

**O-256-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3288855  
BY MY DNA HEALTH LTD.  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 5, 41 AND 44:**

**mydnahealth**

**AND**

**OPPOSITION THERETO UNDER NO. 412775  
BY DEWAN FAZIUL HOQUE CHOWDURY**

## BACKGROUND

1. On 8 February 2018 My DNA Health Ltd. (“the applicant”) applied to register the trade mark “mydnahealth” for goods and services in classes 5, 41 and 44.

2. The application was accepted and published for opposition purposes on 8 June 2018.

3. Dewan Faziul Hoque Chowdury (“the opponent”) opposes registration under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK registration 3117087 (“the earlier mark”), for a range of goods and services in classes 5, 35 and 44. The earlier mark was filed on 9 July 2015 and registered on 13 November 2015. The earlier mark is as follows:



myDNA

4. The opponent claims that because of the similarity between the opposed mark and the earlier mark and the similarity between the goods and services of the opposed mark and those of the earlier mark, there exists a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies the grounds of opposition. The counterstatement contained references to communications between the parties made in the context of settlement negotiations, though they were not expressly labelled “without prejudice”. Suffice to say that the content of these communications is not relevant, and I will say no more about it.

6. Only the opponent filed submissions dated 5 November 2018. Neither party filed evidence or requested a hearing. This decision is reached following careful consideration of the papers.

7. In these proceedings the opponent is represented by Serjeants LLP; the applicant is not professionally represented.

## DECISION

9. Section 5(2)(b) of the Act reads:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10. The opponent’s mark is an earlier trade mark within the meaning of section 6(1) of the Act. It is not subject to a requirement to provide proof of use.

### **Section 5(2)(b) - case-law**

11. 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 greater 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 and services**

12. In comparing the respective specifications, all the relevant factors should be taken into account. 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:

“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”.

13. 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.

14. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

16. 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 OHIM*, Case T-325/06, the General Court (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".

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

18. Whilst on the other hand:

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

19. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

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

20. The parties’ goods and services are as follows:

Applicant's goods and services	Opponent's goods and services
<p><b>Class 5:</b> <i>Health food supplements made principally of vitamins.</i></p> <p><b>Class 41:</b> <i>Health and wellness training.</i></p> <p><b>Class 44:</b> <i>Health care; Health-care; Health-care services; Healthcare; Healthcare advisory services; Healthcare consultancy services; Healthcare information services; Healthcare services; Human healthcare services; Information relating to health; Managed health care services; Medical and health services relating to DNA, genetics and genetic testing.</i></p>	<p><b>Class 5:</b> <i>dietetic substances adapted for medical use; medicated confectionery; herb teas and infusions; medical preparations for slimming purposes; vitamins; vitamin preparations.</i></p> <p><b>Class 35:</b> <i>Retail services in connection with the sale of cosmetic preparations, pharmaceutical preparations, non-medicated toilet preparations.</i></p> <p><b>Class 44:</b> <i>Medical and healthcare services relating to genetics and genetic testing; medical and healthcare clinics.</i></p>

21. The applicant accepts that there is a degree of overlap between the parties' goods in class 5 and services in class 44 but argues that the opponent's use focuses more on medical and pharmacological use, whereas the applicant's use focuses on health supplement. These are not attributes which I am able to project on to the assessment of the goods and services concerned. As these proceedings are concerned with an opposition to an application to register a trade mark, rather than infringement proceedings, it is notional and fair use<sup>1</sup> of both parties' specifications across all segments of the markets which must be the basis for the assessment, and not the use made by the parties of their trade marks<sup>2</sup>. Consequently, I must include consideration of the likelihood of confusion in the hypothetical case of the parties (and their successors in title to the marks) deciding to target the same segment of the market. The fact that the parties are currently, or currently intend to, target different market segments is irrelevant.

<sup>1</sup> *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41

<sup>2</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 (paragraph 66)



### Class 5

22. The applicant's *health food supplements made principally of vitamins* are likely fall within the opponent's *dietetic substances adapted for medical use* and *vitamin preparations* and encompass the opponent's *vitamins*. It follows that the respective goods are identical in accordance with *Meric*; if not identical, there is a very considerable overlap and high degree of similarity between these goods by virtue of their nature, use, purpose and channels of trade.

### Class 41

23. The opponent states that the applicant's *health and wellness training* are complementary to its services in class 44. It argues:

“[...] people working within the medical and healthcare service or in the clinics are likely to partake in training. It may be that the clinic is run by the opponent and the training is run by the applicant, drawing an association between them both”

24. I agree with the opponent that in order to provide direct clinical work to its users, the opponent will need to provide training intended to build skills and capacity to its staff, for the purpose of which it could commission the applicant's services. There is therefore a certain degree of relatedness between the requirements fulfilled by the applicant's *health and wellness training* and the delivery of the opponent's *medical and healthcare clinics* such that it gives rise to a complementary relationship. Furthermore, the services could be provided by the same undertakings and target the same users. In my view, the respective services are similar to a medium degree. Alternately, the applicant's *health and wellness training* services could relate to the management of weight control and are also similar to a medium degree to the opponent's *medical preparations for slimming purposes* since they are highly complementary, target the same users and might be provided by the same undertakings through the same trade channels.

#### Class 44

25. The applicant's *medical and health services relating to DNA, genetics and genetic testing* and the opponent's *medical and healthcare services relating to genetics and genetic testing* cover fundamentally the same services and are identical.

26. The applicant's *health care; health-care; health-care services; healthcare; healthcare services; human healthcare services; managed health care services* encompass (and, on the *Meric* principle, are identical to) the opponent's *medical and healthcare clinics* and would also likely include the opponent's *medical and healthcare services relating to genetics and genetic testing*.

27. The applicant's *healthcare advisory services; healthcare consultancy services; healthcare information services* are part and parcel of the opponent's trade in *medical and healthcare clinics* and *medical and healthcare services relating to genetics and genetic testing*; the competing services target the same users, have the same purpose and share trade channels and are highly complementary. In my view these goods are similar to a high degree.

#### **The average consumer and the nature of the purchasing act**

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

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

29. The average consumer of the parties' goods and services is the public at large, although in some instances, i.e. *health and wellness training*, the average consumer will also include healthcare professionals. Even if the parties' goods in class 5 are not pharmaceutical as such, they are still purchased for some health purpose and concern the health of the final consumers. The level of attention will therefore range from above average, for the parties' goods in class 5 and the contested health and wellness training services in class 41, to high for the parties' healthcare services in class 44. The general public are likely to obtain the goods through self-selection from a shelf, over the counter purchases, word of mouth recommendations or by prescription after discussion with a medical professional. Likewise, for the contested health and wellness training in class 41 and the parties' healthcare services in class 44, there is likely to be a visual and an aural dimension, as the services are likely to be selected both visually (from websites and advertising material) and aurally (from recommendations and referrals). Bearing all of this mind, I find that both visual and aural considerations are important.

### **Distinctive character of earlier mark**

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, 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).”

31. The opponent has not claimed that the earlier mark has an enhanced distinctive character through use and has filed no evidence in this regard. I therefore have only the inherent position to consider.


32. For the purpose of this decision, I shall assess the distinctiveness of the earlier mark in relation to the goods and services which I found to be similar to the applied for specification. Before doing so, I shall consider the submissions made by the applicant in its counterstatement that “the term “my DNA” is [...] pretty common across the Internet”, it is “in common usage” and it is “a descriptive term for the services”. The applicant also provided details of three websites and five trade mark registrations incorporating the words “my DNA” and claimed that the opponent’s mark is diluted; it also claimed that one of the websites listed belongs to a well-known Australian company which “has a good chance to apply for the cancellation of [the opponent’s company]”. Finally, it said that the applicant’s company “has a pedigree of use in the mark, in that [they] have been using the mark since 2014” whereas there is no evidence of the opponent using the mark.

33. All of these arguments must be dismissed. First, the material filed was introduced as part of the applicant’s counterstatement; if the applicant had wished the Tribunal to consider that material, it should have been the subject of properly filed and served evidence. Second, even if the material had been properly filed in the form of exhibits accompanied by a witness statement, I would have found that the existence of other trade marks incorporating the words “my DNA” is not enough to establish that the distinctive character of the words has been weakened because of their frequent use in the field concerned<sup>3</sup>; this is because the existence of marks on the register does not

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<sup>3</sup> See *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01 and *Zero Industry Srl v OHIM*, Case T-400/06

establish that they are used in the market, and even where the existence of other marks in the market is shown, the evidence must be sufficient to establish that the extent of their use in the market had been sufficient to weaken the distinctive character of the words in question (which it is not the case here). Third, the earlier mark is a registered mark and, in the absence of any challenge to its validity, it must be assumed to have “at least some distinctive character”<sup>4</sup>. Finally, the fact that the applicant has used the mark since 2014, prior to the opponent’s mark being registered, has no bearing upon the instant proceedings<sup>5</sup> and since the earlier mark is not subject to proof of use, the opponent is entitled to protection irrespective of whether it has used the mark or not.

34. The earlier mark consists of the sign . The Oxford English Dictionary defines DNA as “*deoxyribonucleic acid, a self-replicating material which is present in nearly all living organisms as the main constituent of chromosomes. It is the carrier of genetic information*”. The word “my” is merely the determiner denoting that the thing that follows belongs or is associated with the speaker. Consequently, the verbal element of the mark as a whole, i.e. “my DNA”, will be understood as an expression referring to the consumer’s DNA or genetic information.

35. The intended use of the opponent’s dietetic substances, supplements and preparations in class 5 is to enhance the physical strength of the human body. Though nutritional needs may change depending on a person’s DNA, and supplements and vitamins can help to restore some deficiencies created by genetic and metabolic factors, the mark does not describe the goods and there is no evidence that the goods are provided on a personalised basis (and no argument was made to that effect). In my view, when applied to these goods, the words “my DNA” are distinctive to an average degree. The graphical representation of the mark does have some visual

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<sup>4</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

<sup>5</sup> See Tribunal Practice Notice 4/2009 “Trade mark opposition and invalidation proceedings – defences”, under the heading “The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark”: “4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211 09. Ms Carboni rejected the defence as being wrong in law. 5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

impact and make some contribution to its distinctive character, but it is not particularly striking, and so does not increase it to any significant extent.

36. Moving on to the opponent's *medical and healthcare services relating to genetics and genetic* in class 44, the words "my DNA" are elements with a very low degree of distinctive character in the context of services concerning personalised DNA and genetic testing. The get-up of the mark might have slightly more significance here than in the context of, say, the goods in class 5 in relation to which the words are inherently more distinctive, but the words "my DNA" are still more distinctive than the get-up. The distinctiveness of the mark as a whole, in the context of these services, is very low.

37. As regards the opponent's *medical and healthcare clinics*, the words "my DNA" are likely to be seen as the name of the clinic referenced in the mark. The services are not limited in any way and could well cover genetic clinics offering genetic testing and counselling, in which case, for reasons similar to those outlined above, the distinctiveness of the mark, as a whole, is very low. In relation to *medical and healthcare clinics* which are not specifically in the field of genetic testing, the mark is more distinctive and has, as a whole, a modest degree of distinctive character. Once again, whilst the get-up contributes to the distinctiveness of the mark to a certain degree, the most distinctive component of the mark lies in the verbal element.


### **Comparison of marks**

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

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

39. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impression created by the marks. The marks to be compared are:

Application	Earlier mark
mydnahealth	

40. The applied for mark consists of the words “my”, “dna” and “health” which are conjoined and presented in lower case. When marks comprise conjoined words, consumers will naturally dissect the words into ones that they recognise. In the present case, all of the three words making up the mark are very well-known to the average consumer and I have no doubt that, despite the words being conjoined, the average consumer will view the mark as three separate words. The combination of the words “my” and “dna” lends itself to being perceived as forming a unit and has more relative weight than the “health” component of the mark, which does no more than describe the nature the goods and services.

41. The earlier mark consists of the word “DNA” written in block capitals and in black and the word “my” written in lower case and in grey. The word “my” appears in a much smaller font and is superimposed on the letter “D” of the word “DNA”. Due to its smaller size, the visual impact of the word “my” is less significant than that of the word “DNA”. However, the combination “my DNA” will still be perceived as a unit.

**Visual similarity**

42. Visually, the marks coincide in the common words “mydna/my DNA”. Whilst the marks are presented in different cases, notional and fair use of the applied for word

mark include use in a mixture of upper and lower case comparable to that used in the earlier mark. The additional word “health” and the conjoining of the words in the applicant’s mark and the size and positioning of the words in the opponent’s mark, create a visual difference between the marks. In my view, the marks are visually similar to a medium degree.

### **Aural similarity**

43. The conjoining of the words will rarely be perceived in oral use of the mark. The marks will be pronounced as MAI-DN-EI -HEALTH and MAI-DN-EI and are aurally similar to a high degree.

### **Conceptual similarity**

44. The presence, in both marks, of the words “mydna/my DNA” creates the same concept. Whilst the word “health” in the applicant’s mark introduces an additional concept, it is a non-distinctive concept in the context of the goods and services at issue and does not create a distinctive conceptual difference between the marks. The marks are conceptually identical (or alternatively highly similar).

### **Likelihood of confusion**

45. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

46. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the



same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

47. Earlier in my decision I have found the parties’ marks to be visually similar to a medium degree, aurally similar to a high degree and conceptually identical (or highly similar). I have identified the average consumer to be a member of the general public or, in relation to the applied for services in class 41, either a member of the public or a healthcare professional. The average consumer will select the goods and services at issue by visual and aural means, so that both visual and aural considerations are important. I have concluded that the degree of attention paid during the purchasing process will be above average or high. I have found the parties’ services to vary from identical to similar to a medium degree. I have also considered the distinctiveness of the earlier mark as a whole and the relative contribution that its features (taken individually) make to the overall impression of the mark in the context of the goods and services relied upon by the opponent.

48. In relation to the applied for *health food supplements made principally of vitamins* (in class 5) I have found the respective goods to be identical (or highly similar). As regards the distinctiveness of the earlier mark in the context of the earlier identical goods in class 5, I have found that the unit created by the words “my DNA” has an

average degree of distinctive character and that, although the get-up of the mark has a visual impact, it does not increase the distinctiveness of the mark to any significant extent. In relation to these goods, my conclusion is that the identity of the goods and the high degree of conceptual and aural similarity (which I have concluded is a feature of the selection process) will lead to a likelihood of confusion. Such confusion in those circumstances is likely to be both direct, through aural use and imperfect recollection, or indirect, i.e. the average consumer will assume that the later mark is, for example, a variant or updated trade mark used by the applicant or by an undertaking economically linked to the applicant. **The opposition against the class 5 specification succeeds.**

49. I extend the same conclusions to the applied for *health and wellness training services* in class 41, which I have found to be similar to, inter alia, the opponent's *medical preparations for slimming purposes* in class 5 (for which the earlier mark has an average degree of distinctive character). Here I find that even if the degree of similarity between the parties' goods and services is lower, i.e. medium, the common presence in the competing marks of the shared components 'mydna/my DNA' will result in the average consumer being confused into thinking that the goods and services are provided by the same (or economically connected) undertakings. **The opposition against the class 41 specification succeeds.**

50. In relation to the applied for *medical and health services relating to DNA, genetics and genetic testing* (in class 44) I found that the parties' services are identical. I have also found that the component of the earlier mark which is similar to the later mark, i.e. the words "my DNA", has a very low distinctive character in the context of the earlier *medical and healthcare services relating to genetics and genetic testing* (in class 44). In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. 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.”

51. 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.



52. On the other hand, a weak distinctive character in the opponent’s mark does not preclude a likelihood of confusion. In *L’Oreal v OHIM*<sup>6</sup> the CJEU stated:

“45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

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<sup>6</sup> Case C-235/05 P

53. The matter was also recently considered by The Hon. Mr Justice Birss in *Nicoventures Holdings Ltd v The London Vape Company Ltd*, where he allowed an appeal against a decision of the Hearing Officer that there was a likelihood of confusion

between the signs  and  in the context of goods and services relating to the sale of e-cigarettes, despite the common elements of the marks, i.e. the words “THE Vape.co” or “Vape.co.”, were found to be descriptive and non-distinctive. The Hon. Mr Justice Birss referred to the decision in *Whyte and Mackay v Origin*<sup>7</sup> for the proposition that if the only similarity between two marks arises from common elements which have low distinctiveness that tends to weigh against a finding of likelihood of confusion. However, as he pointed out, “such a situation does not preclude a finding of likelihood of confusion, but it is a relevant factor and in an appropriate case it may be decisive” and “there may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression”.

54. In the present case, the similarity between the marks is all down to the fact that they share the words “mydna/my DNA”. These common elements are, as a unit, of a very low degree of distinctive character in the context of the respective *medical and healthcare services relating to genetics and genetic testing* (in the opponent’s mark) and *medical and health services relating to DNA, genetics and genetic testing* (in the applicant’s mark). As I said earlier, the correct approach is that this does not preclude a likelihood of confusion, but it does weigh against it. The question is therefore whether there is still a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression conveyed by the competing marks.

55. As regards the impact of the non-coinciding components on the impression of the marks, I have found that the get-up of the earlier mark is not striking and whilst it contributes the distinctive character of the mark as a whole, it does so only slightly. Moving on to the applied for mark, the other components of the mark consist of the

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<sup>7</sup> [2015] EWHC 1271

conjoining of the words “mydna” (without any graphic modification) and the addition of the word “health” (also conjoined); neither of these elements introduce any semantic variation because the conjoining does not prevent the sequence “mydna” from being perceived as two separate words and the word “health” is descriptive and non-distinctive in relation to the services. By contrast with the case in *Nicoventures Holdings Ltd v The London Vape Company Ltd*, I do not find that the stylisation of the marks is so entirely different as to avoid the likelihood of confusion. The differences between the marks at issue, do not, in my opinion, imbue the marks with any additional distinctive characteristic such as to render the overall impression of the signs, as a whole, different. Accordingly, I find that on balance, there is also a likelihood of both direct and indirect confusion in relation to the applied for *medical and health services relating to DNA, genetics and genetic testing* (in class 44). I extend the same conclusions to the applied for *health care; health-care; health-care services; healthcare; healthcare advisory services; healthcare consultancy services; healthcare information services; healthcare services; human healthcare services; information relating to health; managed health care services* (in class 44). **The opposition against the class 44 specification succeeds.**

## CONCLUSION

56. The opposition has succeeded in full. Subject to appeal, the application will be refused.

## COSTS

57. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Written submissions:	£200
Total:	£500

58. I order My DNA Health Ltd. to pay Dewan Faziul Hoque Chowdury the sum of £500. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of May 2019**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**