

**O/0151/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3974078**

**BY SPIRIT HEALTHCARE LTD**

**TO REGISTER:**

**EMPOWER**

**EMPOWER**

**EMPOWER**

**AS A SERIES OF 3 TRADE MARKS IN CLASSES 9, 16, 41 & 44**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**

**UNDER NO. 447303 BY**

**ANTHONY STOCK**

## BACKGROUND AND PLEADINGS

1. On 1 November 2023, Spirit Healthcare Ltd (“the applicant”) applied to register the marks shown on the cover of this decision as a series of three trade marks in the United Kingdom. The series was accepted and published for opposition purposes on 2 February 2024. Registration is sought in respect of the following goods and services:

Class 9

*Electronic publications, computer software, computer programs, all relating to diabetes and insulin management.*

Class 16

*Printed matter; instructional and teaching material; books; magazines; journals; newsletters; all relating to diabetes and insulin management.*

Class 41

*Education and training services relating to diabetes and insulin management.*

Class 44

*Medical services; advisory services relating to diabetes and insulin management; pharmaceutical advisory services; pharmacy advisory services; health screening services; provision of online information and advice on health matter; health risk assessments.*

2. On 2 May 2024, the application was partially opposed by Anthony Stock (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns the goods in Class 9 of the application.

3. Under both grounds, the opponent relies on a single earlier mark, UKTM No. 2653666, which has a filing date of 26 February 2013 and a registration date of 24 May 2013. The mark is shown below:



4. It is registered for goods and services in Classes 9 and 35 and the opponent relies on the following goods:

Class 9

*Computer software and database for the description, selection and sale of goods; for the provision of catalogue information, stock information, and for document and electronic message production, storage, and retrieval before, during, and after the sale of goods.*

5. This mark qualifies as an earlier mark under section 6(1)(a) of the Act. As its registration date is more than five years earlier than the application date of the contested mark, the opponent stated that it had been used in the five-year period ending on the date of application for all the goods relied upon.

6. Under section 5(2)(b), the opponent claims that the dominant element of the earlier mark is the word “EMPOWER” and that the marks are aurally and visually highly similar and conceptually identical. It also claims that the parties’ Class 9 goods are similar. As a result, there is a likelihood of confusion on the part of the public.

7. Under section 5(3), the opponent claims that the earlier mark enjoys a substantial reputation in relation to the Class 9 goods listed above, having been in use for many years, and that use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

8. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark for the goods relied upon. While it denies the similarity of the goods and the marks, the applicant also claims that the marks have co-existed for many years, both on the register and in the marketplace, and that there is no actual confusion.

9. Neither party requested a hearing or filed written submissions in lieu of the same. I have taken this decision following a careful review of the papers. In these proceedings, the opponent is represented by ip21 Limited and the applicant by Harrison IP Limited.

## **EVIDENCE AND SUBMISSIONS**

10. The opponent's evidence comes from the opponent himself, Anthony Stock. His witness statement is dated 19 September 2024 and is accompanied by seven exhibits which go to the use made of the earlier mark. At the same time, the opponent filed written submissions.

11. The applicant's evidence comes from Chris Barker, the Director of the applicant, a position held since the company was incorporated in 2007. His witness statement is dated 18 November 2024 and is accompanied by four exhibits. The evidence goes to the applicant's use of its mark and a previous logo containing the word "EMPOWER". In addition, Mr Barker states that there have been no instances of confusion. The applicant also filed written submissions dated 19 November 2024.

## **RELEVANCE OF EU LAW**

12. 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.

## **DECISION**

### **Proof of Use**

13. Section 6A of the Act is as follows:

“(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in sections 5(1),  
(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section '*the relevant period*' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

*[(5) Repealed]*

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be

treated for the purposes of this section as if it were registered only in respect of those goods or services.

...”

14. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark:

*Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark

or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

'19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

15. The five-year period in which use must be shown for the goods relied on is 2 November 2018 to 1 November 2023.

### ***The evidence***

16. Mr Stock has been the Managing Director of Marathon Warehouse Distribution Limited for over 40 years and he states that he licenses the use of the earlier mark by this company. The applicant criticises the opponent's evidence here on the grounds that the licence has not been included as an exhibit. However, where the proprietor of a mark is the Managing Director of a company, I consider it reasonable to infer that use of the mark by that company is with the proprietor's consent. Mr Stock says that the mark was first used in 2013 and that the software was introduced “*shortly*

*thereafter*". He adds that the mark has been used consistently since then.<sup>1</sup> On the basis of the evidence, I conclude that Mr Stock's company is a distributor of motor vehicle parts.

17. Throughout his witness statement, Mr Stock refers to "*software and associated services*". He explains that:

"9. The EMPOWER software and associated services are the cornerstone of my company's business. Customers download the software from our website, we authenticate their access and the software is the essential tool used to review, order and also return goods.

10. Customers have the facility to download price files on to their own system from the EMPOWER software, making selling and invoicing parts bought from my company an easy process and ensuring that their staff make the correct margins."

18. Further information on how the software is used is provided in Exhibit AS2. However, I note that this appears to be a newsletter dated January 2024, which is after the relevant period.

19. The following table contains turnover figures "*attributed to business using the EMPOWER software and associated services*".<sup>2</sup>

<b>Year</b>	<b>Turnover £</b>
2018	Not less than 3.8 million
2019	Not less than 5.2 million
2020	Not less than 4.2 million
2021	Not less than 7.4 million
2022	Not less than 7.3 million
2023	Not less than 10.8 million
2024*	Not less than 13.2 million

\*forecast figures for the year

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<sup>1</sup> Witness statement of Mr Stock, paragraph 4.

<sup>2</sup> Ibid, paragraph 14.

20. It is my understanding that these figures relate to the sale of vehicle parts made using the software. Mr Stock adds that his company “*presently*” receives 50-100 authentication requests per month for the software. I take this to be the state of play at the time of the witness statement, which is over 18 months after the relevant date.

21. He says that the mark is shown on the website and provides extracts in Exhibit AS1. However, these are all undated. Exhibit AS5 contains some dated photographs of stands at the Automechanika trade fair in Birmingham. The mark is not visible on all of them but can be made out towards the bottom of each of the following photograph from 2019.



22. According to the following table, approximately 14,000 people attended the trade fair that year.<sup>3</sup>

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<sup>3</sup> Exhibit AS4.

Year						
<b>2016</b>	A1 Trade Show	Automechanika Birmingham			IAAF Dinner	
Approximate Attendance	250	12000			650	<b>12900</b>
<b>2017</b>	A1 Trade Show	Automechanika Birmingham			IAAF Dinner	
Approximate Attendance	250	12500			650	<b>13400</b>
<b>2018</b>	A1 Trade Show	Automechanika Birmingham			IAAF Dinner	
Approximate Attendance	250	10200			650	<b>11100</b>
<b>2019</b>	A1 Trade Show	Automechanika Birmingham	MPD Conference	A1 Convention	IAAF Dinner	
Approximate Attendance	250	14000	300	200	650	<b>15400</b>
<b>2020</b>					IAAF Dinner	
Approximate Attendance					650	<b>650</b>
<b>2021</b>	A1 Virtual Convention				IAAF Dinner	
Approximate Attendance	Unknown - via video				650	<b>650</b>
<b>2022</b>	A1 Trade Show				IAAF Dinner	
Approximate Attendance	250				650	<b>900</b>
<b>2023</b>	A1 Trade Show				IAAF Dinner	
Approximate Attendance	250				650	<b>900</b>
<b>2024</b>	A1 Trade Show		MPD Conference	A1 Convention	IAAF Dinner	
Approximate Attendance	250		350	200	650	<b>1450</b>

57350

23. There is also a photograph from 2018, taken at the same event, but there is nothing to tell me whether this took place in either November or December of that year, and therefore fell within the relevant period.

24. Mr Stock states that *“The trade mark is used in the form as registered and also as the word EMPOWER.”*<sup>4</sup> I shall deal with this point shortly.

25. Marketing materials include wall cards, an undated example of which can be found in Exhibit AS6, and mailshots. Exhibit AS7 contains an example of a mailshot from April 2022, as well as ones from 2015 and 2024 (i.e. before and after the relevant period). The former includes text and a link to a video about EMPOWER. The mark is shown thus:<sup>5</sup>



<sup>4</sup> Ibid, paragraph 7.

<sup>5</sup> Page 49.

## **Variant use**

26. There is extremely limited dated use of the earlier mark on its own. It is shown as a “*Big Green Button*” in the mailshot,<sup>6</sup> but this is the only instance. More frequently, the mark is used in the form shown in the previous paragraph. In *Colloseum Holding AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that:

“32. ... the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

...

35. ... a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).”

27. I consider that the variant shown in paragraph 25 above is acceptable.

## **Sufficiency of use and a fair specification**

28. The applicant submits that:

“Paragraph 5 [of Mr Stock’s witness statement] states that the earlier mark is used for ‘software and services particularly those in the auto industry’. The statement and its exhibits make it clear that the mark is used solely in relation to goods in the auto industry, specifically in relation to car parts. No other use has been shown. The applicant therefore requests that the specification considered in the opposition, for the comparison of goods, should be:

Class 9

Computer software and database for the description, selection and sale of motor vehicle parts; for the provision of catalogue information, stock

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<sup>6</sup> Exhibit AS7, page 50.

information, and for document and electronic message production, storage and retrieval before, during, and after the sale of motor vehicle parts.”

29. I take this as an acceptance that the opponent has shown that it has used the earlier mark for the goods in the specification, but that the use of the software relates to the selling of a particular good, namely motor vehicle parts. I agree that the evidence does not show use of software in the selling of any other goods. I must now go on to determine a fair specification.

30. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. ... It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

31. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. ... First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made *partly* in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-2491 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or

services capable of being viewed independently is their purpose and intended use.”

32. I also note that in *ACTC GmbH v European Union Intellectual Property Office*, Case C-714/18, the CJEU said that the fact that goods were aimed at different publics was not relevant for the purpose of defining an independent subcategory: see paragraph 53 of that judgment.

33. Taking account of this case law, I cannot see that the fact that the opponent’s goods are used specifically in relation to motor vehicle parts constitutes an independent subcategory of *Computer software and database for the description, selection and sale of goods; for the provision of catalogue information, stock information, and for document and electronic message production, storage, and retrieval before, during, and after the sale of goods*. The purpose and intended use of the goods are the same, namely, enabling an undertaking to give information about goods on sale and facilitating the purchase of those goods by customers. I therefore consider that the opponent may rely on all the Class 9 goods for the purpose of its claim under section 5(2)(b).

### **Section 5(2)(b)**

34. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

...

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

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

35. The principles to be applied in deciding a claim under this section are set out in paragraph 38 of the Supreme Court’s decision in *Iconix Luxembourg Holdings SARL*

*v Dream Pairs Europe Inc & Anor* [2025] UKSC 25. For reasons that will become apparent, I shall not repeat them here.

### **Comparison of goods**

36. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court said in *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, goods and services are complementary when

“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.”

37. The goods to be compared are shown in the table below:

<b>Contested goods</b>	<b>Earlier goods</b>
<u><i>Class 9</i></u> <i>Electronic publications, computer software, computer programs, all relating to diabetes and insulin management.</i>	<u><i>Class 9</i></u> <i>Computer software and database for the description, selection and sale of goods; for the provision of catalogue information, stock information, and for document and electronic message production, storage, and retrieval before, during, and after the sale of goods.</i>

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

“12. ... 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.”

39. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin said:

“365. ... The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 195; [2004] RPC 40 at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specification of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

40. Although the opponent’s pleading was that the goods were only similar to each other, the opponent submits that the contested goods are identical or, in the

alternative, highly similar to its own Class 9 goods. This is on the basis that the users of the goods “*have the potential*” to be the same.<sup>7</sup> No other reasons are given.

41. In my view, the users of the contested goods are people affected by diabetes and medical professionals, while the users of the earlier goods are businesses selling goods to consumers and who may then give those consumers the option of using the software to manage their purchasing activity. Those end-consumers will also be the users of the opponent’s goods and they will choose whether or not to use the software to conduct their transactions with suppliers. I accept that there may be an overlap in users, but only to the extent that the user of the opponent’s goods is also a member of the general public affected by diabetes. The purpose of the goods is different: the contested goods provide information and tools to help individuals manage their diabetes, while the earlier goods facilitate sales activity. The goods are not in competition and are not complementary. In *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch), Mr Iain Purvis KC, sitting as a deputy High Court judge, said:

“23. ... It seems to me that the greater the level of generality at which some similarity under the *Canon* factors can be found (i.e. both goods are ‘*sold in large department stores*’ or both goods are ‘*used by ordinary people*’) the less relevant could it be to any question of confusion, and any assessment of similarity of goods should take that into account.”

42. Bearing these comments in mind, I do not find that the overlap in user, or the fact that both parties’ goods are software or provided electronically, are sufficient for me to find any similarity between the goods.

43. Section 5(2)(b) requires the goods and services to be identical or similar. Where there is no similarity, there can be no confusion: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. The section 5(2)(b) ground therefore fails.

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<sup>7</sup> Written submissions, paragraph 14.

### Section 5(3)

44. Section 5(3) of the Act is as follows:

“A trade mark which–

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

45. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

### **Reputation**

46. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

47. I have already summarised the evidence that covers the relevant period for the purpose of the proof of use assessment. I acknowledge that evidence going further back may be relevant for the purposes of section 5(3). A newsletter from January 2015,

which states that *“Our superb EMPOWER platform is going from strength to strength and we are adding new users and functionality almost every day”*.<sup>8</sup> This suggests that the software was introduced in 2013 or 2014. The earlier mark is shown on a screenshot accompanying the text.

48. The relevant public for the goods in the opponent’s specification consists of traders. They may be either retailers or wholesalers. Their customers may then have the option of downloading and using the software to manage their interactions with the trader, so I consider that they would also be part of the relevant public. There is no evidence that the opponent has been selling the software to any other undertaking. Instead, its customers have been able to download it to manage the purchasing and returns processes. I am prepared to accept that these customers are spread throughout the UK. A mailshot that appears to be from 2018 (it invites readers to register for the Automechanika Birmingham event on 5-7 June 2018) states that the opponent’s company offers *“Frequent Same Day Service to Areas Covering 85% of The UK Population”* and has distribution centres in the north of England, the Midlands and the south of England.<sup>9</sup>

49. The earlier mark will have a reputation if a significant part of this public knows about the mark. In terms of the levels of sales, these are very low in the context of the sale of all goods in the UK, and they do not relate to the software goods themselves, but rather to goods sold through the software. However, it is clear from the evidence that the mark has been used in relation to software used by the opponent itself, a distributor of motor vehicle parts, and that the promotional activity that has taken place has been aimed at this sector. These activities include mailshots to customers and the trade fairs and events listed in the table reproduced in paragraph 22 above. There is no information on the cost of promoting the mark.

50. I have nothing to tell me what proportion of the relevant market the turnover figures represent or how many customers the opponent’s company had, and therefore the proportion of the relevant public that is likely to know about the mark. Neither is it clear how many of the opponent’s customers were using the software at the relevant date.

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<sup>8</sup> Exhibit AS7, page 54.

<sup>9</sup> Exhibit AS7, page 55.

Anything referring to the number of customers, such as Exhibit AS1 page 12, is undated.

51. In my view, the evidence falls short of what would be required to show that the earlier mark had a reputation at the relevant date of 1 November 2023. However, if I am wrong in this, I take the view that any reputation is small and restricted to the motor vehicle parts industry. I shall consider whether there would be a link between the marks on this basis.

### ***Link***

52. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

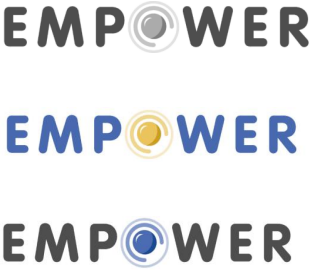

### ***The degree of similarity between the conflicting marks***

53. It is clear from *SABEL* (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* that:

“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

54. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

55. The respective marks are shown below:

Contested series of marks	Earlier mark
	

56. The three marks in the contested series are stylised word marks. They consist of the word “EMPOWER” in capital letters. The letters in the first mark in the series are black; those in the second mark are blue; and those in the third are also black. In each the letter O has been replaced by a circular device. A small circle is coloured grey, yellow or blue respectively and each has a small highlight towards the top left of the circle. The circle is partially surrounded by an incomplete thick line of the same colour, and these two elements are enclosed in by a thin circular line that appears slightly paler. The word “EMPOWER” makes the greatest contribution to the overall impression of the mark. I have no submissions on the meaning of the device, and I consider that it would be seen as decorative or as a stylised letter O. This makes a smaller contribution to the overall impression of the mark, with the roles played by the typeface and the colours smaller still.

57. The earlier mark is a figurative mark. The letters are shown in grey with white highlights giving the appearance of a shiny surface, surrounded by black lines. They are placed on a dark green square with rounded corners. At the top left and bottom right corners there are white shapes, which may also be seen as highlights. The largest element is the capital letter M in the centre of the square. The word “POWER” appears below it, and a letter E sits inside the M, at the top left of the letter. The letter E does not stand out unless the mark is considered in some detail. Close inspection reveals that the top left corner of the letter E is overlaid with a thin curved line that is yellow at the top and orange towards the bottom. The average consumer would, to my mind, see the verbal element as “M POWER”. The letter M makes the biggest contribution to the overall impression of the mark, with “POWER” playing a lesser role. The “get-up” of the mark also makes a contribution. Even if the E is noticed, the consumer may not make a connection with the word “empower”, as they do not analyse the marks to

this extent. However, if the average consumer perceives the verbal element as “EMPOWER”, the presentation of that word is so unusual that, in my view, the word and the figurative aspects of the mark make roughly equal contributions to the overall impression of the mark.

58. Visually, the marks both contain the word “EMPOWER”, but it is presented very differently. I find the marks have a low degree of visual similarity. They are aurally identical. If the average consumer sees the earlier mark as a play on “EMPOWER”, the marks are conceptually identical. If the average consumer does not perceive it in this way, the marks are conceptually dissimilar. I shall consider the link from the perspective of the consumer who sees the earlier mark as meaning “EMPOWER”, as this represents the opponent’s best case.

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

59. In my assessment of section 5(2)(b), I found that the parties’ respective goods were dissimilar. I made this finding when considering the broad terms that I considered to be a fair specification of the earlier mark for the purposes of that section. The goods for which the earlier mark has a reputation are narrower and are further away from the applicant’s goods.

*The strength of the earlier mark’s reputation*

60. I am proceeding on the basis that the earlier mark has a modest reputation.

*The degree of the earlier mark’s distinctive character, whether inherent or acquired through use*

61. The opponent submits that “*The mark EMPOWER is highly distinctive for the goods of the Opponent’s earlier registered right.*”<sup>10</sup> It is not clear whether here he is referring to the word “EMPOWER” or the mark as registered. The word is commonly used in standard English and may be mildly allusive of goods that enable the users to take more control over processes. In my view, the word has an inherent distinctive

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<sup>10</sup> Written submissions, paragraph 10.

character of a slightly lower than medium level. However, the stylistic presentation of the word, emphasising the letter M, increases this to a slightly higher than medium level. As I am proceeding on the basis that the earlier mark has a modest reputation, I consider that any enhancement to the distinctiveness of the mark is also modest.

#### *Whether there is a likelihood of confusion*

62. As I found no similarity between the goods, there was no likelihood of confusion under section 5(2)(b). However, section 5(3) gives a greater degree of protection to marks with a reputation and in some cases the reputation of the mark is such that the public would assume that the marks must have the same proprietor, or that there must at least be a connection between the opponent and the applicant. In this case, I do not consider that the reputation of the earlier mark is such that the differences between the goods could be overcome. I do not find a likelihood of confusion under section 5(3).

#### *Conclusions on link*

63. Taking into account the modest reputation of the earlier mark, and the role played by the stylised presentation of the word “EMPOWER” in the distinctiveness of the same mark, I do not consider that the relevant public will make a link between the marks when used for goods that are as far apart as these are. As I have found no link, the section 5(3) claim fails.

### **OUTCOME**

64. The partial opposition has failed and, subject to a successful appeal, Application No. 3974078 may proceed to registration.

### **COSTS**

65. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale published in Tribunal Practice Notice No. 1/2023. The costs award has been calculated as follows:

*£300 for preparing a statement and considering the other side’s statement*

*£600 for preparing evidence and considering and commenting on the other side’s evidence*

***£900 in total***

66. I therefore order Anthony Stock to pay to Spirit Healthcare Ltd the sum of £900. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25<sup>th</sup> day of February 2026**

**Clare Boucher  
For the Registrar,  
Comptroller-General**