O/0921/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001757540 IN THE NAME OF ESSILOR INTERNATIONAL FOR THE FOLLOWING MARK:

H3D+

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000447116 BY H3D, INC.

BACKGROUND AND PLEADINGS

1. Essilor International (“the holder”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 8 August 2023 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 26 January 2024. The holder seeks protection in the UK for the following goods:

   Class 9: Apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial parameters; apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial parameters, i.e. apparatus and instruments for measuring various parameters for spectacle lenses, including the shape and dimensions of the spectacle frame, the position of the eyes in relation and the wearer's visual behavior, in particular by detecting and measuring eye and head movements in response to visual stimuli; software dedicated to promoting sales of spectacle lenses and/or frames by means of on-screen demonstrations and simulations; software for online ordering of spectacle lenses and ophthalmic lenses.

2. The IR is derived from an earlier trade mark registered by the holder in France. As such, the IR benefits from an earlier priority date of 9 March 2023, being the filing date of the holder’s French mark.

3. On 25 April 2024, H3D, Inc. (“the opponent”) filed an opposition against the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

   H3D

   UK trade mark number UK00801359509
   Filing date 08 June 2017; registration date 15 June 2018.

Relying on all goods, being:

Class 9: Cameras; cameras for monitoring and inspecting equipment in a nuclear power station; computer cameras; computer hardware and software for medical imaging apparatus; digital cameras; gamma radiation detector for electronic detection of hidden contraband; gamma radiation detectors; medical research equipment, namely, computers, gamma cameras, collimators, aperture plates and computer software, all sold together as a unit for use in high resolution, high sensitivity tomographic image processing and imaging in the field of nuclear medicine; nuclear medical research imaging apparatus; nuclear medicine imaging apparatus for research purposes; radiation-measuring instruments; radiation detectors.

Class 10: Medical imaging apparatus, namely nuclear imaging spectrometers and equipment therefore.

4. The opponent's mark is a comparable mark based on an earlier International Registration designating the EU ("IR"). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IR's. These comparable marks enjoy the same filing and registration dates as their European counterparts.

5. By virtue of relying on section 5(2)(b) of the Act, the opponent argues that the marks at issue are highly similar and that the goods of the parties are highly similar. As such, the opponent claims that there exists a likelihood of confusion between the marks.

6. The holder filed a counterstatement denying the claims made against it. It is noted that the holder also elected to request proof of use from the opponent.

7. The opponent is represented by Harper James. The holder is represented by CAM Trade Marks & IP Services. Only the opponent filed evidence in chief. No hearing

was requested and only the opponent filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

8. 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

9. The opponent's evidence in chief came in the form of the witness statement of Michael Streicher dated 24 September 2024. Mr Streicher is the President and Chief Operating Officer of the opponent. Mr Streicher's statement is accompanied by Exhibit MS and was adduced in order to demonstrate genuine use of the opponent's mark.

10. I do not intend to summarise the evidence in full here or the submissions of the opponent. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

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

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark

in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

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

12. Section 6A is also relevant. It reads:

"(1) This section applies where:

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services."

13. Section 100 of the Act is also relevant. It reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

14. As the opponent's mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

15. Given its earlier filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark completed its registration process over five years prior to the priority date of the IR. As set out above, the holder requested that the opponent provide proof of use in respect of its mark. As a result, the opponent's mark is subject to the proof of use assessment.

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

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C– 721/18 Ferrari SpA v DU [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all

the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

17. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use. […] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having

regard to the interests of the proprietor, the opponent and, it should be said, the public."

18. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> '[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends on who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.'

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services

covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

19. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

20. While section 6A of the Act (cited above) is silent on the issue of IRs, the Trade Marks (International Registration) Order 2008 sets out that this section of the Act extends to apply to IRs. As such, the relevant period for the present assessment is the five-year period prior to the priority date of the IR, being 9 March 2023. The relevant period is, therefore, 10 March 2018 to 9 March 2023 ("the relevant period").

21. As the opponent's mark is a comparable mark, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.[1] As the relevant period falls partially prior to IP Completion Day, the EU is the relevant territory from 10 March 2018 to 31 December 2020 and the UK is the relevant territory from 1 January 2021 to 9 March 2023. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice for the European Union ("CJEU") noted that:

"It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."

[1] See paragraph 4 of Tribunal Practice Notice 2/2020

And

"50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

22. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[2] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

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

    a. The scale and frequency of the use shown;
    b. The nature of the use shown;
    c. The goods/services for which use has been shown;
    d. The nature of those goods/services and the market(s) for them; and
    e. The geographical extent of the use shown.

[2] *Jumpman* BL O/222/16

Evidence of use

24. I remind myself that for the purposes of these proceedings the relevant period in which the opponent must demonstrate genuine use is 10 March 2018 to 9 March 2023.

25. I note that Mr Streicher has filed some evidence in Exhibit MS of his witness statement that falls outside of the relevant period. Given this, I will not consider this evidence and will, instead, focus on the relevant evidence only.

26. I note the following from the witness statement of Mr Streicher:

    a. Mr Streicher sets out that the opponent specialises in the development and manufacturing of high-performance radiation detection systems and the opponents products are used in a wide range of applications such as nuclear power, medical imaging, environmental monitoring and national security. He states that the opponent's products are currently being integrated into imaging devices for head and neck tumour removing surgeries. Mr Streicher's reference to 'currently' is somewhat vague as this statement is dated after the relevant period so it is likely that the reference to the opponent's products being integrated into imaging devices for head and neck tumour removing surgeries relates to the provision of the same going forward and not during the relevant period.

    b. Mr Streicher states that the opponent has positioned itself as a leader in the field of radiation detection since its establishment in 2011 and has continually used the opponent's mark throughout its marketing and promotion of various products internationally and in the UK.

    c. Mr Streicher has provided evidence of a document listing the opponent's sales record which details yearly revenue achieved through the sale of H3D products in the UK from 2012 to 2024.[3] It is noted that revenue is only made from 2021 to 2024. As the relevant period concludes in March 2023, all of

[3] Page 1 of Exhibit MS.

the 2024 revenue totalling $416,000.00 falls wholly outside of the relevant period and cannot be taken into consideration. Additionally, it is possible to infer that the majority of the goods sold in 2023 may have been sold after 9 March 2023, falling outside of the relevant period. Consequently, not all of the revenue totalling $825,000.00 for 2023 can be taken into account and while I have no way to determine precisely how much, this is something I will take into account going forward. The total turnover figure for 2021 – 2023 is $1,334,000.00.

d. Mr Streicher sets out that the opponent has achieved sales figures of approximately $1,750,000 since launching its products in the UK in 2017 in respect of the sale of industrial imaging spectrometers, directional gamma-ray imaging spectrometers, handheld radioisotope identification devices, 3D radiation imaging instruments and other instruments for high-resolution spectroscopy and imaging of radioactive sources. However, as per the preceding paragraph, the sales figure in the relevant period is less than this.

e. To support some of the sales figures, Mr Streicher provided eleven purchase orders.[4] Five out of the eleven purchase orders were dated outside of the relevant period so I will not take those into account. Additionally, two of the purchase orders were identical so I will discount one of these purchase orders. This leaves five purchase orders totalling $464,000. I note that the opponent's mark is not featured on these purchase orders. I have no explanation from the opponent as to what any of the descriptions or abbreviations in the purchase order descriptions mean.

f. Undated product images demonstrating the use of H3D on the products have been provided by Mr Streicher.[5] However, approximately only half of the products are labelled and have an accompanying description making it difficult to decipher what some of these products are. Two of the images which are not labelled show the product being used by UK security personnel during a demonstration event in the UK where the UK security

[4] Pages 2-14 of Exhibit MS.
[5] Pages 15-20 of Exhibit MS.

personnel appear to be operating surveying equipment. No costs information regarding the products has been provided.

g. Mr Streicher has provided sales invoices which show the opponent's mark.[6] Mr Streicher states in his witness statement that the opponent's mark is shown on all administrative materials in relation to sales of the products including but not limited to purchase order confirmation documentation, sales invoices and product brochures. Examples of the invoices are provided at pages 21-28 of Exhibit MS. The opponent's mark is displayed as follows:

Three out of the eight invoices provided are outside of the relevant period and cannot be taken into consideration, leaving five relevant invoices totalling $438,215.11. Four out of the five invoices match four of the purchase orders. I have no explanation from the opponent as to what any of the descriptions or abbreviations in the invoices mean.

h. Mr Streicher has also provided evidence via internet screenshots from online archives of the H3D website from 2018-2023.[7] One of the ten screenshots provided is outside of the relevant period. Mr Streicher submits that the opponent's website has been displaying the opponent's mark since 2011. However, the earliest screenshot provided is from 2018. I have not been provided with any website analytics which shows the number of users who visited the company website in the UK during the relevant period.

i. Evidence has also been provided of archived images of the 'southern scientific' website which Mr Streicher states features extensive use of the opponent's mark in the marketing and promotion of the opponent's products since 2020.[8] However, only one screenshot for 2021 and one screenshot

[6] Pages 21-28 of Exhibit MS.
[7] Pages 29-38 of Exhibit MS.
[8] Pages 39-40 of Exhibit MS.

for 2022 have been provided. The screenshots show the opponent's mark and some images of the opponent's products. Additionally, the screenshots show that southern scientific has stated that "H3D is a leader company in producing and commercializing high-performance imaging spectrometers with CZT detectors. Quickly identifying and localizing gamma-ray sources with a single measurement, H3D is revolutionizing how measurements are performed. H3D instruments are used in more than 75% of US nuclear power plants and they find multiple applications in nuclear power plants and nuclear waste facilities".

j. Mr Streicher has provided a copy of an invoice dated 30 April 2019 for an event called the IEEE Nuclear & Plasma Sciences Society, Manchester Central Convention Complex the opponent operated a booth at between 26 October and 2 November 2019.[9] I have not been provided with any documentary evidence of how many visitors attended this conference but the evidence does go some way to demonstrate that the opponent has been engaged in marketing or promotional efforts.

k. Mr Streicher has provided evidence of an example of the banner used by the opponent at conference booths.[10]

l. Mr Streicher has produced a photo of the opponent winning an award at the World Nuclear Exhibition in Paris.[11] However, I have not been provided with any evidence as to what year this award was won (which could be outside of the relevant period), how the award was determined (be that via a judging panel or voting by consumers), what the award was in relation to or the reach of said award amongst consumers.

m. Mr Streicher submits that the opponent promotes its products in the UK through advertisements in technical periodicals. Mr Streicher has provided a copy of the opponent's promotion in a technical periodical[12] but has not

[9] Pages 41-44 of Exhibit MS.
[10] Page 45 of Exhibit MS.
[11] Page 46 of Exhibit MS.
[12] Pages 47-49 of Exhibit MS.

provided the name of the technical periodical, the date it was published or how many consumers it may have reached.

n. Mr Streicher submits that the opponent also promotes its products online through its YouTube channel which was created on 27 October 2020 and has had over 9500 views. Mr Streicher states that the YouTube Channel features prominent use of H3D and has submitted two pages of evidence to support this.[13] While noted, this evidence is of very little assistance because the view count cannot wholly be attributed to the UK or EU and, in any event, it is very low. Further, the subscriber count of 14 subscribers is very low. Additionally, as the print out date of the webpage is not shown, the follower or viewer count could potentially include those that were accrued after the relevant period. The evidence shows the opponent's mark in more than one variation on the YouTube Channel as follows:

o. Mr Streicher states that the opponent likely has somewhere around 80% of the market share for gamma-ray imaging detectors in the UK. He states there are very few competing products available and the opponent has proved more successful than the few competing products due to the competitive advantages their products offer and as a result he predicts that the opponent holds a large proportion of the market share in the UK.

p. Finally, Mr Streicher sets out the products sold by the opponent and how they covered the holder's goods. Mr Streicher states the opponent's goods are:

    i. Directional Gamma-Ray Imaging Spectrometers and Handheld Radioisotope Identification Devices;

[13] Pages 55-56 of Exhibit MS.

ii. High-Resolution Spectroscopy Instruments and Industrial Imaging Spectrometers; and
iii. 3D Radiation Imaging Instruments.

The undated photos of products that are labelled are:

iv. Industrial Imaging Spectrometer;
v. Handheld Radioisotope Identification Device (RIID);
vi. Custom Integrable CZT Module;
vii. Permanent-Mount Spectrometer; and
viii. Collimated Gamma-Ray Imaging Spectrometer.

I have not been provided with images or any explanatory information of the following products referenced in Mr Streicher's witness statement:

ix. Directional Gamma-Ray Imaging Spectrometers – I have been provided with images and a description of a "Collimated Gamma-Ray Imaging Spectrometer". However, I am not aware if this is the same or different to a "Directional Gamma-Ray Imaging Spectrometer".
x. High-Resolution Spectroscopy Instruments – however, I presume this could include industrial imaging spectrometers, permanent mount spectrometers and collimated gamma-ray imaging spectrometers if these are in high-resolution; and
xi. 3D radiation Imaging Instruments – however, I presume this could include industrial imaging spectrometers and collimated gamma-ray imaging spectrometers.

Two undated photos the opponent has provided show the opponent's product being used by UK security personnel in a demonstration event in the UK where the opponent's product appears to be being used as surveying equipment. No images have been provided showing the use of the opponent's products in a medical context.

Form of the mark in use

27. Before I move on to assess the sufficiency of the evidence, I shall begin by addressing the way in which the opponent's mark has been displayed in relation to the relevant goods in evidence.

28. In the product images (pages 15-20 of Exhibit MS) the opponent's mark is displayed in the following ways:





29. The UK sales invoices, screenshots from the online archives of the opponent's website and the archived images of the southern scientific website display the mark as follows:

30. The YouTube Channel displays the opponent's mark as follows:

31. Where there is use of a sign in a differing form to the mark, as registered, it is necessary to decide whether that sign constitutes genuine use of the registered mark. In making that decision, I have borne in mind the following case law.

32. In *Colloseum Holdings AG v Levi Strauss & Co.*,[14] the CJEU found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestlé, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use

[14] Case C-12/12

made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark Page 16 of 25 must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

33. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a

figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO,* EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl,* EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis,* EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 Alder, Page 17 of 25 EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

34. The opponent's mark is registered as a plain word mark. This means that it is the word itself, not the word in a particular typeface or capitalisations, that is protected.[15] The distinctive character of the opponents mark lies in the element "H3D". In my view the average consumer would perceive it as an invented word.

[15] *PresentService Ullrich GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-66/11, paragraph 57

35. In the mark as used on the products, invoices and the opponent's website, the word is presented in different colours with a slightly stylised font altering the appearance of the number 3. However the number 3 and the word is still easily identifiable. I consider that the use of the different font and colours do not detract from the word itself and will be merely seen as an alternation of the stylistic elements of the mark. As such, I do not consider that the addition of the colouring for the letters and the coloured outline for the number "3" or the stylisation of the letters and number alter the distinctive character of the registered trademark. Therefore, use of the opponent's mark in these way does constitute genuine use of the earlier mark relied upon.

36. While this applies for the marks shown at paragraphs 28 and 29 above, I do not consider that it applies to the mark shown at paragraph 30 above.

37. When used in this way, I consider that the mark used clearly alters the opponent's mark as registered. In accordance with the *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, I am satisfied that these changes alter the distinctive character of the registered mark. The font used and the positioning of the letters in a 3D manner results in the element "H3D" being distorted and no longer remaining the dominant or distinctive element. In addition, I consider that the stylistic alterations to the mark mean that it can be read as "3HD" or "H3D" or "3DH", two of which are not the mark as registered. The 3D nature of the letters results in the average consumer not being able to be read it easily and renders the mark incapable of being perceived as an indication of the origin of the goods.[16] These are non-distinctive amendments that do alter the distinctive character of the mark so much that the use of the opponent's mark in this way does not constitute genuine use of the earlier mark relied upon. Overall, this stylised variant of the registered word only mark is not acceptable.

[16] *Hyphen GmbH v EU IPO*, Case T-146/15.

Assessment of evidence

38. I will now consider an assessment of the evidence. This is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[17]

39. As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

40. I find there are several shortcomings in the evidence. The first is that I have no explanation from the opponent as to what any of the descriptions or abbreviations mean on the purchase orders or invoices and how these match the undated photographs of the products supplied. Secondly, Mr Streicher submits that the opponents products are used in medical imaging but I have not been provided with any evidence showing the goods used in such a context. On this point, I consider it reasonable to expect further evidence supporting such a point to have been filed and, without such, I am entitled to be sceptical of this claim. Thirdly, the geographical extent of the use of the mark has not been submitted by Mr Streicher. From reviewing the evidence I can see that some documentation is addressed to West Sussex and Cumbria. However, due to the heavy redactions of the invoices and purchase order these are the only geographical locations I can determine. Given the highly specialised nature of the goods, I understand that these may only be used in a few locations in the UK.

41. I remind myself that the total turnover figure for 2021 – 2023 is $1,334,000.00. While the figures are provided in dollars, the evidence confirms that these figures detail yearly revenue achieved through the sale of H3D products in the UK. However, part of the 2023 revenue cannot be taken into account given the relevant

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

period ends on 9 March 2023, resulting in the overall revenue figure being considerably less than $1,334,000. As set out above, I have no way to determine the figure precisely but this is something I must bear in mind.

42. Mr Streicher, in his witness statement states “H3D Inc. likely has somewhere around 80% market share for gamma-ray imaging detectors in the UK. He also states that there are very few competing products available and H3D products have proved more successful than the few competing products due to the competitive advantages our products offer, as a result he predicts that H3D holds a large proportion of the market share in the UK”. This statement uses words such as “likely” and “we would predict” which do not provide any certainty in relation to the percentage provided or the proportion of the market share the opponent owns in the UK. However, this statement is unchallenged by the holder and I have no reason to disbelieve the claim that the market share lies somewhere around the figure claimed. 80%, on the face of it, appears an extremely high share of the market. However, I am not the average consumer for these goods and I have not been provided with any information as to the size of the market or the nature of the goods that sit within the market. As I have no information about the size of the market or the cost of the opponent’s products, I am unable to determine whether the market at issue is a particularly competitive one or whether it is a niche market with very little undertakings operating within it. In respect of this claim, I appreciate that it could be argued that Mr Streicher’s statement regarding the market share is a bare assertion. However, even if this was the case, I am satisfied that the entirety of the evidential picture is sufficient to demonstrate genuine use. My reasons follow.

43. The case law sets out that use need not be quantitatively significant in order for it to be deemed genuine. Instead, the opponent is only required to provide that it attempted to create or preserve a market share for the relevant goods. In the present case, having taken all of the evidence into account, I am of the view that turnover figures of approximately $1,334,000.00 together with the marketing of the goods (albeit I appreciate that this is limited) shows that the opponent has sought to create or preserve a market share for its goods and, as such, I consider it

sufficient to warrant a finding that there has been genuine use of the opponent's mark.

Fair specification

44. The next step is for me to consider whether or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

45. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.

46. Having summarised the evidence above, it is clear to me that it covers a range of goods that are technical in nature. This is on the basis that the goods cover spectrometers and those relating to gamma radiation. To assist the issue of a fair specification, I note that at paragraph 18 of Mr Streicher's witness statement, he has provided a breakdown of the products sold by the opponent and how these individual products cover the specific goods in the opponent's specification. While this evidence is unchallenged, I am required to prepare a fair specification based on the evidence filed and my assessment of the same. Therefore, it is not appropriate for me to simply accept the explanation given by the opponent.

47. My issue with the opponent's evidence is its technical nature. On this point I note paragraph 18 of Mr Streicher's witness statement which states how the opponent's

goods are similar to the holder's. However, in the evidence I have been provided with little indication as to what the goods are used for and, further, there are a range of goods in the opponent's specification that it has made no efforts to demonstrate use for at all. As I am not the average consumer of the goods in question, the technical nature of the evidence renders it somewhat difficult to arrive at a fair specification. For the avoidance of doubt in respect of this issue, I consider that an explanation from the opponent as to the use of the opponent's goods would have been of some assistance in helping to understand what the evidence shows. In the absence of such, I am required to assess what category of goods the evidence shows based on my own understanding of what the evidence shows.

48. Photos of UK security personnel using H3D equipment have been provided which appear to show them operating surveying equipment.[18] Given this, I have come to the conclusion that use has been shown for "Gamma radiation detector for electronic detection of hidden contraband". No evidence of the goods being used for medical equipment has been provided apart from an undated conference banner that refers to "Medical / R & D", however, I have no explanation as to what this means in terms of the actual use of the goods. Further, I note Mr Streicher's statement that H3D's products are used in a wide range of applications such as "medical imaging". This is noted, however, I have set out above that there is no example of any goods in the evidence being used in a medical context and, without such, I am not willing to simply infer that the use covers such goods, especially in light of the technical nature of the evidence. Given this, I find that the opponent has not genuinely used its mark on any class 10 goods.

49. Having considered a fair specification in the context of the evidence as a whole, I have come to the conclusion that the following terms reflect a fair specification of the goods:

Class 9: Gamma radiation detector for electronic detection of hidden contraband; gamma radiation detectors; radiation-measuring instruments; radiation detectors.

[18] Page 18 of Exhibit MS.

50. As for the remaining goods relied upon, I conclude that either no evidence has been provided in respect of the remaining goods (or those goods are broader terms that are suitably covered by the terms listed above) or, where it has, I am not satisfied that it is sufficient to demonstrate genuine use. As such, the opposition is not permitted to proceed in respect of the following goods:

Class 9: Cameras; cameras for monitoring and inspecting equipment in a nuclear power station; computer cameras; computer hardware and software for medical imaging apparatus; digital cameras; medical research equipment, namely, computers, gamma cameras, collimators, aperture plates and computer software, all sold together as a unit for use in high resolution, high sensitivity tomographic image processing and imaging in the field of nuclear medicine; nuclear medical research imaging apparatus; nuclear medicine imaging apparatus for research purposes.

Class 10: Medical imaging apparatus, namely nuclear imaging spectrometers and equipment therefore.

Section 5(2)(b): legislation and case law

51. Section 5(2)(b) of the Act reads as follows:

> "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".

52. Section 5A of the Act states as follows:

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

53. The following principles are gleaned from the decisions of the 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM"),* Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public 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

54. The competing goods are as follows:

The opponent's goods	The holder's goods
Class 9 Gamma radiation detector for electronic detection of hidden contraband; gamma radiation detectors; radiation-measuring instruments; radiation detectors.	Class 9 Apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial parameters; apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial parameters, i.e. apparatus and instruments for measuring various parameters for spectacle lenses, including the shape and dimensions of the spectacle frame, the position of the eyes in relation and the wearer's visual behavior, in particular by detecting and measuring eye and head movements in response to visual stimuli; software dedicated to promoting sales of spectacle lenses and/or frames by means of on-screen demonstrations and simulations; software for online ordering of spectacle lenses and ophthalmic lenses.

55. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

"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."

56. 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.

57. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

58. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] 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 of 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."

59. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.[19]

60. The opponent's position is that holder's goods and the opponent's goods are highly similar. I have submissions in respect of the goods from the opponent. The holder denies that there is any similarity between the opponent's goods and its own goods. The holder states that the opponent's instrumentation is for purposes completely different from that of the holder (whose business is that of spectacles as opposed to detecting or measuring radiation in a nuclear power station or used in nuclear medicine). The holder states that the consumer would not purchase the

[19] BL O-399-10 (AP)

instrumentation from the same source, would not think of any relationship between the two marks and would not be confused by the IR. The opponent submits that when the holder's goods are considered alongside the opponent's goods such as "medical imaging apparatus", "computer hardware and software for medical imaging apparatus" and "radiation-measuring instruments" they have similarities as they are all likely to be used in a clinical or medical setting, the goods all have a medical focus (the holder's focus being optometry and the opponent's focus being general medical imaging) and the goods are all used for the purpose of measuring and/or producing visual images for medical purposes. The submissions of the opponent are based on the opponent's specification as it appeared prior to the genuine use assessment. Given my findings in the fair specification section above, these opponent's submissions are of no assistance.

61. I do not intend to summarise the remaining comments of the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

Apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial parameters; Apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial parameters, i.e. apparatus and instruments for measuring various parameters for spectacle lenses, including the shape and dimensions of the spectacle frame, the position of the eyes in relation and the wearer's visual behavior, in particular by detecting and measuring eye and head movements in response to visual stimuli.

62. I understand the above terms to cover apparatus and instruments for measuring and displaying optical, ophthalmic and/or facial measurements. The closest comparable term in the opponent's specification is "radiation-measuring instruments". The purpose of these goods differ in that the holder's goods relate to measurements of optical and facial parameters whereas the opponent's goods measure radiation. As far as I am aware, the holder's goods do not use radiation to measure the relevant parameters and neither does an eye omit radiation to the point that it needs to be measured. As such, I see no reason to find that there is any overlap in nature or method of use between these goods. The user is likely to be different, being an ophthalmologist for the holder's goods and a radiation

specialist or scientist for the opponent's goods. On this point, I have nothing before me in evidence to suggest any overlaps in these factors (such as a suggestion that the user of the holder's goods also use the opponent's, for example). Taking all of the above into account, I find these goods are dissimilar.

Software dedicated to promoting sales of spectacle lenses and/or frames by means of on-screen demonstrations and simulations.

63. The above term is software to promote sales of spectacle lenses and/or frames via demonstrations on-screen and simulations. There are no comparable terms in the opponent's specification and even in comparing the above to any of the opponent's class 9 goods, I find that there are no obvious overlaps between them. As such, I find these goods to be dissimilar.

Software for online ordering of spectacle lenses and ophthalmic lenses.

64. The above term is software for ordering spectacle lenses and ophthalmic lenses online. There are no comparable terms in the opponent's specification and I find no obvious overlaps between the above term and any of the opponent's class 9 goods. Therefore, I find that there is no degree of similarity between the above good and the opponent's goods. I find them to be dissimilar.

Conclusion on the goods comparison.

65. Where there is no similarity of goods, there can be no likelihood of confusion in respect of oppositions brought under s5(2)(b) grounds.[20] As a result, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail. As I have found all of the goods to be dissimilar, the opposition fails in its entirety.

[20] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

CONCLUSION

66. The opposition fails in its entirety. Therefore, the IR may, subject to any successful appeal of my decision, proceed to protection in the UK for all of the goods contained in its specification.

COSTS

67. The holder has been successful and is entitled to a contribution towards their costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of £250 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing the counterstatement:	£250
Total:	**£250**

68. I therefore order H3D Inc. to pay Essilor International the sum of £250. The above sum should 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 30th day of September 2025

N Barratt
For the Registrar