O/0885/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3702610

BY TIP-TOP.COM LIMITED

TO REGISTER THE TRADE MARK:

VISTO

IN CLASS 10

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 432300

BY DÜRR DENTAL SE

Background and pleadings

1. On 28 September 2021, tip-top.com Limited ("the applicants") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 24 December 2021. The goods applied for are as follows:

> Class 10: Medical devices; Medical instruments; Medical apparatus and devices; Needles for medical purposes; Needles for medical use; Medical syringe needles; Medical needles and cannulae; medical needle and cannula safety devices; safety devices for use with medical syringes and injectors; medical syringes, needles, injectors, and cannulae with built in safety features and components; medical safety needles; medical pen injector safety needles; none of the aforementioned goods relating to animal health products within the veterinary sector.

2. The application was opposed on 24 March 2022 by Dürr Dental SE (the opponent). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade marks:

UK915959191 ('the first earlier registration')

VISTAINTRA

Filing date: 21 October 2016
Registration date: 23 February 2017

UK915959265 ('the second earlier registration')

VISTAPANO

Filing date: 21 October 2016
Registration date: 23 February 2017

Both relying on the same goods as follows:

> Class 10: Medical apparatus and instruments; Medical imaging apparatus; Dental apparatus and instruments; roentgen apparatus for dental purposes; Dental x-ray mouth props.

UK911020922 ('the third registration')

VISTAVOX

Filing date: 6 July 2012
Registration date: 6 December 2012
Relying on some of the goods registered as follows:

> Class 10: Medical and dental apparatus and instruments, in particular radiological apparatus and installations consisting thereof, apparatus for generating X-rays for medical purposes and installations consisting thereof; Medical and dental cameras for image acquisition; X-ray photographs and tubes for medical purposes; Image converters and image discs for medical and dental purposes; Medical and dental scanners; Accessories for X-ray apparatus and scanners for medical use, included in class 10.

3. The opponent claims that the marks are highly similar to each other and that the goods and services in question are identical or similar.

4. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use of the third earlier registration.

5. The applicant is represented by Dummett Copp Ltd and the opponent is represented by Kilburn & Strode LLP.

6. The opponent filed evidence and the applicant provided submissions in reply dated 30 November 2022. Neither party requested a hearing but the opponent provided

submissions in lieu. This decision is therefore taken following careful consideration of the papers.

7. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

8. The opponent's evidence in chief consists of two witness statements by Nora Fowler, who is the Trade Mark Attorney from the opponent's representatives dated 24 August 2022 and 26 September 2022. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used for the relevant period. There is a further witness statement from Andreas Hering (a 'Director Business Group Diagnostic with the opponent) and Michael Haeuslschmid (the Head of Intellectual Property with the opponent) (this witness statement is undated). This is further evidence of use and was filed in response to the applicant's submissions in reply to the opponent's evidence in chief.

9. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

Decision

Section 5(2)(b)

10. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

…"

12. The opponent's marks qualify as earlier marks, in accordance with the above provision. The third earlier registration is subject to proof of use requirements as it has been registered for five years or more before the application date of the contested mark, as per section 6A of the Act. The applicant has requested that the opponent provides proof of use for this mark.

Proof of use

13. I will begin by assessing whether there has been genuine use of the third earlier registration.

14. Section 6A:

"(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."

15. As the third earlier registration 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".

16. 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."

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the third earlier registration is the five-year period ending with the date of the application in issue i.e. 29 September 2016 to 28 September 2021. This is a comparable mark and so, in accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) 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 Bundervsvereinigung 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 Merken 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].”

Evidence

19. The evidence from Ms Fowler begins with Exhibit NXF1 which contains Wayback Machine pages from the opponent’s website dated 22 September 2021 and 8 April

2017 which purport to show the earlier mark. I note there are a few versions of the mark used on these pages as follows:

VistaVox S and VistaVox S Ceph: taking 3D diagnostics to the next level

VistaVox S

3D and 2D X-ray images with exceptional image quality

VistaVox S

Taking 3D diagnostics to the next level - VistaVox S generates a 3D volume ideally adapted to the contour of the jaw

20. Exhibit NXF3 is a printout showing the pricing as follows (although I note this is from outside of the relevant period):

Durr VistaVOX 3D OPG

£51,662.50

VistaVox S Hybrid X-ray unit for 3D CBCT and 2D panoramic X-ray images

21. Exhibits NXF4 & NXF5 contain articles from the British Dental Journal and Scottish and Irish Dental magazines dated June, October and November 2019. The article appears to be very similar across each of the magazines and references 'VistaVox S' and 'VistaVox S Ceph'.

22. The opponent has provided invoice evidence in Exhibits NXF 8 and NXF11 and I have extracted the following information from them:

Date	Invoice number	Country	Item	Quantity
22/1/2020	E1071086	Spain	VistaVox S	1
22/1/2020	E1071155	Spain	VistaVox S	1
10/2/2020	E1071851	France	VistaVox S	1
21/1/2020	E1071718	France	VistaVox S Ceph	1
28/2/2020	E1071918	France	VistaVox S	1
2/3/2020	E1072900	Italy	VistaVox S	1
18/12/19	E1070864	Lithuania	VistaVox S	1
24/6/2020	E1076881	Poland	VistaVox S Ceph	1
9/3/2020	E1073524	Spain	VistaVox S Ceph	1
31/1/2020	E1071689	Norway	VistaVox S	2
23/7/2020	E1078192	Spain	VistaVox S	1
7/8/2020	E1078473	Czech Republic	VistaVox S	1
7/9/2020	E1079635	Italy	VistaVox S Ceph	1
15/9/2020	E1079548	France	VistaVox S Ceph	1
15/9/2020	E1080126	France	VistaVox S	1
18/9/2020	E1080206	Spain	VistaVox S	1
24/9/2020	E1079643	Italy	VistaVox S	2
11/10/2020	E1080850	France	VistaVox S	2
05/06/2019	E1064065	United Kingdom	VistaVox S	1
29/05/2019	E1064065	United Kingdom	VistaVox S	1
28/06/2019	E1064065	United Kingdom	VistaVox S	1
31/07/2017	E1042179	United Kingdom	VistaVox S	1
07/03/2019	E1060463	United Kingdom	VistaVox S	1
05/03/2019	E1060463	United Kingdom	VistaVox S	1
27/07/2017	E1042179	United Kingdom	VistaVox S	1

23. I note that the name at the top of the invoices is ‘Dürr Dental’ but that the marks ‘VistaVox S/VistaVox S Ceph’ are found in the item list.

24. Exhibits NXF9 and NXF10 are manuals and newsletters that both relate to VistaVox S; however, I have no information as to how these items were made available to consumers nor how many consumers may have seen them.

25. In the witness statement from Mr Hering and Mr Haeuslschmid, they describe in paragraph 4 the goods as “3D X-ray systems which generate pinpoint accurate images for reliable diagnoses and treatment decisions in the dental field.” Beneath this there is a picture of one of the goods showing the mark ‘VistaVox’ which I have copied below:

26. Exhibit 3 to the second witness statement shows the website of ‘One Smile Dental, Sheffield’ who refer to using the ‘VistaVox S Ceph 3D’ machine and also shows a picture of the machine in use. However, this evidence is undated.

27. Exhibit 4 to the second witness statement are Wayback Machine captures from a UK company website, ‘Imaging Technologies’ and the following images are extracted from those captures dated 2 December 2021:

Durr – VistaVox S Ceph

3-in-1 X-ray system

In addition to the various CBCT volumes and the 17 panoramic programs, VistaVox S Ceph also offers six modes for all types of cephalometric exposures:

- Head Lateral
- Head Full Lateral
- Head PA
- SMV (submentovertex)
- Waters View
- Hand

Analysis

Form of the mark/how the marks are used

28. After reviewing the evidence, I can see the mark as registered on the photograph of the goods within the second witness statement. However, I note that for the most part, the evidence shows two variations of the mark: 'VistaVox S' and 'VistaVox S Ceph'. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12 the Court of Justice of the European Union found that use of a mark generally encompasses both its independent use and its use as part of another mark. I can see the mark in use within these variations and as it is a word mark, the word itself is protected even with the different use of lower and upper case letters.

29. I consider that the overall impression of the mark as registered will lie in the word itself. For the mark used 'VistaVox S', I consider that the average consumer might see the additional 'S' as a pluralisation of the original mark or if they notice the space between them, they might view it as a slightly different model or type, perhaps a smaller version as 'S' can sometimes denote a size small. I therefore find that this would not make a material difference to the overall distinctiveness and indeed would be covered by the mark being registered as a word mark.

30. I turn now to the use of 'Vistavox S Ceph'. I have already found above that the addition of the letter 'S' will not alter the distinctive character of the mark. Therefore, I need to consider the addition of 'Ceph'. I consider this to be an invented word, and have been offered no evidence to say otherwise, and therefore it may not be assigned any meaning. I note that the opponent's word mark 'VistaVox' is still clearly visible and at the beginning of the mark. And therefore, the meaning of this is not altered because as a whole 'VistaVox S Ceph' does not have a unitary meaning. Consequently, the word 'VistaVox' retains its independent distinctive role, and therefore this will amount to acceptable use of the opponent's earlier mark.

Conclusions from the evidence on genuine use

31. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. This is the EU for the part of the period up to 31 December 2020 and the UK thereafter. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

32. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[1]

33. The opponent has not provided me with any turnover figures nor any marketing expenditure figures. However, they have provided me with invoices totalling the sale

[1] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

of 28 of the articles under the VistaVox S/VistaVox S Ceph marks. They have shown photographic evidence that the goods themselves also bear the mark. There is also evidence of the machines on customer websites that are aimed towards their own consumers. They have shown some evidence of advertising the goods on their own websites and also through the Dental Journal articles.

34. Although Exhibit NXF3 is dated outside of the relevant dates, it does give an indication as to the price point of such machines. These machines are not everyday purchases and are sold at a high price point. The invoices show a range of sales over the entire 5 year relevant period and show a wide range of sales in 9 different EU countries, including the United Kingdom. I do not consider that x-ray machines, specifically dental x-ray machines have a particularly large customer base nor a large market. These findings therefore offset what appears to be a relatively low number of sales shown in the invoices as per the findings in *Masterbuilders, Heiermann, Schmidtmann GbR v EUIPO*, T-76/21, EU:T:2022:16.

35. Taking into account all of the above, I am satisfied that the opponent has demonstrated genuine use of its earlier mark during the relevant period. When factoring in the high price point of the goods, the geographical spread of sale over the UK and EU, the sustained sales across the relevant period and for goods which are not likely to be purchased on a regular basis by consumers (not even on a yearly basis) then I am satisfied that the opponent has demonstrated genuine use of its mark. I consider that such use has been shown for dental x-ray machines as this has been referred to throughout the evidence and also within the opponent's own witness statement.

Fair Specification

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they

should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

37. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Pl*c [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

> independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

38. As a reminder, the opponent claims to have used the third earlier registration on the following goods:

> Class 10: Medical and dental apparatus and instruments, in particular radiological apparatus and installations consisting thereof, apparatus for generating X-rays for medical purposes and installations consisting thereof; Medical and dental cameras for image acquisition; X-ray photographs and tubes for medical purposes; Image converters and image discs for medical and dental purposes; Medical and dental scanners; Accessories for X-ray apparatus and scanners for medical use, included in class 10.

39. The opponent's second witness statement clearly states that the vistavox goods are "3D X-ray systems…in the dental field". I have seen no evidence that they provide any sort of camera under the vistavox mark, nor have they provided me with any evidence that accessories, photographs, tubes, image converts or image disks are sold under this mark also. Within the evidence, anything that is not the X-Ray machines is usually shown under a different mark, for example:

I therefore do not believe it is necessary to consider these items further.

40. The remaining terms to consider are: Medical and dental apparatus and instruments, in particular radiological apparatus and installations consisting thereof, apparatus for generating X-rays for medical purposes and installations consisting thereof; Medical and dental scanners. I note that the term above states 'in particular' which is the equivalent to 'for example' when noted in a specification and therefore does not restrict the goods to the terms listed after it (whereas the term 'namely' within a specification does restrict the goods to those listed thereafter). In this case, it would mean that "dental apparatus" could include goods such as drills, dental mirrors and suction machines, none of which the opponent has shown the mark has been used for. I find that all the evidence I have been provided- the extracts from dental journals, the example x-rays from the opponent's website which all show teeth and, as mentioned above, the description in the witness statement all show that the Vistavox mark is used specifically within dentistry. I therefore find that there is no need to keep the reference to medical and dental apparatus generally and medical scanners. These terms would be too broad. There is use shown for dental x-ray machines and these involve scanning the patient so I consider that 'dental scanners' can remain as part of the specification.

41. I therefore find a fair specification to be:

Class 10: Dental apparatus namely radiological apparatus and installations consisting thereof, apparatus for generating x-rays for dental purposes and installations consisting thereof; Dental scanners

Section 5(2)(b)

42. In making this decision, I bear in mind the following principles 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 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

43. In the judgment of the 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".

44. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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;

(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.

45. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the GC") 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".

46. 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 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".

47. 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., sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/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".

48. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade*

Mark (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

49. The Parties' respective specifications are:

Applicant's goods	**Opponent's goods**
Class 10: Medical devices; Medical instruments; Medical apparatus and devices; Needles for medical purposes; Needles for medical use; Medical syringe needles; Medical needles and cannulae; medical needle and cannula safety devices; safety devices for use with medical syringes and injectors; medical syringes, needles, injectors, and cannulae with built in safety features and components; medical safety needles; medical pen injector safety needles; none of the aforementioned goods relating to animal health products within the veterinary sector.	*The first and second earlier registrations:* Class 10: Medical apparatus and instruments; Medical imaging apparatus; Dental apparatus and instruments; roentgen apparatus for dental purposes; Dental x-ray mouth props. *The third earlier registration:* Class 10: Dental apparatus namely radiological apparatus and installations consisting thereof, apparatus for generating x-rays for dental purposes and installations consisting thereof; Dental scanners

Medical devices; Medical instruments; Medical apparatus and devices; Needles for medical purposes; Needles for medical use; Medical syringe needles; Medical needles and cannulae; medical needle and cannula safety devices; medical syringes, needles, injectors, and cannulae with built in safety features and components; medical safety needles; medical pen injector safety needles

50. I consider that the above goods from the applicant's specification all fall within the wider category of 'medical apparatus and instruments' from the opponent's first and second specifications and therefore, I find them to be identical under the *Meric* principles.

51. I consider that dentistry is a medical specialism and therefore I find that 'Dental apparatus namely radiological apparatus and installations consisting thereof, apparatus for generating x-rays for dental purposes and installations consisting thereof; Dental scanners' from the opponent's specification will therefore be identical under the *Meric* principles to the applicant's '*Medical devices; Medical apparatus and devices'.*

Safety devices for use with medical syringes and injectors;

52. The above goods from the applicant's specification will share users with the opponent's 'medical apparatus and instruments' (from the first and second registrations) as they will both be being used by medical professionals or those with a medical need. The use will overlap although the applicant goods are focused towards safety rather than the medical need. The nature might therefore also differ. The trade channels will overlap and I consider that these goods are complementary - the applicant's goods are for use solely in conjunction with the opponent's goods and it would be reasonable for a consumer to believe both goods are from the same undertaking. I therefore find these goods to be similar to a high degree.

53. Again, looking at the third earlier registration, 'dental apparatus namely radiological apparatus and installations consisting thereof, apparatus for generating x-rays for dental purposes and installations consisting thereof' might share general users with these goods from the applicant's specification and they might be used alongside one another in the same medical situations. The trade channels might also overlap but they will be different in nature and I do not feel they are complementary in this instance, nor are they in competition. I therefore find them to be similar to between a low and medium degree.

Average consumer and the purchasing act

54. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary

according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

55. In *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), Birss J. (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

56. I find that the goods at issue are all medical or dental related goods and therefore, the average consumer is most likely to be a medical/dental professional although I do not discount that there might be some members of the public who can also use these goods. In either case, both sets of consumers can be said to be paying a higher than normal degree of attention in the selection of those goods.

57. The selection process is likely to predominantly involve a visual aspect when looking for products in a retail setting or perusing a specialist catalogue or website. There may also be advertisements or presentations of the goods that the consumer will be exposed to. I do not however, discount that there may also be an aural component to the purchase through word-of-mouth recommendations or orders which may be placed by telephone.

Comparison of the marks

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural, and conceptual similarities of the marks must be assessed by reference to the overall impressions

created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

59. 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.

60. The parties respective marks are shown below:

Contested Mark	**Earlier Marks**
VISTO	*The first earlier registration:* VISTAINTRA *The second earlier registration:* VISTAPANO

	The third earlier registration: VISTAVOX

61. The contested mark is a word mark comprising a single word, therefore the overall impression lies in the word itself. As all three earlier registrations appear on the register (which is how I must make these comparisons) as all capital word marks, I consider that overall impression of them also lies in the words themselves. However, I note that the opponent submits that their marks would be seen by the average consumer as two words conjoined. I will therefore also consider that this is a possibility when making my comparison.

62. Visually, the contested mark is a word mark comprising of five letters. The first earlier registration is one word containing ten letters and shares the first four letters with the contested mark. The fifth letters are 'A' and 'O' and are somewhat different in shape and the 'INTRA' has no counterpart in the contested mark. Given that the marks do share a beginning but that the contested mark is half the length of the first earlier registration, I consider that the marks are visually similar to a medium degree.

63. The second earlier registration is a word mark made up of nine letters. As above, it shares the first four letters with the contested mark with the fifth letters once again being 'A' and 'O' (although there is an 'O' at the end of the second earlier registration). Once again, the second earlier registration is nearly double the contested mark and I therefore find them to be visually similar to a medium degree.

64. The third earlier registration is a word mark made up of eight letters. Once again, the first four letters are shared with the contested mark and they do share the letter O albeit in different positions. The mark is again longer than the contested mark and I therefore also find them to be visually similar to a medium degree.

65. Next, I will turn to the aural comparison of the marks. The contested mark will be pronounced as two syllables, as *vih/sto.* For the first earlier registration, I consider that it will most likely be pronounced as *vih/stain/truh* in three syllables. The first syllable is identical to the contested mark and the second syllable shares the beginning 'st' sound. The rest of the mark is different and there is a third syllable that has no counterpart in the earlier mark. I therefore find the marks to be aurally similar to a medium degree. However, in considering the opponent's argument that the marks will be viewed as two conjoined words, it is possible that the average consumer might split the term and pronounce it as *vih/stuh/in/truh.* This will therefore be four syllables again with the first syllable being identical to the contested mark and the second syllable sharing the beginning 'st' sound. In this instance there will be two further syllables with no counterpart in the contested mark. In this instance I find them to be aurally similar to a medium degree.

66. Turning to the second earlier registration, I consider that this will be pronounced as four syllables, *vih/stuh/pan/o* regardless of whether the average consumer considers it to be one word or two words conjoined. Once again, the first syllable is identical to the contested mark and the second syllable shares the beginning 'st' sound, further the last sound of both marks will be the 'o' sound. However, the contested mark has two further syllables which have no counterpart in the contested mark and once again, I find them to be similar to a medium degree.

67. For the third earlier registration, I consider that this will be pronounced as *vih/stuh/vox* again, with three syllables. As with the second earlier registration, the pronunciation will be the same whichever way the average consumer views the mark. My initial findings for the first earlier registration in paragraph 65 also apply here and I therefore find them to be aurally similar to a medium degree.

68. Conceptually, the contested mark appears to be an invented word with no particular meaning and no link to the goods applied for. I consider that most consumers will view all of the earlier marks (when seeing them as registered) also as invented terms with no relation to the goods and in that case the marks are conceptually neutral. However, when considering the opponent's argument that the marks are two words conjoined, I consider that in this instance consumers might recognise the term 'VISTA' at the beginning of the contested marks as an ordinary dictionary term meaning a view from a particular place.[2] In my mind 'INTRA' and 'PANO' do not have any recognisable meaning. 'VOX' might bring to mind a voice or sound.[3] For these consumers, the marks will be conceptually dissimilar.

Distinctive Character of the Earlier Mark

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

> "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 WindsurfingChiemsee 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

[2] https://www.collinsdictionary.com/dictionary/english/vista
[3] https://www.collinsdictionary.com/dictionary/english/vox

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)."

70. The opponent has submitted evidence regarding use of its marks which I have summarised above. The opponent has submitted that the distinctive character of the earlier marks is 'at least normal'. I will review the evidence to see whether it shows that use of the marks can be said to have enhanced the distinctiveness of the earlier mark.

71. In order to do this, first I must consider the level of inherent distinctiveness the earlier marks have. For the most part, words that are descriptive or allusive of the character of the goods and services provided are on the lower end of the scale of distinctiveness whereas invented terms are likely to possess the highest level of distinctiveness.

72. I consider that for the consumers that recognise 'VISTA' as having an ordinary dictionary meaning, the marks could be slightly allusive to some of the goods from the specification of the earlier mark as they are related to x-rays and imaging, thus providing a view into the human body. However, the marks have further parts to them which appear to be made up (save for 'VOX' which some consumers might also recognise as having a dictionary definition). I therefore find the marks to be inherently distinctive to a medium degree in this instance. If the consumers view the marks to be single words which are entirely invented then they will be inherently distinctive to a high degree.

73. It is the UK market that is relevant to an assessment of enhanced distinctiveness. The opponent did not provide sales figures but did provide example invoices as detailed above; however, only seven invoices show sales in the UK over the entire relevant period and I have no further details of turnover and further UK sales nor do I have any evidence or indication of the size of the market. Given this, I do not believe that they have shown enhanced distinctiveness in the UK market and therefore the distinctive character of the earlier mark remains at its inherent level.

Likelihood of Confusion

74. There are two types of confusion that may arise. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

75. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

76. I have found as follows:

a) The applicant's goods range from identical to similar between a low and medium degree to the goods covered by the earlier registrations.

b) The average consumer is a medical professional although I do not discount that there might be some members of the public who can also use these goods. The average consumer will be paying a higher than normal degree of attention.

c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

d) The average consumer will either view the earlier marks as whole invented term or as two words conjoined. The overall impression of the contested mark will be in the word as a whole.

e) The marks are visually and aurally similar to a medium degree and conceptually neutral or dissimilar depending on how the consumers view the earlier registration.

f) The earlier mark is inherently distinctive to either a medium or high degree depending on how the earlier marks are viewed by the average consumer.

77. I note the initial four letter of the marks are identical; however in *CureVac GmbH v OHIM,* T-80/08 it was determined that this was not always a decisive matter in the finding of a likelihood of confusion. The earlier registrations are different lengths and contain endings which are not replicated at all in the noticeably shorter contested mark. I note that the opponent has raised that a likelihood of direct confusion might arise through imperfect recollection. Whilst it is possible that the average consumer might imperfectly recall the letters 'A' and 'O' at the end of 'VISTO' and 'VISTA', this is not what is being compared here, all three earlier registrations have extraneous lettering at the end and they would be imperfectly recalling the last letter with the middle letter. Taking into account the higher level of attention being paid by the consumers of these goods, even where the goods are identical, I believe that the average consumer will recall the differences, in particular noting the visual differences and therefore I find there to be no direct confusion.

78. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

> "17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension("FAT FACE" to "BRAT FACE" for example)".

79. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

> "This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."[4]

80. I note that the opponent makes submissions around imperfect recollection which I have already addressed in paragraph 77 and consider this also applies here.

81. Turning to the above categories; firstly, the shared elements between the marks are the beginning letters 'VIST' which is an ordinary combination of letters and beginning of a word and cannot be said to be strikingly distinctive, in particular as it is only part of each of the sole words that makes up the earlier marks and so the

[4] Paragraph 12

consumer would not artificially dissect them and find that particular part to be more distinctive than another.

82. In the event that the average consumer sees the earlier marks as two conjoined words, as the opponent has argued, then, as I have mentioned in paragraph 72 above, the 'VISTA' element could be allusive to the goods registered and therefore, that would make the more distinctive element the three endings, 'INTRA', 'PANO' and 'VOX'. Bearing in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 where he said:

> "38. The Hearing Officer cited Sabel v Puma at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

83. I consider that this means the marks are further away from a likelihood of confusion on this argument.

84. Secondly, the additional elements of the earlier marks are not non-distinctive elements which could form part of a sub-brand. Indeed, the marks are presented together in one word, and as I have found above, the overall distinctiveness of each of the earlier marks lies in the word as a whole.

85. I note that the opponent suggests that removing or replacing second elements would be consistent with brand extension. However, in this instance we have the removal and the addition of other elements and I consider this to be a step too far. Especially when considering that, in the opponent's own arguments they state that

their marks are two words conjoined and, in this instance, the consumer will likely attribute a meaning to 'VISTA' which would be wholly changed by changing the last letter to O (especially when all other earlier registration containing 'VISTA' as the initial element. All of this is once again taking into consideration that the average consumer of the goods in question will be paying a higher degree of attention.

86. Whilst the categories set out above by Mr Purvis are not exhaustive, I can find no other reason why the average consumer would, when exposed to the contested marks, assume that the goods and services at issue came from the same or an economically linked undertaking, or vice-versa. The differences between the visual and conceptual elements of the marks as discussed above will prevent consumers from assuming that there is a connection between the two, they may recall the other mark to mind but that is mere association and not indirect confusion[5].

87. I therefore find that there would be no indirect confusion between the marks.

Conclusion

88. The opposition fails in its entirety.

Costs

89. The applicant has been successful and is entitled to a contribution towards its costs. Award of costs are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs in this matter has been calculated as follows:

Considering the Notice of Opposition and preparing Counter Statement	£300
Considering and commenting on the other side's evidence	£750

[5] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

Total	**£1050**

90. I therefore order Dürr Dental SE to pay tip-top.com the sum of £1050. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 18th day of September 2023

L Nicholas
For the Registrar