

O/0670/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3944725
IN THE NAME OF WEST LONDON MISSION HOUSING ASSOCIATION LIMITED
TO REGISTER AS A TRADE MARK**

STRIDES

**IN CLASSES 36, 37, 43, 44
& 45**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 445906
BY STRIDE HEALTH GROUP LTD**

BACKGROUND AND PLEADINGS

1. On 11 August 2023, West London Mission Housing Association Limited (“the applicant”) applied to register the trade mark “STRIDES” in the United Kingdom. The application was accepted and published for opposition purposes on 17 November 2023, in respect of services in classes 36, 37, 43, 44 and 45.

2. The application is opposed by Stride Health Group Ltd¹ (“the opponent”). The opposition was filed on 16 February 2024 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the services in class 44 only of the application, as listed under paragraph 13 of this decision. The opponent relies upon the following mark:

Stride

UK trade mark registration number 3771623

Filing date: 30 March 2022

Registration date: 26 August 2022

Registered in Classes 5, 10 and 44

Relying on all goods and services, as listed under paragraph 13 of this decision.

3. The above mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that the application mark bears a high aural, phonetic, conceptual and visual similarity to the earlier mark, and that the applicant’s services in class 44 are highly similar to those goods and services in the specification of the

¹ I note that a Form TM16 was filed on 23 August 2023, requesting the transfer of ownership of UK3771623 from Truest Health Limited to Stride Health Group Ltd. Confirmation of the recordal of the assignment was issued on 31 August 2023.

opponent's mark. It submits that there is a high likelihood that the average consumer could be confused as to whether the services provided under the application mark are the same, or are associated with, those emanating from the opponent's earlier trade mark.

5. The applicant filed a counterstatement denying the claims that there exists a likelihood of confusion. The applicant admits that the marks are similar, but does not admit that there is similarity between the opponent's goods and the applicant's services; it admits that "the services in class 44 are similar, as asserted". The applicant submits that alongside the rejection of the opposition, the applicant should be awarded its cost in the matter.

6. Neither party filed evidence or written submissions during the evidence rounds. Neither party requested a hearing nor elected to file evidence in lieu of a hearing, therefore this decision is taken following careful consideration of the papers on file.

7. In these proceedings, the opponent is represented by JMW Solicitors LLP and the applicant is represented by Brandsmiths SL Limited.

DECISION

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 5(2)(b)

9. Section 5(2)(b) is relied on and 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”.

10. Section 5A states:

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

11. I am guided by the following principles which 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 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-334/05P 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 to mind the earlier mark, 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. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

13. The goods and services to be compared are:

Applicant's services
<u>Class 44</u> <i>Medical and healthcare services; Medical care services; Healthcare services; Human healthcare services; Health-care; Health-care services; Services for the provision of medical care information; Mental health services; advisory, consultancy and information services in respect of the aforesaid services.</i>
Opponent's goods and services
<u>Class 5</u> <i>Medicines for human purposes; pharmaceuticals for human purposes; none of the aforesaid goods in this Class 5 relate to medicines for pre-natal, post-natal and maternity use, pharmaceuticals for pre- natal, post-natal and maternity use, vitamins and mineral preparations for pre-natal, post-natal and maternity use, children's vitamins, chemical preparations for the diagnosis of pregnancy, pharmaceutical preparations for preventing skin blemishes during pregnancy, pharmaceutical preparations for hydrating the skin during pregnancy or preparations and medical supplies relating to women's hygiene; all of the aforesaid goods relating to hormonal health, cardio metabolic health, nutrition, glucose metabolism health, metabolic health, cardiovascular health, lipid health, gut microbiome health, gastrointestinal health, immune system function, genetic health, immunological health, nutritional health, neurological health, mental health, and musculoskeletal health.</i>

Class 10

Diagnostic apparatus in the form of urine and saliva testing kits; diagnostic apparatus in the form of swabs; Blood tests namely testing kits comprising of lancets, cassettes, blood capillary tubes, testing strips, blood collection tubes, plasters, pre injection swabs, name labels; DNA testing kits including DNA swabs, nasal swab testing apparatus, lateral flow tests, finger prick testing apparatus including but not limited to tests which detect heritable conditions caused by genetic mutations, intolerance and sensitivities; Microbiome testing kits including but not limited to stool collection paper, tube container for the sample and specimen; Home diagnostic kits to detect a range of biological markers including hormonal health, cardio metabolic health, vitamin and mineral deficiencies, gut biome, cancer, and cholesterol levels; Diagnostic kits for use in testing for medical purposes, namely blood and DNA testing apparatus; Diagnostic patches to be worn by humans for medical use; Apparatus for measuring blood glucose levels; microbiome stool tests to analyse gut bacteria diversity and detect the presence of certain bacteria; Medical devices, limited to home blood test kits screening for various wellness and health markers, performed using finger prick kit; all of the aforesaid goods relating to hormonal health, cardio metabolic health, nutrition, glucose metabolism health, metabolic health, cardiovascular health, lipid health, gut microbiome health, gastrointestinal health, immune system function, genetic health, immunological health, nutritional health, neurological health, mental health, and musculoskeletal health; but not including apparatus for use in medical analysis for analysing mother's milk and diagnostic apparatus for pregnancy testing and fertility tests kits.

Class 44

Medical screening; telemedicine services; all of the aforesaid services relating to hormonal health, cardio metabolic health, nutrition, glucose metabolism health, metabolic health, cardiovascular health, lipid health, gut microbiome health, gastrointestinal health, immune system function, genetic health, immunological health, nutritional health, neurological health, mental health, and musculoskeletal health.

14. In the counterstatement, the applicant has provided a comparison table listing all of the applicant's opposed services in class 44, and some, but not all, of the goods and services relied upon by the opponent. At point 3 of its counterstatement, the applicant admits that the services for which it seeks registration in class 44 are similar to the class 44 services of the earlier mark. Although the applicant does not specify to what degree it considers the services to be similar, it admits that they are similar "as asserted". It is unclear what is meant by "as asserted". It may be interpreted that the applicant agrees with the assertions of the opponent in its statement of grounds that the class 44 services in the specification of the application mark are highly similar to the (class 44) services in the specification of the opponent's earlier registered trade mark. Alternatively, it could be construed that the applicant considers the services similar only to those included in said table, being "*Medical screening; telemedicine services*". I note that the remainder of the opponent's class 44 specification is in the form of a limitation, being "*all of the aforesaid services relating to ...*". However, given that the applicant's services bear no restriction, I do not consider that this has an impact on the admissions of the applicant.

15. Either way, given the aforementioned admission by the applicant that its opposed services are similar to the services relied upon under the earlier registration, I do not consider that undertaking a comparison of the class 44 services against the opponent's goods and services in classes 5, 10 and 44 would serve any useful purpose. I will therefore proceed on the basis that the class 44 services are similar (to whatever degree), without undertaking a full comparison of the goods and services at issue. I will address this at the conclusion of my decision, as necessary.

The average consumer and the nature of the purchasing act

16. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

17. As asserted by the opponent, and admitted by the applicant, the services at issue cover medical and healthcare related services, including services relating to the provision of medical information as well as advisory services and consultancy regarding healthcare.

18. Given the breadth of the services (the restriction to the opponent's services notwithstanding), the average consumer for the competing services will be both the general public and professionals within the healthcare sector such as GPs and other medical practitioners. The services may be sourced through visual means e.g. following sight of notices in GP surgeries, on pamphlets or via the internet, or, in the case of the professional, through medical journals; or by aural means such as from verbal recommendations or radio advertising. I consider that the level of attention paid to the selection of medical services and consultancy by the general public is likely to be higher than medium, as any decision regarding the health of the consumer as a patient will not be undertaken lightly. Where it is the professional consumer who is sourcing the services on behalf of its patient as the end user, this will also demand a high degree of attention as the needs of the patient will be paramount. I acknowledge that some of the services, such as those in relation to nutrition, will warrant a lesser, but no less than medium, degree of attention.

Comparison of marks

19. 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

“34.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.”

20. 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.

21. The applicant’s mark consists of the single word “STRIDES”, presented in capital letters in a standard black typeface, with no other elements to contribute to the overall impression. The overall impression of the mark therefore rests in the word itself.

22. The opponent’s mark has been recorded as a figurative mark, presented in title case in a (stylised) black typeface: **Stride**. Despite the presentation of the word, as the mark contains no other elements, I consider that the overall impression of the mark rests in the word itself.

23. Visually, the competing marks are both single words of seven and six letters in length, respectively. They share in common six of those letters, S T R I D E, situated in the same position within each word. The applicants’ mark also contains the additional letter “S” at the end of the word. A word mark is not limited to any particular script or font, although normal and fair use of word-only marks should not be taken to include stylisation that goes beyond normal and fair use.² However, I do not consider that the stylisation of the opponent’s mark deviates from what would be seen as a “normal” font. The slight difference in typeface notwithstanding, having considered the opposing marks as a whole, I find there to be a high degree of visual similarity between them.

24. Aurally, both marks will be pronounced in the usual way, as one syllable, with the only difference being the sibilant “s” at the end of the applicant’s mark. As such, I consider there to be a high degree of aural similarity between the marks.

² See *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/1.

25. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]³.

26. Neither party has provided any submissions as to the concept of the marks. The opponent's mark comprises the dictionary-defined word "stride", while the applicant's mark consists of the same word in the plural. I would expect that a significant proportion of the average consumer would recognise the dictionary-defined word "stride" as referring to a noun meaning a long step, or as a verb meaning to take long steps. In spite of the pluralisation of the contested mark, I would expect consumers to perceive the conceptual message conveyed by the marks to be essentially identical in both.

Distinctive character of the earlier mark

27. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

"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)."

³ Paragraph 56.

28. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up 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 virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

29. The opponent's mark comprises an ordinary, dictionary-defined word "Stride", which as mentioned earlier in paragraph 25 of this decision, refers to a long step, or to the action of taking a long step. The mark does not, however, describe the goods and services for which it has been registered, and without evidence to the contrary, neither do I consider it to be allusive of such goods and services. Therefore, I find the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

30. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

31. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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”

32. Earlier in this decision, I indicated that as the applicant had admitted to at least some degree of similarity between the contested services and those services relied upon by the opponent, that I would proceed on the basis that the services at issue were all similar (to some degree), and that as such, a full comparison of the services (or the opponent’s goods) would not be made. I found that the general public would pay a higher than medium degree of attention to the selection of the majority of (medical) services, and that the professional consumer within the healthcare sector would pay a high degree of attention to the services sourced on behalf of the patient as the end-user. I also acknowledged that nutritional services and the like would warrant a lesser, but no less than medium, degree of attention. I considered that the selection of the services would be by a combination of visual and aural means.

33. I found there to be a high degree of visual and aural similarity between the marks and that the conceptual message conveyed by the marks to be essentially identical in both. I considered the earlier mark to be inherently distinctive to a medium degree.

34. I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, and I take into consideration the degree of inherent distinctive character of the earlier mark. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. Keeping in mind the high degree of visual and aural similarity between the marks, and that to a significant proportion of consumers, conceptually the marks would be seen as essentially identical, I consider that the consumer would be likely to recall the word Stride/s in each of the competing marks, but be less certain about any differing elements, such as typeface used, or whether the word is in the singular or

plural. In my view, the differences between the marks are insufficient to avoid them being mistakenly recalled as each other. I consider this would be the case even where a higher level of attention is paid by the consumer during the selection process. I therefore find that there is a likelihood of direct confusion between the marks in relation to all of the opposed services.

35. I note the applicant's submissions in the counterstatement that the opposition appears to be predicated on the "interdependence" principle, and that it denies that this is sufficient.⁴ I disagree. For the avoidance of doubt, bearing in mind the finding of a high degree of similarity between the marks and the interdependency principle, I would have reached the same conclusion even had I made a full comparison of the applicant's services against the goods and services relied upon by the opponent and found only a very low degree of similarity between them and the opponent's services in class 44.

36. The opposition under section 5(2)(b) succeeds in respect of the opposed Class 44 services.

CONCLUSION

37. The opponent has been successful. Subject to any successful appeal, the application by West London Mission Housing Association Limited will be refused in respect of the opposed Class 44 services.

38. I note that the opposition was not directed against the applicant's remaining services, and therefore, the application in respect of the unopposed services in classes 36, 37, 43 and 45 in their entirety, as listed under Annex A of this decision, may proceed to registration.

⁴ At point 4.

COSTS

39. The opponent has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. Applying the guidance in that TPN, I consider the following to be fair:

Official fee: £100

Preparing the notice of opposition and considering the counterstatement: £250

Total: £350

40. I therefore order West London Mission Housing Association Limited to pay Stride Health Group Ltd the sum of £350. 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 22nd day of July 2025

Suzanne Hitchings
For the Registrar,
the Comptroller-General

Annex A

Applicant's unopposed services

Class 36

Real estate and property services; real estate and property management services; letting and rental of permanent accommodation; property portfolio management; property (real estate) consultancy services; provision, leasing and rental of accommodation (apartments); provision and leasing of buildings for use as temporary accommodation; leasing and rental of residential and commercial properties; arranging leases for the rental of property; management of residential and commercial properties; arranging permanent accommodation; provision of information relating to real estate and permanent accommodation; financing of property development; financial management in relation to accommodation services; advisory, consultancy and information services in respect of the aforesaid services.

Class 37

Property development; Property maintenance; Building construction; Housing development; Building construction of residential and commercial buildings; Building repair and maintenance; Construction project management services; advisory, consultancy and information services in respect of the aforesaid services.

Class 43

Arranging temporary accommodation; provision of temporary accommodation; provision of information relating to the availability of temporary accommodation; provision of information relating to temporary accommodation; rental of temporary accommodation; accommodation reservations; booking services for accommodation; provision of conference, exhibition and meeting facilities; travel agency services for arranging temporary accommodation; hospitality services; provision of food and drink; advisory, consultancy and information services in respect of the aforesaid services.

Class 45

Political lobbying; legal support services; legal advisory services in relation to welfare, housing, employment, consumer affairs, transport, family matters, education, tax and

financial matters, debt, benefits, employment, housing and discrimination; spiritual advice; guardianship services; mentoring; providing personal support services; information, advisory and consultancy services relating to all the aforesaid, including the provision of online information, advisory and consultancy services relating to all the aforesaid.