

BL O/1075/23

TRADE MARKS ACT 1994

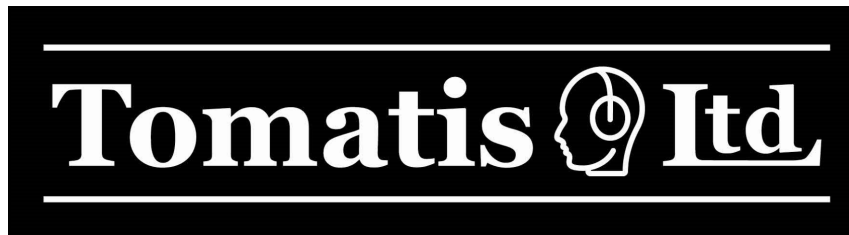
IN THE MATTER OF

TRADE MARK APPLICATION No. 3583545

BY

TOMATIS LTD

TO REGISTER THE TRADE MARK:



IN CLASS 10

-AND-

THE OPPOSITION THERETO UNDER No. 424373

BY

TOMATIS DEVELOPPEMENT S.A.

Background and pleadings

1. Tomatis Ltd (“**the Applicant**”) applied to register the following trade mark in the UK on 23 January 2021:



2. It was accepted and published in the Trade Marks Journal on 19 March 2021. The goods for which registration is sought are a variety of goods in Class 10, including various auditory devices, apparatus and instruments; a variety of therapeutic apparatus; apparatus for acupuncture, massage, stimulation and toning; various physiotherapeutic apparatus, electromagnetic and ultrasonic devices and different kinds of medical testing and diagnostic equipment. The applied-for goods are laid out at paragraph 58 of this decision.

3. On 10 May 2021, TOMATIS DEVELOPPEMENT S.A. (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is directed at all the goods applied for.

4. The opposition is based on the Opponent’s comparable trade mark (IR),¹ which is a word only mark. Details of the Opponent’s trade mark are shown below:

Representation of the mark:	TOMATIS
Comparable registration number:	UK00800891321
International Registration No:	891321
Designation (filing) date:	6 April 2006
Priority date:	9 February 2006 ²
Date protection conferred:	17 March 2008

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all international trade mark registrations designating the EU which were protected before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (IR)’ retains the same designation date, priority / seniority dates (if applicable) and date of protection as the corresponding international (EU) mark from which it derives; and the registration date corresponds with the date of the international registration.

² Priority is claimed from Benelux trade mark registration number 1103675.

5. The Opponent's mark is registered in respect of goods and services in Classes 9, 41 and 44. However, for the purposes of the opposition, the Opponent relies solely on its Class 9 and 44 goods and services which are set out below:³

Class 9

Scientific and recording apparatus and instruments, apparatus for recording, transmitting and reproducing sound; digital, optical discs.

Class 44

Medical and psychotherapy services such as medical care and medical analyses in connection with hearing or psychological problems.

6. By virtue of its priority date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act.

7. The Opponent argues that the marks are similar and that the respective goods and services are similar, giving rise to a likelihood of confusion. As the earlier mark had been registered for more than five years at the filing date of the contested mark, it is subject to the use conditions pursuant to Section 6A and Schedule 2B paragraph 7 of the Act. Accordingly, the Opponent made a statement that it has used its mark in relation to all of the goods and services relied on.

8. The Applicant filed a defence and counterstatement denying the claims made and requested that the Opponent provides proof of use of the earlier mark in relation to some of the Opponent's goods and services, namely "*optical disc; medical services; medical care*".⁴

9. Neither party filed submissions during the evidence rounds and only the Opponent filed admissible evidence in these proceedings. The Opponent's evidence goes to 'proof of use'. No hearing was requested, and neither party elected to file written

³ I note that the EU designation from which the comparable trade mark (IR) derives was subject to a partially successful invalidation in 2017, and as a consequence, the following terms were removed from the Class 9 specification: "*magnetic recording media, sound recording*". Therefore, whilst the Opponent's form TM7 Notice of Opposition states that the Opponent relies on, inter alia, "*magnetic recording media, sound recording*", by virtue of the invalidation, its trade mark is no longer protected in respect of those goods in the UK, I therefore do not include those terms in the list of Class 9 goods.

⁴ The Applicant had additionally requested that the Opponent prove use in relation to (1) "*magnetic recording media*", however, for reasons already outlined in my footnote number 3, the Opponent's mark is not protected in relation to those goods; and (2) "*entertainment and cultural activities and services*" – this is a term that falls under the Opponent's Class 41 specification, which the Opponent is not relying on in these proceedings, therefore there is no requirement for the Opponent to prove use of the earlier mark in relation to those services.

submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers admitted into proceedings.

10. The Opponent is represented by OFFICE FREYLINGER S.A.. The Applicant has no professional legal representation.

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

Preliminary Issues

Applicant's request for 'proof of use'

12. The Registry's Form TM8 'Notice of defence and counterstatement', section 7, relates to a request for 'proof of use'. It makes it clear to an applicant for trade mark registration that if the person opposing the applied-for trade mark under section 5(2) of the Act has provided a statement of use, then the applicant can request that the opponent provide evidence to show that they are using their trade mark. The form also provides that if the applicant does not *"request 'proof of use', the opponent's statement of use will be accepted with the consequence that the earlier mark(s) may be relied upon for all the goods/services identified in the statement of use."*

13. In the event that the applicant requests proof of use, the Form TM8 requires the applicant to *"list goods/services for which [they] require 'proof of use'."*

14. As I have already detailed above, the Applicant requires the Opponent to provide proof of use only in relation to some of the goods and services relied on; as such, the Opponent is only required to prove use in relation to those goods and services. Consequently, the Opponent may rely on the other goods and services contained in its Classes 9 and 44 without having to show any use at all. For ease of reference I have indicated in emboldened font, those goods and services for which the Applicant requires proof of use:

Class 9

*Scientific and recording apparatus and instruments, apparatus for recording, transmitting and reproducing sound; digital, **optical discs**.*

Class 44

***Medical** and psychotherapy **services** such as **medical care** and medical analyses in connection with hearing or psychological problems.*

15. With regard to the Class 44 services, I note that, given the absence of any punctuation in the specification, it could be interpreted as either “*medical and psychotherapy services in connection with hearing or psychological problems (those services including medical care and medical analyses)*” or “*medical and psychotherapy services, including but not restricted to medical care and medical analyses in connection with hearing or psychological problems*”. Based on the evidence I will discuss later, I am adopting the first of these.

16. In other words, the Opponent is required to prove use in relation to: “*medical services such as medical care and medical analyses in connection with hearing or psychological problems*”.

17. For the sake of clarity, the Opponent:

(1) is required to prove use in relation to the following goods and services:

Class 9: *optical discs*

Class 44: *medical services such as medical care and medical analyses in connection with hearing or psychological problems*

(2) can rely on the following goods and services without having to prove use:

Class 9: *Scientific and recording apparatus and instruments, apparatus for recording, transmitting and reproducing sound; digital discs.*

Class 44: *Psychotherapy services in connection with hearing or psychological problems.*

I shall therefore proceed with my decision on this basis.

Opponent's evidence

18. The Opponent filed evidence which the Opponent's witness refers to as evidence relating to use in relation to its Class 41 services (which include, inter alia, education and training).⁵ Since the Opponent is not relying on its Class 41 services, I shall not assess whether that evidence proves genuine use or not in relation to those services as they do not form the basis of the opposition.

PROOF OF USE

Legislation and case law

19. The relevant provisions of the Act are as follows:

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.

⁵ See paragraph 10 of the witness statement.

- (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.

[...]

- (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.

Schedule 2B paragraph 7

- (1) Section 6A applies where an earlier trade mark is a comparable trade mark (IR), 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 (IR); 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 (IR); and
 - (b) the references in section 6A to the United Kingdom include the European Union.

Section 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.

20. The law relating to genuine use of a registered trade mark was summarised by Arnold J (as he then was), in *Walton International Ltd & Anor v Verweij Fashion BV*.⁶ This summary includes, inter alia, that genuine use means actual use of the trade mark by the proprietor or a third party (with the authority to use the mark) and that such use must be by way of real commercial exploitation of the mark on the market, for the relevant goods or services, sufficient to create or maintain a market share for those goods or services.⁷ The use must be more than merely token although there is no *de minimis* rule in relation to genuine use, and it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use. The use must be consistent with the essential function of a trade mark which includes for example, affixing the mark to the relevant goods in order to guarantee to the consumer that the goods come from a single undertaking which controls the manufacture of those goods, and which is responsible for their quality.

21. In determining whether there is real commercial exploitation of the mark, all the relevant facts and circumstances must be taken into account, which include: (1) 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; (2) the nature of the goods or services; (3) the characteristics of the market concerned; (4) the scale and frequency of use of the mark; (5) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (6) the evidence that the proprietor is able to provide; and (7) the territorial extent of the use.

22. The onus is on the Opponent to file evidence of use of its mark.⁸ The genuine use provision is not there to assess economic success or large-scale commercial use;⁹ rather, it is concerned with the sort of use that is appropriate in the economic sector concerned for preserving or creating a market share for the relevant goods and services.

⁶ [2018] EWHC 1608 (Ch), paragraphs 114 and 115 detail the summary in full.

⁷ 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.

⁸ Section 100 of the Act.

⁹ *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

23. In assessing the evidence, I must consider what the evidential picture as a whole shows me, not whether each piece of evidence shows use by itself;¹⁰ that said, where an earlier trade mark satisfies the use conditions in respect of only some of the goods for which it is registered, it shall be treated for the purposes of the proceedings as if it were registered only in respect of those goods.¹¹

24. Whilst there is no requirement for the Opponent to produce any specific form of evidence, in *Awareness Limited v Plymouth City Council*,¹² the Appointed Person stated that:

22. [...] 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.

[...]

28. [...] 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 [...].”

Relevant period

25. In order to rely on its Class 9 “*optical disc*” and its Class 44 “*medical services such as medical care and medical analyses in connection with hearing or psychological problems*”, the Opponent must prove that it has put its earlier mark to genuine use in

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

¹¹ Section 6A(6) of the Act. Also see the following cases with regard to framing a fair specification where use is shown in respect of some goods and services but not others: *Euro Gıda Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10 (page 10, lines 22 – 25 & page 11, lines 1 – 4); and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), paragraph 47.

¹² Case BL O/236/13, paragraph 22 and 28.

relation to those goods and services, during the five year period immediately preceding the filing date of the opposed application.¹³ In these proceedings, the relevant ‘proof of use’ period is therefore 24 January 2016 to 23 January 2021.

26. Given that the earlier mark is a comparable mark (IR) and that part of the relevant five year period for genuine use falls before IP Completion Day, the Opponent may rely on evidence of use in the EU (including the UK) dated between 24 January 2016 to 31 December 2020; and from 1 January 2021 to 23 January 2021 on evidence relating solely to use in the UK.¹⁴ I note that use in the territory of a single member state of the EU might satisfy the use conditions for genuine use.¹⁵

Evidence

27. The Opponent’s evidence is provided in the witness statement of Thierry Gaujarengues, dated 20 June 2022. Mr Gaujarengues is the chief executive officer of TOMATIS DEVELOPMENT S.A.. Attached to the witness statement are seven exhibits, labelled Annex 1 to Annex 7.

28. I note that the Opponent filed a large amount of evidence which I do not propose to exhaustively summarise in my decision. Suffice as to say that I have fully taken into account all of the pertinent evidence (which falls within the relevant period) in determining whether genuine use of the earlier mark has been shown in relation to the relevant goods and services and I have set out details of some salient parts of the evidence in the following paragraphs.

Background

29. Mr Gaujarengues provides details about the Opponent’s background stating that the “company” was founded by “an ear, nose and throat doctor who pioneered the fields of sound therapy and auditory stimulation” – that doctor being ‘Alfred Tomatis’. Mr Gaujarengues continues as follows: “Indeed, the [Opponent] has developed a method under the TOMATIS Trademark which is a listening training that can help people overcome learning and language difficulties, developmental and attention deficit disorders, emotional disorders, burnout and stress. The goal of the “Tomatis

¹³ Section 6A of the Act, subject to the modifications set out in Schedule 2B paragraph 7 of the Act.

¹⁴ See Tribunal Practice Notice 2/2020, paragraph 4.

¹⁵ *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraphs 36, 50 and 55.

Method” is to transform the way that people perceive sounds. By using a dedicated device [...] it is possible to modify the auditory faculties. This is achieved by modifying the listening skills to obtain a transformation of language and of various psychological and mental faculties.”

30. The following information is contained in the evidence: “ [Dr Tomatis] *made a distinction between hearing and listening [...] Hearing, as a function of the ear, is the passive reception of sound, whereas listening as a function of the brain, is the active participation in what one hears. Someone may have good listening but may be a poor listener. [...] Dysfunctional listening can result from a [number of factors]. Whenever this dysfunction occurs, the brain orders the ear to function less efficiently [...]. TalksUp is designed to help [...] in many areas [...]. Adults and children with ADHD, dyslexia, autism, developmental delays [etc.] have achieved significant progress with TalksUp [...].*”¹⁶

31. The Opponent provides training, referred to as the ‘TalksUp Program’, to people in the following professions: Occupational Therapist, Speech Language Therapist, Physical Therapist, Medical Doctor, Special Education Teacher, Psychologist and Clinical Social Worker and communication and language professionals.¹⁷ The ‘TalksUp Program’ is “*a sound-based neuro sensory educational program founded on the TOMATIS® Method implemented in the portable TALKSUP® device (“the Device”) exclusively manufactured by [TOMATIS DEVELOPPEMENT S.A.]*”.¹⁸ The ‘TalksUp’ device is described in the evidence as a portable digital player with a touch screen that processes music and voice “*with all the Tomatis parameters*”.¹⁹

32. The participants of the ‘TalksUp Program’ training must hold existing degree level qualifications in their relevant field of expertise (obtained independently of any training provided by the Opponent) in order to qualify for the Opponent’s training; participants of the training must also purchase a ‘TalksUp Package’ and sign a licence agreement.

¹⁶ See the ‘TalksUp’ training brochures contained in Annex 4.

¹⁷ See the Opponent’s training course brochures, Annex 4 of the evidence.

¹⁸ See the Opponent’s licence agreement contained in Annex 2 of the evidence, in particular clause 2.10 of the licence agreement.

¹⁹ The ‘TalksUp device’ is described in Annex 3, page 51 of the evidence. Images of the device are provided throughout the Annex 3 – it is possible to see the wording ‘By Tomatis’ at the bottom of device’s screen.

Information about the Opponent's products

33. The 'TalksUp Package' includes,²⁰ inter alia, the 'TalksUp device'; headphones with air and bone conduction technology that transmit sound;²¹ copyrighted music processed with the 'Tomatis effect'.²² Below is an excerpt from one of the Opponent's invoices which details the contents of the 'TalksUp Package':²³

DESIGNATION	QTY	U.P	DISC.	TOTAL	VAT%	VAT €
Package Including: TALKSUP® device Level 1	1	1 990,00		1 990,00	17 %	338,30
TALKSUP® (device)	1					
180105-02862						
Wired headphone without balance						
Unassembled Yoga headphone						
Vibrator						
Case for 1 Talksup pack						
USB 5V/2A charger for TALKSUP®						
USB cable included						
USB cable for TALKSUP 1.8m (logilink)						
Small rigid case for Talksup						
Silicone cover for Talksup						
Pre-recorded music references						
USB KEY 4GB						
Headband						
Micro SD Card 32GB (SanDisk)						
2-year licence fees (brand,model design&software)						
One year warranty						
*** This device works with Windows PC only ***						
Special price for the purchase during the training						
Delivery during the training						
Full payment before the delivery by wire transfer to : TOMATIS DÉVELOPPEMENT S.A.						
				PRICE VAT		1 990,00 €

34. The Opponent's evidence contains product catalogues which state:²⁴ "[this] presents the full list of devices and accessories used in the TOMATIS® Method. We put in all our energy and passion into designing innovative, reliable devices adapted to your practice. They are of course perfectly faithful to the parameters of the TOMATIS® Method and help you to work efficiently with your clients".²⁵ Below is a

²⁰ See Annex 4 of the evidence.

²¹ Annex 3, page 46.

²² Images contained in the evidence of the 'TalksUp Package', the 'TalksUp Device' and the headphones show 'Tomatis' affixed to them. See for example Annex 3, pages 45 and 55.

²³ Annex 1, page 11.

²⁴ See Annex 3.

²⁵ Annex 3, page 44.

representative example of a contents page listing the products contained in the catalogues:²⁶

The Tomatis Développement S.A. team

1. TalksUp®: THE NEW PORTABLE AND UPGRADABLE ELECTRONIC EAR	4
2. HEADPHONES AND ACCESSORIES	6
> Wired headphones	6
<i>Wired headphones: adult</i>	6
<i>Wired headphones: child</i>	6
<i>Lateralized wired headphones with microphone: adult</i>	7
<i>Lateralized wired headphones: child</i>	7
<i>Spare cable for Wired headphones</i>	7
> Wireless headphones	7
<i>Wireless headphones</i>	7
<i>Lateralized wireless headphones</i>	7
<i>Pack of six wireless headphones</i>	8
> Accessories	8
<i>Recorder for mother's voice</i>	8
<i>Active group pack</i>	8
<i>Headphones tester</i>	8
<i>Headbands</i>	8
3. TOMATIS® LISTENING TEST SYSTEM - TLTS	9
4. FORBRAIN	10

The Tomatis® Method is a pedagogy and cannot be considered as a medical device or a means of medical diagnosis. The content in this catalog is for information purposes only, it cannot be considered as medical advice and in no way replaces it.

35. The ‘Recorder for mother’s voice’ is a voice recording device. The ‘Active group pack’ consists of headphones, a connection box for headphones, a microphone and a microphone amplifier.

36. The ‘TLTS’ device is described as a high-precision measurement device, the purpose of which is to conduct a listening test to evaluate an individual’s auditory thresholds in terms of frequency. Contained in the evidence is the following information about the Opponent’s TLTS device: “*although originally derived from audiometry,*

²⁶ Annex 3, page 44 – I note that ‘FORBRAIN’ is the name used by the Opponent for a range of ‘bone-conduction headphones’.

TLTS is totally different from the latter. Its purpose being to determine how the individual communicates with others and with him or herself."²⁷

37. The bottom of the catalogue contents page sets out the following information:

"The Tomatis® Method is a pedagogy and cannot be considered as a medical device or a means of medical diagnosis. The content in this catalogue is for information purposes only. It cannot be considered as medical advice and in no way replaces it."

and another version of the catalogue contains the following information:²⁸

"The Tomatis® Method is an Educational Program and it is considered neither a medical treatment nor a means to establish a medical diagnosis."

38. Evidence in relation to a range of headphones called 'TOMATIS INFINITE' is also provided.²⁹ The 'Tomatis Infinite' evidence explains the *"difference between Tomatis® headphones and ordinary headphones"* as follows:³⁰ *"There are many technical differences since Tomatis® Infinite is specially designed for the Tomatis® Method (bone conduction, voice feedback, dynamic filter, laterality etc.). Ordinary headphones cannot be used to follow a Tomatis® journey. Likewise, the Tomatis® Infinite headphones are not suitable for listening to your regular music or any other stimulation program"*.

The Opponent's licence agreement and 'Tomatis' practitioners

39. The Opponent's licence agreement grants practitioners a non-exclusive licence to use the Opponent's 'Licensed Assets' which includes the Opponent's 'TalksUp Device' and the Opponent's trade marks.³¹ The licence agreement stipulates that the training courses provided by the Opponent are pedagogical and that the 'Tomatis Method' is a pedagogical technique designed to complement the principal activity of the licensee.³²

²⁷ Annex 4, page 74.

²⁸ See Annex 3, page 56.

²⁹ See the 'TOMATIS INFINITE USER GUIDE FOR TOMATIS PROFESSIONALS, 2020' contained in Annex 3.

³⁰ Annex 6, page 155.

³¹ Annex 2 of the evidence contains copies of the licence agreement. See Clauses 2.4 and 3 in relation to the non-exclusive licence to use the Opponent's trade marks.

³² See Clause 4.1 of the licence agreement at Annex 2 of the evidence.

40. It also contains a disclaimer and indemnification by the Opponent that the ‘Tomatis Method’ and the ‘TalksUp Program’ are not treatments for any know disease or condition, nor a means of formulating a diagnosis for any medical or psychological disorder; that the ‘TalksUp Program’ is to be used as an audio program for listening education; and that the licensees are solely responsible for their use of the ‘TalksUp device’ and their administration of the ‘Licensed Assets’.³³

41. Included in the website evidence is a screenshot of the Opponent’s website, ‘www.tomatis.com’, which has a map pinpointing a large number of locations in the UK and the EU, of ‘TOMATIS’ ‘practitioners’ and ‘consultants’. Directly below the image of the map is the following information:³⁴

“Only professionals listed on this website have been trained by TOMATIS DEVELOPMENT S.A. and are qualified as well as certified to use the Tomatis® Method. They joined its licensing program and accepted its code of ethics. They are equipped with high quality equipment and have been trained on how to use it. The Tomatis® Method is a complementary approach to educational, therapeutic or medical occupations. It is the customer’s responsibility to make sure that the professional they choose has a profile that matches his/her specific needs. TOMATIS DEVELOPMENT S.A. is in no way responsible for the relationship between a client and the professional that has been contacted”.

Turnover

42. Mr Gaujarengues provides the Opponent’s total turnover for France, Germany, Greece and the UK during the relevant period as follows:

A PAYS	B EUR HT	C EUR HT	D EUR HT	E EUR HT	F EUR HT	G EUR HT
	2021	2020	2019	2018	2017	2016
Total France	120 145.33 €	74 811.00	130 073.57	120 274.72	121 487.27 €	144 386.14 €
Total Germany	134 092.11 €	88 571.00	59 333.06	73 792.56	51 727.94 €	61 566.60 €
Total Greece	61 670.37 €	30 245.00	31 579.00	30 628.06	20 192.29 €	58 058.21 €
Total UK	107 216.98 €	54 165.00	31 062.57	24 071.06	20 695.92 €	41 028.00 €

³³ See Clause 15 of the licence agreement.

³⁴ Annex 6, page 147.

43. The Opponent filed a selection of invoices issued to customers based in the UK, Spain, Germany, Poland, France, Sweden, Austria and the Netherlands. The invoices exclusively relate to the provision of the following:

- Licence fees
- 'TalksUp' training
- Headphones
- 'TalksUp' package

The Opponent's services

44. Mr Gaujarengues states *"regarding services in Class 44 [...], the [Opponent] is well-known for being a company specialised in Auditory Processing issues. As I can see from Annex 4, the earlier trade mark covers, obviously, medical care and medical analyses because the goods help people's auditory processing abilities. [...] It follows from these documents that these services were and still provided under the earlier trade mark."*³⁵ I note that Annex 4 contains the training brochures aimed at professionals. The following information is included in this evidence:³⁶

"Boost your results

The Tomatis® Program improves motor, emotional and cognitive abilities through music and language. It is a natural treatment that operates as a booster to complement your practice.

[...]

The Tomatis® Equipment changes music and voice in real time in order to capture the brain's attention. Through its action on the entire auditory system and the brain, the Tomatis® Method is the most advanced auditory stimulation program available."

Conclusions on the evidence

45. Having reviewed and considered all the evidence in relation to the Opponent's products and product packages, I conclude that I have found no evidence to support any use of the earlier trade mark in relation to Class 9 *"optical discs"*. On this basis, a

³⁵ Paragraph 11 of the witness statement.

³⁶ Annex 4, page 88.

fair Class 9 specification is: *“Scientific and recording apparatus and instruments, apparatus for recording, transmitting and reproducing sound; digital discs; none of the aforesaid being optical discs”*.

46. Notwithstanding the Opponent’s broad statements purporting to verify use in relation to its Class 44 services, the evidence does not support genuine use of the earlier mark in relation *“medical services such as medical care and medical analyses in connection with hearing or psychological problems”*.

47. Indeed, the evidential picture as a whole informs me that the Opponent provides education and training programs in a pedagogical technique and there is no evidence demonstrating that the Opponent provides *“medical services such as medical care and medical analyses in connection with hearing or psychological problems”* to patients / clients, nor does the invoice evidence demonstrate the provision of such services. On the contrary, the evidence makes it clear that it is the practitioners who have undergone the Opponent’s training programs, that offer the ‘Tomatis’ pedagogical technique as a service to patients / clients. Whilst I appreciate that the practitioners are duly authorised to use the Opponent’s trade marks in accordance with the licence agreement, the evidence in any event clearly stipulates that the ‘Tomatis Method’ is not a medical treatment.³⁷

48. As the Opponent has not shown genuine use in relation to the Class 44 services for which it was required to prove use, the Opponent may only rely on the remainder of its Class 44 services.

49. Consequently, the Opponent may rely on the following goods and services, and I shall proceed with my decision on this basis:

Class 9: *Scientific and recording apparatus and instruments, apparatus for recording, transmitting and reproducing sound; digital discs; none of the aforesaid being optical discs.*

Class 44: *Psychotherapy services in connection with hearing or psychological problems.*

³⁷ See my paragraphs 37, 39 and 40.

DECISION

Legislation and Case Law

50. Section 5(2)(b) and 5A of the Act are 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”.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

52. I note from the outset that the task before me under section 5(2)(b) of the Act is to compare the trade mark application with the Opponent's earlier right and decide whether sufficient similarity exists between the marks and the goods and services at hand, such that the average consumer of the goods and services would be confused as to their trade origin.

Comparison of goods and services

53. Section 60A of the Act provides:

- “(1) For the purpose of this Act goods and services-
- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification
 - (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

54. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

55. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia: the physical nature of the goods and services; their intended purpose; their method of use / uses; who the users of the goods and services are; the trade channels through which the goods and services reach the market; in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors); or whether they are complementary to each other.³⁸

³⁸ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

56. 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

57. When interpreting the terms in a specification I bear in mind:

- (1) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”,* although *“where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”*,⁴⁰
- (2) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”*,⁴¹
- (3) the following applicable principles of interpretation:
 - “(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*
 - (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*
 - (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*
 - (4) A term which cannot be interpreted is to be disregarded.”*⁴²

³⁹ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82. Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity – see *Kurt Hesse v OHIM*, Case C-50/15 P.

⁴⁰ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

⁴¹ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

⁴² See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

58. The competing goods and services are set out below:

Opponent's goods and services
<p><u>Class 9:</u></p> <p>Scientific and recording apparatus and instruments, apparatus for recording, transmitting and reproducing sound; digital discs; none of the aforesaid being optical discs.</p> <p><u>Class 44:</u></p> <p>Psychotherapy services in connection with hearing or psychological problems.</p>
Applicant's goods
<p><u>Class 10</u></p> <p>Acoustic amplifiers for partially deaf persons; Acoustic amplifiers [hearing aids] for partially deaf persons; Acupressure apparatus; Acupressure bands; Acupressure mats; Analog hearing aids; Apparatus for acupressure therapy; Apparatus for analysing brain wave frequencies; Apparatus for analysing measured physical signals; Apparatus for carrying-out diagnostic tests for medical purposes; Apparatus for electrical muscle stimulation; Apparatus for medical rehabilitation; Apparatus for nerve stimulation; Apparatus for physical training for medical use; Apparatus for physiotherapeutic treatment; Apparatus for the stimulation of acupuncture points; Apparatus for the therapeutic stimulation of the body; Apparatus for the therapeutic stimulation of the muscles; Apparatus for the therapeutic toning of the body; Apparatus for the therapeutic toning of the muscles; Apparatus for use in treating hearing disorders; Appliances for massaging feet; Audiometers; Bed vibrators; Body massagers; Body toner apparatus [therapeutic]; Diagnostic, examination, and monitoring equipment; Digital hearing aids; Electromagnetic medical apparatus; Electromagnetic wave therapeutic instruments; Electronic hearing aids; Foot massage apparatus; Hearing aids; Hearing aids for the deaf; Hearing apparatus for the deaf; Hearing protection devices; Hearing protectors; Hearing protectors without the ability to reproduce or transmit sound; Massage appliances; Massage balls; Massage mitts; Massaging apparatus for personal use; Medical hearing instruments; Medical therapy instruments; Non-electric acupuncture instruments; Non-electric massage apparatus; Physical therapy devices; Physical therapy equipment; Sound excluding instruments for medical use; Speech aid [therapy] apparatus; Speech therapy apparatus; Test equipment for medical use; Testing apparatus for medical purposes; Therapeutic and assistive devices adapted for the disabled; Therapeutic apparatus for children with autism; Therapeutic apparatus incorporating massaging facilities; Therapeutic devices adapted for persons with disabilities; Therapeutic weighted blankets; Ultrasonic medical diagnostic apparatus; Ultrasonic therapy apparatus; Ultrasound therapy apparatus; Vibration generating apparatus for massage; Vibromassage apparatus; Vibromassage devices.</p>

59. Before I proceed with the comparison, I pause here to reiterate that I am required to consider what the terms specified in the Opponent's registration, based on their ordinary and natural meaning, are **apt to protect**, which does not involve straining the language of the Opponent's goods and services unnaturally and it does not involve a liberal interpretation of those terms so that that their limits become fuzzy and imprecise.

60. I shall firstly approach the comparison between the Opponent's Class 9 goods and the applied-for goods; and then if necessary, I shall compare the applied-for goods with the Opponent's Class 44 services. For the purposes of making the comparison, I have grouped the goods together where the same reasoning applies.⁴³

Auditory devices, apparatus and instruments

61. The Applicant's specification contains the following goods:

“Acoustic amplifiers for partially deaf persons; Acoustic amplifiers [hearing aids] for partially deaf persons; Analog hearing aids; Digital hearing aids; Electronic hearing aids; Hearing aids; Hearing aids for the deaf; Hearing apparatus for the deaf; Medical hearing instruments; Apparatus for use in treating hearing disorders.”

62. The Applicant's goods are medical apparatus, instruments and articles which are used to improve and/or treat a patient's medical condition i.e. deafness / hearing loss. Whilst I recognise that these goods are auditory devices, I do not consider them to be encompassed by the Opponent's Class 9 goods. This is because the Opponent's goods, within their ordinary meaning, include apparatus and instruments for scientific or research purposes (e.g. for scientific research in laboratories) as well as audio equipment (e.g. headphones, speakers, microphones etc.), and I see no justification for straining the language of the Opponent's goods unnaturally to extend it to anything other than what those terms are apt to protect.

63. The Opponent's goods differ from the Applicant's goods in purpose, nature and method of use. The respective goods would also not be in competition with each other and I also do not consider them to be complementary, or at most, any degree of

⁴³ See *Separode Trade Mark* BL O/399/10, paragraph 5, with regard to grouping goods and services together.

complementarity would be insufficiently pronounced for a finding of similarity. These goods are **dissimilar**.

Therapeutic apparatus for children with autism

64. The term “*therapeutic apparatus for children with autism*” in the Applicant’s specification is a broad term. The Opponent’s evidence has demonstrated that its headphones are apparatus capable of transmitting sound and are used by practitioners for adults and children with autism. Albeit ‘headphones’ are proper to Class 9 goods, and are encompassed in the Opponent’s Class 9 registration, because of the broad nature of the Applicant’s term, I consider that it could encompass headphones such as the Opponent’s, and therefore there is a degree of similarity between the respective terms. This is because they overlap in nature and purpose and may also have the same method of use and user. They may also be in competition with each other as the consumer may select apparatus for the provision of listening-based therapies over another kind of therapeutic apparatus for children with autism. These goods are **similar to a low degree**.

Audiometer

65. The Applicant’s specification contains the term “*audiometer*”. An audiometer, within the ordinary meaning of the term, is an instrument used to test and measure hearing, by reproducing sounds of different frequencies and intensity. In other words, they are devices used to measure auditory acuity. In this regard, whilst I recognise the Opponent’s evidence states that its ‘TLTS’ device “*originally derived from audiometry [however, it] is totally different from [audiometry]*”, it is clear from the evidence that the ‘TLTS’ device is a scientific testing device, within the meaning of Class 9, capable of reproducing and/or transmitting sound (as well as recording sound), and that it nonetheless is capable of evaluating “*an individual’s auditory thresholds in terms of frequency*”.

66. On this basis, the Applicant’s “*audiometer*” is similar to the Opponent’s Class 9 goods, this is because they overlap in nature and purpose, and overlap in their method of use. They may also share the same trade channels as well as the same user. In addition, there may also be a degree of competition between them as a consumer may select one instead of the other. The goods are similar to a **low to medium degree**.

Remaining Class 10 goods

67. The Opponent's goods, within their ordinary and natural meaning, relate to 'sound' i.e. they are scientific apparatus and instruments for the recording, transmission and reproduction of sound. With this in mind, I do not consider there to be any similarity between the Opponent's goods and the remainder of the Applicant's Class 10 goods, namely (the headings are for ease of reference):

(1) Acupressure apparatus

"Acupressure apparatus; Acupressure bands; Acupressure mats; Apparatus for acupressure therapy; Non-electric acupuncture instruments."

(2) Massaging apparatus

"Appliances for massaging feet; Bed vibrators; Body massagers; Foot massage apparatus; Massage appliances; Massage balls; Massage mitts; Massaging apparatus for personal use; Non-electric massage apparatus; Therapeutic apparatus incorporating massaging facilities; Vibration generating apparatus for massage; Vibromassage apparatus; Vibromassage devices."

(3) Stimulation and toning apparatus

"Apparatus for electrical muscle stimulation; Apparatus for nerve stimulation; Apparatus for the stimulation of acupuncture points; Apparatus for the therapeutic stimulation of the body; Apparatus for the therapeutic stimulation of the muscles; Apparatus for the therapeutic toning of the body; Apparatus for the therapeutic toning of the muscles; Body toner apparatus [therapeutic]."

(4) Physiotherapeutic apparatus

"Apparatus for physical training for medical use; Apparatus for physiotherapeutic treatment; Physical therapy devices; Physical therapy equipment."

(5) Electromagnetic and ultrasonic devices

“Electromagnetic medical apparatus; Electromagnetic wave therapeutic instruments; Ultrasonic medical diagnostic apparatus; Ultrasonic therapy apparatus; Ultrasound therapy apparatus.”

(6) Equipment for medical testing / diagnosis / monitoring / examination / analysis

“Apparatus for analysing brain wave frequencies; Apparatus for analysing measured physical signals; Apparatus for carrying-out diagnostic tests for medical purposes; Diagnostic, examination, and monitoring equipment; Test equipment for medical use; Testing apparatus for medical purposes.”

(7) Miscellaneous therapeutic apparatus and devices

“Speech aid [therapy] apparatus; Speech therapy apparatus; Therapeutic and assistive devices adapted for the disabled; Therapeutic devices adapted for persons with disabilities; Therapeutic weighted blankets.”

(8) Hearing protection devices

“Hearing protection devices; Hearing protectors; Hearing protectors without the ability to reproduce or transmit sound; Sound excluding instruments for medical use.”

I note that these goods are hearing protectors and they exclude sound, as opposed to recording, transmitting or reproducing it.

68. The Opponent’s goods, within their ordinary meaning, differ from the above goods in purpose, nature and method of use. The respective goods would also not be in competition with each other. I also do not consider there to be any proper basis for the finding of similarity based on complementarity, this is because the respective goods are not indispensable or important for the use of the other, or at most, any degree of complementarity would be insufficiently pronounced for a finding of similarity.⁴⁴ These goods are therefore **dissimilar**.

⁴⁴ I note that there is no rule that ‘complementarity’ always and necessarily equals ‘similarity’. See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, paragraph 22, in which the Appointed Person quoted: *Assembled*

Class 44

69. I now turn to the Opponent's Class 44 services, namely "*psychotherapy services in connection with hearing or psychological problems*". The term 'psychotherapy', within its ordinary meaning, is the name of a branch of medicine that is concerned with mental illnesses. It can often be referred to as 'talk therapy' i.e. where a patient meets with a mental health professional such as a psychiatrist, to talk about issues affecting them. With this in mind, I do not consider these services put the Opponent in a better position than the comparison solely based on its Class 9 goods.

Conclusions on the goods comparison

70. I have found that save for two terms, the applied-for goods are dissimilar to the Opponent's goods. Since some similarity between the goods is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the dissimilar goods identified above.⁴⁵ I therefore proceed to consider a likelihood of confusion only in relation to the goods that I have found to be similar, namely:

"Therapeutic apparatus for children with autism; audiometer."

The average consumer and the nature of the purchasing act

71. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word 'average' merely denotes that the person is typical,⁴⁶ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.⁴⁷ It is therefore necessary to determine who the average consumer of the goods is, and how the consumer is likely to select those goods.

Investments (Proprietary) Ltd v. OHIM, T105/05, paragraphs 30 to 35 (which was upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*, C-398/07P, paragraphs 34, 35).

⁴⁵ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

⁴⁶ *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), paragraph 60

⁴⁷ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

72. The average consumer of scientific apparatus and instruments and the average consumer of the Applicant's goods still in play, are likely to be professionals. Whilst I recognise that the ultimate end user of some of the devices may be clients / patients, the consumer actually selecting the goods would be a professional who is selecting them for their patients or to use in the treatment of their clients / patients.

73. In selecting the goods, the average consumer will take various factors into account such as cost, whether the goods meet certain criteria and needs and/or perform specific functions. Consequently the level of attention paid during the selection process will be high.

74. The goods are likely to be selected visually, through catalogues, websites etc., but oral recommendations and orders may also play some part in the process. Therefore the way the respective marks look is of primary importance, as the average consumer is most likely to encounter the trade marks on the goods themselves or on their packaging, but the way they sound must also be taken into account.

Comparison of marks

75. It is clear from *Sabel BV v. Puma AG*,⁴⁸ 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 Court of Justice of the European Union ('CJEU') stated in *Bimbo SA v OHIM*,⁴⁹ 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."

⁴⁸ Case C-251/95, paragraph 23.

⁴⁹ Case C-591/12P, paragraph 34.

76. It would be wrong, therefore, to dissect the trade marks artificially, 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.

77. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
TOMATIS	

Overall impression

78. The earlier trade mark is a word-only mark for the word 'TOMATIS'. The overall impression therefore lies in that word.

79. The contested mark is a black and white figurative mark made up of verbal and non-verbal elements. The verbal component consists of the words 'Tomatis Ltd'. The letter 'L' in 'Ltd' extends below the adjacent letters 'td'; apart from this small stylistic flurry, the typeface is quite plain and the stylisation of the words nonetheless plays a lesser role in the overall impression of the mark.

80. 'Ltd' is a commonly understood abbreviation for the word 'Limited' and is a reference to the legal status of a company. It is not an uncommon practice throughout a range of industries for businesses to use their full company name in their branding. I find that 'Ltd' is not distinctive in relation to the Applicant's goods and accordingly has limited relative weight in the overall impression of the mark. Indeed, there is a real possibility that the average consumer of the goods may fail to perceive 'Ltd' as an intentional part of the brand name; therefore it would be accorded less attention than the word 'Tomatis'.

81. The figurative element consists of a profile silhouette of a head wearing headphones. The wording and the device element are contained between two horizontal lines. Despite the contested mark being made up of several components, the word 'Tomatis' is the most prominent element as it forms the longest part of the mark and it appears at the beginning (generally, although just as a rule of thumb, the beginnings of words tend to have more visual and aural impact than the ends⁵⁰). I find that the head device element is in any event less distinctive than the word 'Tomatis'.

82. Taking all the foregoing into account, it is my opinion that the average consumer, whilst perceiving the contested mark as a whole, will also perceive that it consists of several components, and that it is the word 'Tomatis' that has an independent distinctive role in the contested mark,⁵¹ and that the overall impression of the mark is dominated by that word – the other elements having limited weight relative to the word 'Tomatis'.

Visual comparison

83. I note that a word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. The protection of a word mark is not limited by any features such as capitalisation or the typeface which appears on the Register,⁵² as such those features do not provide a point of distinction when comparing a word-only mark with a figurative mark, where the figurative mark comprises of words in a stylised font.⁵³

84. The marks visually coincide in the word 'TOMATIS', which is wholly reproduced in the contested mark.

85. Given my earlier comments regarding the overall impression of the contested mark being dominated by the word 'Tomatis', I assess the degree of visual similarity as high.

⁵⁰ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81.

⁵¹ See *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*, [2015] EWHC 1271 (Ch), paragraphs 19 – 21 with regard to the assessment of composite marks.

⁵² See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 37.

⁵³ *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

Aural comparison

86. The sequence of letters 'TOMA' in 'TOMATIS' are likely to be pronounced the same way as the same letter sequence in the ordinary word 'tomato'; and the 'TIS' portion of the word is likely to be pronounced as 'TISS'. In any event, the word will be pronounced identically in the respective marks.

87. The general conformity is to pronounce 'Ltd' as though there were full stops after each letter i.e. as 'L. T. D.', or sometimes as the full word for which it is an abbreviation i.e. 'Limited'. As this element is not present in the earlier mark, it represents a point of difference between the competing marks. That said, given my assessment of the relative weight that 'Ltd' plays in the overall impression of the contested mark, this difference is not significant. 'Ltd' is a banal, non-distinctive element and the consumer is unlikely to pronounce it when referencing the contested mark. Indeed, I consider it likely that the average consumer of the goods would merely articulate the word 'Tomatis'. As such (based on this consideration), the marks are aurally identical.

88. However, I acknowledge that whilst 'Ltd' is banal and non-distinctive, that does not render it negligible or aurally invisible.⁵⁴ Therefore, in the alternative, I do not overlook that the average consumer may also articulate the abbreviation 'Ltd'. In such circumstances the degree of aural similarity would be high.

Conceptual comparison

89. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁵⁵ Whilst I appreciate the evidence states that 'Tomatis' is a surname (and there appears to be no conceptual message beyond that) and therefore from this perspective, the marks are conceptually identical, I do not discount that the average consumer is likely to perceive it as an invented word, as opposed to a name, in which case, 'Tomatis' has no discernible concept.

⁵⁴ *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22.

⁵⁵ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

90. The device represents a point of difference between the two marks. The concept of 'Ltd' has already been set out – it too represents a point of conceptual difference since no equivalent element is present in the earlier mark.

91. That said, given my earlier comments regarding the overall impression of the contested mark, and my finding that the contested mark is dominated by the word 'Tomatis', I assess the degree of conceptual similarity as high – where the average consumer attributes the concept of a name to that word. Where the average consumer perceives it as an invented word, then there is no clear concept in respect of that word that is capable of immediate grasp, and the marks will be conceptually dissimilar owing to the presence of the device in the contested mark.

Distinctive character of the earlier mark

92. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be,⁵⁶ although it is the distinctive character of a component that is similar between the marks that is particularly relevant.⁵⁷

93. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can however be enhanced by virtue of the use that has been made of it.

94. 'TOMATIS' makes no descriptive nor allusive reference to the relevant goods and services, and although it appears that it is the name given to a pedagogic 'method' that is practised throughout the EU and the UK, it is clear from the evidence that the Opponent controls the use of its trade marks by its licensees and that 'Tomatis' remains an indication of trade origin.

95. I find that the earlier mark is inherently distinctive to a high degree.

⁵⁶ *Sabel v Puma*.

⁵⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

96. I have already attributed a high level of inherent distinctive character to the earlier mark. Therefore even if I make a finding that the evidence is sufficient to show enhanced distinctiveness, it could only ever serve to reinforce that high level of inherent distinctive character in any event.

97. As a matter of completeness, I will nonetheless assess whether the evidence would sufficiently show an enhancement of the distinctive character of the earlier mark. In that regard, I note that notwithstanding the Opponent is entitled to rely upon the use it has made of its mark in the EU prior to 31 December 2020, it is only use in the UK which is relevant to the question of whether that use has been enhanced.⁵⁸ This is because the assessment is made from the perspective of the UK average consumer, therefore the relevant market for assessing this is the UK market.

98. The Opponent has provided turnover figures for the UK (between 2016 and 2021). These figures show an almost doubling of turnover from 54,165 Euros in 2020 to 107,216 Euros in 2021. There is invoice evidence that supports the provision of the relevant goods to UK consumers; and a list of UK-based practitioners who are signed up to the Opponent's licensing agreement⁵⁹ – which involves the purchase of the Opponent's devices. That said, no details of advertising expenditure have been provided, nor have any details in relation to market share.

99. Whilst I appreciate the Opponent has given evidence that Dr Tomatis founded the “company”, and there is an indication that the ‘Tomatis’ name at least has long been associated with the Opponent's particular scientific field of expertise,⁶⁰ I do not find the evidence sufficient to establish any enhancement of the distinctiveness of the earlier mark in the UK market for the goods and services the Opponent may rely on.

Conclusions on Likelihood of Confusion

100. 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

⁵⁸ Tribunal Practice Notice 2/2020.

⁵⁹ See Annex 2, pages 37 – 38; and paragraph 7 of the Witness Statement of Thierry Gaujarengues.

⁶⁰ Annex 3, page 40 - the evidence demonstrates that Dr Alfred Tomatis won a gold medal award for scientific research for his ‘Electronic Ear’ device (which appears to be a first iteration of the Opponent's ‘TalksUp’ device) at the Brussels Universal Exhibition in 1958.

kept in mind.⁶¹ I must also consider the average consumer of the goods, the nature of the purchasing process and bear in mind that 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.⁶²

101. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.⁶³ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.⁶⁴

102. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.⁶⁵

103. I have found that a few of the applied-for goods are similar to the Opponent's goods to a low, or low to medium, degree; that the word 'Tomatis' has an independent distinctive role in the contested mark and that the overall impression of the contested mark is dominated by that word; that the respective marks are visually, aurally and conceptually identical with regard to the word 'Tomatis', and that they are similar overall to a high degree.

104. The distinctiveness of the earlier mark lies solely in the word 'TOMATIS' which I have found to be distinctive to a high degree on an inherent basis, and that the average consumer will be paying a high degree of attention when selecting the goods.

105. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the

⁶¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

⁶² *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

⁶³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

⁶⁴ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

⁶⁵ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

average consumer, or at least a significant proportion thereof, will mistake one mark for the other and be directly confused as to the origin of the contested goods still in play.

OUTCOME

106. The opposition under section 5(2)(b) of the Act is partially successful. Subject to any appeal, the contested trade mark application shall be refused only in relation to the following goods in Class 10, namely:

“Therapeutic apparatus for children with autism; audiometer.”

and shall proceed to registration in respect of the remainder of the applied-for goods.

COSTS

107. The Applicant has largely been successful therefore given the circumstances, the Applicant would ordinarily be entitled to an award of costs. However, as the Applicant had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs by returning a completed costs pro-forma setting out accurate estimates of the number of hours spent on a range of given activities relating to the proceedings. It was made clear by letter dated 7 June 2023, that if the pro-forma was not completed and returned, costs, other than official fees arising from the action, may not be awarded.

108. The Applicant did not file a completed costs pro-forma therefore I make no award of costs in these proceedings.

Dated this 13th day of November 2023

Daniela Ferrari

For the Registrar