

O/1005/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3592558
IN THE NAME OF BIEDERMANN TECHNOLOGIES GMBH & CO. KG
TO REGISTER AS A TRADE MARK**

in:situ

**IN CLASSES 5, 10, 40, 41,
42 and 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 427015
BY ADAPTTECH LIMITED**

BACKGROUND AND PLEADINGS

1. On 08 February 2021, Biedermann Technologies GmbH & Co. KG (“the applicant”) applied to register trade mark number UK3592558 for the mark “**in:situ**” in the United Kingdom.¹ The application was accepted and published for opposition purposes on 23 July 2021, in respect of the following goods and services:

Class 5: *Implants comprising living tissue, in particular surgical implants of living tissues, orthopaedic implants of living tissue, spinal implants of living tissue, biological bone and skin tissue for subsequent implantation, surgical implants comprising living tissue; bone cement for medical purposes; materials for coating surgical implants.*

Class 10: *Surgical, medical, dental and veterinary apparatus and instruments, in particular instruments and apparatus for orthopedic surgery, trauma surgery and neurosurgery; implants for trauma surgery; implants for neurosurgery; surgical implants; special purpose surgical instruments for inserting implants and for handling implants, in particular for inserting spinal implants; bone implants; orthopedic implants; spinal implants; medical guidewires; orthopedic articles; artificial limbs, eyes and teeth; suture materials; instruments for inserting bone cement.*

Class 40: *Custom-manufacture of medical and surgical apparatus and instruments; Custom-manufacture of surgical implants; Custom-manufacture of orthopedic implants; Custom-manufacture of special purpose surgical instruments for inserting and handling implants.*

Class 41: *Education; training courses; the aforesaid services including the organisation, conducting, arranging and managing of seminars, workshops and academies for teaching purposes in the field of orthopedic surgery, in particular in the field of trauma surgery, spinal*

¹ This case was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, based on European Union Trade Mark (“EUTM”) No. 018285626. The EU filing date was 06 August 2020.

surgery; provision of training courses and exhibitions for educational purposes in the field of using instruments and implants for orthopedic surgery, in particular for trauma surgery and for spinal surgery; providing electronic publications, publication of texts (other than publicity texts; editing and publication of printed matter; film and video production, namely providing and compilation of texts and images on video films, DVDs and similar electronic data carriers, included in class 41, all of the aforesaid in the field of orthopedic surgery, in particular in the field of trauma surgery, spinal surgery.

Class 42: *Scientific and technological services and research and design relating thereto; industrial analysis and research services; technical consultancy; technical project planning; technical project management services; development of surgical articles; development of orthopedic articles; development of implants; development of instruments for inserting implants; material development; material testing; providing technical know-how; testing of basic material; scientific and technological services and research and design related thereto in the field of orthopedic surgery and bone implants; technical consultancy, technical project planning, technical project management in the field of orthopedic surgery and bone implants.*

Class 44: *Medical services, in particular techniques for fixing bone implants in bone.*

2. The application is opposed by ADAPTTECH LIMITED (“the opponent”). The opposition was filed on 20 September 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all goods and services in classes 5, 10, 40, 42 and 44 only of the application. The opponent relies upon the following mark:

Insight

UK trade mark registration number 917886280

Filing date: 11 April 2018

Registration date: 04 January 2019

Registered in Classes 9, 10, 40 and 44

Relying on all goods and services, namely:

Class 9: *Computer software for designing, manufacturing and fitting prostheses and prosthetic devices.*

Class 10: *Prosthetic devices and artificial implants; monitoring and measuring devices for monitoring fit of prostheses and prosthetic devices, excluding X-ray machines for medical purposes.*

Class 40: *Custom manufacture of prostheses and prosthetic devices.*

Class 44: *Consultancy services relating to prostheses and prosthetic devices; Fitting of artificial limbs, prosthetic devices and prostheses.*

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM or International Trade Mark designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.²

4. The opponent submits that the competing marks have a similar visual appearance and are pronounced similarly, and that they are also conceptually similar. It submits that the goods and services of the opposed marks refer to identical and similar products as the goods and services of the earlier mark which the opposition is based upon.

² See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

5. The applicant filed a counterstatement denying the claims. It denies that the marks are visually, aurally or conceptually similar or similar overall, and it denies that the goods and services covered by the application are identical and highly similar. Consequently, the applicant denies that there is a likelihood of confusion and requests that the opposition be dismissed in its entirety, that the mark applied for be accepted for registration, and that an award of costs is made in its favour.

6. Both parties filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. Neither party elected to file evidence and neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Sonnenberg Harrison and the applicant is represented by Marks & Clerk LLP.

Preliminary Indication

8. I note that, in accordance with rule 19(2) of the Trade Mark Rules 2008, a Preliminary Indication (PI) was issued to both parties on 06 December 2021, where it was considered that, notwithstanding any similarity between the respective goods and services, there was insufficient similarity between the respective marks to give rise to a likelihood of confusion, either direct or indirect, and that the opposition should be rejected for all goods and services.

9. PIs are issued to give the respective parties an indication on a prima facie basis as to the likely decision in respect of the grounds of opposition, giving either party the opportunity to withdraw either the opposition or the application accordingly, without incurring costs. The PI is not binding, nor does it replace a full decision by a different Hearing Officer.

10. As the PI was that the opposition should be rejected for all goods and services, if the opponent does not accept the PI, it has the right to give formal notice to that effect. In order to proceed, the opponent must file Form TM53, otherwise the opposition is

accordingly deemed to be withdrawn. In this instance, the opponent was given until 6 January 2022 to file the Form TM53, should it wish to do so.

11. On 5 January 2022, the opponent filed Form TM53 to request that the opposition proceed to evidence rounds.

12. As I am not bound by the PI, following careful consideration of all of the evidence before me, I will make my own assessment of the likelihood of confusion between the competing marks and the opponent's goods and services against the opposed goods and services of the application.

DECISION

13. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

14. Section 5(2)(b) is relied upon, which reads as follows:

“5(2) A trade mark shall not be registered if because -

...

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

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

15. Section 5A states:

“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.”

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

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

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(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;

...”

17. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods and services indicated without having to prove that genuine use has been made of them.

18. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation 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 greater 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 to mind the earlier mark, is not sufficient;

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

20. I am therefore mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

21. The goods and services to be compared are:

Opponent’s goods and services	Applicant’s goods and services
	<p><u>Class 5</u> <i>Implants comprising living tissue, in particular surgical implants of living tissues, orthopaedic implants of living tissue, spinal implants of living tissue, biological bone and skin tissue for subsequent implantation, surgical implants comprising living tissue; bone cement for medical purposes; materials for coating surgical implants.</i></p>
<p><u>Class 9</u> <i>Computer software for designing, manufacturing and fitting prostheses and prosthetic devices.</i></p>	
<p><u>Class 10</u> <i>Prosthetic devices and artificial implants; monitoring and measuring devices for monitoring fit of prostheses and prosthetic devices, excluding X-ray machines for medical purposes.</i></p>	<p><u>Class 10</u> <i>Surgical, medical, dental and veterinary apparatus and instruments, in particular instruments and apparatus for orthopedic surgery, trauma surgery and neurosurgery; implants for trauma surgery; implants for neurosurgery; surgical implants; special purpose surgical</i></p>

	<p><i>instruments for inserting implants and for handling implants, in particular for inserting spinal implants; bone implants; orthopedic implants; spinal implants; medical guidewires; orthopedic articles; artificial limbs, eyes and teeth; suture materials; instruments for inserting bone cement.</i></p>
<p><u>Class 40</u> <i>Custom manufacture of prostheses and prosthetic devices.</i></p>	<p><u>Class 40</u> <i>Custom-manufacture of medical and surgical apparatus and instruments; Custom-manufacture of surgical implants; Custom-manufacture of orthopedic implants; Custom-manufacture of special purpose surgical instruments for inserting and handling implants.</i></p>
	<p><u>Class 42</u> <i>Scientific and technological services and research and design relating thereto; industrial analysis and research services; technical consultancy; technical project planning; technical project management services; development of surgical articles; development of orthopedic articles; development of implants; development of instruments for inserting implants; material development; material testing; providing technical know-how; testing of basic material; scientific and technological services and research and design related thereto in the field of orthopedic surgery and bone implants; technical consultancy, technical project planning, technical project management in the field of orthopedic surgery and bone implants.</i></p>

<p><u>Class 44</u> <i>Consultancy services relating to prostheses and prosthetic devices; Fitting of artificial limbs, prosthetic devices and prostheses.</i></p>	<p><u>Class 44</u> <i>Medical services, in particular techniques for fixing bone implants in bone.</i></p>
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22. 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”.³

23. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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”.⁴

24. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

³ Paragraph 29

⁴ Paragraph 23

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.⁵

26. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁶

27. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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.”⁷

⁵ Paragraph 82

⁶ Paragraph 5

⁷ Paragraph 12

28. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

30. In its written submissions, the opponent submits that the goods and services of the opposed application which refer to implants are similar to the services of the earlier trade mark which all relate to prosthesis and prosthetic devices because many implants are prosthetics and as such, goods and services which cover implants automatically include prosthetics and prosthetic devices. It further submits that any of the applicant’s other goods and services relating to the medical field must be

considered strongly similar if not identical to the opponent's goods and services if they do not explicitly exclude prosthetic devices.

31. I note that in its written submissions, the applicant has provided an in-depth comparison of the competing goods and services, outlining why they consider certain goods and services to be dissimilar. I further note that it accepts that the class 10 goods of the application may be considered similar to the opponent's broad term "*Prosthetic devices and artificial implants*", although it has not submitted to what degree. It also accepts that there are broad similarities between some of the competing services in class 40 insofar as the services all being custom-manufacture, however, it submits that custom manufacture of prostheses is dissimilar to custom manufacture of instruments for inserting implants.

32. I will now set out my own considerations of the comparison of goods and services, grouping them together where this is appropriate, as per *Separode*.

Class 5

33. "*Implants comprising living tissue, in particular surgical implants of living tissues, orthopaedic implants of living tissue, spinal implants of living tissue, biological bone and skin tissue for subsequent implantation, surgical implants comprising living tissue.*"

The applicant's various implants as listed above all share the same basic purpose as the opponent's Class 10 goods, "*Prosthetic devices and artificial implants*", i.e. they are all intended to be transplanted into the body of a human or animal in order to replace or enhance the original organ or body part. The nature of the competing goods differs in that the applicant's goods are natural, comprising living tissue, while the opponent's goods are synthetic (artificial), although I would assume that the method of use would be somewhat similar. I would expect, depending on the individual circumstances, the competing goods to be in competition with each other, with an informed choice being made by either the medical practitioner or the recipient on whether to select implants that are artificial or of living tissue. Both sets of goods are specialist in nature and I would expect there to be an overlap in channels of trade. To my mind, the applicant's "*Implants comprising living tissue, in particular surgical*

implants of living tissues, orthopaedic implants of living tissue, spinal implants of living tissue, biological bone and skin tissue for subsequent implantation, surgical implants comprising living tissue” and the opponent’s “*Prosthetic devices and artificial implants*” are similar to a medium degree.

34. “*Bone cement for medical purposes; materials for coating surgical implants.*”

While I consider the above goods to be different in nature and method of use to the opponent’s “*Prosthetic devices and artificial implants*”, there will be an overlap in users. With the absence of evidence to the contrary, I would expect the competing goods to each be provided by a different specialist manufacturer, therefore to my mind, although the goods may be used together, they are not complementary in a trade mark sense to the extent that the average consumer would automatically expect them to be the responsibility of the same undertaking, as outlined in *Boston Scientific*. I therefore consider that “*Bone cement for medical purposes; materials for coating surgical implants*” to be similar to “*Prosthetic devices and artificial implants*” to a low degree.

Class 10

35. “*Surgical, medical, dental and veterinary apparatus and instruments, in particular instruments and apparatus for orthopedic surgery, trauma surgery and neurosurgery.*”

I note the applicant’s use of “*in particular*” following the broad term “*Surgical, medical, dental and veterinary apparatus and instruments*” above. In *Häfele GmbH & Co. KG v OHIM*, Case T-336/09, the GC stated that the words “*in particular*” used in a description of goods are merely indicative of an example, rather than limiting those goods to those listed following the term.⁸ I consider that the wider term “*Surgical, medical, dental and veterinary apparatus and instruments, in particular instruments and apparatus for orthopedic surgery, trauma surgery and neurosurgery*” encompasses the opponent’s “*Monitoring and measuring devices for monitoring fit of prostheses and prosthetic devices, excluding X-ray machines for medical purposes*”, rendering the competing goods identical as per the principle outlined in *Meric*.

⁸ Paragraph 33.

36. *“Implants for trauma surgery; implants for neurosurgery; surgical implants; bone implants; orthopedic implants; spinal implants; artificial limbs, eyes and teeth.”*

I note that some of the aforementioned implants have not been described as either living or artificial, however, as the goods have been applied for under Class 10 rather than Class 5 under the Nice Classification, I construe them as being artificial in nature. As such, I consider the applicant’s *“Implants for trauma surgery; implants for neurosurgery; surgical implants; bone implants; orthopedic implants; spinal implants; artificial limbs, eyes and teeth”* to be identical to the opponent’s *“Prosthetic devices and artificial implants”*.

37. *“Orthopedic articles”*

As outlined in *Skykick*, I consider the above term to be somewhat vague. However, the core meaning of “orthopedic” means “relating to problems affecting people’s joints and spines”.⁹ As such, I would expect *“Orthopedic articles”* to encompass the opponent’s *“Prosthetic devices and artificial implants”* and I therefore find the competing goods identical as per the principle outlined in *Meric*. If I am wrong in this, then I consider them to be similar to a high degree.

38. *“Special purpose surgical instruments for inserting implants and for handling implants, in particular for inserting spinal implants; medical guidewires; suture materials; instruments for inserting bone cement.”*

While there will be an overlap in users of the above goods and the opponent’s artificial implants, inasmuch that the surgeon inserting the implants will require special purpose surgical instruments and materials in order to carry out such procedures, the nature and purpose of the goods, and the methods of use are different. In my view, the implants and the surgical instruments and materials are likely to be produced by different specialist manufacturers to the extent that the consumer will not expect the respective goods to come from the same trade source. Therefore, I find *“Special purpose surgical instruments for inserting implants and for handling implants, in particular for inserting spinal implants; medical guidewires; suture materials; instruments for inserting bone cement”* to be dissimilar to the earlier *“Prosthetic devices and artificial implants”*. However, if I am wrong in this, and there is any

⁹ Source: Collins English Dictionary online, accessed on 28 October 2022.

similarity, it will be at a very low level based on the overlap in users I have identified above, with the possibility that a proportion of consumers may presume complementarity, as outlined in *Boston Scientific*.

Class 40

39. *“Custom-manufacture of surgical implants; Custom-manufacture of orthopedic implants.”*

I consider the above services to be self-evidently identical to the opponent’s *“Custom manufacture of prostheses and prosthetic devices”*.

40. *“Custom-manufacture of medical and surgical apparatus and instruments; Custom-manufacture of special purpose surgical instruments for inserting and handling implants.”*

The core nature of custom-manufacture will be the same for both the above services and the opponent’s *“Custom manufacture of prostheses and prosthetic devices”* in that both involve the bespoke manufacture of high quality goods on a small scale, rather than the mass-production of goods. However, the end product derived from the respective services at issue are different. There will be an overlap in users and also in common purpose i.e. both the instruments and the implants will be used in conjunction for the good of the recipient. Nonetheless, I consider that the average consumer of each of the services will be specialists in their field who would not automatically expect the provider of *“Custom-manufacture of medical and surgical apparatus and instruments; Custom-manufacture of special purpose surgical instruments for inserting and handling implants”* to be the same provider as for the opponent’s *“Custom manufacture of prostheses and prosthetic devices”*. Consequently, I consider there to be a low degree of similarity between the respective services.

Class 42

41. *“Scientific and technological services and research and design relating thereto; industrial analysis and research services; technical consultancy; technical project planning; technical project management services; providing technical know-how.”*

The above terms are so broad that they could relate to a vast range of fields, inter alia, from agriculture to aviation, computing to engineering, and as such it can be argued that the term clearly encompasses the field of medicine, including in relation to the goods and services relied upon by the opponent. In *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, Case C-307/10, the CJEU held that the use of the general indications of the class headings of the Nice Classification may be acceptable¹⁰, and thus the terms within the application were accepted at examination stage. However, in relation to this opposition, I also note the guidance outlined in *Avnet* regarding broad specifications. The opponent has not specifically stated why it considers the aforementioned opposed services are similar to the goods and services of the earlier mark, aside from a general statement submitting that “any other goods and services in the opposed trade mark application relating to the medical field must be considered to be strongly similar if not identical to the opponent’s goods and services if they do not explicitly exclude prosthesis and prosthetic devices.”¹¹ The applicant’s services are not specific to the medical field, and there is a lack of clarity on the part of both the applicant and the opponent, so without further evidence, I consider the applicant’s “*Scientific and technological services and research and design relating thereto; industrial analysis and research services; technical consultancy; technical project planning; technical project management services; providing technical know-how*” to be dissimilar to any of the opponent’s goods and/or services.

42. “*Material development; material testing; testing of basic material.*”

For the same reasons outlined above in paragraph 41, I consider the applicant’s broad term “*Material development; material testing; testing of basic material*” to be dissimilar to any of the goods and services relied upon by the opponent.

43. “*Development of surgical articles; development of orthopedic articles; development of implants; development of instruments for inserting implants; scientific and technological services and research and design related thereto in the field of orthopedic surgery and bone implants; technical consultancy, technical project*

¹⁰ At [64].

¹¹ See page 5 of the opponent’s written submissions dated 14 April 2022.

planning, technical project management in the field of orthopedic surgery and bone implants.”

The opponent’s earlier mark covers *“Prosthetic devices and artificial implants; monitoring and measuring devices for monitoring fit of prostheses and prosthetic devices, excluding X-ray machines for medical purposes”* in Class 10. While I acknowledge that services are not the same as goods, nevertheless, there will be an overlap in consumers of the respective goods and services. The goods and services are directly connected, as without the design and development of goods such as implants, there cannot be any resulting end product. I also consider there to be a complementary relationship between the consultancy services and the goods at issue, and as per *Kurt Hesse*, I do not consider it unreasonable for consumers to expect the same or economically linked undertakings to provide both goods and services. I therefore find them similar to a medium degree.

Class 44

44. *“Medical services, in particular techniques for fixing bone implants in bone.”*

As mentioned earlier in this decision, I construe the term *“in particular”* within the specification as an example of the medical services provided rather than being restricted to only *“techniques for fixing bone implants in bone”*. Therefore, I consider that the broad term *“Medical services, ...”* encompasses the opponent’s *“Consultancy services relating to prostheses and prosthetic devices; Fitting of artificial limbs, prosthetic devices and prostheses”*, and as such the services are identical as per *Meric*.

The average consumer and the nature of the purchasing act

45. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he was then) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.¹²

46. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

47. In its written submissions, the opponent submits that taking into account the nature of the goods, the average consumer will be both the general public in need of prostheses and prosthetic devices, and professionals who buy such products for their patients, with the general public having a lower level of attentiveness compared to specialists, having an average degree of attention. The opponent refers to paragraph 21 of “*ERGO*” Case T-220/09, where it reminds me that where the target audience is both the general public and specialists, the likelihood of confusion should be assessed against the perception of the part of the public with the lower degree of attentiveness, i.e. the general public, since professional consumers are considered to have special background knowledge or experience in relation to the goods and services.

48. In its written submissions, the applicant submits that the average consumer of the goods and services is likely to be a highly-qualified medical professional on account that only surgeons are likely to come into direct contact with goods such as orthopedic implants, and the level of attention paid is higher than average. Likewise, they submit that the services being provided are highly specialised and even if a member of the public were receiving the services, they would pay a very high level of attention when selecting them.

49. In my view, the average consumer for the various implants and prosthetic devices will include the general public as the recipient of the implants and medical services, as well as the highly skilled and knowledgeable medical professional responsible for their implementation, while professional bodies such as clinics and hospitals at large

¹² Paragraph 60

and their personnel will be the consumer of the apparatus used in the procedures and for the procurement of custom manufacture and technical services.

50. I agree with the applicant that the general public as the patient and end user is unlikely to select the goods at issue, which are highly technical, specialist goods, and which will be sourced by the medical professional and/or establishment undertaking the procedure. However, I acknowledge that the perception of the end user, who may not have purchased the goods themselves, is also relevant.¹³ I also agree that the specialist will pay close attention to the selection process, given the consequences to both the patient and the reputation of said professional, should an inadequate or inappropriate selection be made, which will be by predominantly visual means, although I do not discount aural considerations. Cost implications also play a part, with the cost of the goods such as implants being passed on to the end user in private practice, whereas in government funded national health services, the department responsible for procuring the goods will be held accountable and as such will need to ensure that the goods are fit for purpose at the best possible value. In both private and public practice, the goods will be sourced through specialist trade channels, and it is my view that overall, a high degree of attention will be paid to the selection of the appropriate goods.

51. With regards to the services at issue, I consider that the level of attention paid to the selection of medical services and consultancy by the general public is likely to be higher than average, as any decision regarding the health of the consumer as a patient will not be undertaken lightly. The needs of the patient will be paramount, and so the custom manufacture of the goods as well as technological, research and design services, all of which will be sourced by professional consumers for the good of the end user, and which will ultimately lead to the manufacture of the finished products, will also demand a high degree of attention.

Comparison of marks

¹³ See *Schütz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712 (Ch), at [99].

52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹⁴

53. It would be wrong, therefore, to artificially dissect the trade marks, 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.

54. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
Insight	in:situ

55. The opponent submits that both marks consist of seven characters, with five of the seven characters being identical and appearing in the same order in both marks, and therefore the opposing marks are visually highly similar, and that the marks are at least

¹⁴ Paragraph 34

on average phonetically similar. It submits that the marks are at least on average conceptually similar, and that patients who are in need of an implant or prosthesis will not know the meaning of the Latin word in the applicant's mark "in:situ", and will instead think that the word should allude to the word "insight", having the same meaning as the opposition trade mark.

56. The applicant submits that while both marks coincide in respect of the fact that they both begin with the letters "in", this is an extremely common prefix. It submits that the separation of "in" and "situ" by a colon in the contested mark adds a visual difference; that the application is likely to be pronounced as three syllables, while the earlier mark has two syllables; and that the meanings of the opposing marks are completely different. It submits that overall, the marks are visually, aurally and conceptually dissimilar.

Overall impression

57. The opponent's mark consists of the single, dictionary defined word "Insight", presented in a standard font without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the word itself.

58. The applicant's mark comprises two words connected by a colon, "in:situ", giving the initial impression of a single word, which is presented in a standard font in lower case, without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the combination of words and punctuation as presented.

Visual comparison

59. The opponent's mark consists of seven letters which make up the single word "Insight". The applicant's mark consists of seven characters, but this is displayed as two words which are separated by a colon, however, as there are no spaces between the characters, at first glance it appears to be a single word. The competing marks have the first two letters, "IN", in common. In *El Corte Inglés, SA v OHIM*, Cases T-

183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. Following the colon in the contested mark, the first and second letters of the second word are S and I, which are identical to the third and fourth letters of the earlier mark. However, to my mind, the colon significantly differentiates visually between the marks, and overall, I find there to be no more than a medium degree of visual similarity between them.

Aural comparison

60. The common element of the competing marks is the word “in”, positioned at the beginning of each of the marks, which would be pronounced equally in both marks. The opponent’s mark would be articulated as two syllables IN-SITE (ɪnsaɪt), whereas the applicant’s mark would be pronounced as three syllables, IN-SIT-YOU (ɪn sɪtju). The colon would not be voiced. Overall, I consider that the marks are aurally similar to no more than a medium degree.

Conceptual comparison

61. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)* the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.”¹⁵

¹⁵ Paragraph 8.

62. The Collins English Dictionary defines the term “in situ” as “in the natural, original, or appropriate position.”¹⁶ Given that the goods are implants and prosthesis and instruments used in the surgery thereof, I consider that the applicant’s mark strongly alludes to the implants being appropriately positioned.

63. The term “insight” is defined as, inter alia, “the ability to perceive clearly or deeply.”¹⁷

64. To my mind, while the average consumer may or may not know the exact meaning of the applicant’s mark, which derives from Latin, a significant proportion will have at least a general idea to what the phrase pertains, either with or without a colon punctuating the words “in” and “situ”. I consider that a significant proportion of the average consumer of the goods and services at issue, which as considered earlier in this decision will include highly skilled and knowledgeable medical professionals, as well as the general public, will link the concept that the goods, being implants and prosthesis, will need to be fixed in an appropriate position, being placed “in situ”, while the related services are provided to help facilitate this. I cannot agree with the opponent that the relevant public would find a conceptual similarity in the opposing marks, which it submits both allude to “the correctness of a thing”.¹⁸

65. In my view, a significant proportion of the average UK consumer will understand the meaning of the word “insight” in the opponent’s mark as per the dictionary definition given above, and which does not describe the goods and services at issue. Although general consumers may expect that a medical professional would have insight into a patient’s individual requirements, any link between the mark and the goods and services is open to interpretation and is not immediately obvious¹⁹, the link is therefore tenuous, at best.

¹⁶ Sourced from the Collins English Dictionary online, accessed on 28 October 2022.

¹⁷ Ibid.

¹⁸ See 5.3 Conceptual similarity, of the opponent’s written submissions, dated 14 April 2022.

¹⁹ See paragraph 56, Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006].

66. Overall, I consider that the average consumer will be able to differentiate between the distinct concepts of the competing marks. Consequently, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier marks

67. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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.

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

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

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

69. Registered trade marks can possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

70. I agree with both parties that the earlier mark comprises an ordinary, dictionary defined word which is neither descriptive nor allusive²⁰ of the goods and services to which it relates. Consequently, I find the mark to be inherently distinctive to a medium degree.

Likelihood of confusion

71. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

72. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

²⁰ See paragraph 65 of this decision regarding the consideration of a tenuous conceptual link between the mark and the goods and services.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

73. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

74. Earlier in this decision, I found that all the contested goods in Class 5 and Class 10 to be identical or similar to at least a low degree to the opponent's goods, with the exception of "*Special purpose surgical instruments for inserting implants and for handling implants, in particular for inserting spinal implants; medical guidewires; suture materials; instruments for inserting bone cement.*", which I considered dissimilar (with the proviso that if I were wrong in this consideration, then any similarity between the goods at issue was at a very low level). I found the contested services in Class 40 and Class 44 to be either identical, or similar to the opponent's services to at least a low degree, and I found the Class 42 services to be dissimilar to any of the opponent's goods and services, with the exception of "*Development of surgical articles; development of orthopedic articles; development of implants; development of instruments for inserting implants; scientific and technological services and research and design related thereto in the field of orthopedic surgery and bone implants; technical consultancy, technical project planning, technical project management in the field of orthopedic surgery and bone implants*" which I found to be similar to the opponent's Class 10 goods to a medium degree.

75. I found that the average consumer of the goods at issue would be the general public and highly skilled medical professionals, including medical establishments, and that a high level of attention would be paid during the selection process of the goods. The goods would be selected by predominantly visual means, although aural considerations would also play a part. I found that the professional consumer would also pay a high level of attention to the selection of the services, while the general public would pay a higher than average degree of attention when choosing medical and consultancy services.

76. I considered the competing trade marks to be visually and aurally similar to no more than a medium degree, and to be conceptually dissimilar, with the earlier mark possessing a medium degree of inherent distinctiveness.

77. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, given the degree of attention paid during the selection process, the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise. I find this even where the respective goods and services are held to be identical, which offsets a lesser degree of similarity between the marks.

78. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

79. Keeping in mind the global assessment of the competing factors in my decision, it is my view that it is unlikely that the average consumer would assume that there is an economic connection between the brands. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar* are not exhaustive, however, I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other, or assume that there is an economic connection between the parties. I therefore find no likelihood of indirect confusion.

80. The opposition under section 5(2)(b) fails.

Conclusion

81. The opposition has failed. Subject to any successful appeal, the application by Biedermann Technologies GmbH & Co. KG may proceed to registration.

Costs

82. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award the applicant the sum of £600, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement: £200

Preparing written submissions: £400

Total: £600

83. I therefore order ADAPTTECH LIMITED to pay Biedermann Technologies GmbH & Co. KG the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of November 2022

Suzanne Hitchings
For the Registrar,
the Comptroller-General