

**BL O/0450/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3819160**

**BY**

**DANIEL BULKIN**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**HEALISTIC**

**AND**

**OPPOSITION NO. 600002641 THERETO**

**BY**

**HEALY INTERNATIONAL AG**

## **Background and pleadings**

1. On 11 August 2022, Daniel Bulkin (the “Applicant”) applied to register the word only trade mark **HEALISTIC**. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 26 August 2022. Registration of the mark is sought in respect of goods and services in Classes 3, 5, 9, 10, 35, 36, 39, 42 and 44.

2. On 25 November 2022, Healy International AG (the “Opponent”) filed a Fast Track opposition, partially opposing Class 9 of the application only (see **Comparison of goods**) under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of one earlier International Registration (IR):

IR WO0000001307915

**HEALY**

UK Designation date: 26 February 2019

UK Protection date: 29 August 2019

3. For the purposes of this Fast Track opposition, the Opponent relied upon the goods in Class 9 for which the earlier mark is registered only, namely:

Class 9 *Apparatus and transmitters of electronic, magnetic and/or photonic signals; apparatus for analyzing noise signals to estimate probabilities; software for the afore mentioned products.*

4. Since the designation date of the earlier mark predates the filing date of the contested application, the Opponent’s mark is considered to be an “earlier mark” in accordance with section 6 of the Act. However, as the mark has not been protected in the UK for a period of five years or more before 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 may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

5. Considering that this is a Fast Track opposition it is necessary to highlight Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, which disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought to file any evidence in respect of these proceedings by either party.

7. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. In its statement of grounds, the Opponent submitted that the contested goods are either identical or highly similar to those in Class 9 of the earlier mark. The Opponent contended that the start is the dominant part of each mark, and that each mark starts with the identical letters ‘HEAL’. The Opponent argued that the letter ‘Y’ of the earlier mark and letter ‘I’ of the contested mark are likely to be pronounced in an identical or highly similar way. The Opponent concluded that because the only difference between the marks is the non-dominant latter part of the contested mark there exists a likelihood of confusion, including a likelihood of association.

9. On 4 February 2022, the Applicant filed a counterstatement in which it denied that the marks are similar. The Applicant argued that the average consumer would readily distinguish between the marks based on the clear visual, phonetic and conceptual differences. The applicant contended that the earlier mark will immediately be recognised as a five-letter surname, whereas the Applicant’s mark is a nine-letter, newly coined neologism.

10. On 20 February 2023, the Applicant filed submissions in which it provided detailed argument relating to the similarity of the goods at issue. The Applicant's submissions in this regard shall not be summarised here, rather they shall be called upon if they provide assistance during my own comparison of the goods at issue. The Applicant contended that due to the technical nature of the goods at issue the average consumer will pay a high degree of attention.

11. The Applicant argued that the marks are visually different due to their length, and are aurally different due to the contested mark containing an additional syllable which ends in a hard 'K' sound, whereas the earlier mark ends with a soft letter 'Y'. As for the conceptual comparison, the Applicant argued that the earlier mark is mundane whilst the contested mark playfully alludes to the words 'Heal', which means to cure, and 'Holistic', which is used in connection with healing and healthcare.

12. The Opponent did not file submissions.

13. Both parties are professionally represented. The Applicant is represented by Wilson Gunn, and the Opponent is represented by Mohun Aldridge Sykes Limited.

## **Decision**

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Section 5(2)(b)**

15. Section 5(2)(b) of the Act is as follows:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

## **Section 5A**

16. Section 5A of the Act is as follows:

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

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### Comparison of goods

Earlier mark	Application
Class 9: <i>Apparatus and transmitters of electronic, magnetic and/or photonic</i>	Class 9: <i>Software; computer software; software platforms; application software;</i>

<p><i>signals; apparatus for analyzing noise signals to estimate probabilities; software for the afore mentioned products.</i></p>	<p><i>software applications; downloadable software applications; application software for mobile communication devices; databases; recorded data files; database programs; database software; audio and/or video recordings; downloadable data, text, documents, graphics, video images, sound recordings and games; downloadable publications; downloadable electronic publications; software for use in the field of healthcare; e-commerce software.</i></p>
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18. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. It has also been established by the General Court (“GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

22. In its statement of grounds, the Opponent submitted that the earlier mark is registered for electronic apparatus and software, which are either identical or highly similar to the contested Class 9 goods. The Applicant countered that this was “not a very precise description of the very narrowly-defined specialist goods for which the



earlier mark is registered”. For the purposes of comparison, it is necessary to confirm that the earlier mark is in fact registered for specific types of apparatus and specific software.

23. In its submissions, the Applicant argued that the earlier mark’s “narrowly defined software” cannot be held to be similar to the specific software of the contested application. The “narrowly defined software” of the earlier mark is *software for the aforementioned products*, with the aforementioned products being apparatus and transmitters of electronic, magnetic and/or photonic signals; and apparatus for analysing noise signals. It seems to me that the contested *software for use in the field of healthcare* and *e-commerce software* would have a different intended purpose, user and (likely different) trade channels from software that is used in relation to photonic signal transmitters or noise analysing apparatus, for example. I am mindful of the fact that the Opponent did not provide any specific submissions as to any potential overlap. Further, the respective types of software would neither be in competition, nor would they be complementary. In addition, the contested software would be different from the actual apparatus and transmitter goods themselves. The contested *software for use in the field of healthcare* and *e-commerce software* is therefore considered to be dissimilar.

24. I consider the same finding of dissimilarity to apply equally to the contested *application software for mobile communication devices; database software; and database programs*<sup>1</sup>. These types of software have also been specified as relating to devices or trades that are, in my opinion, self-evidently different from photonic signal transmitters or noise signal analysis apparatus, for example. They have different intended purposes, users and (likely) trade channels. Further, they are neither in competition nor are they complementary, and are therefore dissimilar.

25. The contested *Software; computer software; software platforms; application software; software applications; and downloadable software applications*, however, are general categories that would include within them the more specific types of software of the earlier mark, regardless of what the earlier software relates to. The contested *Software; computer software; software platforms; application software;*

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<sup>1</sup> *Programs* is a *synonym* of software, and therefore a finding in relation to software applies equally in relation to programs.

*software applications*; and *downloadable software applications* are therefore considered to be identical in accordance with the *Meric* principle.

26. The contested *databases*; *recorded data files*; and *audio and/or video recordings* are essentially all types of stored information. They have a different nature, intended purpose, use, end user and trade channel to an item which has the function of transmitting and analysing, and its subsequent software. The contested *databases*; *recorded data files*; and *audio and/or video recordings* are therefore dissimilar. The same finding applies to *downloadable data*, *graphics*, *video images*, *sound recordings* and *games*, which are all types of stored information that is available to download.

27. The contested *downloadable text*, *documents*; *downloadable publications*; and *downloadable electronic publications* are essentially forms of literature that can be downloaded, i.e., transferred onto another device. The content of the literature has not been particularised, however, and therefore could include instruction on how to use the apparatus and transmitters of the earlier mark, e.g., a downloadable user manual for a photonic transmitter. The contested *downloadable text*, *documents*; *downloadable publications*; and *downloadable electronic publications* are therefore complementary as a user manual is important and/or dispensable to the goods of the earlier mark.

28. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

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

29. In relation to those contested goods which have been found to be dissimilar there can be no likelihood of confusion. Consequently, I will continue with the assessment

only in relation to the following contested goods, which have been found to be identical or complementary:

*Class 9      Software; computer software; software platforms; application software; software applications; downloadable software applications; downloadable text, documents; downloadable publications; downloadable electronic publications.*

### **Comparison of the marks**

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

32. The respective trade marks are shown below:

Earlier mark	Application
HEALY	HEALISTIC

33. At first glance, it appears that the earlier mark uses a particular stylised font for the letters ‘A’ and ‘Y’. However, upon review of the registration information on the Madrid Protocol System, it is clear that the earlier mark is not figurative:

- The applicant declares that they wish the mark to be considered as a mark in standard characters (only if word mark)

The earlier mark should therefore be considered to consist exclusively of the uppercase word ‘HEALY’, presented in a plain, non-stylised font. I note the Applicant’s submission that ‘HEALY’ is a surname. I also note that the Opponent neither agreed nor disagreed with the Applicant’s submission. In my opinion the term ‘HEALY’ will in fact most likely be perceived as a surname. The overall impression of the earlier mark lies exclusively in the perception of the surname ‘HEALY’, which is also where any distinctiveness lies.

34. The contested mark consists exclusively of the uppercase term ‘HEALISTIC’, presented in a plain, non-stylised plane font. Whilst the Applicant submitted that the contested mark is a combination that alludes to the words ‘Heal’ and ‘Holistic’, the term in and of itself has no meaning in the English language. The overall impression of the contested mark lies in the impression of the seemingly invited term ‘HEALISTIC’, which is also where any distinctiveness lies.

### **Visual similarity**

35. The marks are visually similar insofar as they coincide in their respective first four letters. This is the extent of the visual similarity. The marks differ as to their respective fifth letters, with it being a ‘Y’ in the earlier mark and an ‘I’ in the contested mark. The marks further differ visually due to the inclusion of the additional four letters ‘STIC’ in

the contested mark, which have no counterpart in the earlier mark. Overall, the marks are visually similar to no more than a medium degree.

### **Aural similarity**

36. Aurally the marks are similar insofar as they coincide in the identical first syllable 'HEAL'. The second syllable of the earlier mark is an 'EE' sound ('Y'), whereas the second syllable of the contested mark is an 'IS' sound. The contested mark also contains the third syllable 'TIC', which has no counterpart in the earlier mark. Overall, the marks are aurally similar to between a low and medium degree.

### **Conceptual similarity**

37. The concept of the earlier mark is that of the surname 'HEALY, which I consider to be neither particularly common nor particularly obscure. The contested mark has no concept. Although the term 'HEALISTIC' may be perceived to "allude" to particular concepts by virtue of consisting of the combination 'Heal' and '-istic', as argued by the Applicant, the contested mark is ultimately an invented term which cannot be said to have a clearly identifiable concept. The marks at issue are therefore conceptually dissimilar.

### **Average consumer and the purchasing act**

38. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>2</sup> In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

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<sup>2</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39. The goods at issue include software and downloadable literature. Such goods would likely include versions that are generic and used on a daily basis by the majority of average consumers in both their personal and professional lives, and also versions that are more specific and used for particular reasons by a more specialist consumer. The goods at issue also include apparatus and transmitters (and their associated software) of specific natures and for specific purposes. Such goods would most likely be used by a specialist consumer. The goods at issue would likely vary considerably in cost depending on their ultimate function. With that having been said, however, the price of the goods is immaterial as regards the definition of the relevant public, since price will not be the subject of the registration.<sup>3</sup> Considering the broad scope of the goods, and the broad scope of relevant consumer, the degree of attention is considered to be medium overall.

40. Based on the nature of the goods at issue, they are invariably made available for purchase in both physical and online retail stores, as well as app stores. As such, the purchase process would predominantly depend on the visual aspect. I do not discount the possibility that the goods may also be bought over the telephone from a telemarketer or following consultation with a shop assistant or technical expert, for example, in which case such interactions would rely heavily on an oral exchange. Therefore, it is logical that an aural element would play a part in certain purchasing processes. I nevertheless consider this to be a secondary purchasing process to the visually dominant process.

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

41. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has the Opponent filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

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<sup>3</sup> *Bang & Olufsen A/S v OHIM*, Case T-460/05

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43. In *Kurt Geiger v A-List Corporate Limited* BL O-075-13, Mr Iain Purvis Q.C (as he then was), acting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

44. The earlier mark consists of a plain word without any additional stylisation or figurative elements, and as such any inherent distinctive character rests exclusively in the meaning of the word ‘HEALY’. I agree with the Applicant’s submissions that ‘HEALY’ is a surname and that it will be perceived as such. Whilst I do not agree with the Applicant’s submission that the earlier mark is “mundane”, I nevertheless do not consider surnames to be particularly remarkable or highly distinctive. As the surname ‘HEALY’ has no apparent meaning in relation to the contested goods at issue, and neither party has suggested any potential connection, the earlier mark is considered to be distinctive to a medium degree.

### **Likelihood of confusion**

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and their respective goods and services down to the responsible undertakings being the same or related.

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and



services, and vice versa (see *Canon*, C-39/97, para 17). Further factors to keep in mind include the distinctive character of the Opponent's trade mark, the nature of the purchasing process, and the average consumer of the particular goods and/or services. As regards the average consumer, I must also be alive to the fact that the consumer rarely has the opportunity to make direct comparisons between trade marks, and must instead rely upon the imperfect picture of them that he has retained in his mind.

47. Whilst conducting a global assessment of the likelihood of confusion I must also be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.<sup>4</sup> Having conducted a comparison of the marks at issue, I have determined that it is the visual consideration which is of primary importance due to the purchasing process of the respective goods being visually dominated.<sup>5</sup> With this in mind, I refer to my finding that the marks are visually similar to no more than a medium degree. It is important to reaffirm, however, that I did not rule out the possibility that the marks may be spoken in certain purchasing environments, in which case it is worth considering that I found the marks to be aurally similar to between a low and medium degree.

48. In *El Corte Inglés*,<sup>6</sup> the GC noted that the beginning of words tend to make more of a visual and aural impact than the end of words. The beginnings of the respective marks share the identical four-letter combination 'HEAL', which contribute to the findings that the marks are visually similar to no more than a medium degree, and aurally similar to between a low and medium degree. Despite the degrees of similarity in these aspects, however, I do not consider the coincidence of the same four letters to necessarily indicate that the consumer would mistake 'HEALY' with 'HEALISTIC'. The marks at issue in *El Corte Inglés* were 'MUNDICOLOR' and 'MUNDICOR', with the GC finding that the marks shared the same "root" 'MUNDI', which the GC also described as a prefix. I do not consider the mere coincidence of the four letters H-E-A-L in the marks at issue to constitute a shared root to the degree that it did in

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<sup>4</sup> *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

<sup>5</sup> *Quelle AG v OHIM*, Case T-88/05

<sup>6</sup> *SA v OHIM*, Cases T-183/02 and T-184/02 paragraphs 81 – 83.

'MUNDICOLOR/MUNDICOR', nor do I consider the four letters to represent a prefix. In order constitute a prefix, the collection of letters would have to either impact or influence the subsequent stem of the word. Although the four letters H-E-A-L create the word 'HEAL' in isolation, they do not represent this word within the earlier mark - they are simply the first four letters of a five-letter surname.

49. In addition, it is not a rule that marks which share the same beginnings are automatically visually similar. In *CureVac*<sup>7</sup>, the GC found that the similarity resulting from the identical first three letters of 'RNActive' and 'RNAiFECT' was strongly mitigated by the fact that even though four of the last five letters were the same they did not occur in the same order. The GC found that this gave rise to a "very different visual perception". The contested mark at issue in these proceedings 'HEALISTIC' contains a higher number of letters that are not included in the earlier mark than it actually shares in common. I consider this also gives rise to a very different visual perspective between the signs

50. Of further significance is that fact that the marks at issue are conceptually dissimilar. As is settled in case law, the conceptual differences that are observed between marks may counteract any visual and phonetic similarities they may have.<sup>8</sup> The distinctive character of the earlier mark rests entirely in its concept as the surname 'HEALY'. This concept does not exist in the contested mark. With this in mind, I am of the opinion that the conceptual difference between a surname and invented term is great enough to counteract the visual and aural similarities, which in any case have not been found to be similar to a particularly high degree.

51. Based on the above, I find there to be no likelihood of direct confusion.

52. Having found there to be no likelihood of direct confusion, any likelihood of confusion would now be dependent on a finding of indirect confusion. It should be borne in mind that finding a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.<sup>9</sup> In *L.A. Sugar Limited v*

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<sup>7</sup> *CureVac GmbH v OHIM*, T-80/08

<sup>8</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

<sup>9</sup> *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017*, paragraph 13.

*By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

53. Whilst the categories above do not represent an exhaustive list, they nevertheless represent a fair reflection of instances where indirect confusion “tends to fall”.

54. I acknowledge that the marks at issue coincide as to their respective first four letters H-E-A-L. However, to my mind this does not represent the sharing of a common element. Although the Applicant submitted that the collection of letters represents the allusive word or ‘element’ HEAL in the contested mark, the same collection of letters does not represent a word or ‘element’ in the earlier mark. In my opinion, the consumer will exclusively perceive the earlier mark as the surname ‘HEALY’, rather than perceive it as consisting of the word or ‘element’ HEAL plus an arbitrary letter ‘Y’. The marks at issue would not, therefore, lead to a finding of indirect confusion on the basis that they share an element which is “so strikingly distinctive” that the consumer would assume that no-one other than the brand owner would be using it in a trade mark at all.

55. The marks at issue are also unlikely to lead to a finding of indirect confusion on the basis of the contested mark being perceived as a sub brand or brand extension of the earlier mark. Firstly, the additional letters ‘ISTIC’ in the contested mark do not represent the addition of a non-distinctive element to the degree that ‘LITE’ or ‘MINI’ would. This is because the letters do not represent an element. Secondly, the addition of ‘ISTIC’ does not, to my mind, make any logical sense for a brand extension. I do not consider it likely that upon seeing the contested mark ‘HEALISTIC’, the consumer would believe the brand owner has extended its brand by replacing the letter ‘Y’ of the earlier mark with the collection of letters ‘ISTIC’.

56. Based on the above, I find there to be no likelihood of direct confusion.

57. I am aware of the interdependency principle, whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods and services at issue, and vice versa. Although the goods at issue have been found to be either identical or complementary, I do not consider this to offset the differences between the marks at issue. By conducting a global assessment it seems to me that the only similarity between the marks at issue is the sharing of the four letters H-E-A-L, which although are at the beginning of each mark are nevertheless parts of marks which have greater visual, aural and conceptual differences. The mere coincidence of the letters is not enough, in my opinion, to cause

the consumer to either directly or indirectly confuse the invented term 'HEALISTIC' for surname 'HEALY.

### **Conclusion**

58. The opposition fails in its entirety. Subject to an appeal, the contested application may proceed to registration.

### **Costs**

59. As the opposition has failed, the Applicant has been successful and is entitled to a contribution towards its costs. I bear in mind the guidance in Tribunal Practice Notice 2/2015 which governs costs in Fast Track proceedings issued after 1 October 2015. In the circumstances I award the Applicant the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering a notice of opposition and

filing a counterstatement	£200
Preparing submissions	£100
Total	£300

60. I therefore order Healy International AG to pay Daniel Bulkin the sum of £300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 12<sup>th</sup> day of May 2023**

**Dafydd Collins**

**For the Registrar**