O/0728/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL DESIGNATION NO. WO0000001340142

BY M.DOC GMBH

TO REGISTER THE FOLLOWING TRADE MARK:

m.Doc

IN CLASS 10

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002459

BY DIGITONIC LTD

BACKGROUND AND PLEADINGS

1. m.Doc GmbH is the holder of the international registration shown on the cover page of this decision ("the IR"). The IR was registered on 6 March 2017. With effect from 23 November 2021, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder originally sought protection for goods and services in classes 9, 10 and 42. However, the goods and services in classes 9 and 42 were deleted from the holder's designation request and the application proceeds in respect of the following goods set out in paragraph 15 below.

2. The request to protect the IR was published on 8 April 2022. On 5 July 2022, Digitonic Ltd ("the opponent") opposed the protection of the IR in the UK based upon sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is brought under the fast track opposition procedure. The opponent relies upon UK registration no. 3234944 for the series of two trade marks: MDOC and mDoc. The earlier mark was filed on 2 June 2017 and registered on 25 August 2017. The opponent identifies the following goods and services upon which it relies:

> "Data processing programs and software; computer software for controlling the operation of audio and video devices; memory devices; readers; real-time data processing apparatus; scanners; analytical plotters; event analytics software; data analytics software; devices for streaming media content over local wireless networks; wireless communication devices; wireless communication devices for voice, data, or image transmission; wireless controllers to remotely monitor and control the function an status of other electrical, electronic, mechanical devices or systems; wireless instruments; design and development of computer hardware and software; design and development of wireless data transmission apparatus, instruments and equipment; rental of computer software, data processing equipment and computer peripheral devices; instructional and teaching materials; clothing; parts and fittings for clothing; data processing; retail services in relation to computer software; data validation."

3. The opponent claims that the goods and services are similar and the marks are similar or identical, with the result that there is a likelihood of confusion.

4. The holder filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. Neither party sought leave to file evidence.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, but both parties filed written submissions in lieu.

8. The opponent is represented by Cloch Solicitors and the holder is represented by Forresters IP Ltd.

9. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

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

PRELIMINARY ISSUE

11. As noted above, the opponent identified a list of goods and services upon which it relies in its Form TM7. However, those goods and services are not identified by class and do not correspond directly in all cases with the terms covered by the opponent's specification.

12. Consequently, on 18 July 2023, the Registry wrote to the opponent as follows:

> "In preparing her decision, the hearing officer has noted that the goods and services identified in the Form TM7 are not all replicated exactly within the opponent's specification. Having considered the opponent's specification, the hearing officer has identified the following terms upon which it appears that the opponent seeks to rely:
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> Class 9
> Data processing programs; Data processing software; Computer software for controlling the operation of audio and video devices; Memory devices for use with data processing apparatus; Readers [data processing equipment]; Real-time data processing apparatus; Scanners [data processing equipment]; Analytical plotters; Event analytics software; Data analytics software; Devices for streaming media content over local wireless networks; Wireless communication devices; Wireless communication devices for voice, data, or image transmission; Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems; Wireless high frequency transmission instruments.
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> Class 16
> Instructional and teaching materials.
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> Class 25
> Clothing; parts and fittings for all the aforesaid goods.

Class 35

Data processing services in the field of healthcare; Retail services in relation to computer software.

Class 42

Design and development of computer hardware and software; Design and development of wireless data transmission apparatus, instruments and equipment; Rental of computer software, data processing equipment and computer peripheral devices;

Class 45

Data validation.

If either party disagrees with this assessment, they should inform the Registry within the next 7 days, providing their reasons. Otherwise, the hearing officer will finalise the decision on the basis of the above specification.

13. Neither party responded. Consequently, I will assess the opposition on the basis of the above specification.

DECISION

11. Section 5(2) of the Act reads as follows:

"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."

12. Section 5A of the Act is as follows:

"5A 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."

13. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the date of the designation in issue, it is not subject to proof of use pursuant to section 6A of the Act.

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v 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 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

15. As similarity of goods and services is necessary for a finding of likelihood of confusion, I will begin by assessing the similarity between the parties' respective specifications. The competing goods and services are as follows:

Opponent's goods and services	**Holder's goods**
Class 9 Data processing programs; Data processing software; Computer software for controlling the operation of audio and video devices; Memory devices for use with data processing apparatus; Readers [data processing equipment]; Real-time data processing apparatus; Scanners [data processing equipment]; Analytical plotters; Event analytics software; Data analytics software; Devices for streaming media content over local wireless networks; Wireless communication devices; Wireless communication devices for voice, data, or image transmission; Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems; Wireless high frequency transmission instruments.	Class 10 Medical apparatus; medical devices; medical instruments; medical emergency cases; medical emergency bags.

Class 16 Instructional and teaching materials. Class 25 Clothing; parts and fittings for all the aforesaid goods. Class 35 Data processing services in the field of healthcare; Retail services in relation to computer software; Class 42 Design and development of computer hardware and software; Design and development of wireless data transmission apparatus, instruments and equipment; Rental of computer software, data processing equipment and computer peripheral devices; Class 45 Data validation.	

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary."

17. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the General Court ("GC") stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

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

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

Whilst on the other hand:

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

20. In its written submissions in lieu, the opponent submits as follows:

> "12. The Applicant's submission that the Application only covers class 10 is misleading and irrelevant. It is well established that the class system only exists for the expediency of administrative matters, not an insight into the perception by the average consumer. It is therefore irrelevant as to the assessment of similarity. The Applicant filed for classes 09, 10, and 42. The Opposition was partially successful insofar as the Applicant deleted classes 9 and 42 from the Application. The goods in class 10 must be construed in light of the specification as a whole as filed, which clearly suggests a form of mobile healthcare business. In any event, the Applicant's submission is of no moment. The provision of medical goods and services includes the processing of data and is almost often delivered using the goods and services relied upon by the Opponent."

21. In its written submissions in lieu, the holder submits as follows:

> "33. When making this comparison, there is clearly no similarity between the class 10 goods the Applicant is seeking protection for and the goods/services of the Earlier Registration as relied upon by the Opponent.
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> 34. The class 10 goods which relate to highly specialised medical apparatus/devices/instruments have an entirely different nature, intended purpose and method of use to all of the goods/services relied upon by the Opponent. Further, the goods are neither complementary nor in competition.
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> 35. The Opponent's goods/services focus mainly upon data processing apparatus/equipment, computer software/programs, communication devices and controllers. All of which are everyday IT products of an entirely different nature to medical apparatus/devices which are highly specialised goods not targeted at the general public but not sold to and used by medical practitioners.
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> 36. In addition, the Opponent's clothing goods are again everyday products, purchased with little care and attention by the general public. They are entirely dissimilar to the medical devices/apparatus covered by the Application in class 10.
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> 37. Further, the goods covered by the Application would be sold through recognised medical trade channels and would not be readily available to the general public to purchase. In addition, the end users will be entirely different as they will be used by patients either in hospital or at home (through guidance from a medical practitioner), and will be used for a specific purpose to treat a particular issue, they are not everyday goods used by the general public."

21. The goods covered by the holder's specification must be construed in accordance with their ordinary and natural meaning. I accept that some of the opponent's goods and services may overlap in user with the holder's goods. For example, "data processing services in the field of healthcare" and "instructional and teaching materials" could both be used by medical professionals, as would the holder's goods.

However, the purpose, method of use and nature of the goods and services clearly differ. I have no evidence before me that there would be any overlap in trade channels, and I can see no reason why there would be. The goods and services are not in competition. Further, whilst there may be some instances of the opponent's goods being used with the holder's goods (such as computer software which is used with medical devices), I can see no reason why the average consumer would conclude that they originate from the same undertaking. Consequently, they are not complementary within the meaning of the case law. Taking all of this into account, and having considered the full breadth of the opponent's specification, I consider the parties' goods and services to be dissimilar.

22. As some similarity of goods and services is essential for a finding of likelihood of confusion, the opposition in relation to the holder's class 10 goods fails.

CONCLUSION

23. The opposition against UK designation of IR no. 1340142 fails.

COSTS

24. The holder has been successful in relation to the defended goods. Consequently, it is entitled to a contribution towards its costs based upon the Tribunal Practice Notice 2/2016. I calculate the holder's costs as follows:

Considering the Notice of opposition and filing a counterstatement	£150
Written submissions in lieu	£200

25. However, given that the application was partially withdrawn following the filing of the TM7, and the holder was notified of the opponent's intention to oppose the application by the filing of a Form TM7A, I will offset these costs against the opponent's costs of filing the Form TM7 (taking into account the only partial withdrawal). In my view, a fair amount for the opponent's costs in this regard is £175.

26. Consequently, I order Digitonic Ltd to pay m.Doc GmbH the sum of £175. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of July 2023

S WILSON
For the Registrar