

**o/0157/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003689029**

**BY VIAX DENTAL TECHNOLOGIES LLC**

**TO REGISTER THE TRADE MARK:**

**BIOS SMILE DESIGN**

**IN CLASS 44**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 431658**

**BY FAHAD KHAN**

## BACKGROUND AND PLEADINGS

1. On 4 November 2020, Viax Dental Technologies LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the European Union. The applicant subsequently applied for the same mark in the UK on 1 September 2021. In accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, by filing an application for the EU mark in the UK within nine months of the end of the transition period, the applicant is entitled to rely on the priority date of the EU mark in UK proceedings. Therefore, the date of the application in these proceedings is considered to be 4 November 2020.

2. The applicant’s mark is applied for in respect of the following services:

Class 44      Dental imaging services; Dental services, namely, performing restorative and cosmetic procedures; Dental services.

3. The application was opposed by Fahad Khan (“the opponent”) on 8 March 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon the following trade mark:

# The Smile Designers

# THE SMILE DESIGNERS

(“Series of 2”)

UK registration no. UK00003482449

Filing date 18 April 2020.

Registration date 11 August 2020.

Relying upon all of the services for which the mark is registered, namely:

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<sup>1</sup> The opposition was originally based upon sections 5(1) and 5(2)(b). In an official letter from the Registry dated 11 March 2022, the section 5(1) claim was dismissed on the basis that the marks weren’t identical. The opponent then proceeded to file an amended Form TM7 only basing the opposition on section 5(2)(b).

Class 44 Dentist services; Dentistry; Dentistry services; Providing information relating to dentistry; Cosmetic dentistry; Cosmetic dentistry services; Advice relating to dentistry; Dental assistance; Dental clinic services; Dental consultations; Dental hygienist services; Dental services; Dentist services; Dentistry; Dentistry services.

4. The opponent claims that there is a likelihood of confusion because of the identity/similarity of the marks and the services.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is unrepresented, and the applicant is represented by FRKelly.

7. Neither party requested a hearing, however, both parties filed written submissions and submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

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

## **PRELIMINARY ISSUE**

9. In its written submissions, the opponent made multiple points that I intend to address as a preliminary issue. The opponent submits the following:

“3. The applicant gives no relevant evidence as to why the trademark would not cause confusion in the public and professional space.

4. I do not accept their use in the class 44 of Dental Services. I have plans to grow and become a national household name, so intend to protect my trademark and avoid confusion of any kind. [...]

6. My entire business name, brand name and product line will be called Smile designer. My computer software division may include the name bios as this run on all computers. It is the basis of all computer operating systems. So common that I see no scenario where the use is permissible. [...]"

10. My comparison must be of the applicant's mark and the opponent's mark as registered. Therefore, the above submissions on the applicant's lack of evidence to demonstrate that there wouldn't be confusion, and that the opponent intends to grow their brand and could include the word "BIOS" in subsequent marks, is not relevant to my assessment and consequently does not assist the opponent.

## **DECISION**

11. Section 5(2)(b) reads as follows:

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

(a)...

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

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

12. The earlier mark had not completed its registration process more than five years before the relevant date (the priority date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply.

13. The opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

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

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

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

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

16. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording 'namely' should be interpreted as covering only the named goods within that specification. Therefore, the specification is limited to only those services.

17. "Dental services" appears identically in both specifications.

18. "Dental imaging services" in the applicant's specification falls within the broader categories of "dental services", "dentist services" and "dentistry services" in the opponent's specification. The services are identical on the principle outlined in *Meric*.

19. "Dental services, namely, performing restorative and cosmetic procedures" in the applicant's specification falls within the broader categories of "dental services", "cosmetic dentistry services" and "dentistry services" in the opponent's specification. The services are identical on the principle outlined in *Meric*.

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

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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 (as he then was) 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

21. The average consumer for the services will be members of the general public. The cost of the services in question is likely to vary, however, it is not likely to be at the very highest end of the scale. I also consider that the frequency of purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of purchase is low, various factors will be taken into consideration such as the location, cost, the range of dental services on offer and the suitability of the services for user's particular dental needs. The services could range from a basic dental check-up, to whitening, replacing a crown, getting a root canal or getting veneers, for example. Therefore, whether for cosmetic reasons or health reasons, these would have potential risks associated with them. Taking the above into account, especially as these services are medical in nature, the level of attention paid during the purchasing process will be at least between a medium and high degree.

22. The services are likely to be obtained from a dental practice, its online equivalent or following inspection of a specialist catalogue. Alternatively, the services may be purchased following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from medical professionals in a dentistry setting or through word-of-mouth recommendations from friends, family, etc.

### **Comparison of the trade marks**

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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



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

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

25. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="217 920 772 1144"><b>The Smile Designers</b> <b>THE SMILE DESIGNERS</b>  ("Series of 2")</p>	<p data-bbox="834 976 1362 1025"><b>BIOS SMILE DESIGN</b></p>

26. The opponent's marks both consist of the words THE SMILE DESIGNERS, in different cases. As registration of a word only mark covers use in any standard typeface, I do not consider that the differences between the marks will make any impact upon my assessment. I consider that the overall impression lies in the combination of these words.

27. The applicant's mark consists of the words BIOS SMILE DESIGN. I consider that the word BIOS plays an independent distinctive role from the words SMILE DESIGN, with the word BIOS being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression. I consider that, for the reasons I will come to discuss in the conceptual comparison, the highly allusive nature of the words SMILE DESIGN means that they will play a lesser role in the overall impression of the mark.

28. Visually, the marks coincide in the second word SMILE. I also note that the third word of the applicant's mark is the word DESIGN, which is wholly contained in the opponent's third word DESIGNERS. These act as visual points of similarity. However, the opponent's mark starts with the word THE, and the third word ends with the letters E, R and S. The applicant's mark also starts with the word BIOS. I bear in mind that greater attention is normally paid to the beginning of marks.<sup>2</sup> Consequently, I consider that the marks are visually similar to between a low and medium degree.

29. Aurally, the opponent's marks will be pronounced as THE SMILE DES-EYE-NER-SS. The applicant's mark will be pronounced as BI-OS SMILE DES-EYE-NH. Consequently, the beginnings of the marks differ aurally. However, as the marks overlap in the pronunciation of the word SMILE and DESIGN/the beginning of the word DESIGNERS, I consider that the marks are aurally similar to between a low and medium degree.

30. Conceptually, the applicant submits that BIOS SIMLE DESIGNER "has a similar meaning to Computer or Digital Smile Design" because BIOS is the "basis of all computer operating systems. I also note that BIOS is defined as "Basic Input Output System: the build-in software which controls the primary functions of a PC".<sup>3</sup>

31. However, I do not consider that the average consumer would know what BIOS means, especially in the context of the parties' dentistry services. I consider that the average consumer will see the word BIOS as an invented word with no conceptual meaning, or they might recognise it as initialism, which is an abbreviation in which each letter is pronounced separately, rather than an acronym being pronounced as a word,<sup>4</sup> with no immediate conceptual meaning, since they may stand for any number of word combinations.

32. The words SMILE DESIGN in the applicant's mark will be understood as it is presented; to design a smile. I consider that this is highly allusive of the applicant's dentistry services, which will be used to improve the appearance of their patient's

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<sup>2</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/bios> accessed 4 February 2023

<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/initialism> accessed 4 February 2023

teeth, and therefore, in turn, improves their smile. Consequently, the word BIOS in the applicant's mark may be identified as the house mark, with the words SMILE DESIGN being an indicator of a sub-brand mainly focussed on cosmetic dentistry.

33. The words THE SMILE DESIGNERS in the opponent's mark will also be understood as it is presented; people who design smiles. I consider that this is also highly allusive of all the services relied upon by the opponent. I note that this conceptually overlaps, to some extent, with the applicant's SMILE DESIGN element. Therefore, I consider that the marks are conceptually similar to a medium degree.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

35. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by the use that has been made of it.

36. As highlighted above, the opponent's mark consists of the words THE SMILE DESIGNERS. A "smile designer" will be understood as someone who designs smiles. I note that the mark is highly allusive of all the opponent's services, whereby dentists provide cosmetic and medical work in order to improve its patients teeth, and therefore their smile. Consequently, I consider that the opponent's mark is inherently distinctive to a low degree.

### **Likelihood of confusion**

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

38. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's marks consist of the words THE SMILE DESIGNERS, in different cases. I consider that the overall impression lies in the combination of these words.
- The applicant's mark consists of the words BIOS SMILE DESIGN. I consider that the word BIOS plays an independent distinctive role from the words SMILE DESIGN, with the word BIOS being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression. The highly allusive nature of the words SMILE DESIGN means that they will play a lesser role in the overall impression of the mark.
- I have found the marks to be visually and aurally similar to between a low and medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a low degree.
- I have identified the average consumer to be members of the general public who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least between a medium and high degree of attention will be paid during the purchasing process for the services.
- I have found the parties' services to be identical.

39. In *Ancco, Inc. V OHIM*, Case T-385/09, the GC considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

"48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, **will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43**

**above), the most distinctive element in the mark applied for.** (emphasis added)

49. Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50. Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue."

40. I also take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

41. Therefore, taking all of the above case law into account, I consider that 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.

42. As highlighted by 38 paragraph above, I consider that the word BIOS in the applicant's mark plays an independent distinctive role, being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression. This is on the basis that the word BIOS will be recognised by the average consumer as either an invented word, or initialism, which has no conceptual meaning.

I also note that the words SMILE DESIGN in the applicant's mark is highly allusive of the applicant's dentistry services, which would provide cosmetic or medical work in order to improve its patients' smile. Consequently, and as highlighted by the case law above, since the opponent's mark does not include the BIOS element, which is the most distinctive element in the mark applied for, I do not consider that there would be a likelihood of direct confusion. As established above, the beginning of marks tend to make more of an impact than the ends, and the average consumer will be paying at least between a medium and high degree of attention when selecting the services. I, therefore, do not consider that the average consumer would overlook the word BIOS in the applicant's mark, especially as this creates a clear, visual and aural impact, as well as a difference in concept in which to differentiate the marks. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

43. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by 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."

44. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize

for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

45. I consider that having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they came from the same or economically linked undertakings. I do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent and vice versa on the basis that they both contain the words SMILE and DESIGN/DESIGNERS. It is more likely to be viewed as coincidence, especially as the words SMILE DESIGN/SMILE DESIGNERS are highly allusive of the parties' dentistry services.

46. As highlighted above, I consider that the average consumer may recognise the word BIOS as a house mark, with the words SMILE DESIGN being an indicator of a sub-brand mainly focussed on cosmetic dentistry. Furthermore, the distinctive and dominant element of the applicant's mark lies in the word BIOS at the beginning of the mark, which is not replicated in the opponent's mark. Therefore the marks are clearly not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

## **CONCLUSION**

47. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

48. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
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Filing written submissions and submissions in lieu of a hearing	£350
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<b>Total</b>	<b>£550</b>
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49. I therefore order Fahad Khan to pay Viax Dental Technologies LLC the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 13<sup>th</sup> day of February 2023**

**L FAYTER**  
**For the Registrar**