O/0578/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3926279

BY MEDIGARMENTS LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

SENSORY DYNAMIC ORTHOSIS

IN CLASSES 10 AND 25

AND

AN OPPOSITION THERETO UNDER NUMBER 443476

BY DM ORTHOTICS LIMITED

Background and pleadings

1. On 23 June 2023, Medigarments Limited (“***the Applicant***”) applied to register in the UK the trade mark shown on the cover page of this decision (“***the Contested Mark***”). The application was accepted and published for opposition purposes on 7 July 2023 and registration is sought for the following goods in classes 10 and 25:

Class 10:	Garments for medical and therapeutic purposes; garments for orthopaedic purposes; garments for treating neurological conditions; orthotic textile products; medical devices for compression therapy; compression garments; apparatus for assessing the effects of compression therapy; apparatus for sizing compression garments; garments and medical devices for dynamic compression therapy; compression garments in the form of body suits, gauntlets, gloves, sleeves, belts, vests, leotards, shorts, socks, tights; medical support, compression and recovery clothing.
Class 25:	Clothing, footwear, headgear; sports clothing.

2. On 9 October 2023, DM Orthotics Limited (“***the Opponent***”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”).

3. The Opponent relies upon the following earlier United Kingdom Trade Mark (UKTM) for its opposition (“***the Earlier Mark***”):

   UK trade mark registration no: UK00003600939

   Mark’s representation: **DYNAMIC MOVEMENT ORTHOSES**

   Filing date: 25 February 2021

   Registration date: 18 March 2022

4. For the purpose of these proceedings, the Opponent is reliant upon all of the goods, for which the Earlier Mark is registered.

5. Given the filing date, the Opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements

specified within section 6A of the Act. As a consequence, the Opponent may rely upon all of the goods for which the Earlier Mark is registered without having to establish genuine use.

6. Under section 5(2)(b), the Opponent claims in its statement of grounds[1] that the application is similar to the Earlier Mark visually, phonetically and conceptually and that the goods in the application are identical/similar to the goods in the Earlier Mark and, as a result, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.

7. The Applicant filed a defence and counterclaim[2] denying there was any similarity to the Opponent's mark or that the application covered identical and/or similar goods to the earlier right.

8. The Applicant is represented by Adamson Jones and the Opponent is represented by Withers & Rogers LLP.

Relevance of EU law

9. 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 and submissions

10. Both parties filed evidence during the evidence rounds. The Opponent filed its evidence in the form of a witness statement of Martin Matthews, Managing Director of DM Orthotics Limited, a position held since 2004. The witness statement is dated 5 March 2024 and is accompanied by nine exhibits, (MM1 – MM9). The Applicant filed its evidence in the form of a witness statement of Colleen Elizabeth Ward, Director of Medigarments Ltd, a position held since January 2022. The witness statement is dated 28 May 2024 and is accompanied by six exhibits, (CW1 – CW6).

[1] Form TM7 filed on 9 October 2023, page 6, Q9.
[2] Form TM8 filed on 18 December 2023, paragraphs 3 and 7 of the counterstatement.

Neither party requested a hearing, but both parties filed written submissions in lieu. The evidence and submissions will not be summarised here, but I have given due consideration to all of the documents filed by both parties, and they will be referred to as and where appropriate during this decision.

Preliminary matters

Prior use of the Contested Mark

11. Ms Ward submitted, in her witness statement, that her company "*adopted its SENSORY DYNAMIC ORTHOSIS as a trade mark in the United Kingdom in 2006*" and that "*the mark, SENSORY DYNAMIC ORTHOSIS, was coined in-house by my company in 2006".*[3] Ms Ward also provided me with evidence concerning such uses dating back to 2010 (***Exhibit CW2***). I appreciate that the Applicant's evidence shows uses of the Contested Mark that predate the Earlier Mark's registration. However, such evidence does not assist the Applicant under section 5(2)(b) of the Act for the reasons given in Tribunal Practice Notice (TPN) 4/2009 which states (my emphasis):

    "4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another,* BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

    5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, <u>or having used the trade mark before the attacker used or registered its mark are wrong in law</u>. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

12. The Applicant has not brought any such counterclaim against the Opponent.

No actual confusion argument

[3] Colleen Elizabeth Ward's witness statement dated 28 May 2024, [10]-[11].

13. The Applicant argued that "*it is apparent that both my company and the Opponent have been operating in a similar medical field for over 20 years operating under different trade marks. To date, there has been no instances of any commercial confusion surrounding the use of the marks SENSORY DYNAMIC ORTHOSIS and DYNAMIC MOVEMENT ORTHOSES*".[4] Although I acknowledge these comments, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the Applicant's mark and the Opponent's mark. Whilst evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant. This is because the absence of confusion may be attributable to the Earlier Mark having only been used to a limited extent, in relation to only some of the goods for which it is registered, or in such a way that there has been no possibility of the one being mistaken for the other.

Decision

Section 5(2)(b)

14. Sections 5(2)(b) and 5A of the Act state:

> "5(2) A trade mark shall not be registered if because –
>
> > (a) […]
> >
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
> >
> > there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> 5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

[4] Colleen Elizabeth Ward's witness statement dated 28 May 2024, [19].

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant case law

15. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

17. 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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

18. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") 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 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."

19. Further, in *Kurt Hesse v OHIM*,[5] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,[6] the General Court ("GC") stated that "complementary" means:

[5] Case C-50/15 P.
[6] Case T-325/06.

> "[…] there is 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."

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "[…] 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) (IP TRANSLATOR)* [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 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."

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

> "[…] the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

22. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[7]

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

23. The goods to be compared are shown in the table below:

The Opponent's goods	The Applicant's goods
Class 10	**Class 10**
Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs; orthopaedic articles; suture materials; compressors for medical and surgical use; cannulae; elastic supportive and suspensory bandages; anti-embolism stockings; compression hosiery; elasticated garments, stockings, tights, pantyhose, ankle immobilisers, all for medical support or therapeutic purposes, orthopaedic support apparatus; surgical sponges; orthopaedic footwear; gloves for medical use; knee bandages; clothing adapted for medical use; disposable clothing for medical use; protective	Garments for medical and therapeutic purposes; garments for orthopaedic purposes; garments for treating neurological conditions; orthotic textile products; medical devices for compression therapy; compression garments; apparatus for assessing the effects of compression therapy; apparatus for sizing compression garments; garments and medical devices for dynamic compression therapy; compression garments in the form of body suits, gauntlets, gloves, sleeves, belts, vests, leotards, shorts, socks, tights; medical support, compression and recovery clothing.

[7] BL O/399/10

clothing for medical use; all included in Class 10.	
	<u>Class 25</u>
	Clothing, footwear, headgear; sports clothing.

24. The Applicant submitted that (original emphasis):

> "*The Applicant also denies that the goods covered by the present Application are identical with or similar to the goods for which the Opponent's earlier mark has been registered.*
>
> *In particular, the terms "Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs; orthopaedic articles; suture materials; compressors for medical and surgical use; cannulae; anti-embolism stockings; surgical sponges; orthopaedic footwear" are highly technical surgical instruments and/or tools for use in a <u>surgery theatre as a pre-surgical or postsurgical intervention</u>. Most surgical subspecialties have specialized equipment specific to the procedures they commonly perform (for example cardiopulmonary bypass, urology, gynaecology, endocrine surgery, and other specialties).*
>
> *The type of clothing mentioned in the Opponent's specification, namely "anti-embolism stockings; compression hosiery; elasticated garments, stockings, tights, pantyhose, ankle immobilisers, all for medical support or therapeutic purposes, orthopaedic support apparatus;" as well as "gloves for medical use; knee bandages; clothing adapted for medical use; disposable clothing for medical use; protective clothing for medical use" are sufficiently different from the type of clothing listed in the Applicant's specification in that they are not intended for the same purpose. The articles of clothing intended to be protected by the Applicant are not intended for pre-operative or post-operative surgical use or for use when performing or receiving surgical operations*".[8]

[8] Applicant's submissions in lieu dated 25 October 2024, [44] – [46].

25. The Opponent contended that *"the applied for goods in Class 10 and 25 are identical and similar to those registered under the Opponent's Mark in Class 10. The Class 10 specification includes the identical terms […]. As to the goods applied for in Class 25, they have the same nature as the registered goods in Class 10 as they are all to be worn, as such, they are similar to a degree*".[9]

Class 10

- "*Garments for medical and therapeutic purposes; garments for orthopaedic purposes; garments for treating neurological conditions; compression garments; garments […] for dynamic compression therapy; compression garments in the form of body suits, gauntlets, gloves, sleeves, belts, vests, leotards, shorts, socks, tights; medical support, compression and recovery clothing*"

26. I note the Applicant's submissions that its goods "*are not intended for pre-operative or post-operative surgical use or for use when performing or receiving surgical operations*", nonetheless I find that all the above terms essentially consist of medical garments used for the treatment or improvement of function or condition of persons. Therefore, they all fall within the Opponent's wider category of "*clothing adapted for medical use*". Thus, the respective goods are <u>identical</u> in line with the principle outlined in *Meric*.

- "*orthotic textile products*"

27. The above term refers to medical articles (made of fabric) aimed at supporting or assisting movement of a weak or injured part of the body. The Opponent's term "*orthopaedic articles*" refers to items of different nature for the treatment of the musculoskeletal system. Therefore, I find the Applicant's term falls within the Opponent's wider category of "*orthopaedic articles*" and, thus, are *Meric* <u>identical</u>.

- "*medical devices for compression therapy; apparatus for assessing the effects of compression therapy; apparatus for sizing compression garments; […] medical devices for dynamic compression therapy*"

[9] Opponent's submissions in lieu dated 25 October 2024, [31] – [33].

28. The Applicant's terms above fall within the Opponent's wider category of "*Surgical, medical, […] apparatus and instruments*". Therefore, they are identical in line with *Meric*.

Class 25

- "*Clothing, footwear, headgear; sports clothing*"

29. The Opponent's goods are specialised medical goods designed specifically to serve medical or therapeutic functions. For example, they may have adjustable closures, specialised fastenings, or compression capabilities to support and aid in the treatment of certain medical conditions. They may also have pockets or openings for medical devices or attachments. Medical garments are often made from specialised materials (e.g. with antimicrobial or moisture-wicking properties). Clothing, headgear, and footwear for medical purposes often need to adhere to specific medical standards or regulations to ensure safety, efficacy, and quality. In contrast, the Applicant's goods are typical clothing, primarily worn for general purposes such as comfort, fashion, protection from the elements, or for practising sport. The explanatory note for class 10 states that class 10 includes, inter alia, "*articles generally used for the diagnosis, treatment or improvement of function or condition of persons and animals*". Therefore, the various items of medical clothing, footwear and headgear covered by the Contested Mark in class 10 must primarily be regarded as articles for the diagnosis, treatment or improvement of function or condition of persons rather than as items of clothing, footwear and headgear, which they also are, but to a lesser extent.[10] Therefore, the competing goods are different since they all have different natures and purposes. Consequently, they have no relevant public in common. The goods are neither in competition nor complementary and do not coincide in pertinent distribution channels or origin. Therefore, the contested goods are dissimilar to the Opponent's goods.

30. Some similarity between the parties' goods is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

[10] Case T-20/19, Mediflex easystep / Stepeasy (fig.), EU:T:2020:309, [55].

"49. […] I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity".

31. The opposition against the terms that I have found to have no similarity to the Opponent's goods therefore fails at this point. For ease of reference, those terms are:

Class 25: Clothing, footwear, headgear; sports clothing.

32. I will now continue with the opposition based on section 5(2)(b) of the Act in respect of the similar goods.

The average consumer and the purchasing act

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

34. The average consumer for the goods in class 10 for which I found similarity is likely to be medical professionals that will apply (or prescribe) to their patients garments

or purchase devices for medical and therapeutic purposes (e.g., compression therapy) as well as the public at large purchasing directly the medical garments they need to wear for their own health. Whilst I appreciate the goods in question are not within class 5, they nonetheless are medical goods and, thus, I take into consideration the decision *Olimp Laboratories sp. z o.o. v EUIPO* (Case T-817/19) in which the General Court considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products. It said:

> "39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika* (TOLPOSAN), T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma* (COLINEB), T-36/17, not published, EU:T:2017:690, paragraph 49).
>
> 40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, TOLPOSAN, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).
>
> 41 […]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness".

35. The consumer, whether a member of the general public or a medical professional, would apply a higher-than-average degree of attentiveness during the purchasing process. The goods at issue will be purchased by the general public from pharmacies and by medical professionals from medical wholesalers. In both cases, visual considerations will play a dominant role, although aural considerations should not be discounted as advice may be sought from pharmacists, and particularly in the case of medical professionals, orders may be placed over the phone. When purchasing over the phone, aural considerations will dominate. When purchasing online, visual considerations will dominate. When purchasing in person, both aural and visual considerations will be taken into account.

Comparison of trade marks

36. It is clear form *Sabel* 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 the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, 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."

37. 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 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 marks.

38. The marks to be compared are as follows:

The Opponent's Earlier Mark	The Applicant's Contested Mark
DYNAMIC MOVEMENT ORTHOSES	SENSORY DYNAMIC ORTHOSIS

Overall Impression

39. The Opponent's mark consists of the three words 'DYNAMIC MOVEMENT ORTHOSES' represented in all-capitalised standard character. I find the overall impression equally rests in each and every word of the mark without any word standing out predominantly in the mark.

40. The Contested Mark is composed of the three words 'SENSORY DYNAMIC ORTHOSIS'. The Applicant contended that "*the word element SENSORY is positioned in a primary and dominant position. The word elements DYNAMIC and OTHOSIS follow the dominant element*".[11] The Contested Mark is comprised of three words all in standard character and in same size, thus, I cannot see how 'SENSORY' can occupy a predominant position within the mark. Conversely, I find that the Contested Mark's overall impression lies equally in all the three words composing the mark and in their combination as a whole.

Visual similarity

41. The Earlier Mark is comprised of three syllables for a total of 23 letters. The contested mark is also a three-syllable string of words for a total of 22 letters. The marks share the same word 'DYNAMIC' placed at the beginning of the Earlier Mark

[11] Applicant's submissions in lieu dated 25 October 2024 [22].

and at the centre of the Contested Mark (i.e., second word). Both marks terminate with words that have the same prefix, ‘ORTHO-’: respectively ‘ORTHOSES’ in the Earlier Mark and ‘ORTHOSIS’ in the Contested Mark. These two words exclusively differ in their penultimate letter (‘I’ vs ‘E’). Overall, the marks’ visual similarity is <u>medium</u>.

Aural similarity

42. The Applicant submitted that “*in an aural comparison, the shared DYNAMIC element will be pronounced identically as /daɪˈnæm.ɪk/. The similar element ORTHOSIS/ORTHOSES will be pronounced similarly as ORTHOSIS (/ɔːˈθəʊ.sɪs/) or ORTHOSES (/ɔːˈθəʊ.siːz/). The elements SENSORY (/ˈsen.sər.i/), and MOVEMENT (/ˈmuːv.mənt/) each require an entirely different pronunciation. Due to the position of each word within the marks in dispute, the points of aural difference in the respective marks will be so different that there is a very low degree of aural similarity. It is unlikely that an average consumer could mistake the sounds produced when enunciating each of the marks as if they are somehow similar*”.[12] The Opponent merely reported that “*the respective marks are also aurally similar*”.[13] I agree with the Applicant that, in both marks, the words ‘DYNAMIC’ will be pronounced according to their dictionary definition. Similarly, taking into consideration that the words ‘ORTHOSES’ and ‘ORTHOSIS’ differ only in their penultimate letter and that they have somewhat similar sounds, particularly given the propensity of the UK consumer to swallow or slur word endings,[14] I find the relevant consumers are likely to pronounce these words almost identically. The main aural difference between the mark lies in the words ‘MOVEMENT’ and ‘SENSORY’ in the competing marks. Overall, I find the marks to be aurally similar to a <u>medium</u> degree.

Conceptual similarity

43. Ms Ward, in her witness statement, submitted that “*the only common component between both marks is the word DYNAMIC which is a descriptive term understood*

[12] Applicant’s submissions in lieu dated 25 October 2024, [41].
[13] Opponent’s submissions in lieu dated 25 October 2024, [25].
[14] *Premier Brands UK Ltd. v. Typhoon Europe Ltd* ([2000] FSR 767).

within the medical field to mean something that 'pertains to or manifests force'. Both my Company and the Opponent use the word DYNAMIC to highlight that its products apply force namely compression". Ms Ward provided me with an extract from the Medical Dictionary to show the meaning of 'DYNAMIC' as indicated in her witness statement (***Exhibit CW6***). With regard to this definition, the Opponent contended that "*the dictionary definition provided is not one that is commonly used in the UK and is a 'Free online' dictionary, from a .com source which does not reflect the position in the UK, nor is relevant to the average consumer in the UK*".[15] The Opponent also directed me to a previous decision from the Registrar where the Hearing Officer disregarded a definition provided from the Merriam-Webster dictionary as being attributed to the United States. The Opponent also submitted that "*the words within each of the respective marks are used in everyday language and are clearly understood and attributed these everyday meanings by the average consumer*".[16]

44. 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* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

45. The parties did not provide me (or agree on) alternative meanings that may be understood by the professionals in the medical field. Therefore, I will take into consideration exclusively the everyday dictionary meanings these words have. Accordingly, the relevant consumer is likely to understand the Opponent's mark as alluding to multiple orthopaedic appliances or apparatuses (such as braces or splints) for or relating to an active movement of the body, whilst they will understand the Applicant's mark as alluding to an orthopaedic appliance or apparatus that allows or relates to an active sensation. Although both marks do not convey a clear meaning, I find both marks allude to orthopaedic appliances/apparatuses and to a force producing motion (i.e., something dynamic), but the concept of the senses is absent from the Opponent's mark. Overall, I find the marks share a <u>medium</u> conceptual similarity.

---

[15] Opponent's submissions in lieu dated 25 October 2024, [17].
[16] Ibid [14].

Distinctive character of the earlier mark

46. 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 *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)."

47. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

48. Dealing first with the inherent distinctiveness, I note the Opponent's goods at hand mainly relate to orthopaedic or orthosis articles (i.e., orthopaedic garments, appliances, or apparatuses that serve to support or assist movement in a body part). I find that the relevant consumers, when confronted with the Earlier Mark, will perceive all the verbal elements composing the mark ('DYNAMIC MOVEMENT ORTHOSES') as alluding to a characteristic of the goods (e.g., apparatuses or garments that enable consumers to perform energetic movements). Therefore, the

Opponent's mark consists of a combination of dictionary words that will be understood as alluding to a positive characteristic of the goods. Thus, the Earlier Mark is found to be inherently distinctive to a low degree.

49. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use. The Opponent submitted, in the witness statement from Mr Matthews, that the Opponent's company was founded in 2004 and that the Earlier Mark has been used for the goods at hand since then. Mr Matthews also provided me with revenues figures between 2015 and 2023. Mr Matthews did not specify the market share his company occupies and I am not familiar with the size of orthopaedic/orthosis garments or apparatuses, however it seems reasonable to assume that this industry in the UK is likely to be worth millions, or even, billions of pounds. The Opponent provided evidence of revenues of an average of 2 or 3 million pounds per year. I find these numbers to be relevant but not particularly impressive given the nature and presumable size of this market in the UK. Additionally, it is unclear whether these figures all relate to the marketing of the Earlier Mark and the goods at hand as the evidence is not broken down per category of goods. The Opponent also provided extracts of the products available online, advertising expenditure (a total of almost half a million of pounds for advertising between 2016 and 2023), a list of advertising initiatives, and examples of advertising material produced over the years as well as examples of manuals and training material. Whilst I acknowledge the Opponent's evidence and find that this shows uses of the Earlier Mark over various years, I do not believe that the evidence provided sufficiently shows that the Earlier Mark has acquired enhanced distinctiveness through use.

Likelihood of confusion

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency

principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

51. I have found the respective goods to be identical. The consumer is likely to pay a higher than average (medium) level of attention in their selection. The distinctiveness of the Earlier Mark is low. The visual, aural and conceptual similarity is medium. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind.

52. I acknowledge that both marks share the same word 'DYNAMIC', albeit in different positions within the marks, and both contain a descriptive reference to the goods at hand with the Earlier Mark's being in the plural form ('ORTHOSES') and the Applicant's in the singular ('ORTHOSIS'). The Contested Mark features the additional word 'SENSORY' (absent from the Earlier Mark) placed at the beginning of the mark and that does not create a syntactically correct structure with the following 'DYNAMIC' and 'ORTHOSIS'. Conversely, the Earlier Mark features the grammatically correct word combination 'DYNAMIC MOVEMENT' (i.e., adjective followed by noun) and a descriptive reference to the goods at hand ('ORTHOSES'). Considering that the goods in object are orthopaedic/orthosis garments or apparatuses aimed at supporting the user in moving parts of their body, the Earlier Mark consists of a lowly distinctive word combination alluding to a laudatory meaning for the Opponent's goods (i.e., orthosis apparatuses that enable the users to make energetic or effective movements). I remind myself that weak distinctive character of an earlier mark does not preclude a likelihood of confusion.[17] However, in *Whyte and MacKay*[18] the court stated that:

[17] *L'Oréal SA v OHIM*, Case C-235/05 P.
[18] *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33.

> "[…] if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion."

53. This point was taken further in *Nicoventures*[19] where Justice Birss stated:

> "[…] in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer that they might otherwise."

54. In my opinion, the word combination 'SENSORY DYNAMIC' contained in the Contested Mark is syntactically incorrect and does not convey a clear meaning in relation to the goods at hand although alluding to the fact that the goods (ORTHOSIS) relate to a sensory feeling (SENSORY) and movement (DYNAMIC). This difference in meaning and quirkiness in the Applicant's mark's structure will lead consumers, who pay a higher-than-average degree of attention, to have greater awareness of the differences between the marks. Therefore, it is my view that, despite the goods' identity and the similarity between the marks created by the commonality of the words 'DYNAMIC' and 'ORTHOS-S' (or the prefix 'ORTHO-') it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. Therefore, in my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers to avoid mistaking the marks for one another, when factoring in the principles of imperfect recollection, interdependency, and that consumers pay more attention to the beginning of marks[20] (where the marks differ as they begin with different words). As a result, I find that there is no likelihood of direct confusion.

55. I turn to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

---

[19] *Nicoventures Holdings Ltd v The London Vape Company Ltd* [2017] EWHC 3393.

[20] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

"16. 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 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 recognized 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

56. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[21] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere

---

[21] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

association not indirect confusion.[22] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[23]

57. I can see no logical basis for the Opponent to substitute the word 'MOVEMENT' in the Earlier Mark with 'SENSORY', invert the order of the words and make 'ORTHOSES' singular to create a new word combination that does not convey a clear meaning. For these reasons and taking into consideration the low inherent distinctive character of the Earlier Mark, and finding insufficient the Opponent's evidence to show enhanced distinctiveness through use, I do not believe the average consumer is likely to perceive the Contested Mark as a brand extension or sub-brand deriving from the Opponent. Therefore, I do not see how the average consumer, having recognised that the marks are not the same, is nevertheless likely to believe that they come from the same or linked undertaking(s). Therefore, I find there is no likelihood of indirect confusion.

<u>Conclusion</u>

58. The opposition fails under section 5(2)(b) of the Act.

59. The Applicant has been successful. Subject to any successful appeal, the application by Medigarments Limited may proceed to registration.

60. The Applicant is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the applicant as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Considering the Opponent's evidence and preparing evidence in reply	£600
Submissions in lieu of a hearing	£350
Total:	**£1,200**

[22] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[23] *Liverpool Gin Distillery*.

61. I order DM Orthotics Limited to pay Medigarments Limited the sum of **£1,200**. This sum is to 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 26th day of June 2025

Andrea Rossi

For the Registrar