

O-0756-23

**TRADE MARKS ACT 1994  
IN THE MATTER OF CONSOLIDATED PROCEEDINGS FOR  
TRADE MARK APPLICATION NOS. 3648589, 3648573 & 3648491  
BY AENEAS GMBH & CO.KG  
TO REGISTER**

**AESKUCARE**



**AESKUCARE**  
Allergy



**AESKUCARE**  
Food Intolerance

**AS TRADE MARKS  
IN CLASSES 5, 10, 42, 44  
AND OPPOSITION THERETO  
(UNDER NOS. 427938 (LEAD), 427939 & 427987)  
BY  
AESCULAP AG**

## Background & pleadings

1. Aeneas GmbH & Co.KG (“the applicant”) made applications in the UK for the three trade marks set out on the title page of this decision on 28 May 2021. The applications were made pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU. Under the terms of that agreement, the applicant is entitled to rely upon the earlier EU filing date, namely 8 February 2018 for AESKUCARE, 14 June 2018 for AESKUCARE ALLERGY (and device) and 15 June 2018 for AESKUCARE FOOD INTOLERANCE (and device). All three marks were published in the UK on 6 August 2021 in classes 5, 10, 42 and 44. The goods and services were amended by means of a TM21B dated 31 October 2022. The goods and services as they currently stand are set out later in this decision.

2. Aesculap AG (“the opponent”) opposed the application in full under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following goods and services in the registration set out below.<sup>1</sup> For section 5(2)(b) the opponent relies on classes 10, 35, 37, 39, 42 and 44. For section 5(3) the opponent relies on those classes plus classes 9 and 41.

UK TM No. 903432382	Goods & services relied on
<b>AESCULAP</b>  Filing date: 23 October 2003 Registration date: 29 September 2005	Class 9: Computer programs, including machine readable data carriers containing programs or other information.  Class 10: Surgical, medical, healthcare, dental, veterinary and animal-breeding instruments, apparatus and equipment; implants, internal joint prostheses;

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<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

	<p>electric medical apparatus; sterilisation containers for medical instruments.</p> <p>Class 35: Drawing up organisational plans and operational plans for hospitals.</p> <p>Class 37: Repair and maintenance of medical instruments, apparatus and equipment; cleaning of surgical instruments and equipment; filling of surgical instrument stores; hospital services, namely sterilisation of instruments and equipment.</p> <p>Class 39: Storage of surgical instruments and equipment; disposal (transport) of surgical instruments and apparatus.</p> <p>Class 41: Providing of training and further training for external personnel; conducting training courses for others; film showings, film rental; publication of scientific information journals; arranging of symposiums and workshops.</p> <p>Class 42: Construction drafting of endoprotheses.</p> <p>Class 44: Medical equipment rental.</p>
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4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the respective marks are similar, and the goods and services are identical or similar.

5. Under section 5(3), the opponent claims that it has a reputation for all of the goods and services identified above and that use of the contested marks would, without due cause, take unfair advantage of or be detrimental to the reputation and distinctive character of the registration.

6. The opponent's above trade mark has a registration date that is earlier than the filing date of the applications and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the filing date of the contested applications, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services it relies on.

7. The applicant filed counterstatements for its applications and denied the opposition grounds claimed. It also put the opponent to proof of use of its claims.

8. The opposition proceedings were consolidated on 24 February 2022.

9. The parties have been represented throughout these proceedings. The applicant has been represented by Forresters IP LLP and the opponent by Venner Shipley LLP.

10. Both parties filed evidence and the matter came to be heard before me on 8 March 2023. Mr. Dominic Hughes of Counsel, appointed by Forresters, appeared for the applicant and Mr. Ashley Roughton of Counsel, appointed by Venner Shipley appeared for the opponent.

11. This decision is taken following a careful reading of the papers and consideration of the submissions made at the hearing.

### **Opponent's evidence**

12. Mr Michael Parden is the UK Division manager of the opponent, employed by B. Braun Medical Ltd which itself is a subsidiary of the opponent. The opponent initially filed two witness statements dated 25 April 2022 and associated exhibits as evidence in chief in the name of Mr Parden. A witness statement was also filed in

the name of Norbert Hebeis dated 19 August 2022, who states he is an attorney at law in the firm of Friedrich Graf von Westphalen & Partner mbB and was responsible for the English translations of the German documents relied on in Mr Parden's evidence.

13. Following receipt of the applicant's evidence, the opponent filed evidence in reply with exhibits dated 19 July 2022 again in the name of Mr Parden. Subsequently a fourth witness statement in Mr Parden's name was filed on 1 March 2023. This fourth statement was intended as a means of clarifying certain undated material provided in earlier evidence. The opponent asked for this fourth statement to be admitted as late evidence. The applicant had the opportunity to view this evidence prior to the hearing and did not object to its admission. Clearly any information which provides clarification about dates will be material to the decision I must make and as the applicant did not raise any objections, I admitted the late evidence.

14. For ease of information, I will accept the naming convention set out by Mr Parden in his fourth witness statement, viz

First witness statement dated 25 April 2022 – **Parden I** with exhibits MPA to MPI

Second witness statement dated 25 April 2022 – **Parden II** with exhibits MP1 to MP9

Third witness statement dated 19 July 2022 – **Parden III** with exhibits MP3a & MP3b

Fourth witness statement dated 1 March 2023 – **Parden IV**

15. In Parden I, Mr Parden sets out the commercial origin and history of the opponent. In addition he exhibits<sup>2</sup> a promotional brochure published in 1995 setting out the opponent's position as a provider of surgical equipment, instruments and implants. The following trade mark is used on the brochure,



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<sup>2</sup> Exhibit MP-C

16. Mr Parden also exhibits<sup>3</sup> the current range of the opponent's goods and services which include surgical instruments (an illustration of which is set out below), technical services and academia courses.



17. In Parden II, Mr Parden exhibits pages showing specific products from the opponent's brochures dated between 2012 and 2017 as set out below. Although the date is not overtly apparent, Parden IV clarifies that the numeric aspect of the code contained in the footer section of each brochure (set out here in bold), namely **XX-COMB-01-16**, equates to the month and year of production.

- Exhibit MP1 is a container system bearing AESCULAP dated January 2016
- Exhibit MP2 comprises images of aneurysm clips as part of an AESCULAP branded package dated October 2018
- Exhibit MP3 relates to the AESCULAP Power Renu package dated March 2017
- Exhibit MP4 comprises images of artificial joints under the AESCULAP brand dated May 2017
- Exhibit MP5 relates to the AESCULAP Surgical Asset Management service dated January 2018
- Exhibit MP6 comprises images of artificial spine implants under the AESCULAP brand dated May 2017
- Exhibit MP7 comprises images of ligating clips under the AESCULAP Caiman model dated February 2014

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<sup>3</sup> Exhibits MP-D & MP-E

- Exhibit MP8 comprises images of artificial cervical disc implants under the AESCULAP brand dated February 2014
- Exhibit MP9 relates to the AESCULAP Endoscopy package dated August 2015

18. Mr Parden sets out the opponent’s turnover derived from its goods and services between 2016 and 2021. In Parden IV, this information is supplemented by an extraction of those figures derived for its services only. I set out the information taken from Parden IV below with the explanation as to why the services figure is not available for 2016

Years	Annual turnover	Thereof "service" sales
2016	£33,363,000	Unavailable
2017	£33,655,000	£4,536,241
2018	£32,291,000	£4,450,678
2019	£32,248,000	£4,148,919
2020	£26,244,000	£4,092,981
2021	£32,237,000	£4,658,876

Please note that the service sales recorded for 2016 are unavailable in our system due to their technical accounting treatment at the time.

19. In Parden I, Mr Parden also sets out the opponent’s advertising expenditure in the UK under the earlier mark during the same time period.

Years	Annual Advertising
2016	£636,000
2017	£667,000
2018	£750,000
2019	£642,000
2020	£225,000
2021	£366,000

20. In Parden IV, Mr Parden states that in addition to social media advertising, the opponent also advertises via mailshots and in trade journals such as those for The Royal College of Surgeons. The opponent also attends surgical conferences with trade bodies which, among others, include the Society of British Neurosurgeons, British Orthopaedic Association and the British Society of Gynaecological Endoscopists.

21. Mr Parden states that it is not possible for him to ascertain the opponent’s market share only that it is “considerable” in the specialist market for surgical and medical

instruments. The opponent states it supplies its goods and services to the entire NHS network, private healthcare providers and the veterinary sector.

### **Applicant's evidence**

22. The applicant filed a witness statement in the name Dr Torsten Matthias, its founder and CEO. Dr Matthias states the applicant's business is concerned with "detection, diagnosis and prognosis of autoimmune diseases". He also states that the applicant chose the three applied for trade marks as additions to its already existing family of AESKU- formative trade marks which had been accepted without objection from the opponent. Moreover Dr Matthias states that he only became aware of the opponent's objections to the trade mark applications when they were first filed at EUIPO.

### **Opponent's Evidence in reply**

23. Parden III contains a rebuttal to the applicant's evidence and sets out a German court decision between the parties dated 2001 which Mr Parden says demonstrates a history and familiarity between the parties. Mr Parden also states that because the opponent chose not to oppose the applicant's previous registrations does not give due cause to the applicant choosing to enlarge its AESKU-formative trade mark family with the contested applications in these proceedings.

24. That concludes my summary of the evidence.

### **Relevant statutory provision: Section 6A:**

25. "(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 section 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)-(5A) [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.”

26. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

27. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

28. In *Walton International Ltd & Anor v Verweij Fashion BV*<sup>4</sup>, Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *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*

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<sup>4</sup> [2018] EWHC 1608 (Ch)

*Bunderversvereinigung 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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 [76]-[77]; *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].”

29. I also find the following case law to be of use where in *Awareness Limited v Plymouth City Council*<sup>5</sup>, Mr Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, 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 (which in many cases will be the Hearing Officer in the first instance) 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.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such

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<sup>5</sup> Case BL O/236/13

as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

30. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*<sup>6</sup>, Mr Geoffrey Hobbs Q.C. (as he was then) also sitting as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be

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<sup>6</sup> Case BL O/404/13

provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

### **Relevant period**

31. My first task is to establish whether, or to what extent, the opponent has shown genuine use of the earlier UK mark within the ‘relevant period’. The relevant period is defined as being a period of five years ending with the filing date of each of the contested applications. In this case given there are three applications, the relevant periods are 9 February 2013 to 8 February 2018 for AESKUCARE, 15 June 2013 to 14 June 2018 for AESKUCARE ALLERGY (and device) and 16 June 2013 to 15 June 2018 for AESKUCARE FOOD INTOLERANCE (and device).

### **Sufficiency of Use**

32. The applicant in its skeleton argument submitted that the opponent’s evidence demonstrated that there was use only in relation to class 10 goods and moreover in relation to *surgical instruments* and *internal joint prosthesis* only. The opponent accepted in its oral submissions that that the “fighting ground” between the parties was in relation to class 10 but averred that the evidence went wider to *surgical, medical, healthcare instruments*. In my consideration of the evidence, I agree that the use of the mark is heavily weighted toward surgical instruments rather than more general healthcare products. The opponent markets its products at surgical conferences and in trade journals to various specialist associations and professional bodies for surgeons. It also supplies the NHS with surgical instruments. There has been a consistent turnover and advertising expenditure during the relevant periods. Although an element has been extracted from the turnover figures to reflect turnover

for services, and I note that the opponent mentions academic, technical and asset management services in exhibits MP-D, MP-E and MP5, there is no evidence demonstrating what services were taken up either by the NHS or private healthcare providers. Therefore, on the basis of the evidence before me, I agree with the applicant's submissions that genuine use and a reputation has been proven on the following goods namely *surgical instruments; internal joint prosthesis* which I consider to be a fair specification.

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

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

“5(2) 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”.

34. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *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.

The principles:

(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 the 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 the goods and services**

35. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*<sup>7</sup>, the court stated at paragraph 23 of its judgment 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”.

36. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>8</sup>, for assessing similarity were:

- (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;

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<sup>7</sup> Case C-39/97

<sup>8</sup> [1996] R.P.C. 281

(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.

37. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>9</sup> the General Court stated that:

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

38. In *Kurt Hesse v OHIM*,<sup>10</sup> 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,<sup>11</sup> the General Court 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”.

39. In *Sanco SA v OHIM*,<sup>12</sup> the General Court 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

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<sup>9</sup> Case T- 133/05

<sup>10</sup> Case C-50/15 P

<sup>11</sup> Case T-325/06

<sup>12</sup> Case T-249/11

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.”

40. The goods and services to be compared are set out below in light of my earlier findings. For ease as the three applications have identical classes and specifications, I have just set them out once.

Opponent’s goods	Applicant’s goods and services
	5. Medical, chemical and biological test kits and test reagents for medical purposes, included in class 5; Antiserums for diagnostic purposes; Chemical reagents for medical diagnostic, medical or veterinary purposes; Medical or veterinary chemical test reagents; Chemical test reagents [medical]; Diagnostic preparations for medical or veterinary purposes; Diagnostic preparations; Diagnostic preparations for medical,

	<p>pharmaceutical or veterinary purposes; Diagnostic biomarker reagents for medical purposes; Diagnostic testing materials for medical use; Diagnostic reagents for medical use; Diagnostic substances for medical use; Immunoassay reagents for medical or medical diagnostic purposes; In vitro diagnostic preparations for medical use; Indicators for medical diagnosis; Medical diagnostic test strips; Medical diagnostic reagents and assays for testing of body fluids; Medical diagnostic reagents; Preparations of microorganisms for medical or veterinary use; Preparations for detecting genetic predispositions for medical purposes; Preparations for detecting mutation in prion genes for medical purposes; Reagents for use in analysis [for veterinary purposes]; Reagents for analysis purposes (for medical diagnostic, medical or veterinary purposes); Reagents for use in diagnostic tests [for veterinary purposes]; Clinical diagnostic reagents; Reagents for in-vitro laboratory use [for medical purposes]; Reagents for in-vitro laboratory use [for veterinary purposes]; Reagents for blood grouping [for medical purposes]; Reagents for use with testing apparatus for medical or medical diagnostic purposes; Reagents</p>
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	<p>for use in diagnostic tests or in analyses for medical purposes; Reagents for use with testing apparatus for medical diagnostic or veterinary purposes; Reactants for medical or veterinary diagnosis; Veterinary diagnostic reagents; Clinical medical reagents; Biological reagents for medical, medical diagnostic or veterinary purposes; Chemical reagents for medical, medical diagnostic or veterinary purposes; Chemical reagents for medical or veterinary purposes; Reagents for microbiological analysis, for medical or veterinary purposes; Genetic identity tests, consisting of reagents for medical purposes; Reagents and media for medical and veterinary diagnostic purposes; Reagents for medical use; Reagents for medical or veterinary genetic testing; Chemical preparations for use in dna analysis [medical]; Chemical preparations for medical or medical diagnostic purposes; Blood for medical or medical diagnostic purposes; Biological preparations for medical, medical diagnostic or veterinary purposes; Mixed biological preparations for medical or medical diagnostic purposes; Blood plasma; Blood components; Blood protein fractions; Enzymes for medical, medical diagnostic or veterinary purposes;</p>
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	<p>Enzyme preparations for medical or veterinary purposes; By-products of the processing of cereals for medical or medical diagnostic purposes; Nucleic acid sequences for medical diagnostic, medical or veterinary purposes; all of the aforesaid goods for use in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances.</p>
<p>10. Surgical instruments; internal joint prosthesis</p>	<p>10: Medical apparatus and instruments; Analysers for medical use; Diagnostic apparatus for medical purposes; Automated testing apparatus for bodily fluids, for medical or medical diagnostic purposes; Diagnostic, examination, and monitoring equipment; Laser pointers for medical use; Laser beam delivery instruments for medical use; Medical instruments; Medical instruments incorporating lasers; Tools for medical diagnostics; Medical and veterinary apparatus and instruments; Apparatus for carrying-out diagnostic tests for medical purposes; Apparatus for analysing images [for medical use]; Apparatus for DNA and RNA exams for medical purposes; Apparatus for analysing bacteria in biological samples [for medical use]; Capillary tubes for delivering reagents; Specimen cup holders; Laboratory apparatus for the</p>

	<p>transmission of liquids, for medical or medical diagnostic purposes; Laboratory apparatus for mixing liquids, for medical or medical diagnostic purposes; Laboratory apparatus for administering liquids, for medical or medical diagnostic purposes; Laboratory apparatus for thinning liquids, for medical or medical diagnostic purposes; Laboratory apparatus for incubating liquids, for medical or medical diagnostic purposes; Medical or immunological testing apparatus; Electronic analyzers for medical purposes; Photometric analyzers for medical use; Automatic analyzers for medical diagnosis; Body composition analyzers for medical purposes; Analysers for bacterial identification for medical purposes; Physical analyzers for medical use; Blood centrifuging tubules [for medical use]; Blood filters for extracorporeal use; Hypodermic needles; Medication injectors; Injectors for medical or medical diagnostic purposes; all of the aforesaid goods for use in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances.</p>
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	<p>42: Medical research laboratory services; Biological laboratory services; Analytical laboratory services; Chemical laboratories; Laboratory (Scientific -) services; Chemical laboratories; Medical laboratory services; Laboratory research services relating to pharmaceuticals; Services of a chemical and/or biological laboratory; Laboratory analysis in the field of bacteriology; Laboratory services relating to the production of antibodies; Veterinary laboratory services; Laboratory services for analytical testing; Chemical laboratories; Analytical laboratory services; Laboratory testing; Consultancy relating to laboratory tests; Research laboratories, all of the aforesaid services for use in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances.</p>
	<p>44: Medical assistance; Medical services; Veterinary services; Medical analysis in connection with the treatment of individuals; Pharmaceutical advice; Advisory services relating to medical apparatus and instruments; Providing information relating to the rental of medical machines and apparatus; DNA screening for medical purposes; Medical diagnostic services;</p>

	<p>Medical testing services relating to the diagnosis and treatment of disease; Medical and health services relating to DNA, genetics and genetic testing; Pharmaceutical advice; Pharmacy advice; Consultancy for medical or medical diagnostic instruments; Consultancy in relation to immunology or autoimmunology; Consultancy and information relating to medical or medical diagnostic products; Consultancy in relation to medical or medical diagnostic services; Medical analysis services for the diagnosis of cancer; Medical analysis for diagnosing autoimmune diseases; Medical laboratory services for the analysis of blood samples taken from patients; Medical laboratory services for the analysis of samples taken from patients; Medical analysis for the diagnosis and treatment of persons; Medical analysis services for cancer diagnosis and prognosis; Medical analysis for the diagnosis and prognosis of autoimmune diseases; Medical analysis services relating to the treatment of patients; Medical analysis services relating to the treatment of persons; Medical analysis services relating to the treatment of persons provided by a medical laboratory; RNA or DNA analysis for cancer diagnosis and prognosis; RNA</p>
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	and DNA analysis the diagnosis and prognosis of autoimmune diseases, all of the aforesaid services for use in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances.
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41. For the purpose of a comparison, it is appropriate to group related goods and services together, where they are sufficiently comparable to do so<sup>13</sup>.

Class 5

42. The applicant’s goods in class 5 are broadly used for testing, diagnostic and analytic purposes relating to specific medical conditions namely autoimmune diseases, allergies and food intolerances. The products fall into several categories, i.e. pharmaceutical, chemical, biological or reagents. Their nature and purpose are therefore different from the opponent’s goods in class 10. I note that the respective goods are all in the medical field and may have some overlap of users and trade channels, but this would be at too general a level to make a finding of similarity. The respective goods are not in competition with each other, and they do not have a “close connection between them, in the sense that one is indispensable or important for the use of the other” as set out in *Boston Scientific*. Taking all this into account, I do not find similarity between the respective goods.

Class 10

43. The applicant has the terms *medical apparatus and instruments; medical instruments* which I find to be broad enough to encompass the opponent’s goods and are therefore considered identical under the *Meric* principle.

44. The applicant’s terms *Laser pointers for medical use; Laser beam delivery instruments for medical use; Medical instruments incorporating lasers; all of the aforesaid goods for use in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances* are highly similar to *Surgical*

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<sup>13</sup> *Separode Trade Mark* decision, BL O-399-10 (AP)

*instruments* in the opponent's specification. The nature and purpose of the respective goods are shared, as they are all goods intended to perform specific actions within the body by using an external object, e.g., to perform biopsies or take tissue samples. There is likely to be a greater overlap of users and the trading channels for apparatus and instruments would also coincide. I also find there would be some degree of complementarity between the goods.

45. The applicant's remaining goods in class 10 are used in the medical field but have a testing, diagnostic or analytic nature and purpose which is different from the opponent's surgical instruments which are used to perform operations. As previously stated, any overlap of users and trade channels would be at too general a level to make a finding of similarity. As such I find these goods dissimilar to the opponent's goods.

#### Class 42

46. The applicant's services in this class, broadly speaking, relate to research and laboratory services in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances. I do not find this shares the same nature or purpose as the opponent's goods. Neither is there any competition or complementarity. Any overlap of users or trade channel simply because the goods and services are all in the medical field is again at too general a level to make a finding of similarity. Therefore, I find the goods and services dissimilar.

#### Class 44

47. The applicant's services here relate to the medical services associated with the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances. I do not find this shares the same nature or purpose as the opponent's goods. Neither is there any competition or complementarity. Any overlap of users or trade channel simply because the goods and services are all in the medical field is again at too general a level to make a finding of similarity. Therefore, I find the respective goods and services dissimilar.

48. In *eSure Insurance v Direct Line Insurance*,<sup>14</sup> Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

### **Average consumer and the purchasing process**

49. I next consider who the average consumer is for the contested goods and services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>15</sup> 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.<sup>16</sup>

50. The average consumer for the contested goods and services will be surgical and medical professionals or medical supply chain specialists. Either way these are not goods and services purchased by the general public. The goods and services will vary in price but are likely to be relatively expensive. The purchasing process will be predominately visual, as consumers will see promotional material, demonstrations at conferences or browse online catalogues, but aural consideration cannot be ruled out entirely if say advice is sought from technicians. Given the specialist nature of the goods and services and because they relate to use in treating medical conditions, I find the level of attention paid during the purchasing process will be high.

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<sup>14</sup> [2008] ETMR 77 CA

<sup>15</sup> *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

<sup>16</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.

### Comparison of the marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>17</sup>, that:

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

52. 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.

53. The respective trade marks to be compared are:

Opponent's mark	Applicant's marks
<b>AESFULAP</b>	<u>TM No. 3648589</u> <b>AESKUCARE</b>   <b>AESKUCARE</b> Food Intolerance

<sup>17</sup> Case C-591/12P



54. The opponent's mark consists of the word **AESKULAP** with no other stylisation. Therefore the overall impression derives solely from this word.

55. The applicant's mark no.3648589 ("the '589 mark") consists of the word **AESKUCARE** with no other stylisation. Therefore, the overall impression derives solely from this word.

56. The applicant's mark nos.3648573 ("the '573 mark") and 3648491 ("the '491 mark") both consist of the word **AESKUCARE**, a device element and an additional descriptive word element, namely **Food Intolerance** and **Allergy**. Both marks share the same presentation, that is a device being ears of wheat in the '573 mark and a bee with a flower in the '491 mark, contained within a square background then placed to the left of the words and taking up the height of both word elements. **AESKUCARE** is larger in scale than the other word elements and is positioned above them. The device and **AESKUCARE** make an equal contribution to the overall impression of these marks.

57. In a visual comparison the respective marks share their first three letters A-E-S and have a U as their fifth letter. The fourth letters are different, being a C in the opponent's mark and a K in the applications. The respective marks have different endings namely LAP and CARE, making the applicant's '589 mark slightly longer. There is no counterpart in the opponent's mark to the devices and additional word elements found in the applicant's marks. The opponent, in its skeleton argument, drew my attention to settled case law<sup>18</sup> which sets out that beginnings of words usually have greater visual and aural impacts than the ends. Taking all these

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<sup>18</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

factors into account, weighing up the similarities and the differences, I find there is a low degree of visual similarity.

58. The devices will play no part in an aural comparison so I need only consider the words. The opponent's mark will likely be pronounced as ACE-CUE-LAP or EES-CUE-LAP. Likewise the applicant's marks will have the same likely pronunciation of their beginnings namely ACE-CUE-CARE or EES-CUE-CARE. I find there will be no difference in the pronunciation of the C and the K in the respective marks as it will be a hard C sound when followed by a U. The marks clearly differ in their endings and the additional word elements in the applicant's marks will be pronounced in their usual way but have no counterparts in the opponent's mark. Overall I find there is a medium degree of aural similarity.

59. Turning to the conceptual similarity, in *Parden I*, the opponent states that its mark is derived from the name Aesculapius being the Roman god of medicine. It is agreed by the parties that there has been an association between Aesculapius and the practice of medicine since antiquity. Although the opponent's mark is an invented word it contains sufficient letters likely to carry at least some conceptual associations with the Roman god especially for some consumers in the medical profession. If the association with the Roman god is not known then the opponent's mark will be seen as purely invented. The applicant's **AESKUCARE** is an invented word and has no meaning. Its devices will likely bring to mind concepts of the natural world and its additional word elements namely Food Intolerance and Allergy will be understood by their usual dictionary meanings. Overall I find the respective marks to be conceptually neutral.

### **Distinctiveness of the earlier marks**

60. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive an earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*<sup>19</sup> the CJEU stated that:

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<sup>19</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in 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).”

61. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

62. I begin by considering the inherent position. The earlier mark is an invented word albeit that it may allude to the Roman god Aesculapius whose name would be known to many in the medical profession, however, overall I find it has a high degree of inherent distinctiveness.

63. As evidence was provided in these proceedings, I next examine whether use of the earlier mark has enhanced its distinctiveness. The relevant market I must consider in this examination is the UK. Taking into account the *Chiemsee* factors given above, I note the evidence shows the mark in use during the relevant period

for surgical instruments; internal joint prosthesis. Although, no market share has been provided, turnover and advertising expenditure figures have been demonstrated. The opponent has demonstrated a wide geographical customer base as it supplies the NHS. Overall I find that use of the earlier mark has enhanced its distinctiveness for the above specified goods to a very high degree.

### **Likelihood of confusion**

64. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind<sup>20</sup>. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

66. In *L.A. Sugar Limited*,<sup>21</sup> Mr Iain Purvis Q.C.(as he was then), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

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<sup>20</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>21</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

67. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark<sup>22</sup>. This is considered mere association not indirect confusion.

68. So far in this decision I have found that,

- There is identity and high degree of similarity between some of the goods and a dissimilarity between other goods and services
- The average consumer for the contested goods and services is a medical professional or professional in the medical supply chain, both paying a high degree of attention in a predominantly visual purchasing process
- There is a low degree of visual similarity between the respective marks
- There is a medium degree of aural similarity
- There is conceptual neutrality
- The earlier mark has enhanced distinctiveness to a very high degree

69. Taking first the opponent’s mark and the applicant’s ‘589 mark. Both start with the same three letters namely AES and both have a letter U as their fifth letter. The respective fourth letters C and K are aurally identical but they are visually quite different. Both marks are invented words but the opponent’s mark may have some conceptual hook relating to the Roman god Aesculapius whereas the applicant’s mark does not. Taking this into account, in addition to the case law relating to the impact of the beginnings of words and the distinctiveness of the earlier mark, I find any similarity is outweighed by the different endings. The LAP and CARE elements have different visual and aural impacts. These endings will not go unnoticed and overall I find there is no direct confusion between the marks.

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<sup>22</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

70. The visual, aural and conceptual differences are even greater between the opponent's mark and the applicant's '573 and '491 marks given their device elements and additional words. I also find no direct confusion here.

71. Having found no likelihood of direct confusion, I will go on to assess the likelihood of indirect confusion. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to the same or an economically connected undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark. However I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because two marks share a common element.

72. Consumers may note that the respective marks share similarly constructed beginnings namely AESCU/AESKU but in my view are unlikely to be confused into thinking the goods and services come from the same or connected undertakings given the level of attention paid. It would be highly unusual for a sub brand to adopt a name based on a prefix which is differently spelled to the original. If one mark is brought to mind by the other on the basis of the similarly constructed beginning then I consider this to be mere association and not indirect confusion as per *Duebros*. Consequently I find that there is no indirect likelihood of confusion.

73. Having failed to find a likelihood of confusion under section 5(2). I will go on to consider the other ground.

### **Section 5(3)**

74. The opponent opposes the contested trade mark under Section 5(3) of the Act on the basis of its earlier mark and the goods and services in classes 9, 10, 35, 37, 39, 41, 42 and 44 for which it claims have a reputation. In particular the opponent argues,

“...that use and registration by the Applicant of the subject application for the opposed goods and services would take unfair advantage of or be detrimental

to the reputation and distinctive character of the Opponent's earlier registration."

75. Section 5(3) of the Act states:

"5(3) A trade mark which –  
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 repute of the earlier trade mark."

76. Section 5(3A) of the Act states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

77. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. 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 Saloman*, 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/services, the extent of the overlap between the relevant consumers for those goods/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 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'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/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/services for which the earlier mark is registered, or a serious risk that this will happen in 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 of the earlier mark; *L'Oreal v Bellure NV*,

paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(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 (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

78. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark is similar to the applicant's marks. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later marks. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

### **Reputation**

79. In my previous assessment of the opponent's evidence I found it had demonstrated the requisite reputation for *surgical instruments; internal joint prosthesis*. There was nothing in the evidence before me demonstrating a reputation for the other goods and services classes claimed.

## **Link**

80. Having found that the opponent has established the requisite reputation, I will go on to make the assessment of whether the public will make the required mental 'link' between the marks, taking account of all relevant factors. The factors identified in *Intel* (underlined below) are:

### The degree of similarity between the conflicting marks

81. For the reasons given previously I find there is a low degree of visual similarity, a medium degree of aural similarity and conceptual neutrality.

### 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

82. The applicant is seeking to register its mark for goods and services broadly in the field of medicine and all for use in relation to the detection, diagnosis and prognosis of autoimmune diseases, allergies and food intolerances including for medical apparatus and instruments which cover the goods of the opponent. The relevant consumer concerned with these goods will perceive some degree of closeness between the respective goods as both are used to perform specific actions within the human body.

### The strength of the earlier mark's reputation

83. I found that the opponent's evidence has demonstrated a requisite reputation for *surgical instruments; internal joint prosthesis* in the UK given its use by the NHS and surgical professionals at the relevant date.

### The degree of the earlier marks' distinctive character, whether inherent or acquired through use

84. I found that the earlier mark is inherently distinctive to a high degree but that this has been enhanced through use to a very high degree in respect of *surgical instruments; internal joint prosthesis*.

### Whether there is a likelihood of confusion

85. Previously in this decision, I found there was no likelihood of direct or indirect confusion.

86. Taking the above factors into account, I find that the required link will not be made because of the visual, aural and conceptual differences between the respective marks, i.e. that the shared three letters AES and a similarly constructed prefix is insufficient in light of the differences arising from the remaining letters and other matter, and the high level of attention paid in the purchasing process by a professional consumer. Therefore as a link will not be made, then the section 5(3) grounds falls at this hurdle.

### **Conclusion**

87. The opposition has been unsuccessful and subject to any appeal against this decision, the applications can proceed to registration.

### **Costs**

88. The applicant has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the TPN, I award costs as follows:

£700	Considering the opposition statements & preparing the counterstatements
£1300	Considering the opponent's evidence & preparing own evidence
£1000	Preparing for and attending the hearing
<b>£3000</b>	<b>Total</b>

89. I order Aesculap AG to pay Aeneas GmbH & Co.KG the sum of £3000. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9th day of August 2023**

**June Ralph**

**For the Registrar**

**The Comptroller-General**