the compilation of data service is for research purposes in the field of medical science etc., whereas the Opponent's term is neutral as to the field of activity.¹⁸ Therefore the Opponent's term could relate to rendering services to a business that operates in the medical sector and/or a number of different fields of activity.
39. By way of another example, the same can be said of the Applicant's services in Class 41 for the provision of educational classes in the field of hyperbaric medicine (they are evidently educational services, however they are related to

¹⁸ Save for the limitation which specifically indicates what fields the Opponent's Class 35 services do not relate to.

the medical field) and the Opponent's neutral education services in Class 41 (that could relate to numerous fields of education, including the medical field).

40. That being said (irrespective of any generalising comments I have made about the parties' specifications when viewed in the whole) my comparison is guided by the provisions of section 60A of the Act and the principles of comparison as set out above, and by having regard to the wording contained in each term within the parties' specifications.
41. For the purposes of making my comparison, I have grouped the goods and services where the same reasoning applies.¹⁹
42. I note that I have taken into account that the parties' specifications are both subject to limitations, however these limitations do not affect the assessments I have made below.

Class 9

43. 'Computer software and hardware'
 - (i) The Applicant's specification contains the following 'computer software and computer hardware' goods (my emphasis):

"Computer software; computer hardware; application software; recorded computer software for database management; computer hardware and downloadable computer software for collecting and viewing data associated with the use of hyperbaric chambers for medical treatment; computer hardware and downloadable computer software for collecting, understanding, analysing and viewing data associated with the medical record of a patient; computer hardware and downloadable computer software for managing Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records for patients that is comprised of (one, two or three) Diagnostic Data, Data collected from wearables and Internet of Medical Things (IoMT) and Data Analytics

¹⁹ *Separode Trade Mark* BL O/399/10, paragraph 5

of a large database-base population; computer hardware and downloadable computer software for collecting, viewing, automatic detection and analysis data associated with the use of MRI for patient diagnostic and treatment; computer hardware and downloadable computer software for automation of MRI Scans processes and procedures; computer hardware and downloadable computer software for collecting, detecting, analysis and viewing data associated with (defending) cybersecurity systems; computer hardware and downloadable computer software for collecting, analysis, manipulation and viewing data associated with a mapping of Genome (DNA) and the Epigenetics (RNA, Telomeres and Stem cells) of a patient; computer hardware and downloadable computer software for collecting, analysis and viewing data associated with the use of cognitive and neurocognitive assessment, diagnostic and training of patients; computer hardware and downloadable computer software for Virtual Reality (VR)-based cognitive assessment and training; computer hardware and downloadable computer software for collecting and viewing data associated with the use of Virtual Reality (VR)-based cognitive assessment and training of patients; computer hardware and downloadable computer software for mobile application for screening, monitoring, analysis, and viewing of healthcare data for patients; downloadable computer software applications for use with mobile devices for monitoring and managing patient medical information; computer hardware and downloadable computer software for screening, monitoring, analysis, and viewing of healthcare data for patients using wearables, Internet of Medical Things (IoMT)-based and Internet of Things (IoT)-based devices; computer hardware and downloadable computer software for big data and analytics of healthcare, medical records, across all medical disciplines; computer hardware and downloadable computer software for collecting and viewing data associated with the use of physical assessment and training of patients; computer hardware and downloadable computer software for managing medical and healthcare centers; computer hardware and downloadable computer

software for managing scheduling for healthcare and medical centres' staff; computer hardware and downloadable computer software for managing scheduling patients' assessments treatments, training and meetings; computer hardware and downloadable computer software for managing patients' finance (CRM); computer hardware and downloadable computer software for managing healthcare centres' supplies (ERP); computer hardware and downloadable computer software for managing Enterprise Resource Planning (ERP) solutions; computer hardware and downloadable computer software system of alerts and messaging between professionals and patients; computer hardware and downloadable computer software for patients' cognitive training inside HBOT (Hyperbaric oxygen therapy) chambers (HBOs); computer hardware and downloadable computer software for patients' entertainment inside HBOT (Hyperbaric oxygen therapy) chambers (HBOs); computer hardware and downloadable computer software for collecting, monitoring, analysing and viewing data of wearables and Internet of Medical Things (IoMT) devices for medical and healthcare usage; downloadable computer software for interpretation of neuro and brain scans provided via diagnostic imaging equipment; advice, information and consultancy in relation to all above goods"

- (ii) The Opponent's Class 42 specification contains computer software and hardware 'development services' namely:

"IT services, namely development of computer software, development of computer hardware; consultancy and information in relation to the aforesaid services, included in this class"

as well as 'software as a service', namely:

"IT services, namely software as a service (SaaS); consultancy and information in relation to the aforesaid services, included in this class"

(a) The Opponent's 'development services'

There is a difference in nature between the Applicant's computer software (including application software) and computer hardware goods and the Opponent's development services. (The difference in nature arises from the fundamentally intangible nature of services in contrast to goods.) There is also a difference in purpose and method of use. That said, the goods are the end results of the development services, therefore there would be a degree of overlap in user. This is because the user of the services would have commissioned those services because they require specific software and/or hardware for their own use (in which case it follows that they are therefore also the user of the resultant goods). The respective goods and services may reach the market through the same trade channels as the same undertaking may provide both, and there may be a degree of complementarity between the goods and the services. I therefore find a **low degree** of **similarity** between the Applicant's goods and the Opponent's 'development services'.

(b) The Opponent's 'software as a service'

(1) I interpret "*software as a service*" as software being delivered as an 'on demand' service. For example, relating to the delivery of web-based software and applications that are accessed online via a subscription, as opposed to traditional 'software as a product' where the software would be bought/licensed and installed on individual computers.

(2) An analogous situation may be in relation music and films that can be accessed via web-based subscription streaming services as opposed to buying the products themselves by, for example, purchasing a downloadable file containing the music/film or purchasing a physical recording of the music/film such as a CD or DVD for example.

- (3) With this in mind, there is a degree of similarity between the Applicant's 'software goods' and the Opponent's services. This is because they would overlap in their intended purpose and their method of use. The users are likely to be the same and the respective goods and services may reach the market through the same trade channels as the same undertaking may provide both. They are also likely to be in competition with each other as the consumer may select one above the other and they would also be complementary to each other. The Applicant's 'software goods' are **similar** to the Opponent's services to at least a **medium degree**.

44. 'Wearable monitors'

- (i) The Applicant's specification contains the following goods (my emphasis):

"wearable monitors; wearable activity trackers; wearable, Internet of Medical Things (IoMT) and Internet of Things (IoT) monitors used to measure biometric data for medical and general data analysis purposes"

- (ii) My understanding is that these 'wearable devices' are electronic devices that are capable of collecting, transmitting and presumably storing data. For example, data that can be used to provide healthcare to the person wearing the device i.e. data in relation to physiological parameters such as a person's pulse, their sleeping habits, step count and exercise data. These devices can also have automated alert and monitoring capacities and would be capable of transmitting the data collected (perhaps to a computer network) where it can be analysed in order for medical professionals to provide patients with medical assistance for example.²⁰

²⁰ I make this interpretation and provide these examples by having regard to the Applicant's specification, namely, the terms within their specification that refer to such 'wearable' devices and the kind of functionalities they have and/or the type of data collected by them (included in Classes 9, 42 and 44 of the Applicant's specification).

- (iii) I therefore interpret these 'wearable devices' as being a type of wearable computer hardware, particularly when bearing in mind the above and also by taking into account the ordinary meaning of the word computer, and the ordinary meaning of the word hardware (relating to computers).²¹
- (iv) With this in mind, using the same reasoning as above (insofar as it applies to computer hardware),²² I find there is a **low degree** of **similarity** between the Applicant's goods and the Opponent's 'development of computer hardware' services.
- (v) In addition, given the nature and purpose of the wearable devices, they could also be complementary to the following services in the Opponent's Class 42 specification (and may also overlap in user as well as trade channels):

"IT services, namely data mining, computer services, monitoring of computer systems by remote access;"

This is because the IT services i.e. computer services could relate to the provision of wearable devices. The IT services could also monitor the computer systems that collect the data from the devices, and they could also interpret/analyse that data i.e. through the service of data mining.²³ There is therefore a **low degree** of **similarity** between them.

²¹ See the Oxford English Dictionary (www.oed.com) entries for: (i) 'computer': *"an electronic device (or system of devices) which is used to store, manipulate, and communicate information, perform complex calculations, or control or regulate other devices or machines, and is capable of receiving information (data) and of processing it in accordance with variable procedural instructions (programs or software); esp. a small, self-contained one for individual use in the home or workplace, used esp. for handling text, images, music, and video, accessing and using the internet, communicating with other people (e.g. by means of email), and playing games"*; and (ii) 'hardware': *"the physical portion of a computer system, including electrical, electronic, electromechanical, and mechanical components (as a disk drive, CPU, keyboard, etc.). As a mass noun: computing or electronic devices or components considered collectively."*

²² See my paragraph 43(ii)(a).

²³ 'Data mining' being the process of examining and analysing data (typically using specialized computer software) in order to generate new information, for example, in order to find out about people's habits. It involves collecting information from data stored in a database. See the dictionary entries for 'data mining' in the Oxford English Dictionary (www.oed.com) and the Collins English Dictionary (www.collinsdictionary.com).

Class 35

45. Data

The following services in the Applicant's specification, namely (my emphasis):

"Compiling, collecting of data for research purposes in the field of medical science, digital health and medical consultancy; compiling data for research purposes in the field of medical science and medical consultancy"

are services for the compilation and collection of data. As such, they fall within the following broad category in the Opponent's specification:

"compilation, systemization, updating and maintenance of data and information into computer databases"

These services are **identical** on the principle outlined in *Meric*.

46. Management

The following services in the Applicant's specification, namely:

"healthcare and healthcare management services in the nature of establishing and managing hyperbaric oxygen therapy centers"

are, within the context of Class 35 services, the kind of services that establish (for example they assist in the set-up and development of a new facility) and manage the running of a healthcare facility. I bear in mind that healthcare facilities can be private enterprises that are run for profit (i.e. they can be regarded as a 'business'). As such, the Applicant's services in Class 35 fall under the following broad categories in the Opponent's specification (noting that the Opponent's services are not limited to any particular kind of business):

"Business assistance, management and administrative services; Business administration; Company management and development services in the form of assistance for start-up companies, for others"

These services are **identical** on the principle outlined in *Meric*.

Class 41

47. Education, providing of training

- (i) The Applicant's specification, contains the following terms (my emphasis):

“providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of hyperbaric medicine;

providing educational classes, training, conferences, non-downloadable webinars and workshops to cybersecurity of medical centers and healthcare services;

providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records;

providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of MRI;

providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of Neurocognitive assessment, diagnostic and training;

providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of physiological assessment, diagnostic and training;

providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of medical usage of wearables, Internet of Medical Things (IoMT) devices and Internet of Things (IoT) devices;

providing medical technology training services;

computer-based simulation training services in the field of medical technology;

conducting educational support programmes for patients”

educational services, namely, hyperbaric oxygen therapy training courses;

educational services, namely, aging, stroke, TBI (traumatic brain injury), fibromyalgia assessments and rehabilitation courses;

educational services, namely biomarkers assessments courses;

education services, namely, providing online cognitive assessments and training programs that help identify cognitive strengths and weaknesses of an individual;

advice, information and consultancy in relation to all above services”

The core meaning of the services being described is education and training services. As such, the Applicant’s services above fall under the following broad categories in the Opponent’s specification:

“Instruction, education, providing of training; conducting courses, seminars and workshops; consultancy and information in relation to the aforesaid services, included in this class”

These services are **identical** on the principle outlined in *Meric*.

- (ii) The term “*physical training*” in the Applicant’s specification is a form of training within the meaning of Class 41 services. It falls under the broad category of “*providing of training*” in the Opponent’s specification. These services are therefore **identical** on the principle outlined in *Meric*.

48. Publishing

The following services in the Applicant's specification, namely (my emphasis):

"publishing and issuing of scientific papers in relation to medical technology; publishing and issuing scientific papers in relation to medical technology, digital health and the mix between technology and medicine; none of the aforesaid provided in relation to publishing services, digital classified advertisements or marketing outside the medical field"

fall under the following broad category in the Opponent's specification:

"publishing and reporting"

These services are **identical** on the principle outlined in *Meri*.

Class 42

49. Design

The following services in the Applicant's specification (my emphasis):

"scientific and technological services and design relating thereto; design of computer hardware and software; design of mobile applications for monitoring, viewing, analysis and alerting of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records; design of Virtual Reality (VR)-based cognitive assessment and training; advice, information and consultancy in relation to all above services"

all fall within the following categories in the Opponent's specification:

"design services; consultancy and information in relation to the aforesaid services, included in this class".

These services are **identical** on the principle outlined in *Meri*.

50. Development

The following services in the Applicant's specification (my emphasis):

"development of computer hardware and software; development of mobile applications for monitoring, viewing, analysis and alerting of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records; development of Virtual Reality (VR)-based cognitive assessment and training"

all fall within the following broad categories in the Opponent's specification:

"IT services, namely development of computer software, development of computer hardware"

These services are **identical** on the principle outlined in *Meric*.

51. Technological services and research

The following term in the Applicant's specification, namely:

"technological services and research relating thereto"

is a broad term that covers the following services in the Opponent's specification:

"IT services, namely research of computers and computer systems; IT services, namely technological services in relation to computers, computer networking, updating of memory banks in computer systems, data migration, updating of websites, for others, monitoring of computer systems by remote access"

These services are **identical** on the principle outlined in *Meric*.

52. Data

(i) Analysis and processing

(a) The following services in the Applicant's specification, namely:

“analysis of data, engineering services relating to data processing for research purposes in the field of medical science, digital health and medical consultancy”

are services for the analysis and the processing of data.

- (b) I interpret the following services in the Applicant’s specification, namely:

“providing an interactive website featuring technology that enables users to enter, access, track, monitor and generate health and medical information and reports”

as also services for the analysis and processing of data, insofar as the technology available via the website enables users of the website to enter their data (i.e. health and medical information) which is then analysed (tracked and monitored) and processed so as to generate a report, presumably on the interpretation of that data.

- (c) The following services in the Opponent’s specification:

“IT services, namely data duplication and conversion; IT services, namely data mining, data migration”

are services for the processing (i.e. duplication, conversion and migration) and analysis (i.e. mining) of data.

- (d) As such, the Applicant’s services (referred to in my paragraphs 52(i)(a) and (b) above) fall within the broad categories contained in the Opponent’s services and vice versa. These services are therefore **identical** on the principle outlined in *Meric*.

(ii) Sharing and collaboration

- (a) The following services in the Applicant’s specification, namely:

“sharing and collaboration of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records”

relate to the sharing of and collaboration (i.e. gathering or bringing together) of records. ‘Records’ can be a collection of data.

- (b) With this in mind, the Applicant’s services fall within the broad categories contained in the following services in the Opponent’s specification (and vice versa), namely:

“IT services, namely data duplication and conversion; IT services, namely data mining, data migration”

The respective services are therefore **identical** on the principle outlined in *Meric*.

- (c) In the **alternative**, they are at least **similar to a high degree** since the sharing of data would essentially involve the gathering of data and then moving it from one location to another – this encompasses the process of ‘data migration’ i.e. gathering and moving data sets (for example records) from one location to another. It could also involve the ‘conversion’ of that data (for example, from one format to another) and the ‘duplication’ of that data. It also follows that in order to mine data, it would require the gathering (i.e. ‘collaboration’) of that data.
- (d) The respective services would therefore overlap in purpose and nature and they would also overlap in method of use, and user. They may also reach the market through the same trade channels and they would also likely be complementary to each other since, for example, one purpose of sharing and collaborating the medical records (data) could be for it to be analysed and interpreted (i.e. ‘mined’).

(iii) Electronic data collection

- (a) The following service in the Applicant's specification, namely (my emphasis):

“electronic monitoring of physiological parameters, including pulse, saturation, sleeping habits, steps, exercise, mention level using computers and sensors [electronic data collection]”

is for electronic data collection (via electronic monitoring) using computers and sensors. As such, it falls within the following broad categories in the Opponent's specification, namely:

“IT services, namely data mining, computer services, data migration, monitoring of computer systems by remote access; IT services, namely data conversion, data encoding”

The respective services are therefore **identical** on the principle outlined in *Meric*.

- (b) In the alternative, there is a degree of similarity between them. This is because:

- (1) there would be an overlap in their nature, since the collection of electronic data using computers and sensors (in the Applicant's specification) is in the nature of an *'IT service, namely a computer service'*, and it could also encompass the *'monitoring of computer systems'* (that are collecting the data) by remote access. The collection of the electronic data would also encompass the *'migration'* of that data (since the data collected would likely be transferred to other systems in order for it to be analysed);
- (2) they would overlap in their method of use, since the service of collecting electronic data may be used in the same way as an *'IT service, namely a computer service'*;

- (3) they may overlap in their intended purpose, since collecting electronic data by electronic monitoring of physiological parameters, is likely to be with the intended purpose of collating that data and analysing it in order to provide insight and generate information into people's sleeping habits for instance, which overlaps with the intended purpose of 'data mining'; as such
- (4) there may also be overlap in the user of the respective services; and
- (5) the Applicant's services would be complementary to the Opponent's services for example, they would be used together since the Opponent's 'IT services, namely computer services', would enable the collection of the electronic data. Also, the Applicant's data collection services are complementary to the IT services of 'data migration', 'monitoring of computer systems by remote access', 'data conversion' and 'data encoding'.

Therefore, in the alternative, I find the Applicant's services to be **similar** to the Opponent's services to a **medium degree**.

(iv) Data security

The following services in the Applicant's specification, namely:

"data security services, including cybersecurity of medical centers and healthcare services"

fall within the Opponent's following broad category of services, namely:

"IT services, namely IT security and protection, data encoding"

since the IT security services can be regarded as synonymous with

cybersecurity,²⁴ and since the Opponent's services would encompass data security – as data security would be a form of IT security and protection. In addition, data encoding involves the transformation of information/ data into code,²⁵ which is a broad term that would encompass data security perhaps for example, data security in the form of data encryption.²⁶ These services are therefore **identical** on the principle outlined in *Meric*.

(v) Electronic storage (of data)

(a) I have already stated that my interpretation of “*software as a service*”, in the Opponent's Class 42, is that it relates to web-based software and applications. This can encompass software services for cloud-based storage of files, records, documents, data etc.

(b) The following services in the Applicant's specification, namely:

“electronic storage of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records”

are essentially services for the electronic storage of records. They therefore fall within the following broad category in the Opponent's Class 42 specification:

“IT services, namely software as a service (SaaS)”

since electronic storage of records would include cloud-based storage of records (provided as ‘software as a service’). And they

²⁴ I note that ‘cyber’ indicates that something relates to, inter alia, computers and information technology – see the Collins English Dictionary (www.collinsdictionary.com) and the Oxford English Dictionary (www.oed.com)

²⁵ See the entry for ‘encode’ in the Collins English Dictionary (www.collinsdictionary.com) and the Oxford English Dictionary (www.oed.com) e.g. “*to convert (a message) from plain text into code*”; “*to translate into cypher or code*”; a synonym of ‘encode’ is ‘encrypt’ according to the Collins English Dictionary entry for ‘encode’.

²⁶ See the entry for ‘data encryption’ and the related entry for ‘encrypt’ in the Collins English Dictionary – www.collinsdictionary.com e.g. “*if a document or piece of information is encrypted, it is written in a special code*”

also fall within the Opponent's broad category of "IT services, namely computer services" since 'computer services' could encompass the storage of information. The Applicant's services are therefore **identical** to the Opponent's services, on the principle outlined in *Meric*.

- (c) In addition, the Applicant's services are complementary to the following services in the Opponent's Class 35 specification, namely:

"compilation, systemization, updating and maintenance of data and information into computer databases"

as the respective services would likely be used together. It therefore follows that they would overlap in user. These services are **similar** to a between a **low and medium degree**.

53. Research, analysis and testing

- (i) The Opponent's specification contains the following services:

"testing; consultancy and information in relation to the aforesaid services, included in this class"

- (ii) "Testing" in the Opponent's specification is a broad term. Within the context of Class 42, it would encompass 'testing' in relation to 'scientific and technological services'.²⁷ As such, I find the Opponent's "testing" services **identical** (on the principle outlined in *Meric*) to the following services in the Applicant's specification (my emphasis):

"scientific and technological services, namely, scientific testing in the field of hyperbaric therapy"

²⁷ When taking into account the kind of services covered by Class 42 i.e. "Scientific and technological services and research and design relating thereto; industrial analysis and industrial research services; design and development of computer hardware and software"

- (iii) 'Testing' is the act or process of examining something or someone, or experimenting with something. The purpose of the testing would be to generate information that can be analysed as part of conducting research; that information could, for instance, relate to chemical or biological properties of something, or it could relate to the technical performance of a device. For example, testing would form part of the research and analysis conducted as part of a clinical trial for a new vaccine; and testing would form part of the research and analysis when developing new medical instruments in order to ensure they perform their intended functions correctly and accurately.
- (iv) 'Testing' would play a role in scientific, technological and medical research and analysis. It would form part of, and perhaps be intrinsic to that research and analysis.
- (v) With that in mind, there is a degree of similarity between the Opponent's services, of:

"testing; consultancy and information in relation to the aforesaid services, included in this class"

and the following services in the Applicant's specification that relate (broadly) to scientific, technological and medical 'research and analysis', namely (my emphasis):

"chemical, biochemical, biological and bacteriological research and analysis; medical and scientific research, namely, conducting clinical trials for others; providing medical and scientific research information in the field of clinical trials; scientific and technological services, namely, scientific research and analysis in the field of hyperbaric therapy; technology research in the field of medical instruments; scientific consulting and research services relating to foods and dietary supplements"

- (vi) This is because the purpose and the nature of 'testing' would overlap with the purpose and nature of 'research and analysis', and they would overlap

in their method of use and user. There will also be overlap in trade channels as the same undertaking providing the testing services would likely be the same undertaking carrying out the analysis of the results of those tests as part of their research. There would also be complementarity between the services of testing and the services of research and analysis. The respective services are **similar** to a **medium degree**.

54. Information regarding medical devices

- (i) With regard to the Applicant's services in Class 42 that relate to 'medical devices' the Opponent has submitted that such medical devices "*could be computerised (for example, robotic surgical apparatus)*".²⁸ I agree with this observation, I also consider that 'medical devices' is a broad term that could encompass medical devices that have integrated computers that are used, for example, as medical diagnostic devices. Medical devices could also refer to specialist computerised machines that are adapted for use in medical care. With that in mind, there is a degree of similarity between the following services in the Applicant's specification:

"providing technological information regarding medical devices"

and the following broad services in the Opponent's specification:

"IT services, namely computer services, technological services in relation to computers; consultancy and information in relation to the aforesaid services, included in this class"

- (ii) This is because the respective services would overlap in purpose and nature as they could both essentially be providing technological information in relation to technological devices. There would therefore be overlap in method of use and user. There may be overlap in trade channels as the same undertakings may provide the same technological

²⁸ See paragraph 22 of the Opponent's submissions dated 31 August 2022.

information services. There would also be a degree of complementarity between them. As such, the services are **similar** to a **medium degree**.

55. Medical laboratory services

- (i) The Applicant has applied for “*medical laboratory services*”. I interpret medical laboratory services as services relating to laboratory testing, for example, testing of medical specimens and recording the results. ‘Testing’ is a broad term, which, within the context of Class 42 services, could encompass ‘laboratory testing’.²⁹ As such, I consider the Applicant’s services to be complementary to the Opponent’s services of “*testing*”.
- (ii) They would also likely overlap in purpose, nature, method of use and user, since the user of the services is likely to require the services because they want medical tests carried out, perhaps for diagnostic purposes. It is tenable that the user may synonymously refer to the ‘medical laboratory services’ as ‘testing services’, since it may be implied that the tests would be carried out by a laboratory. There would also be overlap in trade channels, since the organisation providing the medical laboratory services could be the same organisation carrying out the testing. I consider these services to be **similar** to a **medium degree**.

Class 44

56. Before proceeding with my comparison between the Applicant’s Class 44 services and the Opponent’s services, I note that the Applicant’s specification contains general categories that are broad in their scope. For example, the term “*medical services*” is one such term. I will keep these broad terms in mind when carrying out my comparison and I will return to this point when I reach my conclusions in relation to this opposition.

²⁹ ‘Laboratory testing’ is a term that is included in Class 42

57. Rehabilitation and physical therapy

- (i) The Applicant's specification contains the following 'rehabilitation' and 'physical therapy' services in Class 44 (my emphasis):

“physical rehabilitation services; rehabilitation services for patients with traumatic brain injury (TBI), or other cognitive or physical brain impairment including strokes; physical therapy services; medical, physical rehabilitation and physical therapy services; physical therapy evaluation, identification, and management of movement dysfunction to restore, maintain, and promote optimal physical function prevent the onset, symptoms and progression of impairments, functional limitations and disabilities resulting from disease, disorders, conditions or injuries; rehabilitation patient care services”

- (ii) 'Rehabilitation' involves inter alia, the treatment of physical conditions through targeted exercises;³⁰ it encompasses the restoration of a person's physical health following medical treatment and intervention to aid, for example, in the recovery from surgery or from an injury. 'Physical therapy' can involve the treatment of physical disorders by some physical means (as opposed to surgical means)³¹ to *“restore, maintain, and promote optimal physical function”*; for example, a person suffering from a knee ailment may require physical therapy.³²

- (iii) The Opponent's Class 41 specification includes the following services:

“providing of training; consultancy and information in relation to the aforesaid services, included in this class”

'Providing of training' is a broad term which would cover a wide range of services. Within the context of Class 41 services, 'training' can encompass the teaching of new skills (or relearning of skills) and it can also encompass services that relate to physical exercise, for example,

³⁰ See the entry for 'rehabilitation' in the Collins English Dictionary (www.collinsdictionary.com).

³¹ See the entry for 'therapy' in the Collins English Dictionary (www.collinsdictionary.com).

³² As per the Applicant's specification.

'physical training services', 'physical fitness training services' and 'personal trainer services'.³³

- (iv) With the above in mind, it is likely that there may be a degree of similarity between the respective services. This is because they may overlap in purpose, method of use and user, since training (in the form of physical training) and the consultancy and information relating thereto, would be a means to provide rehabilitative services and physical therapy.
- (v) They may also overlap in trade channels since the same organisation may be providing the two services. For instance, they may provide the restorative services of rehabilitation and therapy along with the training services that promote the optimal physical function of the user of those services. As such, they would also be complementary to each other as the same user may use the training service to complement the physical rehabilitation and therapy services; indeed the training services may even be a necessary process or even be intrinsic to the provision of rehabilitation and therapy services. As such I find at least a **low degree of similarity** between the respective services.
- (vi) The Applicant's specification also includes the following service:

"exercise facilities for the provision of health rehabilitation purposes"

There is some degree of similarity between the Applicant's exercise facilities and the Opponent's *"providing of training"* services since they are likely to be complementary to each other and as such they may also overlap in user. There may also be an overlap in trade channels since the provider of those exercise facilities may also be the same undertaking that provides the training services. I find that the services are **similar to a low degree**.

³³ These are terms included in Class 41.

(vii) Finally, I note the following term in the Applicant's specification:

“medical evaluation services, namely, functional assessment program for patients receiving medical rehabilitation services for the purposes of guiding treatment and assessing program effectiveness”

These services share a similarity with the Opponent's consultancy and information services relating to their training services. In the context of 'consultancy and information' relating to the provision of training, the Opponent's services would cover physical fitness assessment services that a person would use before they could start their training for example (and it would cover the continued assessments and consultancy as they proceed in their training, in order to monitor their progress).

(viii) With this in mind, there would be a degree of overlap in purpose and method of use. The user may also be the same. They may also overlap in trade channels since the provider of the 'medical evaluation services' may also be the provider of the 'consultancy and information services relating to the provision of training'. The services would also be complementary to each other and the user may believe that they would be provided by the same undertaking. I find that the services are **similar** to a **low degree**.

58. Testing

(i) The Applicant's specification contains the following 'medical testing' services in Class 44 (my emphasis):

“providing medical testing of fitness and medical consultations to individuals to help them make health, wellness and nutritional changes in their daily living to improve health; consulting services in the field of diagnostic medical testing; medical testing services, namely, cognitive evaluation, training and therapy; medical testing services, namely, nutrition evaluation; medical testing services, namely, fitness evaluation; medical testing for diagnostic or treatment purposes”

- (ii) The Opponent's Class 42 specification contains the following services:

“testing; consultancy and information in relation to the aforesaid services, included in this class”

'Testing' is a broad term and would cover a wide range of services. For example, within the context of Class 42, 'testing' would encompass 'laboratory testing', 'microbiological testing', 'bacteriological testing' and 'scientific testing'.³⁴

- (iii) With the above in mind, there is a degree of similarity between the respective services since 'testing' in Class 42 would overlap in purpose and method of use when compared to 'medical testing' in Class 44 and it would also overlap in nature. For instance, microbiological and bacteriological testing of a person's gut biome would overlap with *“medical testing [for the purpose of helping individuals] make health, wellness and nutritional changes in their daily living to improve [their] health”*, specifically their gut health. It would also overlap in user and may also overlap in trade channels since the laboratories providing the medical testing may also be providing the testing services of the kind that fall within Class 42. The services would also be complementary to each other. The respective services are therefore **similar** to a **medium degree**.

59. Lifestyle and nutrition, counselling

- (i) The Applicant's specification contains services that are, broadly, in relation to 'healthy lifestyles and nutrition', these are as follows:

“providing healthy lifestyle and nutrition services, namely, personal assessments, personalised routines and maintenance schedules; food nutrition consultation; consulting services in the field of nutrition; dietary and nutritional guidance; providing information in relation to

³⁴ These are terms included in Class 42.

dietary and nutritional guidance and lifestyle wellness; advice, information and consultancy in relation to all above services”

(ii) The Opponent’s specification contains the following services in Class 41:

“Instruction, education, providing of training; conducting courses, seminars and workshops; consultancy and information in relation to the aforesaid services, included in this class”

(iii) The Opponent’s specification is broad and would cover a wide range of services. Taking into account the Class number, they would encompass ‘life coaching’, ‘personal coaching’ or life-coaching workshops for example.³⁵ They would also encompass, for example, ‘personal development courses’, ‘perceptual teaching services’, ‘conducting classes in weight reduction/ weight control’, ‘personal trainer services’, ‘health and wellness training’, ‘dietary education services’, ‘instruction in diet’, ‘instruction in nutrition’ and ‘conducting classes in nutrition’.³⁶

(iv) With this in mind, given the nature of the Applicant’s services, it is likely that they overlap with the nature of the Opponent’s services. They may also overlap in purpose and method of use and user, as well as potentially overlapping in trade channels. The services may also complement each other, for example, the services of dietary and nutritional guidance may be used alongside instructional classes in weight control. The user may indeed believe that the responsibility for the services lies with the same undertaking. There is a **low degree of similarity** between the respective services.

(v) The Applicant’s services are also complementary to the Opponent’s *“testing; consultancy and information in relation to the aforesaid services,*

³⁵ ‘Life coaching (training)’ and ‘personal coaching [training]’ being terms that fall within Class 41. Also see the definition of ‘life coach’ in the Collins English Dictionary (www.collinsdictionary.com) i.e. (my emphasis), *countable noun*: – “a ‘life coach’ is someone whose job involves helping people to improve their lives by doing challenging or worthwhile things; *uncountable noun*: – ‘life coaching’ e.g. “life-coaching workshops”; *noun*: – a life coach is “a person whose job is to improve the quality of their client’s life, by offering advice on professional and personal matters such as career, health, personal relationships etc.”

³⁶ Such services being terms that fall within Class 41.

included in this class". Applying the same example as in my paragraph 58(iii), with regard to microbiological and bacteriological testing of a person's gut biome, it is probable that Opponent's testing services would be complementary to the Applicant's services. For instance, the tests could be carried out as part of a personal assessment about nutrition. Based on the test results, the Applicant could provide the individual with a personalised lifestyle and nutritional routine. For example, the testing service to ascertain information about an individual's gut bacteria would complement the service of providing that person with dietary and nutritional guidance in order to improve their gut health. There is a **low degree of similarity** between the respective services.

(vi) The Applicant's specification also contains the following services:

"providing healthy lifestyle and nutrition services, namely, counselling; counselling services in the fields of health, nutrition and lifestyle wellness; cognitive therapy services; behavioural health services"

(vii) The Applicant's 'counselling/therapy' services relate to the type of services offered by practitioners such as counsellors, therapists, doctors or other experts. These services would involve the practitioners supporting their clients to enable them to solve their own problems, or to alter unwanted behaviour patterns that may be affecting a person's physical health (such as overeating for example which would contribute to a person's obesity).³⁷

(viii) These services are similar to the Opponent's Class 41 services (set out in my paragraph 59(ii) above). Particularly when bearing in mind that the users of the Opponent's services would require those services because

³⁷ 'Counselling' (in the context of psychology – 'psychology' being the scientific study of the human mind and the reasons for people's behaviours) is a form of psychotherapy in which the counsellor adopts a permissive and supportive role in enabling a client to solve their own problems; and 'cognitive therapy' (in the context of psychology) is a type of psychotherapy in which unrealistically negative patterns of thought about the self and the world are challenged in order to alter unwanted behaviour patterns or treat mood-related psychiatric disorders such as depression (see the Oxford English Dictionary entry – www.oed.com)

they may want to learn, for example, new coping skills, new ways of thinking and new healthier habits.

- (ix) With this in mind, the end user of the parties' respective services may be the same and they may believe that the responsibility for the respective services lies with the same undertaking. For example, it is conceivable that a counsellor or therapist may offer one-to-one client services to help someone break the habit of over-eating, or they could hold workshops to help support a group of people with the same issue. The services would therefore overlap in purpose and method of use, as well as potentially overlapping in trade channels. There may also be a degree of competition between them as a user may prefer the one over the other, and the services would complement each other. I find there is a **low degree of similarity** between the respective services.

60. 'Medical services'

- (i) The Applicant's specification contains the following terms (my emphasis):

"Medical services; medical treatment services; medical clinic services; medical services, namely, hyperbaric oxygen therapy services; internet-based medical diagnosis pertaining to cognitive and physical aging processes, including information regarding treatment, prevention and cure; provision of mental rehabilitation facilities; bio marker services, Stem cells, Generation of new blood vessels, Neurogenesis and angiogenesis creation and renewal; Medical diagnosis and treatment of an individual or group of individuals via remote data monitoring; consulting services in the field of mental fitness; medical services in the field of hyperbaric oxygen treatment; providing information in the field of medical treatments; medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity"

(ii) The Opponent's 'workshops and training' services in Class 41

- (a) The Opponent has submitted that the following applied-for services, namely:

“medical services; medical treatment services; medical clinic services; [...] advice, information and consultancy in relation to all above services”

are *“broad enough to include the [Applicant's] therapeutic and nutritional services, and so are similar to the Opponent's Class 41 [workshops and training] services on the same basis”*.

- (b) The *“same basis”* to which the Opponent is referring relates to its submissions about similarity between its 'workshops and training services' and the Applicant's 'therapeutic and nutritional services'.³⁸ Whilst I have already found that a low degree of similarity exists between (inter alia) the Opponent's 'workshops' and the Applicant's 'counselling/therapy' services (for the specific reasons set out in my paragraph 59), I disagree with the Opponent's submissions that a finding of similarity between those would lead to a finding that 'medical services' at large are therefore similar to 'workshops and training services'.

- (iii) In my view the interpretation of the respective terms should not be taken so far that it leads to a straining of the relevant language.³⁹ The ordinary and natural, or core, meaning of the Applicant's 'medical services' would not include 'workshops and training services'.

³⁸ The submissions are contained in paragraphs 23 and 24 of the Opponent's submissions dated 31 August 2022.

³⁹ See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraph 12

(iv) That said, these terms in the Applicant's specification, namely:

“medical services; medical treatment services; medical clinic services; providing information in the field of medical treatments; advice, information and consultancy in relation to all above services”

are broad terms and could collectively encompass all of the Applicant's foregoing Class 44 terms that I have found to be similar to the Opponent's specification, as well as services that are not similar to the Opponent's services. No fall-back specification has been provided by the Applicant, therefore I will proceed on the basis that these services are similar to a low degree, though I will return to this point when I make my conclusions on the outcome of this opposition.

(v) The Opponent's 'IT services' in Class 42

(a) The Opponent has submitted that the following services (included in the above list), namely (my emphasis):

“internet-based medical diagnosis pertaining to cognitive and physical aging processes, including information regarding treatment, prevention and cure; medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity; advice, information and consultancy in relation to all above services”

are similar to the Opponent's 'IT services' of:

“development, programming and implementation of computer software; software as a service (SaaS)” (and the consultancy and information services relating thereto)

on the basis that the Applicant's services include *“such services provided by pre-programmed non-downloadable software (i.e.*

online programs which allow users to input various details such as age, weight, symptoms and the like, and receive initial medical diagnosis information, and software-enabled devices that allow for the remote monitoring of users to provide health updates if/as needed).” As such, the Opponent has submitted that the respective services “can have the same nature and purpose, and target the same public”.

- (b) I note the reasoning for the Opponent’s comparison, however I disagree with the Opponent’s conclusions on similarity. Whilst I acknowledge that the Applicant’s services could be made possible by the Opponent’s ‘IT services’ (and for that matter, it is tenable that a great deal of the medical services applied for, as set out in my paragraph 60(i) above, could be delivered with the aid of ‘IT services’), I do not consider the respective services to be similar.
- (c) The Applicant’s services are in the nature of ‘medical services’, therefore the user of those services would be patients (i.e. members of the general public), whereas the user of the Opponent’s ‘IT services’ would be the provider of the medical services i.e. medical practitioners (as the medical practitioners for example, would require the ‘IT services’ in order to deliver the ‘medical services’ to their patients).
- (d) The respective services therefore not only differ in nature and intended purpose, they also differ in user (as they do not target the same public). In addition, they would also differ in method of use, and they would not be in competition with each other nor complementary.
- (e) With regard to complementarity, I note that whilst, in general terms, a finding of similarity can be made in circumstances where the nature and intended purpose of the services is different, the case-law definition of complementarity implies that complementary goods or services can be used together, which presupposes that

they are intended for the same public i.e. that the users are the same.⁴⁰ Indeed, the purpose of examining whether there is a complementary relationship between the services is to assess whether members of the relevant public are likely to believe that the responsibility for those services lies with the same undertaking or with economically connected undertakings.⁴¹

- (f) In *Commercy AG v OHIM*,⁴² for example, the General Court upheld a finding of the Second Board of Appeal of OHIM that:

“49. [...] complementarity had to be excluded in the present case since the public at large, for which the services covered by the mark at issue are intended, does not purchase the relevant goods and services covered by the earlier mark, which are exclusively intended for businesses which, subsequently, provide services to the public at large.”

- (g) Therefore, although the ‘IT services’ may make it possible for medical practitioners to provide ‘medical services’ to their patients, the respective services cannot be complementary as they are not intended for the same public. A user of the ‘medical services’ (i.e. the patients) would not consider themselves to be using ‘IT services’ for instance. There is **no similarity** between the respective services.

- (vi) I also find **no similarity** between any of the Opponent’s services and the remainder of the Applicant’s Class 44 services, namely:

“medical services, namely, hyperbaric oxygen therapy services; provision of mental rehabilitation facilities; bio marker services, Stem cells, Generation of new blood vessels, Neurogenesis and angiogenesis creation and renewal; Medical diagnosis and treatment of an individual or group of individuals via remote data monitoring;

⁴⁰ *Commercy AG v OHIM*, Case T-316/07, paragraph 58

⁴¹ *Sanco SA v OHIM*, Case T-249/11

⁴² Case T-316/07

consulting services in the field of mental fitness; medical services in the field of hyperbaric oxygen treatment; providing information in the field of medical treatments”

Conclusion on the comparison of the goods and services

61. I have found instances of identity, similarity (to varying degrees) and dissimilarity between the respective goods and services.

The average consumer and the nature of the purchasing act

62. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical.⁴³ It is therefore necessary to determine who the average consumer of the respective goods and services is, and how the consumer is likely to select those goods.

63. I note that some of the respective goods and services terms have a wider scope of average consumer than others. For example, a consumer of ‘computer software’ could be a business or other form of organisation/undertaking (such as a medical practice) wanting computer software for *“automation of MRI scans processes and procedures”* or they could be a member of the general public who is a home PC user wanting computer software for word processing (I note this serves to demonstrate that the term *“computer software’ is of immense breadth”*⁴⁴). Likewise, a consumer of ‘education services’ could be a business or other form of organisation/undertaking wanting their staff to learn about new topics or to learn specific skills; or they could be an individual who is a professional in a certain area, or even an individual with no prior skills in a certain area, both wanting to learn new things (perhaps to advance their careers).

⁴³ *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), paragraph 60; also see *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98, as to what “average” means

⁴⁴ See *Massachusetts Financial Services Company v MFS Africa Limited*, Case O/531/22, paragraph 13, in relation to the comment about ‘computer software’

64. Whilst in general terms the average consumer's level of attention is likely to vary according to the category of goods and services in question,⁴⁵ such that the average consumer can be deemed to demonstrate a low degree of attention when selecting certain categories of goods and services for instance, given the nature of the goods and services at hand, I do not consider any of them fall into that 'low level of attention' category.
65. Rather, the relevant average consumer (whether they are members of the general public, a professional, or a business, organisation/undertaking) is at the very least, likely to pay a medium level of attention when selecting the respective goods and services. Where the goods and services are of a specialised nature, then the level of attention paid by the relevant average consumer is only likely to increase, this is true whether the consumer of those goods and services is a member of the general public or a business user for example.
66. The respective goods and services are varied and will reach the market through varying trade channels (depending on the category of goods and services). Therefore some of the physical goods may be available through general retailers that sell to the public at large and others only through specialist retailers or perhaps just retailers that sell to the trade. The same is true of the services, some may be made available to the public at large and others may just be rendered exclusively to businesses for example. Whichever way the goods and services are offered to the relevant average consumer, in each instance, the selection process will be predominantly visual.
67. For example, the average consumer will select the goods having viewed an image or description of them first (whether they are displayed on shelves or made available on a website to download for example), and with regard to the services, the average consumer is most likely to encounter the trade marks on promotional materials, brochures, through marketing campaigns etc. (including their online equivalents).

⁴⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

68. That said, I do not discount that aural consideration may play a part by way of word-of-mouth recommendations.

Comparison of marks

Sections 5(1) and 5(2)(a) claims

69. The respective trade marks are shown below:

Earlier Word Mark	Contested Mark
AVIV	AVIV

70. The Contested Mark is self-evidently identical to the Earlier Word Mark.

Distinctive character of the Earlier Mark

71. There is a requirement to consider a likelihood of confusion under a section 5(2)(a) claim and the degree of distinctiveness of the Earlier Word Mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the Earlier Word Mark, the greater the likelihood of confusion may be.⁴⁶

72. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with higher inherent distinctive character, such as invented words which have no allusive qualities.

73. The Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier Word Mark, therefore I only have the inherent distinctiveness of the mark to consider.

⁴⁶ Although it is always important to bear in mind what it is about the earlier mark which gives it distinctive character. See *Kurt Geiger v A-List Corporate Limited*, Case O-075-13, paragraph 39

74. There being no dominant components, or any elements that retain an independent distinctive role in the Earlier Word Mark, the distinctive character of the mark lies solely in the word 'AVIV'.
75. The word 'aviv' appears in a standard English dictionary,⁴⁷ however, I do not think that it is a word that would be readily understood by the average consumer; indeed, the average consumer is likely to view it as an invented word or perhaps it might call to mind the Israeli city of Tel Aviv. In any event it has no suggestive nor allusive connotations in relation to the Opponent's services. Consequently, the Earlier Word Mark possesses at least a medium degree of inherent distinctive character.

Conclusion on the section 5(1) claim

76. Since there is no requirement to consider a likelihood of confusion under a section 5(1) claim, given that the Contested Mark is identical to the Earlier Word Mark, the opposition under section 5(1) is successful in relation to the Applicant's services that I have identified as being identical to the Opponent's.⁴⁸
77. I shall now move on to consider the likelihood of confusion under the section 5(2)(a) claim.

Likelihood of Confusion under section 5(2)(a)

78. With regard to the Applicant's services that I have found to be dissimilar to the Opponent's services, since some degree of similarity between the services is necessary in order to consider the likelihood of confusion, a finding of no similarity between them means that there is no likelihood of confusion to be considered. Therefore the opposition must fail under section 5(2)(a) of the Act in respect of the Applicant's services that I have found to be dissimilar to the Opponent's.⁴⁹ Therefore my assessment as to the likelihood of confusion only

⁴⁷ It is defined as a biblical word borrowed from Hebrew, meaning the first month of the Jewish ecclesiastical year (and the seventh of the civil year) – see the Oxford English Dictionary (www.oed.com) and the Collins English Dictionary (www.collinsdictionary.com)

⁴⁸ For the avoidance of doubt, where I have made an alternative finding of 'similarity' (as opposed to 'identity') in relation to some of the services, I will consider these services under the section 5(2)(a) claim.

⁴⁹ As set out in my paragraph 60.

relates to those respective goods and services that I have found to be similar (to some degree).

79. In assessing the likelihood of confusion, I keep in mind the average consumer of the goods and services, the nature of the purchasing process and have regard to 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 vice versa.⁵⁰
80. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. It is not a process of analysis or reasoning, but an impression or instinctive reaction.⁵¹ The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.⁵²
81. There are three sets of circumstances where a consumer may associate a later mark with an earlier mark:⁵³ (i) direct confusion, which is a simple matter of the consumer mistaking one mark for another; (ii) indirect confusion, which is where the consumer recognises that the marks are different, but also that they share common elements, and because of those similarities, they conclude, for example, that the later mark is another brand of the owner of the earlier mark;⁵⁴ and (iii) mere association, where the later mark merely brings the earlier mark to mind but it does not lead to confusion between them.
82. Taking into account: (i) the identity between the respective marks; (ii) the at least medium degree of distinctive character of the Earlier Word Mark; and (iii) the similarity between the respective goods and services, I find that a significant

⁵⁰ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

⁵¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

⁵² See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

⁵³ See to that effect *Sabel BV v Puma AG*, Case C-251/95, paragraph 16

⁵⁴ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC (as he then was), sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion; see also the comments of Arnold LJ in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12, in relation to 'L.A. Sugar' i.e. "This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."

proportion of the average consumer would be directly confused as to the trade origin of the goods and services.

83. I make this finding even though I have found only a low degree of similarity between some of the goods and services (there is no minimum threshold level of similarity between the goods and services that has to be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion).⁵⁵ I also make this finding even though the relevant consumer will pay at least a medium level of attention when selecting the goods and services – this point is largely neutralised by the identity of the marks and the inherent level of distinctive character of the Earlier Word Mark.
84. I find that a lesser degree of similarity between the respective goods and services would in this case be offset by the identity of the respective marks, such that the average consumer, when seeing an identical mark (with an at least medium degree of distinctiveness) on goods and services that are similar (even to a low degree), would associate the Contested Mark with the Earlier Word Mark and it would lead them to conclude that the goods and services come from the same (or at least economically linked) undertaking, thus giving rise to a likelihood of confusion.

Conclusion on the section 5(2)(a) claim

85. The opposition succeeds under section 5(2)(a) of the Act in respect of all of the Applicant's goods and services that are similar to the Opponent's services.
86. Given that the application is to be refused in part (as per section 5A of the Act), Tribunal Practice Notice ("TPN") 1/2012 in relation to 'Partial Refusal' applies.⁵⁶

⁵⁵ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

⁵⁶ TPN 1/2012 refers to 'Article 13'. This is 'Article 13' of the First Council Directive 89/104 of December 21, 1988, to approximate the laws of the Member States relating to trade marks, which states: "*Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.*" This has (subsequent to the publishing of TPN 1/2012) been added to the Act as section 5A.

87. It is noted that the practice outlined in the TPN reflects the comments of Mann J in *Giorgio Armani SpA v Sunrich Clothing Ltd*.⁵⁷ He stated that:

“53. [...]

(ii) [...]the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification (“save for [the goods in respect of which the opposition succeeded]”) will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities”.

(iii) [...] What must not be lost sight of is that what is sought is the fair determination of the extent of the coverage to which the applicant is entitled to in his registration in the event of a successful partial opposition.

88. In ‘*Giorgio Armani*’ Mann J went on to consider, and adopt, a range of procedural possibilities in which a dispute as to ‘residual wording’ could be determined. Mann J stated that:

*54. The sort of procedures that can be adopted to achieve this are referred to in the decision of Mr Geoffrey Hobbs as the Appointed Person in *Citibank NA v Citybond Holdings Plc* [2007] R.P.C. 13. At [17]–[20] he set out a range of possibilities in which a dispute as to residual wording could be determined. [...] I respectfully agree with and adopt what he says about the various procedural possibilities. I do not set them out again here because it is unnecessary to do so. [...] The unarticulated thesis underlying all of Mr Hobbs’s case management possibilities is the need to adopt the procedure appropriate for the case.*

⁵⁷ [2010] EWHC 2939 (Ch)

[...]

58. [...] *True it is that [‘Armani’] has not made an unconditional application to amend the specification, but I do not regard that as fatal. It could even be obstructive to sensible decision-making at this stage. Suppose Armani made such an application and it turned out that there was a well-founded objection as to whether that precise formulation gave proper effect to the limits of the opposition. Would it then lose the whole of its registration application? That would probably be absurd. Would it then be able to mount another amendment application to fix the first problem? That would be cumbersome; and what if the opponents fashioned a limited objection to that? There would then have to be a third application, and so on. I do not think that the answer to the technical or procedural problems lies in that overly formalistic method of resolving the dispute, especially in the present case.”*

89. Mann J concluded that hearing officers should provide a mechanism for ensuring that they are able to give a ruling as to what was left of the registration after a successful opposition.⁵⁸ Having adopted Mr Hobbs’ *‘range of possibilities’* in relation to *‘residual wording’*, Mann J ultimately concluded that the *“question of the extent to which [Armani’s] registration application can go forward [would] have to be determined”*, as such, he decided that the procedure appropriate for that case was for *“the matter [to] be remitted to the Hearing Officer so that that [could] be done”* i.e. an interim order was made.
90. Mr Hobbs, in his decision in *‘Citibank’*, having already laid out the range of procedural possibilities available to him, decided that the procedure appropriate in that case was to make a *‘final order’* in relation to the *‘residual wording’*. Under the heading *‘Interim or Final Order’*, Mr Hobbs states:

51. [...] *I have paused long and hard over the question whether my decision to strike out the wording I have found to be objectionable should be interim or final. If I make an interim order allowing the applicant a specified period of time within which to put forward narrower wording for the purpose of*

⁵⁸ Ibid., paragraph 59

eliminating the objections I have upheld, that will (judging by the open correspondence I have referred to above) lead to further wrangling in the remitted opposition and consequently increased costs and delay in bringing it to a final conclusion. That is not something I can contemplate with equanimity in relation to an application for registration that has been pending since October 1999. It also troubles me to see the applicant suggesting that it might be willing to restrict its list of services to “travel insurance policies and travel insurance services”, but at the same time suggesting that the inherently uncertain ambit of the phrase “travel insurance services” (which was in the list from the beginning) may lead to further difficulties in future. [...] In the end, however, I have come to the conclusion that the correct, fairer, cheaper and kinder course in the present case will be to avoid further disputation and delay. I shall therefore order the wording I regard as objectionable to be finally and unconditionally struck out. [...]”

91. In the submissions I have before me, the Applicant has indicated that they operate in the medical field and healthcare profession. The Opponent has not made any submissions in relation to its intended target market or the field in which it operates and there is nothing in the Opponent’s submissions to suggest that the Opponent’s interests do not lie in the provision of services that relate to the medical field and healthcare profession.
92. The Opponent’s specification does not include Class 44, however, I bear in mind the provision of section 60A(1)(b) of the Act i.e. goods and services are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification, and my findings that there are terms within the Opponent’s specification that are similar to terms in the Applicant’s Class 44 specification. I have also made findings of identity and similarity between the parties’ specifications in other Classes (outside of Class 44), where the terms were broad and thus included the other party’s services. I made these findings even in instances where the Applicant’s specification was limited to the field in which it operates e.g. I found that the Opponent’s “*education*” services in Class 41 were identical to the Applicant’s “*educational services, namely, hyperbaric oxygen therapy training courses*” also in Class 41.

93. I indicated in my paragraphs 56 and 60(iv), that certain terms within the specification applied for in Class 44 cover a wide range of services, some of which would collectively encompass all of the Applicant's Class 44 terms that I have found to be similar to the Opponent's specification, as well as services that are not similar to the Opponent's. Therefore, whilst I can mostly apply a 'blue pencil' approach to the terms applied for, based on my findings of identity and similarity, I do not consider a simple 'blue pencilling' approach or a 'save for' type of exclusion would suffice to reflect my findings in relation to the following services contained in the Applicant's Class 44 specification (hereinafter referred to as **"the Medical Services Terms"**):

"Medical services; medical treatment services; medical clinic services; providing information in the field of medical treatments"

94. In addition, applying a limitation to the Applicant's Medical Services Terms by reference to their intended target market i.e. the medical field and healthcare profession, would not be limiting the Medical Services Terms for reasons that are self-evident, and such limitation would not alter my findings in relation to similarity in any event. And there is nothing in the Opponent's submissions to suggest that the Opponent's interests lie in services that are materially different from the Applicant's wide-reaching Medical Services Terms.

95. I note that the Registry has an overriding objective to ensure that proceedings are completed within a reasonable time. During the course of these proceedings (which were initiated in March 2020) a cooling off period was granted to the parties in order to negotiate a settlement. This cooling off period was further extended, yet no settlement was reached. The Applicant has filed two TM21Bs amending its specification, neither of which led to the Opponent agreeing to withdraw the opposition and no fall-back position has been offered by the Applicant for me to consider.⁵⁹

96. I also note that neither party filed written submissions nor elected to file evidence during the evidence rounds in these proceedings. Neither party made any request to be heard, instead, both parties elected to solely file written

⁵⁹ I note that I make no inference from the lack of a fall-back position, I merely state it as fact.

submissions in lieu of a hearing and to allow the case to be decided based on such submissions.

97. After weighing up all the factors in this case, I have come to the conclusion that this dispute should not be unnecessarily prolonged, I therefore do not consider it appropriate to issue an interim decision in order to invite any further submissions in relation to the parties' specifications, nor to allow any further time to the parties to negotiate between themselves as to the wording of the residual terms, or indeed to allow the Applicant a further opportunity to put forward narrower wording for the purpose of eliminating the objections I have upheld. To paraphrase Mr Hobbs in 'Citibank', such an approach would lead to further wrangling and consequently increased costs and delay in bringing this case to a final conclusion.
98. In order to avoid any further delay, it is appropriate in the circumstances in this case that the application be allowed to proceed to registration in relation to the following services in Class 44 as I have amended them below.
99. In making these amendments I have not lost sight of the fair determination of the extent of the coverage the Applicant is entitled to in its applied-for registration, following the successful partial opposition. On the one hand, merely deleting the Applicant's broad Medical Services Terms would be unduly limiting the residual specification; on the other hand, I cannot allow these terms to proceed to registration without any narrowing of their scope. This amended specification therefore reflects the Applicant's indicated field of operation, whilst limiting the broad Medical Services Terms so as not to encompass the Opponent's terms (I have emphasised the amendments for ease of reference):

*“Medical services,[;] medical treatment services **and**[;] medical clinic services **all relating to the: provision of;[;] ~~medical services, namely,~~ hyperbaric oxygen therapy services,[;] **provision of internet-based medical diagnosis services pertaining to cognitive and physical aging processes, including the provision of information regarding treatment, prevention and cure pertaining to cognitive and physical aging processes,[;] provision of mental rehabilitation facilities,[;] provision of bio marker services relating to,*****

*sStem cells, gGeneration of new blood vessels, nNeurogenesis and angiogenesis creation and renewal, provision of; mMedical diagnosis and treatment of an individual or group of individuals via remote data monitoring,; provision of consulting services in the field of mental fitness,; provision of medical services in the field of hyperbaric oxygen treatment,; provision of medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity; providing information in **relation to the ~~field of~~ foregoing** medical treatments; advice, information and consultancy in relation to all above services; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.”*

Final remarks

100. The opposition is successful under sections 5(1) and 5(2)(a) of the Act in respect of the Applicant’s goods that I have found to be identical and/or similar to the Opponent’s services. There is therefore no need to consider the claim under section 5(2)(b) as it does not materially improve the Opponent’s position, particularly since the Opponent’s specification is the same across all three of its earlier rights relied on under its claims, such that my findings of dissimilarity between some of the services apply likewise under the section 5(2)(b) claim.

OUTCOME

101. The opposition is partially successful under sections 5(1) and 5(2)(a) of the Act. Subject to any appeal, the Contested Mark, trade mark application number 3446275, may proceed to registration only in respect of the services as set out in **Annex 3** to this decision.⁶⁰

⁶⁰ i.e. the Class 44 services specification as amended in my paragraph 99.

COSTS

102. The Opponent has been partially successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for filing Form TM7F	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing written submissions	£300
TOTAL	£600

103. I therefore order Aviv Scientific Ltd. to pay Axel Springer SE the sum of **£600**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 26th day of January 2023

Daniela Ferrari

For the Registrar

Annex 1

The Applicant's goods and services

Class 9

Computer software; computer hardware; application software; recorded computer software for database management; computer hardware and downloadable computer software for collecting and viewing data associated with the use of hyperbaric chambers for medical treatment; computer hardware and downloadable computer software for collecting, understanding, analysing and viewing data associated with the medical record of a patient; computer hardware and downloadable computer software for managing Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records for patients that is comprised of (one, two or three) Diagnostic Data, Data collected from wearables and Internet of Medical Things (IoMT) and Data Analytics of a large database-base population; computer hardware and downloadable computer software for collecting, viewing, automatic detection and analysis data associated with the use of MRI for patient diagnostic and treatment; computer hardware and downloadable computer software for automation of MRI Scans processes and procedures; computer hardware and downloadable computer software for collecting, detecting, analysis and viewing data associated with (defending) cybersecurity systems; computer hardware and downloadable computer software for collecting, analysis, manipulation and viewing data associated with a mapping of Genome (DNA) and the Epigenetics (RNA, Telomeres and Stem cells) of a patient; computer hardware and downloadable computer software for collecting, analysis and viewing data associated with the use of cognitive and neurocognitive assessment, diagnostic and training of patients; computer hardware and downloadable computer software for Virtual Reality (VR)-based cognitive assessment and training; computer hardware and downloadable computer software for collecting and viewing data associated with the use of Virtual Reality (VR)-based cognitive assessment and training of patients; computer hardware and downloadable computer software for mobile application for screening, monitoring, analysis, and viewing of healthcare data for patients; downloadable computer software applications for use with mobile devices for monitoring and managing patient medical information; computer hardware and downloadable computer software for screening,

monitoring, analysis, and viewing of healthcare data for patients using wearables, Internet of Medical Things (IoMT)-based and Internet of Things (IoT)-based devices; computer hardware and downloadable computer software for big data and analytics of healthcare, medical records, across all medical disciplines; computer hardware and downloadable computer software for collecting and viewing data associated with the use of physical assessment and training of patients; computer hardware and downloadable computer software for managing medical and healthcare centers; computer hardware and downloadable computer software for managing scheduling for healthcare and medical centres' staff; computer hardware and downloadable computer software for managing scheduling patients' assessments treatments, training and meetings; computer hardware and downloadable computer software for managing patients' finance (CRM); computer hardware and downloadable computer software for managing healthcare centres' supplies (ERP); computer hardware and downloadable computer software for managing Enterprise Resource Planning (ERP) solutions; computer hardware and downloadable computer software system of alerts and messaging between professionals and patients; computer hardware and downloadable computer software for patients' cognitive training inside HBOT (Hyperbaric oxygen therapy) chambers (HBOs); computer hardware and downloadable computer software for patients' entertainment inside HBOT (Hyperbaric oxygen therapy) chambers (HBOs); computer hardware and downloadable computer software for collecting, monitoring, analysing and viewing data of wearables and Internet of Medical Things (IoMT) devices for medical and healthcare usage; downloadable computer software for interpretation of neuro and brain scans provided via diagnostic imaging equipment; wearable monitors; wearable activity trackers; wearable, Internet of Medical Things (IoMT) and Internet of Things (IoT) monitors used to measure biometric data for medical and general data analysis purposes; advice, information and consultancy in relation to all above goods; none of the aforesaid provided in relation to publishing services, digital classified advertisements or marketing outside the medical field; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.

Class 35

Compiling, collecting of data for research purposes in the field of medical science, digital health and medical consultancy; compiling data for research purposes in the field of medical science and medical consultancy; healthcare and healthcare management services in the nature of establishing and managing hyperbaric oxygen therapy centers; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.

Class 41

Providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of hyperbaric medicine; educational services, namely, hyperbaric oxygen therapy training courses; educational services, namely, aging, stroke, TBI (traumatic brain injury), fibromyalgia assessments and rehabilitation courses; educational services, namely biomarkers assessments courses; education services, namely, providing online cognitive assessments and training programs that help identify cognitive strengths and weaknesses of an individual; providing medical technology training services; computer-based simulation training services in the field of medical technology; publishing and issuing of scientific papers in relation to medical technology; publishing and issuing scientific papers in relation to medical technology, digital health and the mix between technology and medicine; providing educational classes, training, conferences, non-downloadable webinars and workshops to cybersecurity of medical centers and healthcare services; providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records; providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of MRI; providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of Neurocognitive assessment, diagnostic and training; providing educational classes, training, conferences, non-downloadable webinars and workshops to medical professionals in the field of physiological assessment, diagnostic and training; providing educational classes,

training, conferences, non-downloadable webinars and workshops to medical professionals in the field of medical usage of wearables, Internet of Medical Things (IoMT) devices and Internet of Things (IoT) devices; conducting educational support programmes for patients; physical training; advice, information and consultancy in relation to all above services; none of the aforesaid provided in relation to publishing services, digital classified advertisements or marketing outside the medical field; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.

Class 42

Scientific and technological services and research and design relating thereto; design and development of computer hardware and software; analysis of data, engineering services relating to data processing for research purposes in the field of medical science, digital health and medical consultancy; sharing and collaboration of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records; chemical, biochemical, biological and bacteriological research and analysis; medical and scientific research, namely, conducting clinical trials for others; providing medical and scientific research information in the field of clinical trials; scientific and technological services, namely, scientific research, analysis and testing in the field of hyperbaric therapy; medical laboratory services; electronic monitoring of physiological parameters, including pulse, saturation, sleeping habits, steps, exercise, mention level using computers and sensors [electronic data collection]; design and development of mobile applications for monitoring, viewing, analysis and alerting of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records; data security services, including cybersecurity of medical centers and healthcare services; electronic storage of Electronic Medical Records (EMR), Electronic Health Records (EHR), Electronic Personal Records (EPR), and Medical Records; design and development of Virtual Reality (VR)-based cognitive assessment and training; technology research in the field of medical instruments; providing an interactive website featuring technology that enables users to enter, access, track, monitor and generate health and medical information and reports; scientific consulting

and research services relating to foods and dietary supplements; providing technological information regarding medical devices; advice, information and consultancy in relation to all above services; none of the aforesaid provided in relation to publishing services, digital classified advertisements or marketing outside the medical field; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.

Class 44

Medical services; medical treatment services; medical clinic services; medical services, namely, hyperbaric oxygen therapy services; behavioural health services; internet-based medical diagnosis pertaining to cognitive and physical aging processes, including information regarding treatment, prevention and cure; provision of mental rehabilitation facilities; rehabilitation patient care services; physical rehabilitation services; rehabilitation services for patients with traumatic brain injury (TBI), or other cognitive or physical brain impairment including strokes; physical therapy services; medical, physical rehabilitation and physical therapy services; physical therapy evaluation, identification, and management of movement dysfunction to restore, maintain, and promote optimum physical function prevent the onset, symptoms and progression of impairments, functional limitations and disabilities resulting from disease, disorders, conditions or injuries; bio marker services, Stem cells, Generation of new blood vessels, Neurogenesis and angiogenesis creation and renewal; medical evaluation services, namely, functional assessment program for patients receiving medical rehabilitation services for the purposes of guiding treatment and assessing program effectiveness; exercise facilities for the provision of health rehabilitation purposes; Medical diagnosis and treatment of an individual or group of individuals via remote data monitoring; providing medical testing of fitness and medical consultations to individuals to help them make health, wellness and nutritional changes in their daily living to improve health; providing healthy lifestyle and nutrition services, namely, personal assessments, personalised routines, maintenance schedules and counselling; food nutrition consultation; consulting services in the fields of diagnostic medical testing and nutrition; dietary and nutritional guidance; counselling services in the fields of health, nutrition and lifestyle wellness; consulting

services in the field of mental fitness; medical testing services, namely, cognitive evaluation, training and therapy; medical testing services, namely, nutrition evaluation; medical testing services, namely, fitness evaluation; medical services in the field of hyperbaric oxygen treatment; providing information in the field of medical treatments; providing information relation to dietary and nutritional guidance and lifestyle wellness; medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity; medical testing for diagnostic or treatment purposes; cognitive therapy services; advice, information and consultancy in relation to all above services; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.

Annex 2

The specification for the:

(1) Earlier Word Mark

(2) Group Mark

(3) Earlier Figurative Mark

Note: The variant Class 45 terms referred to in the 'Preliminary Issues' section to this decision, at my paragraph 25, are included below for ease of reference.

Class 35

Business assistance, management and administrative services; Human resources management and recruitment services; Advertising, marketing and promotional services; Design, arranging and placement of advertisements; Procurement services, for others, subscription services; Creation and evaluation of business plans; Business administration; Business planning services; Business marketing services; Company management and development services in the form of assistance for start-up companies, for others; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise; Business organization consultancy; Business administration consultancy; Conducting of business appraisals; Contract management in the form of developing, managing and amending business contracts, for others (business management); Business analysis, research and information services; compilation, systemization, updating and maintenance of data and information into computer databases; Consultancy and information in relation to the aforesaid services, included in this class; None of the aforesaid services relating to or used in connection with insurance and/or monetary affairs.

Class 41

Publishing and reporting; Instruction, education, providing of training, entertainment; Conducting courses, seminars and workshops; Organisation of conferences,

exhibitions and competitions; Consultancy and information in relation to the aforesaid services, included in this class; None of the aforesaid services relating to or used in connection with insurance and/or monetary affairs.

Class 42

IT services, namely development, programming and implementation of computer software, development of computer hardware, hosting services; IT services, namely software as a service (SaaS) and rental of software, rental of computer hardware and installations, IT consultancy and information; IT services, namely IT project management, IT security, protection and repair, data duplication and conversion, data encoding, computer analysis and diagnostics, research and development, and implementation of computers and computer systems; IT services, namely computer project management, data mining, digital watermarking, computer services, technological services in relation to computers, computer networking, updating of memory banks in computer systems, data migration, updating of websites, for others, monitoring of computer systems by remote access; Testing, authentication and quality control; Design services; Consultancy and information in relation to the aforesaid services, included in this class; None of the aforesaid services relating to or used in connection with insurance and/or monetary affairs.

Class 45

Licensing of industrial property rights and copyright; Management of industrial property rights and copyright; advisory, consulting and information services regarding the foregoing in this class.⁶¹ / consulting and information services relating to the above mentioned services, (included in Class 45).⁶²

⁶¹ This term relates to the Earlier Word Mark and the Group Mark only.

⁶² This term relates to the Earlier Figurative Mark only.

Annex 3

The Applicant's services which may proceed to registration

Class 44

Medical services, medical treatment services and medical clinic services all relating to the: provision of hyperbaric oxygen therapy services, provision of internet-based medical diagnosis services pertaining to cognitive and physical aging processes, including the provision of information regarding treatment, prevention and cure pertaining to cognitive and physical aging processes, provision of mental rehabilitation facilities, provision of bio marker services relating to stem cells, generation of new blood vessels, neurogenesis and angiogenesis creation and renewal, provision of medical diagnosis and treatment of an individual or group of individuals via remote data monitoring, provision of consulting services in the field of mental fitness, provision of medical services in the field of hyperbaric oxygen treatment, provision of medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity; providing information in relation to the foregoing medical treatments; advice, information and consultancy in relation to all above services; none of the aforesaid relating to or used in connection with insurance, health insurance, financial or monetary matters with the exception of providing insurance companies with medical research data for risk assessment purposes only.