

TRADE MARKS ACT 1994

**IN THE MATTER of Application No 2179856
by Precision Orthodontics Limited**

and

**IN THE MATTER of Opposition thereto under No 50780
by Accius B.V.**

Background

1. On 16 October 1998, Precision Orthodontics Limited applied under the Trade Marks Act 1994 to register the following as series of two trade marks:

DYNA-TI

DYNA TI

2. Following amendment, the specification of goods reads:

Class 10

Preformed dental wires, all for orthodontic use.

3. The application was accepted and published. On 1 March 2000, Accius B.V. filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out two grounds of opposition, these can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application DYNA-TI and DYNA TI is similar to the opponents' earlier trade mark DYNA (logo), registration number 1300672 and that the products covered by the application are similar to those for which the earlier trade mark is protected; and
- (b) under section 5(4)(a) the opponents' believe that they have common law rights in the mark DYNA. By reason of the goodwill and reputation acquired in their registered trade mark, the use of the mark applied for is liable to be prevented by the law of passing off.

4. The applicants filed a counterstatement denying the grounds of opposition and submitting that the goods covered by the application are "specialised goods in the orthodontic field". Both parties filed evidence and the matter came to be heard before me on 5 March 2002. The applicants were represented by Mr Lock of Fry Heath & Spence. In a letter dated 12 February 2002, the opponents' representatives indicated that they would not be represented at the hearing but that this was not due to ambivalence or lack of commitment on the part of the

opponents. Their letter states that they were simply prepared to accept the decision of the Hearing Officer on the basis of the papers already on file.

Evidence

5. The opponents' evidence consists of a witness statement by Mrs J Augustyn, the Management Assistant of Accius B.V.. The applicants filed a statutory declaration dated 15 June 2001, by Mr Mike Debenham, Director of Precision Orthodontics Limited. Finally, the opponents filed a witness statement dated 18 September 2001 by Ms Helen Thomas-Peter, a Trade Mark Attorney and partner in the firm of Wildbore & Gibbons.

Opponents' Evidence

6. Mrs Augustyn states that she is a citizen of The Netherlands but is fully conversant with the English language. She states that the opponents are a company incorporated in the Netherlands whose business is the manufacture and sale of dental apparatus and devices.

7. Mrs Augustyn states that her company is the registered proprietor of UK trade mark registration number 1300672 for the mark DYNA (word and device) in class 10. At exhibit D1 she attaches the relevant print out from the Marquesa Trade Mark Search System.

8. At D2, Mrs Augustyn exhibits two brochures which she states show the opponents' mark in use in relation to dental implants, abutments, root caps and dental instruments. She states that trade in these products is undertaken by Dyna Dental Engineering bv which is a wholly owned subsidiary of the opponents and that their use of the mark is with the opponents' consent.

9. Ms Augustyn states that the opponents first started selling DYNA products in England in approximately 1985. She says that the products are always sold to distributors (mainly dental depots) who then sell them on to dental laboratories and to dentists. Most sales are made to dental laboratories for making prosthesis or denture superstructures for dentists and their patients. She goes on to say that the original distributor in the United Kingdom was Quayle Dental Mfg.Co.Ltd. This company was superseded by Quayle Dental Manufacturing Limited which trades as Zahn Laboratory but is ultimately owned by the Henry Schein Group of companies.

10. Ms Augustyn gives turnover figures for the years 1993-2000 as follows:

<u>Year</u>	<u>Customer</u>	<u>Sales in Dutch Guilders</u>
1993	Quayle Dental	71,826.95
1994	Quayle Dental	53,886.04
1995	Quayle Dental	64,861.19
1996	Quayle Dental	36,908.05
1997	Quayle Dental	42,574.37
1997	Henry Schein	13,840.03
1998	Quayle Dental	1,152.30

1998	Henry Schein	57,078.34
1999	Henry Schein	60,797.20
2000	Henry Schein	44,233.26

11. I note of course, that the relevant date in these proceedings is the date of application, that is 16 October 1998. Over the last few years, Mrs Augustyn estimates turnover in pounds sterling to be on average, £19,250 per year. She states that their product is highly specialised and the turnover is significant within the market. At D2 she states that she exhibits extracts from the opponents' accounts system showing the sales made by Dyna Dental Engineering by in the years referred to above. However, Exhibit D2 is the catalogue showing examples of the opponents' products referred to above. There is no exhibit D3 to her witness statement. That said, Ms Thomas-Peter provides similar evidence at HTP3.

12. Mrs Augustyn states that although "preformed dental wires, all for orthodontic use", may be used for a different purpose to the opponents' goods, both products ultimately end up in the patient's mouth and both would be sold by Dental product wholesalers to members of the dental profession. She gives her opinion as to the likelihood of confusion and points out that the applicants mark DYNA-TI and DYNA TI has been applied for in respect of goods which presumably have a tying function in fitting braces to crooked teeth. She states that consumers could easily be confused as to the origin of the applicants' goods thinking that they are ties from DYNA.

13. Mrs Augustyn states that she has consulted their distributors in the United Kingdom who advise her that DYNA is well known to the dental profession in the United Kingdom. In my view, given that this evidence is fairly remote hearsay, I can place little if any weight on this aspect of Mrs Augustyn's evidence.

Applicants' Evidence

14. Mr Debenham states that the specification of his company's trade mark covers orthodontic wires generally used for straightening alignment of teeth in young people. He refers to the examination process for the application in suit and notes that the citation of the opponents' mark was overcome following a hearing. However, this is not relevant to the proceedings before me. At MD1 he exhibits a copy of his letter which was entered on the application file and which seeks to explain the differences between the applicants' goods and those of the opponents.

15. Mr Debenham states his views as to the lack of similarity between the opponents' and applicants' trade marks. He states that the registry allowed the opponents' mark onto the register despite the presence of the mark DYNA-LOCK in class 10. In addition, he notes that the registry has allowed registration of the mark DYNA BAND. Thus, he states that it appears that DYNA has become non-distinctive. He notes that the opponents' registration is in the form of a device and states that it would be wrong for the applicant [sic] to allege rights in respect of any form of DYNA. He states that in view of the differences in the goods and the marks, he believes that there is no likelihood of confusion on the part of the intended customers and that he is not aware of any actual confusion.

16. Mr Debenham states that he has reviewed the dental catalogues of Henry Schein and that he has not been able to find any reference to the opponents' mark. He goes on to refer to the laboratory catalogues for Zahn Laboratory and notes that they do refer to DYNA marks in respect of dentures having magnetic attachment but in his view these do not show use of the mark in the form in which it is registered. At MD2 he exhibits the relevant pages from this catalogue. The catalogue refers to DYNA magnets it states:

“Dyna Dental of Holland are manufacturers of Implants and the famous Dyna Magnetic Attachment that can be used in conjunction with rootcaps or implants.”

17. Contrary to the submissions of Mr Debenham, the mark as registered is shown on a box in one of the pictures on the page.

18. Mr Debenham goes on to state that this catalogue provides the only evidence of use of a DYNA mark by the opponents that the applicants have been able to find. He states that this shows the opponents' mark is applied to goods in a “laboratory” sub-sector of the dental profession. He states that the catalogue is not intended for orthodontics- orthodontic [sic] equipment is not mentioned in the catalogue.

19. Mr Debenham states that the applicants' market lies in the distinct and unrelated field of orthodontics. In this regard, dental laboratories (generally concerned with prosthetics for elderly people who have lost their teeth) have no influence in the orthodontic market (which generally relates to fixed wires for correction of the growth of badly aligned teeth in young people).

20. Mr Debenham states that he has various catalogues, and journal articles, in his possession which do not show any use of the registered mark or the opponents. He states that copies of these documents can be provided if it will assist the registry.

21. Mr Debenham refers to the evidence of the opponents. Referring to the opponents' alleged use, he states that it is not clear that this use was in the UK. He notes that the turnover figures are given in Dutch Guilders and estimates that this equates to an average of about £19,250 per year. He states that if one product is sold for £200 it corresponds to the sale of less than 100 products per year.

Opponents' evidence in reply

22. Ms Helen Thomas-Peter refers to the evidence of Mr Debenham. She states that contrary to the indication given in Mr Debenham's declaration, exhibit MD2 does show use of the mark as registered. Ms Thomas-Peter also confirms that the turnover figures given in the opponents' earlier declaration relate to sales in the United Kingdom. At HTP2 she exhibits a copy of the information provided to her as the basis for the evidence to be filed in support of the opposition.

23. At HTP3 she exhibits extracts from the opponents' accounts system showing sales to Quayle Dental and Henry Schein. In addition, there is a letter from Mark Sanderson, Sales & Marketing Manager of Zahn Laboratories, which she states summarises the history of use of

the mark in the United Kingdom.

24. Ms Thomas-Peter notes the comment of Mr Debenham that the fields of dentistry and orthodontics are distinct and unrelated. She observes that all orthodontists must first train as dentists and she refers to exhibit HTP4 which is an extract from the British Orthodontic Society's web site. As further evidence that both disciplines are related and involve similar practitioners, she exhibits at HTP5, some information relating to the International Dental Showcase to be held in Birmingham in October 2001 and where the exhibitors include both those supplying orthodontic apparatus and those supplying mainstream dental equipment including implants. She states that the relevant exhibitors are:

Sheffield Orthodontic Lab
The Orthodontic Company
3I Implant Innovations UK
Henry Schein

25. Ms Thomas-Peter notes that Mr Debenham states that orthodontics generally relates to fixed wires for correction of the growth of badly aligned teeth in young people. However, she states that she would argue that there is some overlap because some orthodontic procedures do involve implants to anchor existing teeth so that the braces do not dislodge them. As evidence to support this statement, Ms Thomas-Peter attaches at exhibit HTP6 a copy of a paper on "The use of palatal implants for orthodontic anchorage". She states that the exhibit D2 shows that the opponents' goods are dental implants.

26. That concludes my review of the evidence.

Decision

27. The grounds of opposition refer to sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

"5.- (1)

(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3).....

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

28. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means -

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

Section 5(2)

29. I will deal first with the opponents’ ground of opposition under section 5(2)(b). In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be

assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

30. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

The earlier trade mark

31. The trade mark on which the opponents seek to rely, registration 1300672 is an earlier trade mark within the definition of section 6 of the Act. For ease of reference I reproduce the applicants' and opponents' trade marks below:

Applicants' trade mark

DYNA-TI

DYNA TI

Class 10

Preformed dental wires, all for orthodontic use.

Opponents' trade mark



Class 10

Dentures included in class 10 incorporating magnets.

Reputation/Inherent distinctiveness of the earlier trade mark

32. The opponents' earlier trade mark being made up of the word DYNA in the form of a device appears highly distinctive. Indeed, at first sight, it would seem that the word DYNA which makes up an important element of the opponents' mark, is also highly distinctive per se. It seems to have no relevance to the goods and as such appears to be a made up word. The case law set out above, indicates that there is a greater likelihood of confusion where the mark is highly distinctive per se or because of the use that has been made of it. As such, the distinctiveness of the opponents' mark becomes one of the factors to take into account when reaching a decision under this section of the Act. However, the applicants in this case argue that the mark DYNA is in fact not distinctive for goods in class 10. The evidence of Mr Debenham, refers to two marks on the register which include the word DYNA. These are DYNA-LOCK and DYNA BAND. Indeed, in his skeleton argument, Mr Lock provided a list of some 32 trade marks covering goods in class 10 which are or include the word DYNA. It should be noted that this complete list of marks was not in evidence before me.

33. At the hearing I questioned Mr Lock concerning the relevance of marks on the register. He submitted that if there was only one other mark containing the element DYNA registered as a trade mark, then that was relevant in assessing the distinctiveness of the opponents' earlier mark. In my view that submission is wrong. It has long been held that the state of the register is prima facie irrelevant; *Madame Trade Mark* [1966] R.P.C. 541 and more recently in *British Sugar plc v. James Robertson & Sons (Treat Trade Mark)* [1996] R.P.C. 281 @ page 305. The applicants in this case have filed no evidence to show that any of these marks are in use in the market place. Mr Lock stated at the hearing that he had evidence of use of one of the marks. It was not however, in evidence before me.

34. Whilst the case law indicates that the state of the register is irrelevant, it seems to me that where there is evidence before the tribunal of a large number of marks on the register which show use of an element such as DYNA, that may be a factor that should be taken into account when assessing whether the earlier mark is in fact distinctive. However, in the circumstances of this case, all I have is a statement that there are two marks on the register in the evidence of Mr Debenham. There is no accompanying exhibit or information showing the goods for which these marks are registered. In my view, I cannot take account of the list of other marks supplied with the skeleton argument. Firstly, this was not submitted in evidence before the tribunal and the opponents have not had an opportunity to comment on the registrations. Secondly, it is merely a list of registrations showing that the various marks are registered in class 10 and for most, I do not know the goods in class 10 covered by the registrations.

35. Further, Mr Lock argued that, in the face of these marks on the register, the opponents' mark must have been allowed to proceed to registration because of its stylisation and also because the registration covers a very narrow and specialised product. On that basis, he argued that the opponents' rights lay in their stylisation and in their limited specification, and it was not open to the opponents to seek to claim a monopoly in DYNA simpliciter for a wide range of goods in class 10. However, I have nothing before me to show how or why the opponents' earlier trade mark achieved registration. The only disclaimer on the registration is of the exclusive use of the letter Y. **Therefore, having considered all of these points, I proceed on the basis that the opponents' earlier trade mark is highly distinctive.**

36. The opponents' filed some evidence of use of their mark. Turnover figures were provided

and an explanation given that the opponents' products are very specialised. From the evidence that seems to be the case, but even so, the annual turnover figures in the United Kingdom appear very modest. I note the comment in the Zahn catalogue at exhibit MD2 to the applicants' evidence where it is stated that "Dyna Dental...are manufacturers of implants and the famous Dyna Magnetic Attachment...". However, given that Zahn are the UK distributors for the opponents' product, their statement in their catalogue that the product is "famous" cannot be given too much weight. Absent is more detailed evidence to show the market share and penetration of the opponents' product, or some evidence from the trade, **I decline, on the basis of the evidence before me, to find that the opponents' mark enjoyed an enhanced reputation at the relevant date.**

Comparison of the Trade Marks

37. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components. The question must be assessed through the eyes of the average consumer for the goods in question. There was some debate between the parties as to the identity of the average consumer of the goods in question. The applicants submit that their product will be used by orthodontists and the opponents' by dentist and dental laboratories. The opponents' argue that there is some cross-over of users and that they may be stocked by the same suppliers. I will discuss these points further when I consider whether the goods are similar. However, for the purpose of identifying the average consumer, I believe both parties would agree that the average consumer for both types of products will be professionals working in the fields of dentistry or orthodontics.

38. In making a comparison of the marks I must also take into account the fact that the average consumer rarely has an opportunity to make a direct comparison between the trade marks; so called imperfect recollection. However, balanced against that is the fact that the average consumer here is a professional, who is likely to be better informed and more careful. With these considerations in mind I go on to consider the trade marks in issue.

39. Visually, the opponents' earlier trade mark is DYNA presented in the form of a device. The Y of DYNA is enlarged with a cap device placed above the opening of the Y. The device to me, has the appearance of the gum implant and cap or magnet which is used with the opponents' products. That said, the average consumer, even if a dentist, may not proceed to dissect the mark too carefully. Either way, I reach the view that despite the device element of the mark, it clearly strikes the eye as a DYNA mark. The applicants' mark is DYNA-TI and DYNA TI. Both it seems to me are DYNA TI marks and I do not think that it matters which of these I consider.

40. Whilst not ignoring the device element completely, one is left with a comparison between DYNA and DYNA TI. On any view, it seems to me that the two marks are visually very similar. Mr Lock argued that as there were a number of DYNA marks on the register, the dominant and distinctive element of the opponents' mark was in its stylisation. He argued that the dominant and distinctive element of the applicants' mark was in the TI element. I have discussed this point above, and found that on the basis of the applicants' evidence, I cannot reach such a view. At the hearing I expressed the view that to me TI meant titanium; it is the chemical symbol for that element. From the evidence, it seems that both the opponents' and applicants' product contain or are coated with titanium. As such, I put it to Mr Lock that in

fact, the TI element in his clients' mark indicated that the product contained titanium and so was descriptive. In reply, he argued that the distinctiveness of his clients mark lay in the combination of the elements DYNA and TI. He further submitted that his clients' product need not contain titanium and in relation to such orthodontic wires, the mark TI would be distinctive. As noted in the opponents' evidence, TI could also be a reference to the tying function of the applicants' product.

41. Taking all these points into consideration, it seems to me that there is a high degree of visual similarity between the two marks. I remain of the view that TI in the context of dental or orthodontic use would mean titanium to the average consumer or possibly be seen as a reference to its use as a tie.

42. Aurally, the opponents' mark would be pronounced DYNA and the applicants' DYNA with the letters T and I or DYNA TIE. The first element of both marks is the same being DYNA. It is well established that the first element of a mark is the most important in aural use with the end of words often tending to become slurred. In oral use, the stylisation of the opponents' mark is of no assistance. This, together with my comments about the possible descriptive meanings of TI, leads me to the view that there is a high degree of aural similarity between the opponents' and applicants' trade marks.

43. Conceptually, both marks use of the element DYNA, which as stated appears arbitrary and to be an invented word. The opponents' mark is in a stylised form and the applicants' mark contains the element TI. Nevertheless, I reach the view that conceptually the marks are similar.

44. To conclude, I find, that visually and aurally, there is a high degree of similarity between the opponents' and applicants' marks. There is also a degree of conceptual similarity.

Similarity of the Goods

45. Whilst I have found a high degree of visual and aural similarity between the marks, for a finding under section 5(2)(b), I must find that there is some similarity between the goods for which the opponents' trade mark is registered and the goods for which the applicants seek protection. In particular in *Canon* at paragraph 22 the court stated:

“22. It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

46. Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* [2001] R.P.C. 11 has stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

47. The opponents' case is that their mark is registered for dentures incorporating magnets and the applicants seek registration for preformed dental wires all for orthodontic use. Whilst one might predominantly be used by a dentist or in a dental laboratory and the other by an orthodontist, that is not invariably so. Further, in their view, both products end up in the patient's mouth.

48. The applicants argue that the goods are used by different professionals. A dentist would not use dental wire for orthodontic use and an orthodontist would not use dentures incorporating magnets. Mr Lock took me to the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- (a) the uses of the respective goods;
- (b) the users of the respective goods;
- (c) the physical nature of the goods;
- (d) the trade channels through which the goods reach the market;
- (e) [does not apply]
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same of different sectors.

49. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

Are the goods similar?

50. On any view, it seems to me that the uses of the two products in question will be different. One is a wire for use in orthodontics, the other is a denture containing magnets. As for the users of the goods, I have statements in the applicants' evidence that their product is for use by orthodontists and that the opponents' product is applied to goods in a "laboratory sub-sector of the dental profession". To counter this, the opponents put in evidence to show that one must become a dentist before going on to undertake further training to become a specialist orthodontist. They also filed evidence at HTP5 showing that companies such as "The Orthodontic Company" and "Sheffield Orthodontic Lab" exhibited at "International Dental Showcase 18-20 October 2001". Further, the applicants in their own evidence at MD1 state, "Whilst it is possible that an orthodontists [sic] could use a denture, and some General Dentists do treat patients requiring orthodontics and may use an orthodontic appliance, the two applications are quite separate, and are at opposite ends of dentistry". Mr Lock pointed out that in the opponents' evidence at exhibit HTP2 is a statement that, "Although the product itself is not equal we both sell very specialised products and the name DYNA is still alike."

The statement goes on to say, “The main point is that we talk about dental products and that confusion is very easily possible”. It seems to me, based on the evidence, that there is some overlap between orthodontics and dentistry, the two are not mutually exclusive. Therefore, I reach the view that there is some similarity between the users of the respective goods.

51. In considering the physical nature of the respective goods, I think, as with the uses, there is no similarity. One is preformed dental wire, the other is dentures all containing magnets. I have no direct evidence as to the trade channels that these products may reach their respective users. However, there is the opponents’ evidence that orthodontic companies exhibit at dental exhibitions and a statement in their evidence that both products could be stocked by dental product wholesalers. As such, there is some similarity in the trade channels. That said, the products are not in competition with one another.

52. Whilst on one level, it is true that both the opponents’ and applicants’ products end up in the mouth of the patient, this similarity is at the most superficial level. **That said, given my consideration of the factors outlined above, I reach the view that having regard to the potential users and trade channels, there is some, albeit a low degree of similarity between the goods in question.**

Conclusions under section 5(2)(b)

53. Together with my finding in relation to the inherent distinctiveness of the opponents’ mark, how do my findings in respect of the similarities of the marks and the similarities of the goods come together under section 5(2)(b)?

54. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark”, DYNA (device) and the sign subsequently presented for registration, DYNA-TI and DYNA TI, were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

55. Having considered the various factors, I reach the view that this question must be answered in the affirmative. In so finding, I have taken account of the high level of distinctiveness of the opponents’ mark and that as such, there is a greater likelihood of confusion. I have also taken account of the high degree of similarity between the two marks and that a lesser degree of similarity between the goods can be offset by a greater degree of similarity between the marks.

56. Taking into account my finding that the relevant consumer here will be a professional in the field of dentistry or orthodontics and so will be more careful and circumspect, then in my view there is no likelihood that a dentist or orthodontist would mistake one product for the other. However, that is not the test under section 5(2)(b); the section requires me to assess, having regard to all the factors, whether there is likelihood of confusion as to origin.

57. The guidance from the ECJ indicates that if the average consumer wrongly believes that the respective goods come from the same or economically linked undertaking, there is a likelihood of confusion within the meaning of section 5(2)(b). Given my findings in respect of the high degree of similarity between the respective marks, it seems to me that this would be the case here and that this would be sufficient to offset the lesser degree of similarity between the goods.

58. To conclude, I reach the view that if the marks DYNA-TI and DYNA TI were used in respect of dental wire all for orthodontic use, the relevant public would wrongly believe that the goods came from the opponents or some economically linked undertaking. **As such, I find that there is a likelihood of confusion within the meaning of section 5(2)(b).**

Section 5(4)(a)

59. The opponents also seek to rely on the ground of objection under section 5(4)(a) of the Trade Marks Act 1994. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

Goodwill and Reputation

60. Under section 5(2)(b) I declined, on the basis of the evidence before me, to find that the opponents' mark enjoyed a reputation in the United Kingdom. The same must apply here. There seems to me to be insufficient evidence to base a claim to a reputation in the mark DYNA or DYNA (device). All I have is some turnover figures with no indication of market share or penetration. There is no evidence as to how the mark was used prior to the relevant date, how and where it has been advertised or exhibited. Absent such evidence I cannot in my view find the necessary goodwill and reputation. **The opponents' ground of opposition under section 5(4)(a) fails at the first hurdle and is dismissed.**

Conclusions

61. I have found that the opponents' ground of objection under section 5(2)(b) is made out but that the objection section 5(4)(a) should be dismissed.

Costs

62. The opponents have been successful and are entitled to a contribution towards their costs. I order that the applicants pay the opponents the sum of £1100-00 as a contribution towards their costs. Such award of costs being made from the published scale. In making an award of £1100-00 I have taken account of the fact that the opponents did not attend the hearing and so did not incur the associated costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23 day of May 2002

**S P Rowan
For the Registrar
the Comptroller General**