

O-561-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3056715 BY
MAVEN MEDICAL LIMITED**

TO REGISTER THE TRADE MARK:



FOR GOODS IN CLASS 10

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000126 BY
NIPRO CORPORATION**

BACKGROUND

1) On 22 May 2014 Maven Medical Limited (“the Applicant”) applied to register the following trade mark:



The application was published for opposition purposes on 20 June 2014 for the following goods:

Class 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

2) The application is opposed by Nipro Corporation (“the Opponent”) under the fast track opposition procedure. The opposition, which is directed against all the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the Opponent relies upon the following goods for the following two Community Trade Mark (“CTM”) registrations respectively:

CTM no. 12021085 which was applied for on 29 July 2013 and for which the registration process was completed on 14 May 2014:



Class 5: Pharmaceutical preparations; empty capsules for pharmaceuticals; adhesive plasters; medical and surgical dressings; diapers; dietetic beverages adapted for medical purposes; dietetic food adapted for medical purposes; medical test strips.

Class 9: Laboratory apparatus and instruments; measuring or testing machines and instruments; electronic machines, apparatus and their parts, namely, computers and computer peripheral devices, computer networking and data communications equipment, computer software.

Class 10: Medical instruments and apparatus; needles for injection; blood collection needles; winged needles for venous injection; arterial venous fistula needles; dental needles; spinal needles; syringes; needles and needle sets for blood access; luer adaptors; blood transfusion apparatuses; solution infusion apparatuses; 3-way stopcocks for medical apparatus and instruments; intravenous hyperalimentation bags; urine bags; enteral nutrition sets consisting essentially of bags and tubes; infusion pumps; catheters;

cannulas; extension tubes for medical purposes; blood collection tubes; blood collection bags; dialyzers; dialysis blood tubing sets; dialysis machines; dialysate supply units; guide wires; intracardiac catheters; ambulatory continuous balloon infusers for medical fluids; drapes for medical purposes; oxygenators; lancets and lancing devices; blood glucose meters; glass vials and bottles sold empty for medical use; glass syringe barrels sold empty for medical use; sanitary masks; glass containers, glass vials and bottles for pharmaceutical and medical use.

CTM no. 8766131 which was applied for on 17 December 2009 and for which the registration process was completed on 10 May 2010:



Class 10: Medical instruments and apparatus.

3) The significance of the respective dates on which the opponent's marks were applied for and on which their registration process was completed is that (1) both the opponent's marks constitute an earlier mark in accordance with section 6 of the Act, and (2) neither is subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed less than five years before the publication of the Applicant's mark.

4) The Applicant filed a counterstatement, denying the grounds of opposition.

5) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) ("the Rules") states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. The Opponent filed written submissions in lieu of a hearing.

6) In its statement of grounds the Opponent refers to both the earlier marks and the opposed mark as being made up of a ribbon device representing an infinity symbol. In its counterstatement the Applicant refers to a number of UK trade mark registrations in class 10, arguing that they demonstrate "that the variety of interpretation and designs of such marks is such that they can co-exist without likelihood of confusion on the part of the consumer", and appending undated print-outs purporting to show three of these marks in use. This material constitutes evidence. In order to be considered in these proceedings it would need to have been filed in evidential format, i.e. accompanied by a witness statement, statutory declaration or affidavit. Rules 20(1)-(3) (as amended) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4), which does, reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of the above is that parties are required to seek leave in order to file evidence (other than proof of use evidence, which is not pertinent in these proceedings) in fast track oppositions. In a letter of 10 October 2014, acknowledging receipt of the Applicant’s form TM8, the parties were referred to the guidance at paragraph 7 of Tribunal Practice Notice 2/2013 and advised that any request for leave to file evidence should be submitted on or before 24 October 2014. No leave was sought in respect of these proceedings. Accordingly, material which should have been filed in evidential format has not been admitted as evidence in these proceedings, and I have taken no account of it in reaching my decision. Perhaps it may be helpful to add that, even if I had taken the material in question into account, it would not in any case have been sufficient to persuade me that the average consumer had been educated to distinguish between figures of the kind in issue when used for class 10.

Section 5(2)(b)

7) Section 5(2)(b) of the Act reads 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”.

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:

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

8) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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”.

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

10) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of “dessert

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. 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."

I will make the comparison with reference to the terms applied for by the applicant, grouping them together where it is reasonable to do so:

Surgical, medical, dental and veterinary apparatus and instruments; suture materials

11) Both the Opponent's earlier marks cover *medical instruments and apparatus* which is clearly identical to the Applicant's *medical apparatus and instruments*. Moreover, *medical instruments and apparatus* is a very comprehensive term, and I consider that *surgical, dental and veterinary apparatus and instruments* and *suture materials* all fall within its ambit. They are really just sub-sets of medical fields. For example, veterinary apparatus and instruments will themselves be medical-type apparatus and instruments, albeit for use on animals. Accordingly, the Applicant's *surgical, medical, dental and veterinary apparatus and instruments* and *suture materials* are identical with the Opponent's *medical instruments and apparatus*. Even if *surgical, dental and veterinary apparatus and equipment* are discrete categories not falling wholly within the category *medical instruments and apparatus*, it remains the case that a great many items covered by the Opponent's *medical instruments and apparatus* will also fall into the categories of *surgical, dental and veterinary apparatus and instruments*. This can also be seen from the remaining items listed specifically in the Opponent's class 10 specification (of its first earlier mark listed above) which highlights the overlap and which results in the goods being identical or at the very least highly similar.

Orthopaedic articles

12) Orthopaedic articles are used in the diagnosis and treatment of problems of the musculoskeletal system. It is thus a medical field. A great many, if not all, will fall within the ambit of the Opponent's *medical instruments and apparatus* and thus are identical. Moreover, they are all used by medical professionals in the course of medical treatment, so even if there is not a direct overlap, they are at least highly similar.

Artificial limbs, eyes and teeth

13) Whilst the end users of *artificial limbs, eyes and teeth* will consist of the patient rather than those treating them, it is the healthcare professional who will normally order the product and use (fit/implant) them. Even if these goods cannot be considered as medical apparatus and instruments (because they are more appliances than apparatus/instruments) there is a similar purpose, because the medical apparatus/instruments would nevertheless include goods which are used in the same field, for treating the same conditions, will be sold to the same professional users, and there is also likely to be an overlap in channels of trade. There is also likely to be a high degree of complementarity between the goods fitted and the

apparatus and equipment used to fit it. There is a reasonably high degree of similarity between *artificial limbs, eyes and teeth* and *medical instruments and apparatus*.

The average consumer and the purchasing process

14) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

15) In its counterstatement the Applicant submits that the relevant consumers are highly skilled professionals, and in its written submissions the Opponent agrees. Given the importance of the goods I consider that at least a reasonably high degree of care and attention will be deployed in their selection. One would expect advertisement in professional journals, specialist catalogues (including online catalogues) and approaches from suppliers' representatives to play a role in the purchasing process. In general terms this would indicate a predominantly visual purchasing process, albeit with aural communication playing some role; however, given the nature of the marks in this dispute (both being pure device marks) aural communication will play very little, if any, role here.

The distinctiveness of the earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

17) As these are fast track opposition proceedings, in which neither party has sought leave to file evidence, I have only the inherent characteristics of the Opponent's marks to consider. The device of which the earlier marks consist is neither descriptive nor allusive of the goods covered by their specifications. As such they enjoy at least a normal degree of inherent distinctiveness in respect of those goods.

Comparison of the marks

18) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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.

19) In its counterstatement the Applicant claims that when buying the products consumers refer to "Nipro" products or "Maven" products, but I have no evidence of this. Moreover, it would not in any case be appropriate for me to take this into consideration in the comparison of the marks, as I must consider the marks notionally, on the basis of how they have been filed/registered. The marks to be compared are shown below (both earlier CTMs consist of exactly the same device):

The Applicant's mark	The earlier marks
	

20) Both marks consist of a single device not susceptible of further analysis into dominant and distinctive elements.

21) The earlier marks consist of a device composed of lines which vary in thickness. The Applicant submits that this gives the impression of having been drawn by a calligraphic pen. I doubt that the average consumer will analyse the mark with such precision. I consider that the mind of the viewer will tend to interpret the way in which a thinner central line apparently runs below the thicker central diagonal line as indicative that the device has three dimensions, evoking a ribbon-like loop twisted into the form of a figure of eight on its side. The lines in the Applicant's mark are of the same width, but they produce a similar effect, creating a clear 3-dimensional effect, though in this case the effect is achieved naturalistically, through use of highlighting and shading of the lighter figure, rather than diagrammatically, as is the case with the dark monochrome presentation of the earlier marks. Both the Applicant's mark and the earlier marks give the impression of ribbons twisted into a figure of eight on its side, though viewed from a slightly more head-on perspective in the case of the Applicant's mark. Whilst there are differences in the way on which the respective effects have been produced, I still consider that, overall, there is a high degree of visual similarity between the marks.

22) For a conceptual meaning to be relevant in a mark, it must be one capable of immediate grasp. This has been emphasised in a number of judgments of both the GC and the CJEU (see, for example, *Ruiz Picasso v OHIM* [2006] ETMR 29). I do not consider that it can be assumed that the average consumer will see the signs of either the Applicant or the Opponent as representing either an infinity symbol or a Möbius strip, or that these concepts would be immediately grasped. There is no evidence to show how widely known such symbols are. I feel that the average consumer will not analyse the mark with enough precision to reach any clear view on a particular fixed meaning, the conceptual content of both signs is therefore neutral. They are neither similar nor dissimilar conceptually.

23) Since the marks consist exclusively of devices, there is no aural element to consider.

Likelihood of confusion

24) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific

formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

25) I have found the Applicant's *surgical, medical, dental and veterinary apparatus and instruments* and *suture materials* to be identical or at the very least highly similar with items of the Opponent's specification. I have found the Applicant's *orthopaedic articles* to be identical or at least highly similar, and *artificial limbs, eyes and teeth* to have a reasonably high degree of similarity with items of the Opponent's specification. I have found that the earlier marks have at least a normal degree of distinctiveness, that they are conceptually neither similar nor dissimilar to the Applicant's mark, but that they have a high degree of visual similarity with the Applicant's mark. The Applicant invites me to consider that differences in the marks are immediately apparent when they are compared side by side. However, it is settled case law that 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 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. Even bearing in mind the higher degree of attention to be expected of the average consumer in this case, what will stay in his or her mind is the basic configuration of the image and its likeness to the other image. Taking into consideration my findings on the average consumer and the purchasing process, I conclude that there is a likelihood that the earlier marks will be confused with the opposed mark for all goods having at least a reasonably high degree of similarity. I have found all the goods of the Applicant's specification to be identical, or to have at least a reasonably high degree of similarity with those of the Opponent. Accordingly, **the opposition succeeds in its entirety.**

Costs

26) The Opponent has been successful and is entitled to a contribution towards its costs. I hereby order Maven Medical Limited to pay Nipro Corporation the sum of £600. This sum is calculated as follows:

<i>Opposition fee</i>	£100
<i>Preparing a statement and considering the other side's statement</i>	£200
<i>Written submissions</i>	£300

The above sum should 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 23rd day of December 2014

Martin Boyle
For the Registrar,
The Comptroller-General