

o/0090/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3923270

BY NHC GROUP LIMITED

TO REGISTER THE TRADE MARK:



IN CLASSES 9, 10, 11, 12, 20, 24, 37 & 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600003028

BY NHC TECHNOLOGY LIMITED

Background and pleadings

1. On 15 June 2023, NHC Group Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 14 July 2023. The goods and services applied for are as follows:

Class 9: Chair scales; nurse call buttons; bluetooth sound systems for assisted baths.

Class 10: Medical furniture; medical furniture and fittings for use in relation to human health and the provision of health-related assistance in a care home or other residential or domiciliary care setting; medical bedding and furnishings; furniture adapted for medical use; mobility aids; assistive devices adapted for persons with disabilities or other special health or accessibility needs; equipment for lifting and moving patients; air beds for medical purposes; air cushions and pillows for medical purposes; air mattresses for medical purposes; airflow cushions; anti-vandal mattresses; assisted baths; assisted showers; beds specially made for medical purposes; hospital beds; profile beds; blankets for medical purposes; commode chairs; mobile commode chairs; draw sheets; assistive devices; hoist slings; stand aids; mobile transfer hoists; pressure cushions; pressure mattresses; profile beds; shower chairs; underlay mattresses; assistive devices for standing; blood pressure monitors; chair scales; chairs specially made for medical purposes; lifting hoists; mobile lifting hoists; patient lifting hoists; nurse call mats; alert mats; sensor pads; slide sheet; apparatus and equipment for the monitoring of human health; apparatus and equipment for the provision of physical therapy; apparatus for the monitoring of human health for use in a care home or other residential or domiciliary care setting; medical infrared monitors; blood pressure monitors; aspirators.

Class 11: Sanitary installations and sanitation equipment for use in a care home or other residential or domiciliary care setting; adapted sanitary installations and sanitation equipment for use in relation to humans with disabilities or other

special health, accessibility or care needs; toilet seats; assisted baths; assisted showers; mood lighting, and hydrotherapy air spa systems for assisted baths.

Class 12: Mobility assistance vehicles, aids and conveyances; Wheelchairs.

Class 20: Furniture; furnishings; articles of furniture; bedroom furniture, fittings and furnishings; bathroom furniture, fittings, and furnishings; furniture, fittings and furnishings for use in a care home or other residential or domiciliary care setting; beds; profile beds; divan beds; bed bumpers; bed wedges; bed rails, tables, overbed tables; over chair tables; mattresses; air-flow mattresses, pressure mattresses; foam mattresses; anti-vandal mattresses; pressure Cushions; airflow cushions; shower chairs; care chairs; reclining chairs; chairs; seats; adjustable chairs; motorised reclining chairs; chest of drawers; bedside drawers; curtain tie backs; cushions; scatter cushions; dining chairs; dressing tables; desks; wardrobes; footstools; bathroom and shower room furniture; pillows.

Class 24: Furnishings made of textiles; commercial and home furnishings made of textiles; coverings for furniture; commercial and home coverings for furniture; Bed bumpers; bed wedges; curtains; fire retardant curtains; covers for cushions; curtain holders; bed runners; bed throws; bedding; bedspreads; bedsheets; covers for mattresses, including protective covers; upholstery fabrics; pelmets.

37 Pre-fit out services in respect of furniture and equipment for use in the provision of health and care service; fit out works, installation and repair services in relation to furniture, curtains and upholstery and flooring; installation, servicing, maintenance and repair of furniture, fittings, and furnishings; installation, servicing, maintenance and repair of medical furnishings, fittings, furnishings, apparatus and equipment; servicing and maintenance of equipment including medical and nursing equipment and equipment for use in relation to humans with disabilities or other special health, accessibility, or care needs; inspections in respect of furniture and equipment for use in the provision of health and care services; repair services in respect of furniture and

equipment for use in the provision of health and care services; technical support in respect of furniture and equipment for use in the provision of health and care services.

Class 42: Design consultancy services; design and planning services in relation to facilities for the provision of care services (including residential and domiciliary care services); planning and design of bedrooms, bathrooms and living areas; room planning, interior design services; conducting onsite surveys; auditing services relating to furniture and CQC regulations.

2. The application was opposed by NHC Technology (“the opponent”) on 13 September 2023. The opposition is based upon sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on the following trade mark:

UK904517793



Filing date: 27 July 2005

Registration date: 15 December 2006

Relying upon some of the goods for which the earlier mark is protected, namely:

Class 10: Apparatus and instruments, pads, cushions; all for therapeutic, massaging and vibrating purposes; medical therapeutic appliances; massage apparatus and appliances for therapeutic purposes for humans and animals.

Class 20: Furniture; beds and bed fittings; chairs; mattresses; head rests; pillows; divans; parts and fittings for all the aforesaid goods; furniture, beds, mattresses, chairs, sofas; all for therapeutic, heating, massaging and vibrating purposes.

4. The opponent claims that the marks are identical or similar. It also claims that the applicant's goods and services are identical or similar. The opponent's states that where the marks are similar, there is risk that confusion will arise in the market.

5. The applicant filed a counterstatement denying that the marks are identical/similar. They state that the goods and services are not identical but admit that they are similar.

6. The earlier mark is subject to use conditions in accordance with section 6A of the Act because it was registered more than five years before the application date of the contested mark. In its notice of opposition, the opponent made a statement of use and filed proof of use evidence in relation to the above goods relied upon.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20(4) states that:

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

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. This would apply to evidence which is filed later in the proceedings and therefore, would not include evidence of use which is required to be filed alongside the notice of opposition (Form TM7F).

9. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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; however, both parties did

file written submissions in lieu. This decision is taken following a careful consideration of the papers.

10. The applicant is represented by The Endeavour Partnership LLP and the opponent represents themselves.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

12. The opponent provided a statement within Form TM7F from Philip Ellin, the Managing Director of NHC Technology dated 13 September 2023 together with 9 pages of attached evidence. The purpose of this evidence is to show use of the earlier mark.

Procedural Issue

13. A letter was sent by the Registry to the parties on 25 May 2024 stating that this matter was to be consolidated with another matter between the same parties (OP600002996). However, upon further review, it has been noted that there are differences in the evidence filed between the two matters and, therefore, consolidation is not appropriate.

DECISION

Section 5(1) and 5(2)(b)

14 Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

15. Section 5(2)(b) is being relied upon and is 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”.

16. Section 5A of the Act is as follows:

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

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

18. As mentioned above, the opponent’s mark is subject to the use conditions.

Proof of use

19. I will begin by assessing whether there has been genuine use of the earlier mark in relation to the registered goods relied upon. Section 6A of the Act states:

“(1) This section applies where

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trademark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

21. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application i.e. 16 June 2018 to 15 June 2023.

22. Section 100 of the Act reads:

“If 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.”

23. Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark was made within the UK in the relevant period, and in respect of the relevant goods as registered. This is a comparable mark and so, in accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020.

24. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Evidence

25. Within the Form TM7F Mr Ellin states the following in relation to turnover figures:

“2021 NCH Technology Ltd sales £5M average selling price £1,100 across all stated goods and services.

2022 NCH Technology Ltd sales £4.8M average selling price £1,100 across all stated goods and services.”

26. The evidence attached to the Form TM7 consists of three invoices (together with direct debit mandate form and a form showing their redacted bank details) and two letters relating to service cover/warranties.

27. The mark is shown at the top of the invoices as shown by this example:



NHC TECHNOLOGY LTD.
 COLOMENDY INDUSTRIAL ESTATE.
 RHYL ROAD
 DENBIGH,
 DENBIGHSHIRE, LL18 5TS

INVOICE

CUSTOMER ADDRESS: **DELIVERY COPY** DELIVERY: TELEPHONE: 01745 811200

[REDACTED]		[REDACTED]	
INVOICE NO. 024247	ORDER NO. [REDACTED]	S/LEDGER [REDACTED]	[REDACTED]
INVOICE DATE 06/04/2023	ORDER DATE 27/09/2021	AGENT MISCELLANEOUS	[REDACTED]

28. There are limited mentions of the goods actually being sold within the evidence, I have extracted the following:



NHC Technology Ltd
 Colomendy Industrial Estate
 Rhyl Road
 Denbigh
 Denbighshire
 LL18 5TS

The service department of Niagara Therapy and Adjustamtic Beds

Memo Order [REDACTED] Date [REDACTED]

Tag No.	Qty.	Description
	1	PLEASE COLLECT PART OF ORDER [REDACTED]
	1	BLEN CHAIR SERIAL [REDACTED]
	1	TAG NUMBER BLPSB000

I accept your offer to continue to receive monthly service cover in connection with my product as shown below:

- OT2666ELST 2.6 x 6.6 OTTOMAN ELECTRIC BED STONE 854816
- OT2666ELST 2.6 x 6.6 OTTOMAN ELECTRIC BED STONE 854817
- 9170CSTP CYCLO-THERAPY PAD CVM (LIME) 742549

29. One invoice only states that it is related to an 'advice note' and the third invoice is entirely redacted so there is no information available to me regarding what goods were sold.

Analysis

30. The mark, as registered has been shown on the invoices but I have been provided nothing to show it on the goods itself.

31. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the registration, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year periods. In making this assessment, I am required to consider all relevant factors, including:

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

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

33. I have been provided with turnover figures for two years which show fairly significant amounts - £5million and £4.8million respectively. There is no breakdown of these figures in regard to the goods relied upon by the opponent. I only have three heavily redacted invoices and so it is difficult to ascertain the scale and frequency of sales made.

34. I have also not been shown any evidence as to exactly what goods have been sold by the opponent. For example, I have no catalogue evidence or web page evidence showing any of the opponent's goods on sale. I only have the brief mentions of 'electric

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

beds' and a 'chair' as extracted above. It is therefore also difficult for me to judge the market for the goods that the opponent is provided.

35. I have no evidence regarding any marketing or expenditure relating to advertising and nothing which shows how the goods may be purchased by consumers. Further, the rest of the information within the invoices has been redacted and therefore, there is no evidence provided that shows the geographical extent of the use of the mark.

36. Even though the opponent has provided the abovementioned turnover figures, they have not provided me with evidence as to the goods those sales relate to nor any other evidence which might assist me in reaching a finding of genuine use in relation to each of the categories of goods relied upon. Therefore, taking all of the above into account, it is my view that the evidence is not sufficiently "solid or specific to enable proper and fair evaluation of the scope of protection to which the opponent is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the [applicant], the opponent and, it should be said, the public".² Thus, the evidence is not enough to establish that there has been genuine use of the mark for any of the opponent's services.

37. The consequence of my finding on use is that UK904517793 may not be relied upon in these proceedings. As there is no other basis for the opposition, the action must fail.

Conclusion

38. The opposition is unsuccessful, and the application may proceed to registration.

Costs

39. The applicant has been successful and is therefore entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 1/2023. I award the applicant the sum of £150. The sum is calculated as follows:

² See *Awareness Limited v Plymouth City Council*, Case BL O/230/13

Considering the notice of opposition and
preparing the counterstatement

£150

Total

£150

40. I therefore order NHC Technology Limited to pay NHC Group Limited the sum of £150. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of January 2025

L Nicholas
For the Registrar