

O/0617/26

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 4157608
BY OLTUNDE ASHAOLU
TO REGISTER THE TRADE MARKS:

DAVINCI

AND

dAvInci

(SERIES OF TWO)

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 600003684
BY INTUITIVE SURGICAL OPERATIONS, INC.

Background and pleadings

1. On 8 February 2025, OITunde Ashaolu (“the Applicant”) applied to register the trade mark series shown on the cover page of this decision (“the contested mark”) in the UK. The application was published in the Trade Marks Journal for opposition purposes on 14 February 2025 in respect of the following goods in class 9:

Class 9: Artificial intelligence software; Artificial intelligence software for analysis; Artificial intelligence software for healthcare; Artificial intelligence and machine learning software; Interactive software based on artificial intelligence; Software for the integration of artificial intelligence and machine learning in the field of Big Data.

2. On 14 May 2025, Intuitive Surgical Operations, Inc. (‘the Opponent’) filed a fast-track opposition, opposing the application in full under sections 5(1), 5(2)(a) and 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:

DA VINCI

United Kingdom trade mark: 3961285

Filed on: 27 September 2023

Registered on: 26 January 2024

4. For the purposes of these proceedings, the Opponent relies upon some of the goods and services for which the earlier mark is registered. ¹
5. The earlier mark, by virtue of its earlier filing date, constitutes an earlier mark in accordance with section 6 of the Act. The Earlier Mark was registered less than

¹ These goods and services are listed in Annex A, attached to this decision.

five years before the filing date of the Contested Mark and is therefore not subject to proof of use in accordance with section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use of the mark.

6. The Opponent claims that as a result of the identity or similarity between the Opposed mark and the Opponent's earlier mark, and the identity, similarity and complementarity between the opposed goods and the goods and services covered by the earlier mark, in addition to the enhanced distinctive character enjoyed by the Opponent's earlier mark, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.²
7. The Applicant filed a counterstatement³ claiming that the respective goods differ in nature, purpose, technical function, field of trade and consumer perception, such that there is no likelihood of confusion.
8. 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.”
9. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
10. 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, the

² Amended Form TM7F and statement of grounds filed 12 June 2025, page 11, paragraph 12

³ Form TM8 and counterstatement filed 20 October 2026, page 11

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

11. The Applicant is not represented and the Opponent is represented by Stobbs (IP) Limited.

RELEVANCE OF EU LAW

12. 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.

PRELIMINARY MATTERS

Authorities

13. I note that I have been directed to a number of previous Trade Mark decisions by the Opponent. As I am not bound by previous decisions, I confirm that I have read and considered these and will refer to them only where appropriate.

Comparison of goods

14. Within the Applicant's Form TM8 and counterstatement,⁴ I note that the Applicant has provided a table comparing the respective goods. Within the table, when making a comparison to the Opponent's *computer software applications, downloadable*, the Applicant has indicated that they have no downloadable software within their specification. However, I have to carry out a notional assessment based upon the specifications before me, (how the goods within the

⁴ Form TM8 and counterstatement filed 20 October 2026, page 14.

parties' specifications could be used and sold), and all the circumstances in which the mark applied for may be used if it were registered.⁵

DECISION

Sections 5(1), 5(2)(a) and (b) and 5A of the Act

15. Section 5(1) of the Act states that:

“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 mark is protected.”

16. Sections 5(2)(a) and (b) of the Act state that:

“A trade mark shall not be registered if because-

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

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

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

17. 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

⁵ *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

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

Identity of the marks

18. For a claim under section 5(1) or 5(2)(a) of the Act to succeed, the competing marks are required to be identical. Whether a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, where the Court of Justice of the European Union (“CJEU”) held that:

“54. [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

19. The marks at issue are word only marks. The Opponent’s mark consists of the words ‘DA VINCI’. The Applicant’s mark is a series of two marks and consists of the words DAVINCI and dAVinci. As the marks are word only marks, they can be used in any font, letter case or colour. However, in my view the size and stylisation of the letters ‘A’ and ‘I’ within the contested marks cannot be considered so insignificant that they would go unnoticed by the average consumer. Furthermore, the earlier mark contains a space between the letters ‘A’ and ‘V’ that is not present in the applied for marks. Therefore, the marks are not identical.

20. Having found that the contested marks and the earlier mark relied upon are not identical, the oppositions brought under sections 5(1) and 5(2)(a) fail. Accordingly, I will proceed on the basis of section 5(2)(b) only.

The Principles

21. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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; Page 8 of 20

(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 and services

22. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.

23. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

24. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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”.

25. 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.”

26. I bear in mind the following applicable principles of interpretation of terms within a specification from the judgement of *Sky v Skykick* [2024] UKSC 36:

“365. I agree with Sir Christopher Floyd and the other members of the Court of Appeal on this issue. The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

27. For the purposes of considering the issue of similarity, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.⁶

28. The Opponent has put forward what they consider to be their best case.⁷ I will therefore use their best case and perform the comparison in relation to class 9 and will only refer to the other classes as necessary. The competing goods are as follows:

Opponent's goods and services	Applicant's goods and services
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⁶ See *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

⁷ Opponent's submissions in lieu filed on 3 February 2026, paragraphs 14 - 16.

Class 9: Cables, electric; Cables, electric, namely cables used to connect electrosurgical instruments to electrosurgical energy generators; Teaching apparatus; Teaching apparatus, namely teleoperated apparatus with dual control consoles for simultaneous operation by instructor and student; Teaching apparatus, namely surgical robot simulators, surgical procedure simulators, and animal tissue models that simulate human tissue; Remote control apparatus; Remote control apparatus, namely teleoperated robotic arms and control units to operate teleoperated robotic arms; Downloadable image files; Downloadable image files, namely downloadable medical image files and medical video image files; Computer software applications, downloadable; Computer software applications, downloadable, namely software for operating surgical robots and robot-assisted surgery devices, and components thereof; Computer software applications, downloadable, namely software for providing information to surgeons and clinical staff during surgical procedures; Computer software applications, downloadable, namely software for operating computers that	Class 9: Artificial intelligence software; Artificial intelligence software for analysis; Artificial intelligence software for healthcare; Artificial intelligence and machine learning software; Interactive software based on artificial intelligence; Software for the integration of artificial intelligence and machine learning in the field of Big Data.
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simulate teleoperated robots, software for operating surgical robot simulators, and software for simulating surgical robot and robot-assisted surgical procedures; Computer software applications, downloadable, namely virtual and augmented reality software for teaching operation of surgical robots and for performing robot-assisted surgical procedures; Teaching robots; Teaching robots, namely robotic mechanisms that simulate surgical robot operation and robot-assisted surgical procedures; Telepresence robots; Telepresence robots, namely robots that allow an operator to feel present at a work site by displaying a real-time image of a teleoperated robotic end effector at the work site; Telepresence robots, namely teleoperated robots that allow clinical medical personnel to feel present with patients during a medical procedure; Telepresence robots for use in medical clinics; Virtual and augmented reality training simulation software in the field of science; Communications hubs, namely communications hubs for surgical robot information and patient medical information in the field of surgical robots and robot-assisted surgery; Microscopes for surgical operations; Scientific and medical data sets downloadable via the internet;	
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Software applications for mobile devices for monitoring and managing patient medical information; Software applications for use with mobile devices for monitoring and managing patient medical information; Training apparatus and simulators; Training apparatus and simulators, namely training apparatus and simulators for surgical robots and robot-assisted surgery; Simulators.	
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29. In its submissions in lieu,⁸ the Opponent submits the following:

“It is the Opponent’s submission that all of the goods covered by the Application fall within the general category of goods designated by the Opponent’s Earlier Mark, namely, “Computer software applications, downloadable”. As outlined in the Opponent’s Statement of Grounds, the Applicant’s software terms are all simply types or subcategories of the Opponent’s protected downloadable computer software applications.”

“On a natural and ordinary interpretation of the meaning of “Computer software applications, downloadable”, it is clear that all of the Applicant’s goods in class 9 fall within this category. Artificial intelligence software, is plainly a category of a downloadable computer software application. Software for the integration of artificial intelligence and machine learning in the field of Big Data, again, is plainly a type of computer software application that one may download.”

30. In its counterstatement, the Applicant submitted the following:⁹

“The Opponent’ goods are confined to Surgical apparatus and Hardware, Surgical robotics, and software inseparably linked to surgical procedures and

⁸ Opponent’s written submissions in lieu filed 3 February 2026, paragraphs 14-15.

⁹ Applicant’s counterstatement filed 28 August 2025, page 6.

training, while our goods are of general artificial intelligence in the field of medical research, cutting across medical and non-medical scientists, and with no connotations to surgical practice or robotics. The respective goods differ in nature, purpose, technical function, field of trade, and consumer perception, such that there is no likelihood of confusion under the principle of speciality or the average consumer test."

Class 9

Artificial intelligence software; Artificial intelligence and machine learning software.

31. The Applicant's '*Artificial intelligence software*' is computer software designed to perform tasks that normally require human intelligence, such as reasoning, learning and decision making, whereas '*Artificial intelligence and machine learning software*' is software that includes artificial intelligence capabilities and specifically incorporates machine learning such as algorithms, that learn from data to improve performance over time. I compare these goods to the Opponent's broad term '*Computer software applications, downloadable*' which are software programs designed for users to perform specific tasks and can be downloaded and installed onto a computer or device. Insofar as the Applicant's artificial intelligence software is downloadable, it will be encompassed within the Opponent's broader category of downloadable application software and therefore considered identical in line with the principle set out in *Meric*. However, if the above goods are not encompassing of one another, the goods will overlap in nature, share the same general purpose and users and overlap in trade channels. The goods will not be complementary nor competitive. Accordingly, I find the contested goods to be similar to a high degree.

Artificial intelligence software for analysis; Artificial intelligence software for healthcare.

32. The Applicant's '*Artificial intelligence software for analysis*' and '*Artificial intelligence software for healthcare*' are forms of artificial intelligence software designed to perform specific functions. Insofar as the Applicant's artificial

intelligence software is downloadable, it is encompassed within the Opponent's broader category of downloadable application software and is therefore considered identical in line with the principle set out in *Meric*. However, if the above goods are not encompassing of one another, for the reasons provided above in paragraph [31], the contested goods will be similar to a high degree.

Interactive software based on artificial intelligence.

33. The Applicant's above goods refer to software that enables systems to engage in real-time, two way communication with users or other systems. Insofar as the Applicant's artificial intelligence software is downloadable, it is encompassed within the Opponent's broader category of downloadable application software and is therefore considered identical in line with the principle set out in *Meric*. However, if the above goods are not encompassing of one another, for the reasons provided above in paragraph [31], the contested goods will be similar to a high degree.

Software for the integration of artificial intelligence and machine learning in the field of Big Data.

34. The Applicant's above goods refer to software for processing and analysing large volumes of data using artificial intelligence techniques. Insofar as the Applicant's artificial intelligence software is downloadable, it is encompassed within the Opponent's broader category of downloadable application software and is therefore considered identical in line with the principle set out in *Meric*. However, if the above goods are not encompassing of one another, for the reasons provided above in paragraph [31], the contested goods will be similar to a high degree.

Average consumer and the purchasing act

35. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

36. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers.
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

37. In its counterstatement, the Applicant submits that its goods are not aimed at the general public or clinicians generally. Rather, it states that the goods are intended for use by medical AI researchers and developers. Furthermore, the Applicant submits that the respective publics are different and highly sophisticated.¹⁰ However, the assessment is a notional and objective one based on the specifications as registered or applied for, rather than on the parties' actual or intended use. I therefore do not consider it appropriate to consider this argument any further.

38. The average consumer for the goods at issue consists of members of the general public, professionals and specialist users. The goods will mainly be available via general and specialist retailers, and their online or catalogue equivalents. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants or specialist advisors. Both software and AI goods can range greatly in both costs and frequency of purchase- there are some low cost/free versions accessed frequently and some higher value resources which are purchased infrequently. In respect of the level of attention paid, I am of the view that when selecting the goods, the consumer is likely to consider software/hardware compatibility with other components or systems or that the goods possess the required features. In this regard, when selecting the goods at issue, the average consumer is likely to pay at least a medium degree of attention.

Comparison of marks

39. 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

¹⁰ Form TM8 and counterstatement filed 20 October 2026, page 13, section 5

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.”

40. 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.

41. The respective trade marks are shown below:

Earlier mark	Contested mark
DA VINCI	

Overall impression

42. The earlier mark is a word only mark that consists of the words 'DA VINCI', presented in a black standard uppercase typeface. I find that the words will be perceived together as the name 'DA VINCI', rather than as two separate words with individual meanings. I therefore consider that the combination of these words will create a distinctive unit, and as such, the overall impression of the mark will reside in the mark as a whole.

43. The contested mark is a series of two marks, 'DAVINCI' and 'dAvInci', presented in a stylised typeface. In both marks the letter 'A' and the first letter 'I' are presented in uppercase letters, in bold and the colour purple. In the first mark in the series, the remaining letters are shown in smaller, uppercase grey letters. In the second mark in the series, the remaining letters are shown in grey lowercase letters. When combined, the 'A' and 'I' elements in both marks, due to their size and colour, may be perceived as an initialism, which will be understood as meaning 'Artificial Intelligence', which is descriptive of the Applicant's goods. I therefore find the word 'DAVINCI/dAvInci' to be the dominant and distinctive element of the contested marks, with the stylisation playing a lesser role.

Visual similarity

44. Visually, the marks coincide insofar as they share the same sequence of seven letters, 'DAVINCI/dAvInci/DA VINCI'. However, the earlier mark is presented as two words, whereas the contested marks appear as one. Both contested marks are stylised and, within the marks, the letter 'A' and first letter 'I' appear in bold purple uppercase letters, while the remaining letters are shown in grey. The remaining letters in the first mark in the series are all uppercase letters, whereas the remaining letters in the second mark in the series are all lowercase letters. In contrast, the earlier mark is presented in uppercase letters, in a plain black font, with no stylisation. Taking all of these factors into account, I find the marks to be visually similar to a high degree.

Aural similarity

45. From an aural perspective, the marks coincide in the word(s) 'DAVINCI/dAvInci/DA VINCI', each consisting of 3 syllables. Although the earlier mark contains a space after the word 'DA', I do not consider that consumers will amplify the space in the earlier mark. Accordingly, I find the marks to be aurally identical.

Conceptual similarity

46. 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*.²⁰ The assessment must, therefore, be made from the point of view of the average consumer.

47. In its counterstatement,¹¹ the Applicant has indicated that 'DAVINCI' is an acronym for 'Diagnostic Algorithm for Intelligent Clinical Intervention'. However, in the absence of evidence, this is not a conceptual factor that I can consider as I do not believe this information is known to consumers at large. In my view, I find that a significant proportion of average consumers will recognise both marks as a reference to the famous artist and painter Leonardo Da Vinci. To that extent, the marks are conceptually identical. However, some consumers may notice the larger and stylised letters 'A' and first letter 'I' in the contested mark which may give rise to a point of conceptual distinction between the marks, where the letters are perceived as the acronym for 'Artificial Intelligence'. For those consumers, the marks will be conceptually similar to a high degree.

Distinctive character of the earlier trade mark

48. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

¹¹ Form TM8 and counterstatement filed 20 October 2026, page 13, section 5

“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). 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).”

49. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. In its statement of grounds, the Opponent claims enhanced distinctive character in its earlier mark,¹² in light of the use it has made of the mark and the recognition and reputation enjoyed by the mark in the UK.

50. However, in this regard it is noted that the Opponent has not filed any evidence to support such a finding. Consequently, I have only the inherent position to consider.

¹² Amended Form TM7F and statement of grounds filed 12 June 2025, paragraph 11.

51. The earlier mark consists of the words 'DA VINCI', which as referred to above, may be recognised by a significant proportion of consumers as a reference to the well-known artist and painter Leonardo Da Vinci. It is neither allusive nor descriptive of the Opponent's goods and services. Accordingly, I find the Opponent's mark to be inherently distinctive to a medium degree.

Likelihood of Confusion

52. 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. It is necessary for me to keep in mind the distinctive character of the earlier 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.

53. Earlier in the decision I found:

- the marks to be visually similar to a high degree, aurally identical and conceptually similar to a high degree or identical.
- the earlier mark to be a word mark comprising of the words 'Da Vinci' and that the combination of these words will create a distinctive unit, and as such, the overall impression of the mark will reside in the mark as a whole.
- the dominant and distinctive element of the contested marks is the word 'DAVINCI/dAvInci', with the stylisation playing a lesser role.

- the parties' goods to be identical or similar to a high degree.
- the earlier mark to have a medium level of distinctive character for the goods and services at issue.
- the average consumer for the goods at issue will be members of the general public, professional and specialist users, who will select the goods primarily by visual means, although I do not discount an aural component. The average consumer will pay at least a medium degree of attention during the purchasing process.

54. Taking all of the above factors into account, I consider that the average consumer, who rarely has the opportunity to compare marks side by side, would be likely to confuse one mark with the other. This is particularly so given the high degree of visual similarity, the aural identity and the identical or high degree of conceptual similarity between the marks. I consider that the 'AI' element being in different font/colour is likely to be overlooked as it is somewhat descriptive of the goods applied for. I am satisfied that the average consumer, even when paying at least a medium degree of attention during the predominantly visual purchasing process, is unlikely to recall the marks accurately and may overlook or misremember the minor differences between them. Accordingly, I find that there will be a likelihood of direct confusion between the marks.

55. In the event that I am wrong in the above finding, I will now go on to consider indirect confusion, which 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*, BL O/375/10:

"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.”

56. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

57. Where a proportion of average consumers recognise the differences between the marks, owing largely to the stylisation of the letter’s ‘A’ and ‘I’ in the contested marks, I find that they are nonetheless likely to be indirectly confused. The stylisation has no counterpart in the earlier mark and, insofar as it may be perceived as the initialism for ‘Artificial Intelligence’, it is descriptive of the goods applied for. In my view, the average consumer is likely to perceive those visual differences as a sub-brand or brand extension focussed on AI, rather than indicating that the goods come from different undertakings.

CONCLUSION

58. The opposition under section 5(2)(b) of the Act has been successful. Subject to any successful appeal, the application will be refused.

COSTS

59. Award of costs in Fast Track proceedings commenced after 1 February 2023 are based upon the scale as set out in Tribunal Practice Notice 1 of 2023. As the

Opponent has been successful, they are entitled to a contribution towards their costs. I therefore award the Opponent the sum of £550. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£250
Preparing written submissions in lieu	£200
Official fee:	£100
Total:	£550

60. I therefore order OITunde Ashaolu to pay Intuitive Surgical Operations, Inc. the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 17th day of July 2026

Mrs Joanne Roberts
For the Registrar

Annex A

Class 9:

Cables, electric; Cables, electric, namely cables used to connect electrosurgical instruments to electrosurgical energy generators; Teaching apparatus; Teaching apparatus, namely teleoperated apparatus with dual control consoles for simultaneous operation by instructor and student; Teaching apparatus, namely surgical robot simulators, surgical procedure simulators, and animal tissue models that simulate human tissue; Remote control apparatus; Remote control apparatus, namely teleoperated robotic arms and control units to operate teleoperated robotic arms; Downloadable image files; Downloadable image files, namely downloadable medical image files and medical video image files; Computer software applications, downloadable; Computer software applications, downloadable, namely software for operating surgical robots and robot-assisted surgery devices, and components thereof; Computer software applications, downloadable, namely software for providing information to surgeons and clinical staff during surgical procedures; Computer software applications, downloadable, namely software for operating computers that simulate teleoperated robots, software for operating surgical robot simulators, and software for simulating surgical robot and robot-assisted surgical procedures; Computer software applications, downloadable, namely virtual and augmented reality software for teaching operation of surgical robots and for performing robot-assisted surgical procedures; Teaching robots; Teaching robots, namely robotic mechanisms that simulate surgical robot operation and robot-assisted surgical procedures; Telepresence robots; Telepresence robots, namely robots that allow an operator to feel present at a work site by displaying a real-time image of a teleoperated robotic end effector at the work site; Telepresence robots, namely teleoperated robots that allow clinical medical personnel to feel present with patients during a medical procedure; Telepresence robots for use in medical clinics; Virtual and augmented reality training simulation software in the field of science; Communications hubs, namely communications hubs for surgical robot information and patient medical information in the field of surgical robots and robot-assisted surgery; Microscopes for surgical operations; Scientific and medical data sets downloadable via the internet; Software applications for mobile devices for

monitoring and managing patient medical information; Software applications for use with mobile devices for monitoring and managing patient medical information; Training apparatus and simulators; Training apparatus and simulators, namely training apparatus and simulators for surgical robots and robot-assisted surgery; Simulators.

Class 38:

Providing access to databases; Providing access to databases, image libraries, and video libraries in the field of surgical robots and robot-assisted surgery; Providing access to databases, image libraries, and video libraries for assisting clinical medical personnel; Streaming of data; Streaming of data in the field of surgical robots and robot-assisted surgery; Streaming of data for assisting clinical medical personnel; Transmission of digital files; Transmission of digital files in the field of surgical robots and robot-assisted surgery; Transmission of digital files for assisting clinical medical personnel.

Class 41:

Arranging and conducting in-person and online conferences, symposiums, seminars, forums, workshops, and coaching for clinical and academic personnel in the field of surgical robots and robot-assisted surgery; Coaching, training, and know-how transfer services in the field of surgical robots and robot-assisted surgery; Educational examination services in the field of surgical robots and robot-assisted surgery; Educational examination services in the nature of providing educational examinations and tests, and analyzing educational test scores and data, in the field of surgical robots and robot-assisted surgery; Educational services in the field of surgical robots and robot-assisted surgery; Educational services in the nature of providing medical education and training services to clinical and academic personnel in the field of surgical robots and robot-assisted surgery; Providing online electronic publications, images, and videos, not downloadable, in the field of surgical robots and robot-assisted surgery; Rental of training simulators in the field of surgical robots and robot-assisted surgery; Medical education and training services for clinical and academic personnel in the field of surgical robots and robot-assisted surgery; Providing continuing medical education courses; Computer-based simulation training services in the field of medical technology; Organization of conferences and symposiums in the field of medical science.

Class 42:

Platform as a service; Platform as a service, namely services featuring computing platforms for use together with medical and surgical devices; Platform as a service, namely digital surgery services for controlling and employing surgical robots and robot-assisted surgery; Platform as a service, namely digital surgery services for monitoring, tracking, managing, and conducting surgical procedures; Software as a service; Software as a service in the nature of providing online non-downloadable software for improving surgical outcomes and reducing patient harm by the enhancement of preoperative planning, surgical performance, therapeutic support, and training; Software as a service in the nature of providing online non-downloadable software algorithms that learn to develop, run, analyze, classify, and take action in response to data related to monitoring, tracking, managing, and conducting surgical procedures; Software as a service in the nature of providing online non-downloadable software for medical use before, during, and after surgical robot and robot-assisted surgery procedures; Software as a service in the nature of creating and maintaining websites for users to obtain information about, participate in discussions about, and receive feedback from peers about, surgical robots and robot-assisted surgical procedures; Software as a service in the nature of providing online electronic storage and retrieval of patient medical information and images; Software as a service in the nature of providing online access to libraries of videos in the field of surgical robots and robot-assisted surgical procedures; Software as a service in the nature of providing online computerized imaging alteration of anatomical images for surgery; Software as a service in the nature of providing online information search engine services that allow patients to locate hospitals, clinics, and medical personnel that provide surgical robot and robot-assisted surgical procedures; Information and computer technological consultancy, namely providing consulting services via a global communications network about the operation, repair, and maintenance of surgical robots, and hardware and software components thereof; Information and computer technological consultancy, namely providing consulting services in the development of surgical robots and robot-assisted surgery procedures; Information and computer technological consultancy, namely providing consulting services in the nature of evaluating and advising on workflow in existing

hospital medical operating rooms and advising on design of surgical suites for surgical robots and robot-assisted surgical procedures.

Class 44:

Rental of surgical robots; Medical clinic services; Medical clinic services in the nature of providing patient medical data and patient medical images to clinical medical personnel before, during, and after surgery; Medical clinic services in the nature of providing computer-enhanced 3D anatomical image data before, during, and after surgery; Telemedicine services; Telemedicine services, namely providing surgical robots and robot-assisted surgery systems that operate at a distance between surgeon and patient; Medical services in the nature of providing health information via a web site to surgeons, hospital personnel, and patients about surgical robots, robot-assisted surgery, and surgical programs.