

**O-184-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003286811**

**BY J.A.K MARKETING LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**AniWrap**

**IN CLASS 10**

**AND**

**OPPOSITION THERETO UNDER NO. 412486**

**BY L&R MEDICAL UK LIMITED**

## BACKGROUND AND PLEADINGS

1. On 31 January 2018, J.A.K Marketing Limited (“the applicant”) filed trade mark application number UK00003286811 for the mark **AniWrap**. The application was accepted and published for opposition purposes on 16 February 2018, in respect of the following goods:

Class 10      Bandages [supportive] for veterinary use.

2. L&R Medical UK Limited (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the UK trade mark (“UKTM”) registration 2317242, **ACTI-WRAP**, which has a filing date of 30 November 2002 and a registration date of 16 May 2003. The opponent’s UKTM is registered for various goods in class 10 but the opponent only relies upon the following goods for the purposes of this opposition:

Class 10      Support articles for surgical or medical use; bandages, cohesive bandages, support bandages.

3. By virtue of having a filing date that predates the filing date of the contested mark, the opponent’s UKTM qualifies, under section 6 of the Act, as an earlier mark for the purposes of these proceedings. As the earlier mark completed its registration procedure more than five years prior to the publication date of the applicant’s mark, it is subject to the proof of use conditions, as per section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the goods on which it relies (support articles for surgical or medical use; bandages, cohesive bandages, support bandages).

4. The opponent argues that the respective goods are identical or similar and that the marks are visually, phonetically and conceptually similar, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement denying the claims made and requesting the opponent provide proof of use of the earlier registered mark upon which it relies.

6. Both sides filed evidence; the applicant's evidence was accompanied by written submissions. Neither party requested a hearing. Only the opponent filed written submissions in lieu of a hearing. The opponent is represented by Urquhart-Dykes & Lord LLP. The applicant is represented by Andrew Jackson Solicitors.

## **EVIDENCE**

### **The opponent's evidence**

7. The opponent's evidence consists of a witness statement and seven exhibits from Pierina Anderson, the opponent's Quality and Regulatory Manager. Ms Anderson has held this position since 1998.

#### Witness statement

8. Ms Anderson's witness statement is dated 21 August 2018, the salient points from which are as follows:

9. The opponent was incorporated in 1998 under the name Activa Healthcare Limited. In 2008, the opponent was acquired by Lohmann & Rauscher and it acquired its current name in 2017.

10. The opponent is a designer and supplier of healthcare products predominantly for use in compression therapy and wound management, including: compression hosiery; compression wraps; cohesive bandages; wound dressings; and bandages.

11. The opponent has used the **ACTI-WRAP** mark continuously since 2002 in relation to cohesive retention bandages, which have been the subject of a number of journal articles dated between 2002 and 2017.

12. The annual turnover for cohesive retention bandages sold under the **ACTI-WRAP** mark has been as follows:

Year	Turnover (£)
2008	57,775
2009	47,225
2010	40,584
2011	37,996
2012	34,638
2013	33,720
2014	40,674
2015	41,000 (estimated)
2016	42,073
2017	48,820
2018 (to July)	27,713

13. The principal customer of products bearing the **ACTI-WRAP** mark is the NHS (via the NHS Supply Chain).

14. The opponent estimates that it has approximately a 23% market share in the UK for cohesive retention bandages.

#### Exhibits

15. Exhibit PA1 is a printout from the Intellectual Property Office website showing the registration of the opponent's **ACTI-WRAP** trade mark.

16. Exhibit PA2 is a copy of the Certificate of Incorporation confirming the opponent's change of company name at Companies House from Activa Healthcare Limited to L&R Medical UK Limited on 3 July 2017.

17. Exhibit PA3 contains printouts from the opponent's website showing the range of products they sell, from which 25 different products are visible. One of the products shown displays the **ACTI-WRAP** mark (as 'ActiWrap' in the description and 'acti-wrap' on the product packaging). The product is described as latex-free cohesive retention

bandage, but no price is displayed. The date on all pages of this exhibit is 30 July 2018.

18. Exhibit PA4 contains evidence of the journal articles referred to in the witness statement. The exhibit consists of three articles: British Journal of Nursing dated 2002; Nurse2Nurse dated 2003; and Practice Nursing dated 2004. Each of these articles make reference to the **ACTI-WRAP** bandage, either as 'Acti-Wrap' or 'Actiwrap'. The fourth and final piece of evidence within this exhibit is a Wounds UK poster dated 2017, which appears to advertise a passport-sized booklet for venous leg ulcer patients. There is mention of compression, but no reference is made to **ACTI-WRAP**.

19. Exhibit PA5 contains further printouts from the opponent's website showing: the specific details of the **ACTI-WRAP** bandage; the available three sizes and their respective order codes; and detailed guidance on how to use the products on various parts of the body. The date on all pages of this exhibit is 30 July 2018.

20. Exhibit PA6 shows the results of a search for 'actiwrap' on the NHS Supply Chain website on 30 July 2018. The results show three different sized bandages which are available to order from L&R Medical UK Ltd, listed as the 'supplier'.

21. Exhibit PA7 contains the promotional leaflet referred to in the witness statement. The leaflet is dated 1 August 2017 and contains: some basic details of the ActiWrap product and how it works; codes for each size of bandage for ordering purposes; precautions for use; and contact details for L&R Medical UK Ltd.

22. That concludes my summary of the opponent's evidence insofar as I consider it relevant.

### **The applicant's evidence**

23. The applicant's evidence consists of a witness statement and three exhibits from Kevin Ingram, the applicant's director and shareholder. Mr Ingram has held this position since 2001. A set of written submissions were also provided in response to the opponent's notice of opposition and evidence.

## Witness statement

24. Mr Ingram's witness statement is dated 17 October 2018, the salient points from which are as follows:

25. The applicant was incorporated in 2001 and is a leading manufacturer and supplier of instruments, equipment and consumables to the veterinary industry, and has been trading since 1995.

26. The applicant specifically chose the specification for its trade mark application so that it was limited to use within the veterinary sector as it does not manufacture or supply its products to any other sector, nor does it intend to in the future.

27. The company has been advertising and selling cohesive bandages within the veterinary sector under the name **AniWrap** since 1 May 2018. The products are supplied for use by veterinarians as part of their clinical practice.

28. The word wrap is widely used as a term to describe a cohesive bandage. In particular, the words 'vet wrap' are commonly used to describe this type of bandage for use on animals.

## Exhibits

29. Exhibit K11 is described by Mr Ingram as the applicant's summer 2018 brochure. The brochure consists of 16 pages. Page seven refers to **AniWrap** cohesive bandages, which appear to be available in a range of different colours and prints and in two sizes.

30. Exhibit K12 is a printout of the results of a Google search of 'vet wrap', dated 10 October 2018. The majority of the results use the terms vet wrap and cohesive bandage interchangeably.

31. Exhibit K13 is described by Mr Ingram as printouts from the internet showing examples of other products which use the word wrap as part of their product name.

The exhibit contains three examples: Equiwrap; EickWrap; and Sure Wrap, all of which are cohesive bandages.

32. This concludes my summary of the applicant's evidence, insofar as I consider it relevant. It is not necessary to separately summarise the written submissions, however, I take them into account and will refer to them, where necessary, throughout this decision.

## **DECISION**

### **Proof of use**

33. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A Raising of relevant grounds in opposition proceedings in case of non-use

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark 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 period of five years ending with the date of publication.

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

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application 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 used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use condition 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.”

34. Section 100 of the Act is also relevant, which reads:

“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.”

35. The relevant period in the current case, in which the opponent must prove use of its mark (no claim for proper reasons for non-use having been made), in accordance with section 6A of the Act, is 17 February 2013 to 16 February 2018.

36. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *Walton International Ltd & Anot v Verweij Fashion BV*<sup>1</sup>, Arnold J. summarised the case law on genuine use of trade marks:

“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 Bunderversammlung 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 Behher 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].

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<sup>1</sup> [2018] EWCH 1608 (Ch) (28 June 2018)

(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].”

37. It is clear at the outset that the earlier mark relied upon by the opponent is a plain word mark, which has been used, in the evidence, in upper case, lower case and sentence case. Use of a mark registered as a plain word includes such use, as per Professor Ruth Annand’s comments, sitting as the Appointed Person in *Bentley Motors Limited v Bentley 1962 Limited*<sup>2</sup>:

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

38. Exhibits PA1 and PA2 do not assist me in making a finding in relation to genuine use.

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<sup>2</sup> BL O/158/17

39. The journal articles at exhibit PA4 are dated approximately nine years (or more) prior to the relevant period and so, do not prove use of the mark within the period set out in section 6A. The poster at exhibit PA4, despite being dated within the relevant period, does not assist the opponent in proving use of its mark since there is no mention of ACTI-WRAP anywhere on the document.

40. The promotional leaflet at exhibit PA7 is dated within the relevant period and contains substantial information relating to the ActiWrap bandage.

41. Whilst some of the evidence filed by the opponent is not useful for the reasons described above, there is no reason to disbelieve the annual turnover set out by the opponent's witness. The turnover made under the mark covers the entirety of the relevant period and whilst the figures do not strike me as huge, they are certainly not insignificant. Whilst supporting exhibits from within the relevant period are thin on the ground, use is supported at least by exhibit PA7. Although exhibits PA3, PA5 and PA6 are dated outside the relevant period (30 July 2018), I find it reasonable to conclude, on the balance of probabilities, that the websites were up and running and displaying the ACTI-WRAP products during the relevant period, given the fairly short period of time between the end of the relevant period and the date on which the websites were accessed. Overall, the evidence shows commercial use of the mark which identifies the origin of the goods and creates or preserves an outlet for these goods. The evidence provides me with a picture which is sufficient to establish that the opponent has genuinely used its ACTI-WRAP mark in the relevant period.

#### Fair specification

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*<sup>3</sup>, Mr Justice Carr summed up the law relating to partial revocation as follows.

“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

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<sup>3</sup> [2016] EWHC 3103 (Ch)

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 Plc* [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."

43. The opponent has shown use for bandages. ‘Support articles for surgical or medical use’ is too wide a term to represent the used goods. However, cohesive bandages and support bandages are included as sub-sets of bandages. Consequently, I am satisfied that the opponent has used its ACTI-WRAP mark for ‘bandages, cohesive bandages, supportive bandages’.

44. I note that the applicant has drawn a distinction between the industries in which the parties are using (or intend to use) their marks, i.e. the medical sector as opposed to the veterinary industry. In *Property Renaissance Ltd*<sup>4</sup>, Mr Justice Carr held:

“[...]”

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].”

45. I am of the view that the average consumer would describe the opponent’s goods as bandages, and not as anything more specific than that. It would therefore be artificial to limit the opponent’s specification in the manner suggested by the applicant.

46. My decision remains unchanged in that the opponent may rely on its ACTI-WRAP mark for ‘bandages, cohesive bandages, support bandages’ for the purposes of this opposition.

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

47. Section 5(2)(b) of the Act states that:

“5 (2) A trade mark shall not be registered if because –

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<sup>4</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

(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.”

## **Relevant law**

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

### *The principles*

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives 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

49. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>5</sup>, that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade 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.”

50. The goods to be compared are as follows:

Earlier mark (following proof of use)	Later mark
Class 10: Bandages, cohesive bandages, support bandages.	Class 10: Bandages [supportive] for veterinary use.

51. Given that the applicant’s bandages [supportive] for veterinary use fall within the scope of bandages, I find that they are identical (in accordance with *Merica*) to the opponent’s bandages, cohesive bandages, support bandages. The parties’ class 10 goods are identical. Referring back to paragraphs 44-46, above, I maintain the goods’ identity in spite of the applicant’s distinction between bandages for veterinary use (on animals) and those for medical use (on humans).

## The average consumer and the nature of the purchasing act

52. 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

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<sup>5</sup> Case T-133/05

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

53. 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. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

54. The goods at issue in class 10 (whether for use on humans or animals) target the public at large as well as specialists with specific professional knowledge or expertise. Such goods are likely to be purchased frequently by professionals, but relatively infrequently by the general public. Whilst the cost can vary, they are relatively inexpensive. Professional consumers are likely to inspect the goods for size, material composition and compatibility with certain medical concerns, whereas the general public will inspect them far less rigorously. Taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average (with a slightly higher level of consideration by the professional user). The purchase is likely to be predominantly visual: the goods will be self-selected from physical stores, websites or brochures. However, I do not discount that there may be an aural element with conversations taking place with professionals in a retail, pharmaceutical or veterinary setting.

### **Comparison of marks**

55. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks

must be assessed by reference to their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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 relevant 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.”

56. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

57. The marks to be compared are as follows:

Earlier mark	Applied for mark
ACTI-WRAP	AniWrap

58. The parties have made various submissions on the similarities of the marks and I have considered them all in reaching my decision. I will refer to some of the arguments raised below (although I do not propose to reproduce the submissions in full).

#### Overall impression

59. The opponent’s earlier mark consists solely of the words ACTI and WRAP, hyphenated. The applicant’s mark consists solely of the word AniWrap, which, considering the capitalisation of the letter W, is more likely to be seen as the two words Ani and Wrap, conjoined. Consumers who would purchase the goods at issue would

likely recognise the relevance (which I discuss later) of the word wrap in relation to bandages. Whilst this may mean that the prefixes ACTI and Ani respectively play a slightly greater role in the overall impression of the marks, the word wrap still contributes to the overall look and feel of the marks when their respective totalities are considered.

### Visual comparison

60. Visually, as noted above, each mark will be seen as two words, hyphenated and conjoined respectively. The similarity between the marks rests in: (i) the first and last letters of the first component of the marks, A and I, and (ii) the word wrap at the end of each mark. The differences are in the length of the first component (three letters compared to four), the middle part of the first component (CT versus n) and the hyphen before WRAP in the earlier mark, which has no counterpart in the application. Taking everything into consideration I find there to be a medium degree of visual similarity between the marks.

### Aural comparison

61. Both marks end with the word wrap, which will be pronounced identically. The opponent's mark begins with the word ACTI, which will be pronounced as two syllables (ACK-TEE). The applicant's mark begins with the word Ani, also two syllables. In my opinion, the average consumer may pronounce Ani in one of two ways: (i) as the common dictionary word ANY, or (ii) as the common female name ANNIE, the latter pronunciation being the most likely. In either case, I consider ACTI and Ani to be somewhat aurally different, given the difference in sound between 'ct' and 'n'. Overall, I find a medium degree of aural similarity between the marks.

### Conceptual comparison

62. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and

the CJEU including *Ruiz Picasso v OHIM*<sup>6</sup>. The assessment must be made from the point of view of the average consumer.

63. The opponent submits the following:

“31. The Applicant in its submissions of 17 October 2018 and the Witness Statement of Kevin Ingram alleges that the word “wrap” in the mark of the Application is non-distinctive as being a [sic] commonly used to describe a compression bandage. In support of this allegation, the Applicant has filed the first page of results from a Google search for the term “vet wrap” and printouts from the websites [...]. It is noted that the evidence of the Applicant is dated 10 October 2018 and is, therefore, after the filing of the Application. The Google search is for a term which is not the subject of the Application, the results of which are, it is submitted, undoubtedly skewed by the inclusion of the word “vet”. Further, the website at [www.eickemeyer.com](http://www.eickemeyer.com) appears to relate to a German business and it is not clear that the products of this company are available in the United Kingdom. The Opponent submits that the evidence of the Application should, therefore, be given little evidential weight. The Opponent also submits that the evidence does not, contrary to the allegation of the Applicant, demonstrate that the word “wrap” is non-distinctive as being used as a commonly used [sic] to describe a compression bandage.”

64. Regardless of the applicant’s evidence on this point (which, in itself, is not compelling given the limited number of references it provided), I am of the view that the word wrap for bandages is allusive since it describes the way in which a bandage is used. Wrap can be defined<sup>7</sup> as: (i) a verb meaning to cover someone with a piece of material in order to protect them, or (ii) a noun meaning a material that is used to cover or protect something. I bear this in mind when comparing the marks at issue.

65. Conceptually, the word wrap is a common dictionary word that will be recognised by the average consumer as relating to the goods in question. The presence of the

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<sup>6</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

<sup>7</sup> See Cambridge English dictionary

word Ani in the earlier mark, which is likely to be seen as an invented word with no connection to the goods, does not create a clear concept for the mark. However, the word ACTI in the contested mark will, in my view, be evocative of the word active. Whilst as a whole the mark does not give an absolutely clear concept, the presence of the word ACTI, and its incumbent evocativeness, provides a form of conceptual hook. As a result, I find the marks to have some conceptual similarity on the basis of the shared (but allusive) concept of something which is wrapped, but also a difference given that one mark has an added conceptual hook of ACTI whereas the other does not.

### **Distinctive character of the earlier mark**

66. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik* 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 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).”

67. I have found that the earlier mark is made up of two words (hyphenated), one being an ordinary dictionary word, which is strongly allusive of the nature of the goods (WRAP). The other, ACTI, is not an ordinary dictionary word but is evocative of the word active. Overall, the earlier mark has an average or normal degree of inherent distinctive character. However, a mark may have an enhanced distinctive character because of the use that has been made of it. With this in mind, I need to assess whether the use made by the opponent of its mark has improved its inherent distinctiveness level. I have been provided with annual turnover figures and an approximate market share of 23% for cohesive retention bandages. However, I do not know how many products have been sold under the ACTI-WRAP mark or the cost of those products individually, nor have I been provided with evidence of any customer other than the NHS. Whilst I am prepared to accept a slight elevation in distinctiveness on the part of the healthcare professional, the evidence is less clear that this will also be the case for the general public, which remains at average.

### **Likelihood of confusion**

68. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). There are two types of confusion that I must consider. The difference between them was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*<sup>8</sup>:

“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

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<sup>8</sup> BL O/375/10

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 recognised 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’.”

69. I also bear in mind *The Picasso Estate v OHIM*<sup>9</sup>, where the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applied in the present case, the Court of First Instance did not in any way err in law.”

70. Although, I bear in mind that conceptual differences do not always counteract visual and aural similarities, as per *Nokia Oyj v OHIM*<sup>10</sup>.

71. I bear in mind that the goods at issue are identical. However, in the case before me, the earlier mark has, in part, an evocative concept (ACTI) that assists in recall, whereas the contested mark has no clear concept beyond the reference to wrap (which is shared with the earlier mark). As a result, I do not find that the average consumer would mistake one mark for the other, even accounting for imperfect recollection. This is so notwithstanding what may be a higher than average level of distinctiveness from the perspective of the healthcare average consumer. However, even if I am wrong in my finding as to the conceptual hook of ACTI, even accounting

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<sup>9</sup> Case C-361/04 P

<sup>10</sup> [2010] ECR II-0089, Case T-460/07

for imperfect recollection, the nature of the respective marks (particularly the three-versus four-letter element at the beginning of the marks, the differences between the letters CT/N, and the fact that the average consumer tends to pay more attention to the start of a mark, which I accept is just a rule of thumb) is such that the average consumer would still not directly confuse them.

72. In terms of indirect confusion, I bear in mind the guidance of Mr James Mellor QC, sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*<sup>11</sup>:

“81.4. Fourth, I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

73. Considering the shared common element, wrap, is allusive for the nature of the goods, I can see no logical step which would induce the consumer to be indirectly confused. The average consumer, noticing the shared element, is likely to think that there are two undertakings unsurprisingly using the same allusive or descriptive word for their goods. The average consumer will then look to the other more distinctive parts of the mark and will notice the difference between ACTI and Ani. I do not consider indirect confusion to be likely.

## **CONCLUSION**

74. There is no likelihood of confusion. The opposition has failed, and the applicant’s mark may continue to registration.

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<sup>11</sup> BL O/547/17

## **COSTS**

75. As the applicant has been successful, it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side’s statement:	£200
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Preparing evidence (and accompanying submissions) and considering the other side’s evidence:	£500
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<b>Total:</b>	<b>£700</b>
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76. I order L&R Medical UK Limited to pay J.A.K Marketing Limited the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 8 April 2019**

**Emily Venables**  
**For the Registrar,**  
**The Comptroller-General**