

O-244-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2371947
BY NIGEL GORDON STRIBLING
TO REGISTER THE TRADE MARK
OPUS SPECIALIST DENTAL SERVICE
IN CLASS 44**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 96348
BY DORNIER MEDTECH GMBH**

BACKGROUND

1) On 1 September 2004, Nigel Gordon Stribling applied to register the following trade mark:



2) In respect of the following services:

Class 44: “Specialist dental service for: private individuals, other referring dental practitioners, surgery and implants, restorative dentistry, prosthodontics, endodontics, orthodontics, periodontics. “

3) Following examination, the application was accepted and published for Opposition purposes in Trade Marks Journal No.6710 on 16 November 2007.

4) On 18 February 2008, Dornier MedTech GmbH, filed a notice of opposition. This consists of a single ground based upon section 5(2)(b) of the Act, under which they rely on the following trade mark:

Trade Mark	Number	Application Date	Registration Date	Goods
OPUS	CTM 927210	10 .09.98	05.11.99	Class 10: Medical tables for examination and treatment, X-ray apparatus and X-ray work stations, apparatus for processing and reproducing medical images.

5) On 15 July 2008 the Applicant filed a counterstatement denying that the two parties are in competition. They also state that the opponent has not used its mark in the UK in the last five years, that the applicant has been trading under the mark in suit in the UK for the last five years without any confusion and pointing out that there are a number of companies using the name OPUS in the UK.

6) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard nor did either provide any written submissions.

OPPONENT’S EVIDENCE

7) The opponent filed two witness statements. The first, dated 11 November 2008, is by Klaus Frank the Director of New Business, Product and Marketing Management in Dornier MedTech Europe GmbH a wholly owned subsidiary of the opponent company. The subsidiary that he works for is responsible for the sales of all Dornier products in Europe, including the UK. He has held this post for five years. His

evidence is based on his own knowledge and also the records kept by the various companies in the group.

8) Mr Frank provides a number of exhibits which I summarise below:

- Exhibit 1: This consists of four brochures. The first, in English, from pages 1-12 inclusive shows the DORNIER OPUS II UIMS which is described as “a state of the art digital urology imaging system”. Simplistically, it appears to be a large X-ray machine with a table that the patient lies upon whilst the medical practitioners can view the images produced via screens attached to the unit. It is said to be able to cover the whole of the urogenital tract and can also be used for urodynamic examinations. This has a copyright date of 2004. The second brochure is also in English and occupies pages 13-17 inclusive. It is very similar to the first and again features the Dornier Opus II with a copyright date of 2003. The third brochure is very similar, pages 18-22 inclusive, is in French and is said to date from 2006. It features the Dornier Opus II. The fourth brochure, pages 23-26 inclusive, is in German and is said to date from 2006. It also features the Dornier Opus II.
- Exhibit 2: In 2000 the opponent company won a RED DOT award for product design for the OPUS system. This exhibit contains a press release describing the product and stating that it had won the award.
- Exhibit 3: This consists of a list of exhibitions worldwide which Mr Frank states his company and its associates have attended. It does not provide specific dates for each exhibition. However, Mt Franks states that his company exhibited the OPUS system in Amsterdam and Dusseldorf in 2005. He provides copies of advertisements which appeared in relation to these two exhibitions. He states that his company spends approximately 200,000 Euros each year on such exhibitions. He also states that sales for Europe have exceeded one million Euros for each of the last five years.

9) The opponent’s second witness statement, dated 11 November 2008 is by Helen Wakerley the opponent’s Trade Mark Attorney. She states that she carried out a search on Google looking for sites discussing dental imaging. She provides copies from websites of companies specialising in the supply and/or the manufacturing of x-ray and imaging equipment for dentists.

10) That concludes my review of the evidence. I now turn to the decision.

DECISION

11) The sole ground of opposition is based upon section 5(2)(b) of the Act. This reads:

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

(a)

(b) it is similar to an earlier 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.”

12) An earlier right is defined in section 6 of the Act, the relevant parts of which state:

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

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

13) In these proceedings the Opponent is relying on one trade mark, registration No. CTM 927210 which has an application date of 10 September 1998 and which qualifies as an earlier trade mark under the above provisions.

14) The publication date of the application in suit was 16 November 2007. I must therefore consider the position under The Trade Marks (Proof of Use, etc.) Regulations 2004. Paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

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

(b) there is an earlier trade mark 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (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.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) The publication date is, as I have already mentioned, 16 November 2007. Therefore, the relevant period for the proof of use is 16 November 2002- 15 November 2007. I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

16) I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example,

if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

17) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

18) In these proceedings, the opponent is relying on an earlier Community trade mark. I note that in the evidence the opponent has provided brochures in English, French and German for the relevant period and states that they have sold their OPUS system in Europe. I note (with my emphasis) the following comments contained in the OHIM guidelines in relation to proof of use i.e.

“3.2. CTMs: Use in the European Community

If the earlier mark is a Community mark, it must be used “in the Community” (Article 15(1) and Article 43(2) CTMR).

Genuine use within the meaning of Article 15 CTMR may be found also when the criteria of that article have been complied with in only one part of the Community, such as in a single Member State or in a part thereof. In territorial terms, the appropriate approach is not that of political boundaries but of market(s). Above, any other rule would discriminate between small and big enterprises, and thus be contrary to the aim pursued by the CTM system which should be open to businesses of all kinds and sizes.

The sufficiency of use in only a part of the Community is reflected in the Joint Statements by the Council and the Commission entered in the minutes of the Council meeting at which the CTMR was adopted (Joint Statements by the Council and the Commission of 20.10.1995, No B. 10 to 15, OJ OHIM 1996, 615). According to these statements, “The Council and the Commission consider that *use which is genuine within the meaning of Article 15* in one country constitutes genuine use in the Community”. While these statements only have an interpretative value and are not legally binding, they have been applied by Office.

It must in any event be underlined that it is the European requirements or standards which must be complied with and not the national standards. It may be that European quantity standards could be different than the respective national criteria in some cases.”

19) And by analogy to the OHIM guidelines regarding revocation (again with my emphasis) on the grounds of non-use i.e.

“3.1.3. Geographical extent of use

Genuine use may be found also when the mark has been used in only one part of the Community, such as in a single Member State or in a part thereof. Any other rule would discriminate between small and big enterprises, and thus be contrary to the aim pursued by the CTM system which should be open to businesses of all kinds and sizes.
....”

20) It is clear from the above that to comply with the proof of use provisions, use of a community trade mark in the United Kingdom (assuming it is considered genuine) ought to be considered sufficient. I note that a similar view (albeit in the context of in which jurisdiction a community trade mark must be used to establish a reputation for the purposes of Article 9(1)(c)), was reached by Mr Geoffrey Hobbs QC sitting as a Deputy High Court Judge in *Whirlpool Corporation et al and Kenwood Limited* [2008] EWHC 1930 (Ch), (paragraph 76 of his decision refers). In my view the evidence provided by the opponent establishes that they have used their OPUS trade mark in the United Kingdom since 2004 in a manner which, in my view, does not alter the distinctive character of the trade mark in the form in which it was registered.

21) I now need to decide as a matter of fact on what goods the trade mark has actually been used. The opponent's evidence which is within the relevant period, shows use with regard only to a digital urology imaging system. This is shown being promoted in France, Germany and the UK. As a result of this, and taking into account the authorities listed earlier, means that the specification for the opponent's mark is reduced to the following for the purposes of the comparison of goods and services under Section 5(2)(b) "digital urology imaging systems".

22) In reaching a decision I take into account the following cases: *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord GmbH v. OHIM* [2004] ECR I-3657, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2005] ECR I-8551 and *OHIM v. Shaker di L. Laudato & C. Sas* [2007] ECR I-4259.

23) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the reduced specification referred to in paragraph 21 above.

24) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average

consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

25) The opponent has shown little use of its mark. I have to consider whether the opponent’s mark has a particularly distinctive character arising from the inherent characteristics of the mark. In my opinion, the opponent’s mark OPUS is inherently distinctive for digital urology imaging systems.

26) I have to determine who would be the average consumer of the goods and services in question. The average consumer for the opponent’s goods (digital urology imaging systems) must clearly be medical professionals and/or hospital staff responsible for purchasing items of equipment. Clearly, the opponent’s goods are highly specialised and would be very expensive. They would only be purchased after several meetings with the company and after consultation within the medical establishment over such an investment.

27) As to the applicant’s services, everyone requires dental services at some stage and so the average consumer has to be regarded as the average citizen in the UK. Dental services in general are sought when they are needed and so long as the practitioner is qualified there tends to be limited choice, certainly if one is seeking services under the NHS. However, when one considers the more aesthetic services offered under what could be loosely termed cosmetic dentistry then this will again be an informed choice, only entered into after discussions with the dentist, and consideration of the considerable expense involved.

28) I shall first consider the specifications of both parties. I shall take into account my finding at paragraph 19 above.

Applicant’s specification	Opponent’s specification
Class 44: Specialist dental service for: private individuals, other referring dental practitioners, surgery and implants, restorative dentistry, prosthodontics, endodontics, orthodontics, periodontics.	Class 10: Digital urology imaging systems

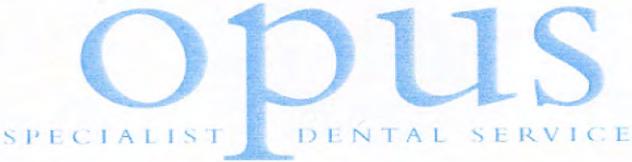
29) In the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon*; ETMR 1. In its judgement, the ECJ stated at paragraph 23:

“23. 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 end users, their method of use and whether they are in competition with each other or are complementary.”

30) The opponent has, in its evidence, shown that dentists use x-ray equipment. However, this does not make the goods and services complementary. The companies

are clearly not in competition with each other and in all other aspects they are totally different. With regard to the opponent's reduced specification they are dealing with completely different ends of the body. Even in its original registered specification the opponent's goods would be considered to be totally different to the services offered by the applicant.

31) I therefore turn to the marks of the two parties. For ease of reference I reproduce them below:

Applicant's mark	Opponent's mark
	OPUS

32) The applicant's mark contains the words "specialist dental service" which taking into account the services offered can have little or no trade mark significance. The dominant element is the word OPUS and so the marks of the two parties whilst not identical are extremely similar visually and aurally. Although neither mark appears to have a conceptual meaning, taking into account the goods and services of both parties they would nonetheless be regarded as providing the same message as they are very similar marks.

33) Taking account of all of the above when considering the marks globally, I believe that, despite the near identity of the marks, there is not a likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

34) As the applicant has been successful it is entitled to a contribution towards its costs.

35) I order the opponent to pay the applicant the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of August 2009

**George W Salthouse
For the Registrar,
the Comptroller-General**