

O/0389/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3663257 BY
CEREBRAL INC.
TO REGISTER AS A TRADE MARK:**

CEREBRAL

IN CLASSES 9, 38, 42 & 44

AND

**OPPOSITION THERETO
UNDER NO. 429145 BY
CEREBRA MEDICAL LTD.**

Background & Pleadings

1. Cerebral Inc. (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed 1 July 2021 and was published on 22 October 2021 in respect of the following goods and services:

Class 9: Downloadable software applications for mobile devices, computers and tablets for providing access to health care information and health care professionals, providing and receiving virtual healthcare; downloadable computer software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; downloadable software for enabling remote examination, diagnosis and treatment of patients; downloadable computer software for interactions between patients and healthcare providers; downloadable computer software for billing and scheduling appointments in the field of healthcare services; downloadable computer software for issuing, tracking, managing, and delivering medications.

Class 38: Telecommunication services, namely, transmission of voice, data, graphics, images, messages, audio and video by means of telecommunications networks, wireless communication networks, global and local computer networks, and the Internet; Telecommunication services, namely, providing electronic message alerts via the internet notifying individuals of appointments, prescription readiness, chats with healthcare providers, bill due dates, medical assessments, insurance eligibility and medical subscriptions.

Class 42: Providing temporary use of non-downloadable software for providing access to health care information and health care professionals, providing and receiving virtual healthcare; providing temporary use of non-downloadable software for uploading,

processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; providing temporary use of non-downloadable software for enabling remote examination, diagnosis and treatment of patients; providing temporary use of non-downloadable software for interactions between patients and healthcare providers; providing temporary use of non-downloadable software for billing and scheduling appointments in the field of healthcare services; providing temporary use of non-downloadable software for issuing, tracking, managing, and delivering medications.

Class 44: Telehealth and remote patient monitoring services; medical services, namely, providing healthcare and health-related information via telecommunication networks; medical services, namely, issuing, updating, managing and sending patient medical prescriptions; medical services, namely, providing patients with support and information for the diagnosis and treatment of medical illness and health-related issues and analyzing, updating and transmitting medical records.

2. Cerebra Medical Ltd. (“**the opponent**”) opposes the application on the basis of Sections 5(1), 5(2)(a), and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition concerns all the goods and services in the applicant’s specification. The opponent is the proprietor of the following mark:

Trade Mark no.	UK00003611002
Trade Mark	CEREBRA
Goods & Services Relied Upon	<p>Class 9: Software for use in evaluation of sleep quality and diagnosis of sleep disorders.</p> <p>Class10: Monitor and data recorder for acquiring, recording and transmitting data relating to sleep quality and diagnosis of sleep disorders.</p>

Relevant Dates	Filing date: 15 April 2020
	Date of entry in register: 05 November 2021
Priority details	Priority date: 15 April 2020 Priority country: European Union Intellectual Property Office (EUIPO) TM from which priority claimed 1550135
	Priority date: 18 October 2019 Priority country: Canada TM from which priority claimed 1991109

3. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's earlier mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

4. The opponent, in its notice of opposition, claims that the marks should be regarded as identical or alternatively highly similar. In particular, the opponent asserts the following:

“The Opposed Mark consists of the word CEREBRAL which is the adjectival form of the word CEREBRUM or CEREBRA. The respective marks CEREBRAL and CEREBRA therefore share a common conceptual significance. The word CEREBRAL is also visually and phonetically similar to the Opponent's earlier CEREBRA mark to such an extent that the respective marks can be considered identical. To the extent that they are not considered identical, they are similar to an extremely high degree.

The Opposed Mark has been applied for in respect of goods and services which are identical and/or similar to those covered by the Opponent's earlier registration. In particular, the Opposed Application covers software products in class 9 which are identical and/or similar to those covered by the Opponent's registration in class 9. The

services covered by the Opposed Application in classes 38, 42 and 44 are all similar to the Opponent's goods in classes 9 and/or 10.

Because of the identity/similarity of the respective marks and the identity and/or similarity of the goods and services at issue, there is a likelihood of confusion on the part of the public. The Opposed Mark should therefore not be registered according to the provisions of Section 5 (1) and/or 5(2)(a), or 5(2)(b) of the Trade Marks Act 1994.”

5. The applicant filed a defence and counterstatement, denying the opponent’s claims in the following terms:

“6. It is denied that the Applied Mark is identical to the Earlier right. A later trade mark is considered identical where it reproduces without any modification or addition all the elements of an earlier trade mark, or when viewed as a whole it contains differences so insignificant that they may go unnoticed by the average consumer, which is not the case here.

7. It is denied that the Applied Mark is similar to the Earlier right. The additional letter at the end of the Applied Mark renders it visually, conceptually and aurally dissimilar to the Earlier right.”

The applicant also denied identity or similarity between the competing goods and services. Thus, it requests the opposition be dismissed in its entirety and an award of costs be issued in its favour.

6. Only the applicant filed submissions. I have read all the papers and shall refer to relevant points only to the extent warranted for the purpose of making this decision. Thus, this decision has been taken following a careful consideration of the papers.
7. In these proceedings, the opponent is represented by Haseltine Lake Kempner LLP and the applicant by Meissner Bolte (UK) Limited.

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 Trade Marks 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.

Decision

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

9. Sections 5(1), 5(2)(a) and 5(2)(b) of the Act state:

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

(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”.

10. The principles considered in this opposition stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market*

(Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly 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

11. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

12. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned, [...], 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 complementary.”

13. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded

identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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 *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

18. The goods and services for the competing marks are as follows:

Opponent's Goods	Applicant's Goods & Services
<p>Class 9: Software for use in evaluation of sleep quality and diagnosis of sleep disorders.</p>	<p>Class 9: Downloadable software applications for mobile devices, computers and tablets for providing access to health care information and health care professionals, providing and receiving virtual healthcare; downloadable computer software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; downloadable software for enabling remote examination, diagnosis and treatment of patients; downloadable computer software for interactions between patients and healthcare providers; downloadable computer software for billing and scheduling appointments in the field of healthcare services; downloadable computer</p>

	software for issuing, tracking, managing, and delivering medications.
Class 10: Monitor and data recorder for acquiring, recording and transmitting data relating to sleep quality and diagnosis of sleep disorders.	
	Class 38: Telecommunication services, namely, transmission of voice, data, graphics, images, messages, audio and video by means of telecommunications networks, wireless communication networks, global and local computer networks, and the Internet; Telecommunication services, namely, providing electronic message alerts via the internet notifying individuals of appointments, prescription readiness, chats with healthcare providers, bill due dates, medical assessments, insurance eligibility and medical subscriptions.
	Class 42: Providing temporary use of non-downloadable software for providing access to health care information and health care professionals, providing and receiving virtual healthcare; providing temporary use of non-downloadable software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; providing temporary use of non-downloadable software for enabling remote examination, diagnosis and treatment of patients; providing temporary use of non-downloadable software for interactions between patients and healthcare

	providers; providing temporary use of non-downloadable software for billing and scheduling appointments in the field of healthcare services; providing temporary use of non-downloadable software for issuing, tracking, managing, and delivering medications.
	Class 44: Telehealth and remote patient monitoring services; medical services, namely, providing healthcare and health-related information via telecommunication networks; medical services, namely, issuing, updating, managing and sending patient medical prescriptions; medical services, namely, providing patients with support and information for the diagnosis and treatment of medical illness and health-related issues and analyzing, updating and transmitting medical records.

19. In its notice of opposition, the opponent contends that the competing Class 9 goods are identical and/or similar, and the contested services are all similar to the opponent's goods in Classes 9 and 10.

20. On the other hand, the applicant made lengthy submissions which I have considered and do not propose to reproduce in full here. However, I will refer to them wherever it is necessary.

21. In addition, for the avoidance of doubt, pursuant to Section 60A(1)(b) of the Act, goods and services are not to be regarded as dissimilar simply because they fall in a different Class.

22. I note that the applicant's specification contains the word "*namely*". Guidance on how to treat this word is contained in the addendum to the Trade Mark Registry's Classification Guide, which reads as follows:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.” (Emphasis added)

23. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.¹

Class 9

Downloadable computer software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; Downloadable software applications for mobile devices, computers and tablets for providing access to health care information and health care professionals, providing and receiving virtual healthcare; downloadable software for enabling remote examination, diagnosis and treatment of patients; downloadable computer software for interactions between patients and healthcare providers

24. The contested terms are sufficiently broad that could readily cover the opponent’s term “*Software for use in evaluation of sleep quality and diagnosis of sleep disorders*” which contains goods in a specific field of healthcare relating to sleep quality and sleep disorders. Thus, I consider the competing goods to be identical under the *Meric* principle.

¹ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

25. If I am wrong, there is a high similarity between the competing terms. The competing goods share the same general nature and purpose. Further, there is an overlap in users, method of use and trade channels, such as online app stores. To that extent, I consider that there is an element of competition between the goods as one can choose one over the other. Nevertheless, I do not consider that there is a complementarity between the terms.

Downloadable computer software for billing and scheduling appointments in the field of healthcare services; downloadable computer software for issuing, tracking, managing, and delivering medications

26. The contested goods are intended for use in medical centres providing healthcare services. The closest comparable term from the opponent's specification is "*Software for use in evaluation of sleep quality and diagnosis of sleep disorders*" in Class 9. The contested terms overlap in general nature, as they both are software. They may also coincide in users, for example, professionals in medical centres, and method of use. In this respect, I consider that there might be an overlap in trade channels sold in online stores for downloading software applications. However, they differ in purpose, as the earlier goods facilitate the evaluation and diagnosis of sleep-related issues as opposed to the contested goods which relate to the billing of healthcare services and the provision of medication. Lastly, there is no element of complementarity or competition. I find them to be similar to between a low to medium degree.

Class 38

Telecommunication services, namely, transmission of voice, data, graphics, images, messages, audio and video by means of telecommunications networks, wireless communication networks, global and local computer networks, and the Internet; Telecommunication services, namely, providing electronic message alerts via the internet notifying individuals of appointments, prescription readiness, chats with healthcare providers, bill due dates, medical assessments, insurance eligibility and medical subscriptions

27. The contested terms are largely telecommunication services. In the absence of evidence, I can see no obvious aspect of similarity between the above contested services and the opponent's goods. The nature, purpose, users, and method of use are different. There is no competition or complementarity between the respective goods. Thus, I find them to be dissimilar.

Class 42

Providing temporary use of non-downloadable software for providing access to health care information and health care professionals, providing and receiving virtual healthcare; providing temporary use of non-downloadable software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; providing temporary use of non-downloadable software for enabling remote examination, diagnosis and treatment of patients; providing temporary use of non-downloadable software for interactions between patients and healthcare providers; Providing temporary use of non-downloadable software for billing and scheduling appointments in the field of healthcare services; providing temporary use of non-downloadable software for issuing, tracking, managing, and delivering medications

28. The contested services enable the users to access virtual healthcare and medical services, or to transfer health data via non-downloadable software. The closest comparable term in the opponent's specification is "Software for use in evaluation of sleep quality and diagnosis of sleep disorders" in Class 9. The competing goods and services differ in nature (goods v services) and purpose as the earlier goods are used for the evaluation of sleep quality and diagnosis of sleep disorders, whereas the contested services relate to the provision of access to virtual healthcare and medical services etc. In the absence of evidence, I do not consider that they would share trade channels. Even though there might be the potential of an overlap in users, for example, the general public, I do not find this to be a sufficient factor to find similarity. I do not consider that there is any element of complementarity or competition. As a result, I find that the contested goods and services are dissimilar.

Class 44

Telehealth and remote patient monitoring services; medical services, namely, providing healthcare and health-related information via telecommunication networks; Medical services, namely, issuing, updating, managing and sending patient medical prescriptions; medical services, namely, providing patients with support and information for the diagnosis and treatment of medical illness and health-related issues and analyzing, updating and transmitting medical records

29. The contested services relate to the provision of healthcare/medical services to patients, such as online/virtual healthcare and prescriptions. I consider that the nature, purpose, method of use, and channels of trade are different. Further, there is no element of competition or complementarity with the earlier goods. Although there is the potential for the users to coincide at a very general level, this is insufficient to create overall similarity between the goods and services. I consider the respective goods and services to be dissimilar.

30. The likelihood of confusion does not arise in relation to the application's services in Classes 38, 42 and 44 which are dissimilar to the goods of the earlier mark.² **The opposition cannot succeed against dissimilar services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 38: Telecommunication services, namely, transmission of voice, data, graphics, images, messages, audio and video by means of telecommunications networks, wireless communication networks, global and local computer networks, and the Internet; Telecommunication services, namely, providing electronic message alerts via the internet notifying individuals of appointments, prescription readiness, chats with healthcare providers, bill due dates, medical assessments, insurance eligibility and medical subscriptions.

Class 42: Providing temporary use of non-downloadable software for providing access to health care information and health care professionals, providing and receiving virtual healthcare; providing temporary use of non-downloadable software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; providing temporary use of non-downloadable software for enabling remote examination, diagnosis and treatment of patients; providing temporary use of non-downloadable software for interactions between patients and healthcare providers; providing temporary use of non-downloadable software for billing and scheduling appointments in the field of healthcare services; providing temporary use of non-downloadable software for issuing, tracking, managing, and delivering medications.

Class 44: Telehealth and remote patient monitoring services; medical services, namely, providing healthcare and health-related information

² Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

via telecommunication networks; medical services, namely, issuing, updating, managing and sending patient medical prescriptions; medical services, namely, providing patients with support and information for the diagnosis and treatment of medical illness and health-related issues and analyzing, updating and transmitting medical records.

Average Consumer and the Purchasing Act

31. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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.”

32. The average consumer of the Class 9 goods will be a member of the general public and professionals/business users. Such goods are usually offered for sale in online stores, brochures, and catalogues but I do not exclude entirely their availability on high street retail stores. The goods most likely will be available via online stores, where consumers will select the goods relying on the images displayed on the relevant web pages or mobile applications. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be

ignored in the assessment, as advice may be sought from a sales assistant or representative. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure software/hardware compatibility with other components or systems or that the goods possess the required features. In this regard, the average consumer is likely to pay a higher than average degree of attention, although not the highest, when selecting the goods at issue.

Comparison of Trade Marks

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

33. It is a pre-requisite of Sections 5(1) and 5(2)(a) that the marks be identical. I will begin by assessing whether they are identical within the meaning of the case law.

34. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, Case C-291/00*, the Court of Justice of the European Union (“CJEU”) held that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

35. The marks to be compared are:

Opponent’s Mark	Applicant’s Mark
CEREBRA	CEREBRAL

36. Although the contested mark incorporates entirely the earlier mark, it is clearly not identical according to settled law as the application does not reproduce the earlier mark without any modifications or additions. The addition of the letter ‘L’ at the end of the contested mark comprises the

only difference. The guidance above states that the differences must be “so insignificant that they may go unnoticed”. However, I do not find the differences between the marks, in this case, to be insignificant that would go unnoticed.

37. On that basis I do not find that the marks are identical. **As the competing trade marks are not, in my view, identical, the opposition based upon Sections 5(1) and 5(2)(a) of the Act must fail.**

Sections 5(2)(b)

38. I must now compare the trade marks for the purposes of the opposition based upon Section 5(2)(b) of the Act.
39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

40. 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.

41. The marks to be compared are shown at paragraph 36 above.

Overall Impression

42. The earlier mark “CEREBRA” and the contested mark “CEREBRAL” are word only marks. Registration of a word mark protects the word itself.³ The overall impression of the competing marks lies in the words themselves.

Visual Comparison

43. As noted above, the contested mark incorporates in full the earlier mark. However, the only point of visual difference stems from the presence/absence of the single letter ‘L’ at the end of the contested mark. Bearing in mind that the beginnings of words tend to have more impact than the ends,⁴ and considering the overall impression of the marks, I find them to be visually similar to a high degree.

Aural Comparison

44. The contested mark is three syllables long and will be articulated as “SE-RI-BRUHL”. Similarly, the earlier mark is three syllables long pronounced as “SE-RI-BRUH”. Although the marks share the same syllables, there is a phonetic difference generated by the absence/presence of the ‘L’ sound at the end. I find that the marks are aurally similar to a high degree.

Conceptual Comparison

45. In its submissions, the applicant asserted that:

“The opponent’s trade mark, CEREBRA is the plural of the word CEREBRUM which refers to a section of the human brain. Whereas

³ See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁴ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

the applicant's trade mark CEREBRAL is likely to be associated with intellect and careful thinking.

As such, the respective trade marks are associated with different concepts and thus it is denied that the respective trade marks will be perceived as conceptually identical as indicated in the Notice of Opposition.”

46. The word elements of the competing marks are dictionary words known to the average consumer in the UK. I agree with the applicant's submissions that the average consumer will understand the word “CEREBRA” as the plural for ‘cerebrum’ attributing a meaning relating to the human brain. However, I note that the word “CEREBRAL” has more than one meaning, including the meaning mentioned in the applicant's submissions, but it will be generally understood as “pertaining or relating to the brain, or to the cerebrum”⁵. It is, thus, my view that the average consumer will likely conceptualise the word elements in the competing marks in the same way, potentially treating them as near-synonyms. Therefore, the competing marks are conceptually similar to a high degree.

Distinctive Character of the Earlier Trade Marks

47. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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

⁵ See online Oxford English Dictionary:

<https://www.oed.com/view/Entry/29869?redirectedFrom=CEREBRAL>

Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

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).”

48. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
49. The opponent has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. As described above in this decision, the earlier mark consists of the word element “CEREBRA” which will be conceptualised as relating to the human brain, with no suggestive or allusive significance in relation to the goods for which it is registered. Thus, I find that the level of inherent distinctiveness will be medium.

Likelihood of Confusion

50. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁶ It is essential to keep in mind the distinctive character of the opponent's trade marks since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁷

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
52. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

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

⁶ See *Canon Kabushiki Kaisha*, paragraph 17.

⁷ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

53. Earlier in this decision I have concluded that:

- the goods at issue range from identical to dissimilar;
- the average consumer for the goods in Class 9 will be a member of the general public or professionals/business users, with the selection process being predominantly visual without discounting aural considerations. The average consumer may examine the products to ensure software/hardware compatibility with other components or systems or that the goods possess the required features. Thus, the level of attention will be higher than average degree of attention, although not the highest;
- the competing marks are visually, aurally, and conceptually highly similar;
- the earlier mark is inherently distinctive to a medium degree.

54. Weighing the above factors and considering the identical goods and services in play, there is likelihood of direct confusion for identical goods. Although I found that the degree of attention will range from higher than average for the respective goods and services at issue, this does not rule out the effect of imperfect recollection. The competing marks, having the same conceptual hook, may be directly confused as the spelling variation may well be lost by virtue of imperfect recollection. Further, it is my view that the diverging letter of the common verbal element, “CEREBRA/CEREBRAL”, is in a much less impactful positioning than if it were at the beginning of the word. Thus, the average consumer will misremember the differences and misrecall one mark for the other. The above findings extend to the rest of the goods I have found to be similar to between a low to medium degree.

Outcome

55. Part of the opposition under Section 5(2)(b) **succeeds and, subject to an appeal against this decision, the application will be refused for the following goods:**

Class 9: Downloadable software applications for mobile devices, computers and tablets for providing access to health care information and health care professionals, providing and receiving virtual healthcare; downloadable computer software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; downloadable software for enabling remote examination, diagnosis and treatment of patients; downloadable computer software for interactions between patients and healthcare providers; downloadable computer software for billing and scheduling appointments in the field of healthcare services; downloadable computer software for issuing, tracking, managing, and delivering medications.

56. Part of the opposition **fails, and the application may, subject to appeal, proceed to registration for the following services:**

Class 38: Telecommunication services, namely, transmission of voice, data, graphics, images, messages, audio and video by means of telecommunications networks, wireless communication networks, global and local computer networks, and the Internet; Telecommunication services, namely, providing electronic message alerts via the internet notifying individuals of appointments, prescription readiness, chats with healthcare providers, bill due dates, medical assessments, insurance eligibility and medical subscriptions.

Class 42: Providing temporary use of non-downloadable software for providing access to health care information and health care professionals, providing and receiving virtual healthcare; providing temporary use of non-downloadable software for uploading, processing, transmitting, managing, integrating, displaying, updating, reviewing, reporting and analyzing medical records and other health data; providing temporary use of non-downloadable software for enabling remote examination, diagnosis and treatment of patients; providing temporary use of non-downloadable software for interactions between patients and healthcare providers; providing temporary use of non-downloadable software for billing and scheduling appointments in the field of healthcare services; providing temporary use of non-downloadable software for issuing, tracking, managing, and delivering medications.

Class 44: Telehealth and remote patient monitoring services; medical services, namely, providing healthcare and health-related information

via telecommunication networks; medical services, namely, issuing, updating, managing and sending patient medical prescriptions; medical services, namely, providing patients with support and information for the diagnosis and treatment of medical illness and health-related issues and analyzing, updating and transmitting medical records.

Costs

57. In terms of costs, whilst both parties have achieved a measure of success, proportionately, the applicant has been more successful than the opponent. This is pitched as being around 65%. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Considering the other side's statement and preparing a counterstatement	£160
Preparing for and filing submissions	£230
Total	£390

58. I, therefore, order Cerebra Medical Ltd to pay Cerebral Inc. the sum of £390. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of April 2023

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General