

O-139-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2360584  
IN THE NAME OF WELLCARE CO., LTD  
TO REGISTER THE TRADE MARK WELLCARE IN CLASSES 10 AND 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 93183 IN THE NAME OF  
WELLCARE LIFESTYLE CLINICS LIMITED**

**Trade Marks Act 1994**

**IN THE MATTER OF Trade Mark Application No. 2360584  
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to register the trade mark WELLCARE in Classes 10 and 11**

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**IN THE MATTER OF opposition thereto  
under No. 93183 in the name of Wellcare Lifestyle Clinics Limited**

**BACKGROUND**

1. On 8 April 2004, Wellcare Co., Ltd made an application to register the trade WELLCARE in Classes 10 and 11 in relation to the following specifications of goods:

- |          |  |
|----------|--|
| Class 10 | Massage and massaging apparatus and instruments including mats, chairs, beds, pads and cushions  |
| Class 11 | Heating pads; heating mats; warming wraps; warming garments; foot warming slippers; warming gloves; warming rugs; warming belts; warming hair covers; warming facial masks, massage bath fittings and instruments. |

The application proceeded with the consent of E622670

2. On 9 February 2005, Wellcare Lifestyle Clinics Limited filed notice of opposition to the application, the grounds of opposition being as follows:

- 1. Under Section 5(2)(a)** because the mark applied for is identical to the opponents' earlier marks, and is sought to be registered in respect of goods that are similar to those for which this earlier mark is registered, such that there exists a likelihood of confusion.
- 2. Under Section 5(2)(b)** because the mark applied for is similar to the opponents' earlier marks, and is sought to be registered in respect of goods that are identical or similar to those for which this earlier mark is registered, such that there exists a likelihood of confusion.
- 3. Under Section 5(3)** because the mark applied for is the same or similar to the opponents' earlier marks for which they have a reputation, and is sought to be registered in respect of goods that are the same or similar to those used in the provision of the opponents' healthcare services, such

that use of the mark by the applicants would take unfair advantage of, or be detrimental to the distinctive character of the opponents' reputation.

**4. Under Section 5(4)(a)** by virtue of the law of passing off.

Details of the earlier marks relied upon by the opponents in these proceedings can be found as an annex to this decision.

3. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

4. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

**Opponents' evidence**

6. This consists of a Witness Statement dated 25 October 2005, from William Robert Tennant, a partner in Sandiford Tennant LLP, the opponents' representatives in these proceedings.

7. Mr Tennant states that the opponents were established in 1979 and are a national company offering specialised clinics in General Practice to complement NHS services in areas of medical care otherwise not easily available. He states that since 1979 the opponents have used the mark WELLCARE in respect of the goods and services covered by registration No. 2202338, and more recently, the stylised mark "WELLCARE LIFESTYLE CLINICS in respect of the goods and services covered by registration No. 2202340. Mr Tennant says that the opponents also use the stylised marks "WellCare" and "WellCare Private General Practice" on the goods and services covered by application Nos 2398374 and 2398376. Details of the above mentioned marks are shown as Exhibit BT1. Mr Tennant says that the opponents are generally known and referred to as WELLCARE by patients and the medical profession, but not how he knows this to be the case.

8. Mr Tennant lists the opponents' turnover and advertising for goods and services as follows:

<b>Turnover</b>	
£	
1999	97,000
2000	158,000
2001	159,000
2002	286,000
2003	610,000

2004	629,000
2005	931,000

### **Advertising**

	£
1999	18,000
2000	29,000
2001	34,000
2002	26,000
2003	31,000
2004	37,000
2005	37,000

9. Mr Tennant refers to Exhibit BT2, which consists of features that appeared in the press. Most that do not include details of when and where it appeared have some or all of this information entered in manuscript. The earliest, dated 11 January 1989, appeared in the South Wales Echo and refers to an initiative run by Wellcare UK Ltd who were conducting heart tests. A further article dating from 26 January 1999 that is marked as having come from the Guardian refers to the creation of a “fifth Wellcare Lifestyle Clinic – a business that focuses almost entirely on impotence therapy”. The article later refers to the “...Bath based Wellcare clinic...”. Another article published in an unnamed publication on 24 November 1999, refers to The WellCare Lifestyle Clinic as “A pioneering health clinic scheme which started in Bath a year ago is looking to continue its expansion.” The headline states “TREATMENT BOOM - WellCare ready to extend its 16 centres” and mentions the start of “..the WellCare firm “20 years ago...”. The article refers to the clinic as offering Viagra, a weight management course with the slimming pill Xenical, an anti-shyness pill Seroxat and the flu jab Relenza. Other parts of the exhibit refer to the WellCare Lifestyle Clinic offering HPV tests (July 2000), to WellCare providing separate inoculations for measles, mumps and rubella, (2003), Wellcare Private Clinic opening in Leeds (2003), and Hormone testing analysis (2004).

10. Mr Tennant refers to Exhibit BT3, which he describes as a selection of advertisements from local and national publications. The exhibit consists of a Patient Information pack that gives details of the services available, and the locations at which they may be obtained. Apart from a mention of WellCare having been established in 1979, and references such as “WellCare has over 20 years experience...” and “...over 25 years in private health care...”, which could place the material at any time from 1999/2000 to 2004/2005, it is not possible to date any part of this exhibit. There is no information that explains how many, and to whom this material has been distributed, and although Mr Tennant later says that the opponents distribute approximately 15,000 advertising leaflets each year, he does not say that this figure relates to the pack, or any part of it. Exhibit BT4 consists of a number of undated advertisements from newspapers, which have the WellCare and gender symbol logo as a header, the words “Private General Practice” beneath, and refer to WellCare or WellCare’s in the body of the advertisement.

11. The remainder of Mr Tennant’s Statement consists of submissions on the identity of the respective marks, the similarity in the goods/services, the nature and extent of the opponents’

reputation. Whilst I will take these comments into account in my decision, I do not consider it to be appropriate or necessary that I summarise them here.

### **Applicants' evidence**

12. This consists of a Witness Statement dated 17 January 2006, from Shu-Chih Wu, President of Wellcare Co., Ltd, a position he has held since 1995.

13. Mr Wu states that his company has exported products under the trade mark WELLCARE to the UK since at least 1997. He refers to Exhibit SCW1, which consists of the following items of printed material:

- leaflets for a sound generator to aid relaxation that is sold under the general name WELLCARE but specifically branded "NATURCARE™ RELAXATION". The page contains a copyright reference of 2004 but otherwise cannot be dated, or placed as having been available in the UK.
- extract from "MegAsia – a premier sourcing guide for Asian general merchandise... Vol. Feb 2003". The top is endorsed "Year 2003 buyers' guide of trade show in London with wellcare brand products", information confirmed by Mr Wu. The second page lists companies, inter alia, Wellcare Co., Ltd, showing them as having a booth, and to use the brand name WELLCARE. The products of the company are listed as an air bubble bath spa, massage mat, massage cushion, hand and neck massage, massage chair and nature sounds with aroma releaser.
- information from Global Sources, endorsed as originating from 1997, and showing the company as having a 16% share of the European market.
- extract from the June 1997 edition of a publication entitled "Asian Sources Gifts & Home" that contains an advertisement for the WELLCARE relaxation massage mat and sound generator. The prices quoted as in \$ which suggests that this is not a UK publication, or at least it is not clear that it is.
- Contract lists from 1997. It is not clear what products these relate to, or who/where the other contracting party is.
- Pages from the Wellcare Co Ltd website taken on 1 April 2006. This shows the company to have been established in 1995 and states that they currently market their goods worldwide, but not specifically in the UK.
- Page endorsed as coming from the Kleeneze mail order magazine, but does not say when this was available. The page shows a massage mat with a sound function and quotes the prices in £. However, apart from the manuscript entry indicating that this is a WELLCARE product there is no mention of the name.

14. Mr Wu confirms that he founded the company in 1995, and that it is a manufacturer and

dealer in products for relaxation. He explains the origins of the WELLCARE trade mark, and that two sister companies trade under the names “Procare” and “Goodcare”. He says that he had no prior knowledge of the opponents, and is not aware of any instances of confusion.

### **Opponents’ evidence in reply**

15. This consists of a Witness Statement dated 18 May 2006, from Bill Tennant, a partner in Sandiford Tennant LLP, the opponents’ representatives.

16. Mr Tennant refers to Exhibit BT1, which consists of a letter setting out the opponents’ arguments in reply to the applicants’ evidence. Whilst it is not necessary or appropriate that I summarise these as evidence, I will consider and take into account all submissions in my determination of this case.

17. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

### **DECISION**

18. Turning first to the grounds founded on Section 5(2)(a) and (b). Those subsections read as follows:

“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, or
- (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.”

19. An earlier trade mark is defined in Section 6 of the Act as follows:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or International trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

20. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases

that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG & Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

21. The opponents rely on two earlier trade mark registrations, neither of which achieved registration more than five years prior to 12 November 2004, the date on which the application in suit was published. This being the case, the provisions of Section 47(2)(A)

introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

22. The opponents rely on two earlier marks, Nos 2202338 and 2202340. The first consists of the word WellCare without any addition or embellishment, the second consists of a series of two marks composed of the word WellCare in a plain font, the letters “e” being encapsulated within the circle of male-female gender symbols respectively, placed above the words Lifestyle Clinics in an italicized script.

23. In their Counterstatement the applicants state that their mark WELLCARE “...is not closely similar to the Opponent’s stylized mark “WellCare Lifestyle Clinics”. They make no mention of the opponents’ other mark, No 2202338, for the word WellCare in plain lettering. The only difference between this and the mark applied for is that in the case of the opponents’ mark the letter “W” in “Well” and “C” in Care is in capital letters with the remaining letters in lower case, whereas the applicants’ mark is entirely in upper case. As far as I am aware, and there is no evidence to the contrary, WELLCARE is not an existing word, but a combination of two ordinary English words “WELL” and “CARE”, so whether represented in the upper/lower case style of the opponents’ mark, or all in upper case as in the applicants’ mark, it will be obvious to the consumer of the goods and/or services in question, that these are marks composed of two conjoined words. The respective marks are visually extremely close, identical in sound when spoken, and insofar as they convey any message, both send the same. If these marks are not identical, they are as close as it is possible to get without being so.

24. The opponents’ second mark has the word WellCare represented in the same upper-lower case style, and if taken absent of any added matter, the WellCare element of the opponents’ stylized mark must also be identical to the mark applied for, or all but. The letter “e” in Well” is encapsulated in the circle of the male gender symbol, the letter “e” in “Care” being represented in the same fashion within the female gender symbol. Gender symbols are well known to the public, and given their relevance for medico-pharmaceutical goods and/or services for which the opponents’ mark is registered, their addition may affect the visual appearance, but will not impact upon the sound of the word when spoken, and will have limited impact upon any conceptual idea created, if anything they may enhance the connection with treatments specifically for a particular gender, eg, erectile dysfunction. The addition of the words “Lifestyle Clinics” must have an impact on any visual similarity of this mark as compared to the applicants’ mark. However, “Lifestyle” and “Clinic” are ordinary English words that will be well known to the relevant consumer who is likely to see them as saying something about the connected goods and/or services. In this mark I would say that WellCare is the distinctive and dominant element, particularly given its relative positioning. When the other matter is factored in and the mark as a whole is compared with the applicants’ mark, I take the view that they are similar, albeit less so than the opponents’ mark for WellCare solus.

25. As I have said, WELLCARE is clearly a portmanteau word composed of WELL and CARE conjoined, and I have little doubt that this is how the consumer of the relevant goods and services will see it. Individually these words would be descriptive of a characteristic of goods, and perhaps more so for services that are for making people feel well or for caring for their well being in some way. In combination they are a “syntactically unusual



juxtaposition” of elements that, although are none too covert in their meaning, are nonetheless not directly descriptive; they are an allusion. In relation to the goods and services for which it is registered, this is a word with an average level of distinctive character. I have already commented that in the opponents’ stylized mark, the gender symbols and the words “Lifestyle Clinic” individually and collectively add little or nothing in terms of distinctiveness.

26. The opponents claim use of WELLCARE in the UK dating from 1979, the first use being in the plain font version, with later use being in the stylised form with the words “LIFESTYLE CLINICS”. The earliest actual mention of the name in the evidence can be found in an extract from the 11 January 1989 edition of the South Wales Echo, which refers to Wellcare UK Ltd running a heart screening initiative. Another article published on 24 November 1999, refers to the start of the WellCare firm “20 years ago”, which provides some corroboration for the first use date claimed. The article refers to the clinic as offering Viagra, a weight management course with the slimming pill Xenical, an anti-shyness pill Seroxat and the flu jab Relenza. Another article marked as having been published in the 26 January 1999 edition of the Guardian, refers to the WELLCARE LIFESTYLE CLINIC as a business focused “almost entirely on impotence therapy”. Other parts of the evidence refer to the WellCare Lifestyle Clinic offering HPV tests (July 2000), WellCare providing separate inoculations for measles, mumps and rubella, (2003), and the provision of hormone testing analysis (2004).

27. Exhibit BT3 consists of a Patient Information pack that gives details of the where and what services are available from WellCare. The pack mentions “WellCare having been established in 1979, with over 20 years experience...” and “...over 25 years in private health care...”. Whilst this corroborates the start of the business, it places the material as being current at any time from 1999/2000 to 2004/2005: it is not possible to accurately date any part of this exhibit. There is no information as to how many, and to whom this material has been distributed. Mr Tennant says that the opponents distribute approximately 15,000 advertising leaflets each year, but he does not say that this relates to the pack, or any part of it.

28. Taken as a whole, the evidence substantiates that in 1979, the opponents were using WELLCARE as part of their corporate name for what was to become a group of clinics, but not in relation to what. It shows such use in 1989 when the opponents were involved in the provision of a heart screening service. By 1999 WELLCARE was primarily known in relation to clinics involved in the provision of impotency treatment, including the prescribing of Viagra, and also the provision of a weight management course with the slimming pill Xenical, anti-shyness treatment using the pill Seroxat and flu treatment by prescribing the jab Relenza. This use has been using both versions of the marks that the opponents registered. Turnover and advertising figures are not massive, but neither are they wholly insignificant in what I would suspect is a specialised market where providers will quickly become known. I am satisfied that at the relevant date the opponents had a reputation in respect of medical clinic services focussed on the treatment of medically related conditions, this being mainly the treatment of impotency, and to a lesser extent, weight problems and shyness. These also involved the prescribing of related pharmaceuticals. The use in relation to medical testing and the provision of vaccinations is somewhat more recent and if there is any reputation in

respect of these services it is likely to be of lesser significance. The hormone testing activity is potentially a service that commenced after the relevant date so should be disregarded.

29. Turning to the question of the similarity (or otherwise) of the goods and services covered by the opponents' earlier marks, and the goods for which the applicants seek registration. Whilst the evidence indicates that the opponents trade in a range of goods that have a similarity in their purpose to those covered by Class 10 of the application, as I have mentioned, such goods are not encompassed by their earlier marks. But in any event, I am required to determine the matter on the basis of the "notional" range of goods and services covered by the respective specifications.

30. In deciding whether the goods and/or services covered by the opponents' earlier mark are the same as, or similar to the applicants' goods, I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297) as set out below:

"...the following factors must be relevant in considering whether there is or is not similarity:

- (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 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 the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors."

31. Whilst I acknowledge that in the view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, as can be seen from the following paragraph, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods:

"23. 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, intended purpose and their method of

use and whether they are in competition with each other or are complementary.”

(see paragraph 56 of Case T-169/03 explaining the change from “end consumers” to “intended purpose”. This appears to have resulted from a mis-translation of the original text.)

32. The criteria in *Treat* clearly indicates that consideration should be given to the nature of the goods, and the circumstances of the trade. It is certainly true that evidence from or relating to the manner in which the market in the respective goods is conducted can be of considerable help in determining whether goods, and or services should be considered similar. This does not, however, mean that absent such evidence the registrar cannot make a judgment based upon his knowledge of the types of goods or services that fall within the class(es) in which the respective goods have been applied for or registered (as required by *Altecnic's* application [2002] RPC 34), and the notional extent of the specification based upon the usual and ordinary meaning of the descriptions.

33. The opponents' specification covers pharmaceuticals and a medical travel kit, and services relating to the dispensing of medicines and the provision of medical services. The application covers “massage” and “heating/warming” items of various types and forms. I do not see that there can be much argument that a pharmaceutical/medical kit has a different use to goods for massage and heating/warming. In the case of massage apparatus/instruments, it seems to me that a medical service, for example one involved in the rehabilitation of a patient, may involve the provision of massage, so at least in that respect the use of the applicants' Class 10 goods, and the services covered by Class 42 of the registration have the same use.

34. Whilst heating/warming items of the type listed in Class 11 of the application may be used in the provision of the opponents' services, such goods if for medical purposes would fall in Class 10 (See “Heating cushions [pads], electric, for medical purposes” 9<sup>th</sup> Edition Nice Classification). In any event, the fact that a potentially similar item could be used in the provision of a service does not make them for the same use; one heats/warms, the other treats using heat or warmth. I therefore consider these goods and the opponents' services to have different purposes. However, for the reason I have given above, the massage bath fittings and instruments may be for a similar purpose.

35. The goods and services covered by the opponents' earlier mark are expressed in general terms that state them to be pharmaceutical, and/or medical goods and services, notionally ranging from the provision of simple, non-prescription medicaments and treatments for minor ailments, to the most sophisticated and specialized pharmaceuticals and procedures requiring the involvement of highly qualified practitioners from within the medical and pharmacy professions. The goods listed in the application are more specific, but unqualified as they are, notionally contain a range from the simple to the sophisticated. In both cases the goods/and/or services are capable of ranging from the type purchased off-the shelf by the public at large, and specifically to order by the trained and knowledgeable professional. The services covered by the opponents' earlier mark are equally capable of covering the routine to the complicated, but in all cases provided by a trained individual. I see nothing that would restrict the notional consumer of such services to any particular group, and that being the case, I have to assume that the consumer base also ranges from the public at large who goes

looking for a particular treatment, to the medical professional who may obtain the service on behalf of a patient.

36. Whether or not they are for the same purpose, pharmaceuticals and apparatus/instruments are self-evidently different in nature. Even more obvious is the difference in nature of goods and acts of service; one is tangible, the other not.

37. Given that the opponents' Class 5, and the applicants' Class 10 specifications contain medically related goods, it seems to me that they may meet somewhere in the trade channels, most likely in the retail end such as large chemists. However, I do not know, and there is no evidence to assist me, whether a pharmaceutical company, or one producing medical travel kits would also be involved in the manufacture of apparatus of the kind covered by the application. It does not seem so unlikely that medical kits and other types of items of the kind covered by the application should meet in the trade channels, but given the controlled manner in which pharmaceuticals reach the end consumer it seems an unlikely scenario that the same would be the case in respect of these goods. Quite clearly, services have no route to the end user; the consumer is either referred to the provider, or seeks them out themselves. I see no reason why non-prescription pharmaceuticals and travel kits should not be sold in the same, self-serve environment such as supermarkets, as the massage apparatus and heating/warming items of the application, but given the propensity for grouping goods of a like kind together, will clearly be on different shelves if not in different areas of the outlet. In large retail chemists the same is also the case in respect of prescription pharmaceuticals, but of course such goods will be kept well away from the consumer.

38. Insofar as massage may be used as a therapeutic treatment in medical centers and clinics, the goods for that purpose covered by the application could potentially be in competition, or at least complementary to the services notionally covered by the opponents' earlier mark. The same can be said of the "consultation" services. However, whilst pharmaceuticals may be used in the treatment of medical conditions, such goods are one step removed from the physical activity of providing medical and therapeutic treatments such as massage, and are, at best, complementary.

39. I have no evidence of how the trade classifies or considers the respective goods and services, or whether market research companies who act for the industry put the goods or services in the same or different sectors. To my mind there may be a correlation where these are for the same purpose, or used as part of a single treatment regime, but they may just as easily be considered completely distinct areas.

40. Given the need to ensure that the goods/services obtained are fit-for-purpose, and the potential harmful consequences should they not be, it seems to me that whether it is the man in the street or the professional that is the purchaser, when obtaining the relevant goods/services covered by the opponents' earlier marks, the degree of observance and circumspection will be higher than would ordinarily be the case; this will be a deliberate and informed purchase. The goods covered by the application, particularly those for heating/warming covered by Class 11 may be less sophisticated, but would, nonetheless be bought with care and attention.

41. I come to the view that whilst there is a degree of overlap in the “notional” trade circumstances between the goods covered by Class 10 of the application and the “massage” items in Class 11, and the goods and services covered by the opponents’ earlier mark, taking the nature of the goods and services and the lack of any trade information into account tips the balance against a finding of similarity. The heating/warming goods covered by Class 11 of the application are even further apart from the goods and services covered by the opponents’ earlier marks and are clearly not the same or similar.

42. Taking all factors into account and adopting the global approach advocated, I come to the position that even though the respective marks are either identical or similar, the differences in the other relevant factors are such that a person familiar with the opponents’ services, on seeing goods of the type covered by the application bearing the same or a similar mark, may be reminded of the opponents, but this association would not be such so as to cause a belief that they are goods from the opponents, or some linked undertaking. The only real connection is that some of the goods covered by the application “may” be used in the provision of the medical and therapeutic treatments notionally covered by the opponents’ earlier marks. There is no evidence that such medical centres trade in goods that they may use, and I do not see that there would be any expectation of this by the consumer. Consequently, I do not see that there is a likelihood of confusion within the meaning of Section 5(2), and the objections under subsections (a) and (b) of that section are dismissed.

43. Turning to the ground under Section 5(3) of the Act. As a result of Regulation 7 of The Trade Marks (Proof of Use etc) Regulations 2004, that section now reads:

“5.-(3) A trade mark which

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

44. The opponents’ put their objection under Section 5(3) as follows:

“The opponent has been using the earlier mark for over 25 years and has built up a reputation for high quality healthcare in the provision of its services and goods at several clinics throughout England and Wales. The goods included in Classes 10 and 11 of the Applicant’s mark are the same or similar to the goods used in the provision of the Opponent’s services and such use will be detrimental to and take unfair advantage of this reputation. The provision of healthcare services obviously needs to be of a high standard and the Opponent is concerned that its excellent reputation will be damaged by the Applicant’s use of an identical mark.”

45. I have already stated in my determination of the earlier grounds, that the applicants’ mark is identical to one of the opponents’ earlier marks, and similar to the other, so the first part of

Section 5(3) is met. I have also given my view that the specifications of the opponents' earlier marks do not contain goods or services that are the same or similar to those covered by the specifications of the mark applied for. However, unlike Section 5(2) that is not the end of the matter. Section 5(3) is not a notional consideration of specification against specification, but is a comparison of the goods of the application against the goods and/or services for which the opponents have used their mark, and built a reputation. So in order to get its case any further, the opponents must establish that its earlier marks have a reputation of sufficient scale such that use by the applicants would have a negative impact on its distinctive character or repute, or give some unfair advantage to the applicants' mark. Guidance on assessing whether the reputation requirement has been met can be found in *General Motors Corporation v Yplon SA*, Case C-375/97, where it was stated:

“23. ..In so far as Article 5(2) of the Directive (is concerned) ...It is only where there is sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for nonsimilar products or services, and that the earlier trade mark may consequently be damaged.”

and

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

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

46. In my consideration of the grounds under Section 5(2), I accepted that the evidence substantiated use of WELLCARE by the opponents dating from 1979 as part of their corporate name for what was to become a group of clinics. However, whilst generally supporting the claim to 25 years use, the evidence does not show what they were actually using the mark for at that time. Over the years they have used the trade mark in connection with medical clinic services throughout a significant part of the UK, focussed primarily on the treatment of impotency, and also weight management, shyness and influenza. These activities also involved the prescribing of related pharmaceuticals. There is also use of WELLCARE in relation to medical testing and the provision of vaccinations, but these activities are somewhat more recent, and if there is any reputation in respect of these services it is likely to be of lesser significance. There is no evidence that tells me the size of the market in which the opponents operate that would enable me to put their use into context and gauge the likelihood and significance of any reputation. The most I can do is make an assessment based on the turnover and advertising figures provided. These are not massive, but nonetheless indicate that the trade carried out under the WELLCARE name has not been insignificant, particularly when considered in the context of what must be a specialised market. Being specialised it is likely that providers will quickly become known. I consider I am justified in accepting that at the relevant date the opponents had some reputation for

WELLCARE amongst a significant part of the relevant public and industry concerned, in respect of medical clinic services focussed on the treatment areas I have mentioned.

47. So we are now at the position where I have determined that the applicants' mark is identical and similar to the opponents' earlier marks, and that the opponents have a reputation. Therefore, the question hinges on whether advantage will be unfairly gained, or detriment caused by the applicants' use of WELLCARE in relation to the goods for which they seek registration. In the *Chevy* case, the ECJ said the following:

“43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “takes unfair advantage of, or is detrimental to”. Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion: see the tenth recital of the preamble.”

48. The opponents have not explained how or why there would be detriment to their reputation should the applicants use the mark applied for in respect of the goods for which they seek registration. They simply say that there will be detriment caused to, or unfair advantage taken of their reputation. On my assessment of the evidence, the only goods that the mark appears to have come anywhere near is the pharmaceuticals prescribed as part of the medical treatment, goods which are substantially different to those of the application. It is my experience that medical clinics do not, as a rule, dispense pharmaceuticals themselves, but issue a prescription to be taken to a dispensing chemist. There is no evidence that the WELLCARE clinics dispensed themselves, so I do not see how this aspect of the opponents' reputation could be affected, or give the applicants some positive benefit.

49. More specifically, the opponents' refer to the fact that the goods covered by the application “...are the same or similar to the goods used in the provision of the Opponent's services.”. That may well be the case, but would that lead to damage or detriment being caused, or advantage gained should the applicants use their mark in connection with such goods? There are circumstances where a medico-type service such as an optician will also sell the goods that they prescribe. To my mind there is no evidence that, beyond issuing a prescription, a medical centre of whatever type would be expected to provide goods other than those that are specifically used in a treatment regime, eg, bandages. I therefore do not see why the relevant consumer of their services would make the link that could lead to detriment or advantage.

50. The final part of their objection is that the provision of healthcare services needs to be of a high standard, and the opponent is concerned that its reputation will be damaged by the applicant's use of an identical mark. They do not say why this would be the case, or how such damage would occur, and for the reasons I have already set out, I do not see that either of these events is likely to arise. In *Premier Brands UK v Typhoon Europe* [2000] FSR 767, it was stated:

“Section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same or similar to, a registered trade mark with a “reputation” nor is section 10(3) intended to enable the proprietor of a well known registered mark “... to be able to object as a matter of course to the use of a sign which may remind people of his mark.”.

51. The intended purpose of the services for which the opponents’ are likely to have established a reputation do not involve massage of treatment by warming, at least there is no evidence that they do. As I have already said, there is no evidence that treatment centres, be they of the kind operated by the opponents’ or offering general medical care trade in any goods. Taking this, and all of the other factors into account, I come to the view that even though the respective marks are the same/similar, and the earlier trade marks have a reputation, I do not see how use of the later mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponents’ earlier trade marks. The objection founded on Section 5(3) is also dismissed.

52. This leaves the ground under Section 5(4)(a). That section states:

“5.-4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

53. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] RPC 455. In that decision Mr Hobbs stated that:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol 48 (1995 reissue) at paragraph 165.

The

guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff;

and

(3) that the plaintiff has suffered or is likely to suffer damage as a`



result of the erroneous belief engendered by the defendant's misrepresentation."

.....Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

54. The first matter that I have to decide is the material date. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v*

*Camelot Group PLC* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

55. Consequently, the material date cannot be after the date of application. There is no conclusive evidence of use of the trade mark by the applicants, so the behaviour complained of is the act of filing the application which occurred on 8 April 2004.

56. I have already accepted that the opponents have established a reputation in the trade mark WELLCARE in respect of medical clinic services for specific treatments, the provision of pharmaceuticals and inoculations for use in those therapies, and medical testing. These services, and even the related goods for which the opponents have a reputation may be considered to overlap because they may be for treatment or therapeutic use, but as I have already said, there is no evidence that the treatments provided by the opponents would involve massage or warming. To my mind there is no natural relationship or progression in trade from the goods and services provided by the opponents to those covered by the application.

57. The difficulty of establishing confusion where there is a distance between the fields of activities was considered by Millet L.J. in *Harrods v Harrodian School* [1996] RPC 697 Millet L.J. stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

And

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

58. In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade L.J. considered the difficulty of establishing damage where the parties are in different lines of business:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs, as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than a minimal loss is in my opinion a heavy one.”

59. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31, Lord Fraser emphasised the substantial nature of the damage that a plaintiff must establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

60. Christopher Wadlow in “The Law of Passing-Off” (third edition) at 4-23 puts forward the following proposition:

“Most of the authorities may perhaps be reconciled with the proposition that the risk of damage is sufficiently real if:

1. Confusion between the parties will be widespread and inevitable, even though there may be no immediate reason to believe that actual damage in any particular form will occur, or

2. There will be some confusion of the parties, and the defendant’s business poses a special risk to the claimant because of the way it is currently conducted or because of future developments which can actually be expected. If confusion with the claimant is slight and tangible damage speculative then there is no liability for passing off.”

61. Even though the respective trade marks are identical and similar, the distinction in the respective activities does not necessarily mean that this amounts to a misrepresentation that would lead to confusion or deception. The distance between the spheres of activity means that it does not automatically follow that there would be damage. It is also important to bear in mind that in *Mastercard International v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) Smith J held that there “must be real possibilities as opposed to theoretical possibilities” of the damage claimed. In *Electrocoin Automatics Limited v Coinworld Limited and others* [2004] EWHC 1498 (Ch) Mr Geoffrey Hobbs QC (sitting as a deputy judge) stated:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, 'the link' established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

62. I have been through the reasons why I do not consider there to be a likelihood of consumers being led into believing that there is a connection between the opponents’ goods for which they have registered the mark, and there is even less reason to infer this from the actual use made. I see no reason why the public would be deceived into buying the applicants’ goods believing them to have directly or indirectly originated from the opponents. As Millet LJ in *Harrods v Harrodian School* stated, “To be known to everyone is not to be known for everything.”. In my view there is no likelihood of damage, and the opposition under Section 5(4)(a) fails.

**63. In summary, the grounds under Section 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) fail.**

64. The opposition having been unsuccessful, the applicants are entitled to a contribution towards their costs. I therefore order that the opponents pay the applicants the sum of £1,950 towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25th day of May 2007**

**Mike Foley  
for the Registrar  
the Comptroller-General**