

**O-0100-23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3644370  
AND THE REQUEST BY INVICTUS GLOBAL LIMITED**

**TO REGISTER THE TRADE MARK**

**EVACUSTAIR**

**IN CLASS 10**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 427712  
BY EVAC+CHAIR INTERNATIONAL LIMITED**

## Background and pleadings

1. On 20 May 2021 Invictus Global Limited (“**the Applicant**”) applied to register the plain text word “EVACUSTAIR” as a UK trade mark. On 23 July 2021 the contested mark was published for opposition purposes in respect of the following goods:

**Class 10:** *Evacuation chairs; medical evacuation chairs; emergency evacuation chairs adapted for patients; stairway evacuation chairs, being medical emergency evacuation apparatus; motorized medical and evacuation chairs; seat pads for medical and evacuation chairs; patient handling and lifting apparatus; patient transferring apparatus; patient carrying apparatus; surgical and medical instruments and apparatus; mobility aids; orthopaedic and mobility aids; apparatus for use as mobility aids for the disabled; mobility aids for the disabled; intensive care patient transporting apparatus; aeromedical patient transporting apparatus; neonatal patient transporting apparatus; paediatric patient transporting apparatus; carrying chairs for patients; stretchers; medical stretchers; stretchers, wheeled; stretchers for patient transport; patient litters in the nature of stretchers; retaining belts for restraining patients on stretchers; patient examination tables; ambulance stretchers; emergency stretchers; devices especially adapted for securing patient handling apparatus to a vehicle; stretcher mattresses; cushions and pillows for medical purposes; pads for seats for wheelchairs [for medical use]; patient immobilising apparatus; patient safety apparatus, namely, safety harnesses and restraints for use with patient carrying apparatus; apparatus to assist patients into and out of baths; patient hoists; patient safety restraints; patient lifting hoists; patient positioning tools; medical patient treatment chairs; slings for patient lifting hoists; assist poles for lifting patients; apparatus for the turning of patients; hospital beds for use by burn patients; patient moving device, namely, a low friction pad for sliding patients to or from a stretcher and bed; parts and fittings for the aforesaid goods.*

2. On 22 October 2021, the application was opposed, in full by Evac+Chair International Limited (“**the Opponent**”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”).

3. Under sections 5(2)(b) and 5(3), the Opponent relies upon the following two UK trade marks:

(i) The “**425 mark**”  
EVAC CHAIR

UK number 915496425  
Filing date 31/05/2016  
Registration date 10/04/2017  
Relying on goods in Classes 9, 10, 12  
and 16

(ii) The “**569 mark**”  
EVAC+CHAIR

UK number 903081569  
Filing date 27/02/2003  
Registration date 09/12/2004  
Relying on goods in Class 12

4. The Opponent relies on its third earlier mark under section 5(2)(b) only:

(iii) The “**006 mark**”  
EVAC+POWER

UK number 3595006  
Filing date 12/02/2021  
Registration date 23/04/2021  
Relying on goods in Classes 7, 9, 10,  
12, 16, 37 and 41

5. An “earlier trade mark” is defined in section 6(1) of the Act as:

*“(a) a registered trade mark, international trade mark (UK), a 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”*

6. The filing date of each of the Opponent's three trade mark registrations is prior to the filing date of the contested mark. Therefore the Opponent's marks constitute earlier marks under the Act.

7. Since the Opponent's 569 mark (EVAC+CHAIR) had been registered for more than five years when the contested mark was applied for, it is subject to the use provisions under section 6A of the Act. The Opponent duly provided statements of use in respect of this mark.

8. Under section 5(4)(a), the Opponent relies upon the following sign:

EVAC+CHAIR

Used throughout the UK since 1985  
Used in relation to Surgical and medical instruments and apparatus; apparatus for use as mobility aids for the disabled; intensive care patient transporting apparatus; aeromedical patient transporting apparatus; neonatal patient transporting apparatus; paediatric patient transporting apparatus; patient examination tables; ambulance stretchers; stretchers; stretcher mattresses; cushions and pillows for medical purposes; patient immobilising apparatus; apparatus to assist patients into and out of baths; parts and fittings for the aforesaid goods.

*The Opponent's case*

*Section 5(2)(b)*

9. Under section 5(2)(b) the Opponent submits that:

- (i) the contested mark is highly similar to the earlier marks, commencing with the same dominant and inherently distinctive element “EVAC” and with the 425 and 569 marks also sharing the last three letters “AIR” with the contested mark;
- (ii) the goods under the earlier marks are identical, or highly similar to those under the contested mark, sharing the same nature, purpose, method of use, end consumer and distribution channels and also being complementary or in competition with one another;
- (iii) the earlier marks are inherently distinctive and through extensive use by the Opponent, they possess an enhanced degree of distinctive character;
- (iv) there is a strong likelihood of confusion, including a likelihood of association between the contested mark and the earlier marks.

*Section 5(3)*

10. Under Section 5(3), in respect of the 425 and 569 marks, the Opponent submits that:

- (i) the marks have a reputation in the UK, the justification for which being the same as set out in respect of section 5(4)(a) of the statement of grounds, which I will address below;
- (ii) the signs are highly similar for the reasons set out in respect of section 5(2)(b) of the statement of grounds, which I have set out above;
- (iii) use of the contested mark is likely to cause a public expectation that the Applicant’s goods originate from the Opponent. Due to this connection, business would unfairly accrue to the Applicant with the marketability of its goods being increased. Use of the contested mark would therefore take unfair advantage of the Opponent’s reputed marks;
- (iv) use of the contested mark would dilute or blur the distinctive character of the marks, making it more difficult for the Opponent’s marks to operate as trade marks;
- (v) use of the contested mark would cause detriment to the Opponent’s marks, which have a reputation in the field of health and safety, where quality and reliability are of paramount importance. Use of the contested mark on any goods of low quality, or which fail regulatory checks, would seriously harm the

reputation of the Opponent's marks, reducing their power of attraction and making consumers less likely to purchase the goods offered by the Opponent.

*Section 5(4)(a)*

11. Under section 5(4)(a), the Opponent makes the following statements about goodwill generated in the EVAC+CHAIR sign:<sup>1</sup>

(i) the Opponent is the leading company within the safety chair market in the UK and rest of the world and was the first company to manufacture and sell a safety chair in the UK, which it has done since 1985;

(ii) the Opponent regularly generates revenues in excess of £9 million in respect of EVAC+CHAIR products which are manufactured in the UK and sold in the UK and worldwide;

(iii) the Opponent's EVAC+CHAIR-branded products have been awarded ISO 13485:2003 standard, in recognition of the high quality of its branded products. The Opponent has also won the Midlands Manufacturer of the year award in 2021;

(iv) due to the Opponent's considerable goodwill, use of the contested mark can be prevented under the law of passing off.

*The Applicant's case*

12. In response, the Applicant denies that registration of its mark would be contrary to section 5(2)(b), 5(3), or 5(4)(a) of the Act. The Applicant puts the Opponent to proof of use of the 569 mark; its reputation and claim of enhanced distinctive character; and its claim of goodwill in EVAC+CHAIR.

13. The Applicant denies that the marks are similar, and in the alternative, denies that any similarities are so great as to lead to a likelihood of confusion. In support of this, the Applicant submits that the suffix "USTAIR" creates a perceptibly different overall impression to that conveyed by the Opponent's marks.

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<sup>1</sup> These statements also refer to reputation under section 5(3).

14. Under section 5(3), the Applicant denies that use of the contested mark is without due cause and denies that use would take advantage, or be detrimental to the distinctive character, or alleged reputation of the Opponent's marks.

15. Under section 5(4)(a), the Applicant denies that use of the contested mark would amount to passing off.

#### *Representation and papers filed*

16. Both parties filed evidence in these proceedings, with the Opponent filing the witness statement, dated 6 May 2022, of Gerard Paul Wallace, Managing Director of EVAC+CHAIR International Limited. Mr Wallace introduces 45 Exhibits, numbered GPW1 to GPW45. The Applicant filed the witness statement, dated 22 July 2022, of Sean McDonagh, Senior Trade Mark Attorney at HGF Limited. Mr McDonagh introduces evidence in two Annexes, A and B. This evidence seeks to show third party use and registration of trade marks including the element "EVAC" in respect of the goods at issue.

17. Following a change to the recorded representative, notified to the Registry on 11 November 2022, the Opponent is represented by Forresters IP LLP. The Applicant is represented by HGF Limited. Neither party requested a hearing and both parties filed submissions in lieu of a hearing. This decision is therefore taken following a careful assessment of the papers.

#### **Decision**

18. Although the UK has left the EU, 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Proof of use**

19. The relevant statutory provisions are as follows:

*“Raising of relative grounds in opposition proceedings in case of non-use”*

*6A(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.*

[...]

*(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.”*

20. Paragraph 7 of Schedule 2A of the Act concerns the application of section 6A to comparable trade marks:

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

[...]

*(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.*

21. Section 100 of the Act is also relevant; it reads:

*“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.”*

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

*“114... The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, La Mer (cited above), 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 Bunderversvereinigung 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], [2013] ETMR 16, Case C-609/11 P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.*

115. *The principles established by these cases 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]; Leno at [29]; Centrotherm at [71]; Reber at [29].*

*(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]; Leno at [29]; Centrotherm at [71].*

*Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].*

*(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] and [22]. 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]; Reber at [29].*

*(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]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].*

*(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] and [76]-[77]; 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].”*

23. The Opponent’s 569 mark “EVAC+CHAIR” is subject to the use provisions under section 6A of the Act. The Opponent must therefore show use of its mark during the five years up to the date when the contested mark was applied for, that is 21, May

2016 to 20 May 2021 (“**the relevant period**”). As the 569 mark is a comparable trade mark created when the UK left the EU, use between 21 May 2016 and 31 December 2020<sup>2</sup> refers to use of the corresponding EU Trade Mark, with the territory of use in this period including the EU.

24. Mr Wallace sets out the history of the escape chair, which is a device for assisting individuals with disabilities out of buildings. He explains that products sold under the Opponent’s marks were the first of their type developed in the early 1980’s in the USA, and went on to be sold worldwide. The Opponent’s sister company, Evac+Chair Corporation is responsible for sales in the USA, while the Opponent’s core market is the UK and EU.

25. Mr Wallace brings evidence in support of the claim that the Opponent is the dominant operator in the escape chair market. First, is a reference to data shown at Exhibit GPW1 from Companies House concerning the turnover figures of companies operating in the market of evacuation products. Mr Wallace states that the figures show that as of 2020, the Opponent’s turnover is between 4 and 5 times higher than its nearest competitor. Second, Mr Wallace refers to a company profile on the website of Health & Safety Matters “HSM”,<sup>3</sup> who describe the Opponent as “the world’s number 1 supplier and original manufacturer of the evacuation chair, owning 90% of the current market”. Third, Mr Wallace provides correspondence and/or witness statements from the Opponent’s distributors in Belgium, the Netherlands, Luxembourg, Finland, Italy and France. All comment on the extensive trading history of EVAC+CHAIR, the renown of the brand and the high market share held.

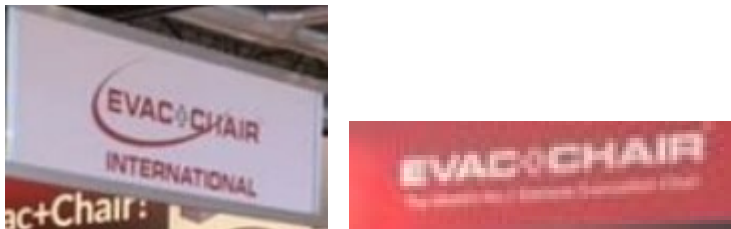
26. Later on in his witness statement, Mr Wallace sets out sales figures for the Opponent’s evacuation chair in the UK and EU and I note that between 2017 and 2020, combined sales for the territories were in the region of £3 million, with a drop to around £2 million in 2020. In terms of marketing expenditure, between 2017 and 2020, Mr Wallace states that the Opponent spent in the region of £250,000 to £400,000 on marketing, with most of this being spent on exhibitions. At Exhibit GPW12 a list of trade fairs and exhibitions attended by the Opponent is provided. Mr

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<sup>2</sup> IP completion day.

<sup>3</sup> At Exhibit GPW2.

Wallace provides information about the attendance at some of the EU-based exhibitions attended during the relevant period, which is in the tens of thousands of visitors. There is little evidence of how the Opponent's mark appeared at the events, with Exhibit GPW14 providing the only examples shown to be from during the relevant period:



27. Mr Wallace states that his company places less emphasis on social media, with between 700 and 3,300 followers across the platforms of Facebook, Twitter and LinkedIn. Exhibits GPW9 to GPW11 include extracts from each of the platforms and show the accounts are in the name "Evac+Chair International". Some communications on the platforms by the Opponent are provided, however, these are all outside the relevant period.



29. Comparing the Opponent's 569 mark to the marks seen in use, I consider that the different figurative elements: bold text; colour; a semi-circle; and the additional wording: "INTERNATIONAL"; and "Emergency Evacuation For Everyone", are all elements that are fairly low in distinctive character and which do not in my view alter the distinctive character of the mark as a whole.<sup>4</sup> This being the case, I find that the forms of use shown by the Opponent constitute acceptable variants of the 569 mark.

<sup>4</sup> T-146/15 Hyphen v EUIPO, EU:T:2016:469.

30. Mr Wallace lists four awards received by the Opponent. Two of the awards were outside the relevant period, and one was awarded in America, so is outside the relevant territory. The fourth award is for winner of the Greater Birmingham Chamber of Commerce Excellence in Manufacturing 2020. Mr Wallace provides a list of notable clients, which includes Twickenham Stadium, various top flight football clubs, international airports, tourist attractions, universities, embassies and large companies including Vodafone and M&S. For a selection of these, extracts from the Opponent's website describe the installation work done at the various sites,<sup>5</sup> though I note that the date the contracts were carried out is not shown, so it is not confirmed that the installation occurred during the relevant period.

31. Mr Wallace provides three examples of third party media coverage of its mark, however, these are either outside the relevant territory (America and Singapore), or are outside the relevant period.

32. In its submissions in lieu of a hearing, the Applicant criticises the Opponent's evidence, and submits that it is not sufficient to support the Opponent's claim of use of the 569 mark. I take note of the Applicant's comments, and agree that there is much in the evidence that is either outside the relevant territory, or the relevant period, or that does not confirm the date of use. The Opponent has chosen not to provide evidence in the form of invoices, which would have assisted by confirming the dates and values of transactions. Also, more use of WaybackMachine extracts and documents or photographs from the exhibitions and awards ceremonies would have assisted in confirming how the mark was used throughout the relevant period.

33. What I consider to be established from the evidence is that there has been longstanding use of the Opponent's mark in respect of evacuation chairs, in the UK and EU and that these have been marketed consistently under a mark that is identical to, or an acceptable variant form of the Opponent's trade mark. With the WaybackMachine extracts from during the relevant period, the attendance at large-scale exhibitions and healthy turnover figures, I consider it to be established that

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<sup>5</sup> Exhibit GPW20 and GPW37

genuine use has been shown during the relevant period of the 569 mark, or an acceptable variation of it.

34. In terms of a fair specification, I consider the terms “wheelchairs; wheeled chairs for invalids; wheeled chairs for individuals”, which appear first in the Opponent’s list of specified goods in Class 12, to be overly broad considering that the use shown is entirely focused on evacuation chairs. Taking account of the remaining specification of goods under the Opponent’s 569 mark, I find a fair specification to be “wheeled chairs for transport of people in staircase; wheeled chair with runners for use by a person for transporting another person down stairs particularly from an upper floor of a building in an emergency; wheeled chairs equipped with intermediate wheels allowing, in case of emergency, evacuation of a person by another by staircase”.

#### **Section 5(2)(b)**

35. Section 5(2)(b) of the Act states:

*“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”.*

36. Section 5A of the Act states:

*5A. - Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.*

*The case law on section 5(2)(b)*



37. 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 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 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.

### *My approach*

38. Under section 5(2)(b), the Opponent relies on all three of its earlier trade mark registrations. I consider the Opponent's stronger case under section 5(2)(b) to be through the 425 and 569 marks, the elements "EVAC" and "CHAIR" separated by a space, or "+" sign. These marks have more letters in common with the contested mark than the 006 mark, so I will begin my assessment under section 5(2)(b) on the basis of the 425 and 569 marks.

### *Comparison of the goods*

39. Some of the contested goods, for example, *Surgical and medical instruments and apparatus; apparatus for use as mobility aids for the disabled; intensive care patient transporting apparatus* are identical to the goods under the Opponent's 425 mark. Also, "evacuation chairs" are identical to the goods under the Opponent's 569 mark where genuine use was shown. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

### *Comparison of the marks*

40. It is clear from *Sabel BV v. Puma AG*<sup>6</sup> (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 at paragraph 34 of its judgment in *Bimbo SA v OHIM*,<sup>7</sup> 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."*

41. 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

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<sup>6</sup> Case C-251/95.

<sup>7</sup> Case C-591/12P.

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.

42. The Applicant's and Opponent's marks are shown below:

The Opponent's earlier UK marks		The Applicant's mark
425 mark	EVAC CHAIR	EVACUSTAIR
569 mark	EVAC+CHAIR	

43. The overall impression of the Applicant's mark is of an invented word "EVACUSTAIR". Whilst I'm alive to the fact that I must not artificially dissect the marks, I consider that the Applicant's mark is likely to be understood as comprising two elements, the first being "EVACU" and the second being the dictionary word "STAIR", which refers to a set of steps used to move between different levels or a building or outside area. Given the descriptive connotations of the element "STAIR" (which I shall return to below), I consider that the "EVACU" element of the mark to have a greater impact (though I shall also address the descriptive connotations of that element).

44. The overall impression of the Opponent's marks is of the word element "EVAC", which appears with a second dictionary word "CHAIR", which refers to a seat. In the 569 mark, the two word elements are separated by an addition sign "+" which can refer to "plus" or may be used to refer to "and". In the case of the 569 mark, the phrases "EVAC plus CHAIR" or "EVAC and CHAIR" sound unusual and clumsy. Due to this, and the positioning of the "+" sign in the middle of the mark, I consider the "+" element of the 569 mark has little impact on the overall impression of the mark. Given this, and the descriptive connotation of the word "CHAIR", I consider that the word "EVAC" has a greater impact in the Opponent's marks.

*Visual similarity*

45. Visually, the marks align in their initial four letters "EVAC". As the parties point out, the marks also align in respect of the final three letters in the "AIR". The marks

differ visually in that the “EVAC” element in the first mark is separated from the dictionary word that follows, by either a space, or a “+” sign, whereas the Applicant’s mark comprises a single word, with the “EVAC” element being followed by the letter “U”.

46. I agree with the Applicant that the structure of the marks provides a somewhat different visual impression, however, I acknowledge that the positioning of the points of alignment is relevant. It is accepted that the beginning of words in verbal marks tend to have a greater impact, and in this case, I have also found the “EVAC” / “EVACU” elements to have a greater impact in the overall impression. Taking account of these factors, I find the marks to be visually similar to a medium degree.

#### *Aural similarity*

47. The Applicant’s mark comprises four syllables, which I consider will be verbalised as “EE” “VAC” “U” “STAIR”. The Opponent’s 425 mark comprises of three syllables, which I consider will be verbalised as “EE” “VAC” “CHAIR”. If the “+” sign is not verbalised, the 569 mark will be verbalised in same way as the 425 mark. In the event that the “+” sign is verbalised, the 569 mark will comprise of four syllables, “EE” “VAC” “PLUS” “CHAIR” or “EE” “VAC” “AND” “CHAIR”.

48. The Opponent’s earlier marks share the same first two syllables, “EE” “VAC”, and the parties both point out that the final syllable in the Applicant’s mark shares the same sound of “AIR”. The number of syllables in the Opponent’s 569 mark will be the same if the “+” sign is verbalised, however, the sound of “PLUS” or “AND” is different to “U”. Taking account of these factors, the relevance of the alignment being in the first two syllables, and that I have found this element to have a greater impact in the marks, I find the marks to be aurally similar to a medium degree.

#### *Conceptual similarity*

49. The concept of the marks is informed by the word elements “EVAC” and “EVACU” which are invented words, albeit words that allude to “evacuation”. The concepts are also informed by the dictionary words that follow, “CHAIR” and

“STAIR”. The “+” sign in the 569 mark refers to “plus” or “and”. The Applicant describes the addition sign as fanciful, but does not define the concept that this element provides within the mark. In my view, plus can suggest something additional, or a superior quality, however, when considering the Opponent’s 569 mark as a whole, I consider the concept created by “+” to be vague and to have little impact on the overall conceptual nature of the mark.

50. The Applicant submits that the Opponent’s marks evoke the concept of an evacuation chair, whereas the contested mark has no clear concept, being likely to be perceived as a made-up arbitrary word. As such, the Applicant submits that no conceptual comparison is possible. The Opponent submits that both parties’ marks “loosely allude to the concepts of ‘evacuation’, ‘escape’ and ‘emergency’” and as such the marks are conceptually identical, or highly similar.

51. I consider the concepts of “CHAIR” and “STAIR” are clearly different, but that there is alignment in the “EVAC” and “EVACU” elements of the marks, where I agree with the Opponent that the terms will be understood as alluding to evacuation. The conceptual essence of the Opponent’s marks is of an evacuation seat. The conceptual essence of the Applicant’s mark is of evacuation steps. I find the marks to be conceptually similar to a medium degree.

*Average consumer and the purchasing act*

52. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them.

53. In *Hearst Holdings Inc*,<sup>8</sup> Birss J. explained that:

*“60 The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect*

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<sup>8</sup> *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), at paragraph 60.

*... 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 ...”*

54. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*.<sup>9</sup>

55. The parties agree that the average consumer of the goods at issue will include a specialised public. The Opponent also contends that the average consumer will include the general public, who will be exposed to the trade mark as it appears on goods in easily accessible locations and the mark will be seen by the public in the normal usage of the goods. The Applicant addresses this same point, but submits that although the goods may be to assist the general public, they are not purchased by the general public. In addition, the Applicant submits that it is typically trained individuals that use evacuation chairs in case of an emergency.

56. I agree that the primary consumer of the goods will be the professional public, being someone responsible for safety in a building. I agree with the Opponent that the general public may be of relevance inasmuch as a disabled person who is limited in their ability to use stairs, may well assure themselves that evacuation chairs are in place in high rise buildings that they attend regularly, where they live etc., notwithstanding that such individuals would not ordinarily purchase the goods.<sup>10</sup> I find that the professional public will pay a high degree of attention and where the general public is relevant, I find they will also pay a high degree of attention.

57. The parties have not commented on the nature of the purchasing act. I consider that visual considerations will be key in the purchase of the goods, which will tend to be selected from a catalogue, or website. However, I do not exclude that aural considerations will play a part, for example through word of mouth recommendations, or when ordering by phone.

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<sup>9</sup> Case C-342/97.

<sup>10</sup> By analogy *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, paras. 39 to 42.

### *Distinctive character of the earlier marks*

58. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

59. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The inherent distinctive character may be enhanced through the use that has been made of the mark.

60. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark's distinctive character should be made:

*“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)."*

61. The Opponent's marks consist of the word "EVAC" followed by "CHAIR" or "+CHAIR". It is the Applicant's position that the "EVAC" element of the Opponent's marks will be perceived by the relevant consumers as indicating that the goods are for evacuation. The Applicant's evidence, introduced by Mr McDonagh comprises Annex A, consisting of the records of around 30 UK trade marks which include the element "EVAC" and which are registered for goods related to evacuation. Annex B to Mr McDonagh's witness statement consists of examples of websites where the term "EVAC" is shown to be used in respect of evacuation equipment.

62. In its submissions in lieu of a hearing, the Opponent contends that the earlier marks cited by the Applicant are not comparable to its mark, and even if they were comparable, the Opponent argues that this is not a basis for concluding that "EVAC" is low in distinctive character. The Opponent comments on specific marks from Annex A, giving reasons that the marks do not support the Applicant's position that "EVAC" is low in distinctive character. In respect of the websites in Annex B, the Opponent submits that they do not show the state of the marketplace at the date of filing as they were taken in July 2022. The Opponent also contends that many of the products shown in screenshots are of products that are not relevant to the Opposed goods, and one website shows the Opponent's own goods.

63. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

*"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been*

*weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”*

64. Reviewing the Applicant’s evidence, Annex A shows that there is a significant number of UK trade mark registrations covering goods for evacuation which contain the word EVAC. Not all of the registrations cover evacuation chairs, with others being registered in respect of goods including evacuation chutes, towers or alarms. I consider that as far as the parties’ goods cover products for escaping a building, the average consumer of the goods covered by many of the registrations in Annex A would be the same as the professional public identified earlier in my decision who are responsible for ensuring that people can escape a building in an emergency.

65. I am alive to the fact that the state of the register is not conclusive,<sup>11</sup> as this information does not convey how the mark are used in the market. However, the examples of use in Annex B show that EVAC is used in the market in respect of goods for evacuating people from building:



**EMERGENCY  
EVACUATION  
SYSTEM**

**Sked Evacuation Tripod**

<sup>12</sup> The SKED-EVAC® Tripod extends to ten feet high <sup>13</sup>

**EVAC-ALERT Evacuation Panels**

<sup>14</sup>

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<sup>11</sup> Zero Industry Srl v OHIM.

<sup>12</sup> Page 9.

<sup>13</sup> Page 12.

<sup>14</sup> Page 13.



## EvacSHEET™ – ADULT

<sup>15</sup> The EvacSHEET (Adult) is a patient evacuation sheet <sup>16</sup>

## EvacPAD™

The EvacPAD is a padded evacuation mat designed f

<sup>17</sup>

66. I acknowledge the Opponent’s point that the websites were accessed after the date the contested mark was filed, however it seems unlikely that the market for evacuation equipment would have changed significantly in the 14 months between the application for the contested mark and the preparation of Mr McDonagh’s witness statement.

67. In my view, the Applicant’s evidence indicates that “EVAC” is used in trade in respect of goods for evacuation. “EVAC” is the first four letters of the word “evacuation”, so consumers, even without knowledge of the products in the market, will see the terms as alluding to evacuation and I recall the Opponent’s own expressed view that the Applicant’s and Opponent’s marks “each loosely allude to the concepts of ‘evacuation’, ‘escape’ and ‘emergency’”.

68. The other elements in the Opponent’s marks are “CHAIR” and “+CHAIR”. I consider that consumers are unlikely to pay much attention to the “+” sign in the 569 mark and the word “CHAIR” in the earlier marks is descriptive. Overall, I consider the Opponent’s marks to possess a low degree of inherent distinctive character.

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<sup>15</sup> Page 17.

<sup>16</sup> Page 25.

<sup>17</sup> Page 26.

Opponent's evidence does not reach the threshold for substantiating a claim to enhanced distinctive character of the 569 mark, citing the same criticisms of the Opponent's evidence as in respect of the proof of use claim. With regards to the Opponent's 425 mark, the Opponent submits that none of the evidence shows use of the mark in the form "EVAC CHAIR", without the "+" sign. Having reviewed all of the Opponent's evidence, I have seen very few examples of its mark used in the form under the 425 mark and I consider that the evidence is insufficient to show any enhancement of the distinctive character of the "EVAC CHAIR" form of the mark.

70. Returning to the Opponent's 569 mark and referring back to my assessment of the evidence undertaken earlier in my decision, I consider the Opponent's evidence to show that the distinctive character of the mark had been enhanced through use. The evidence shows that there had been long-standing and widespread use of the mark in respect of wheeled chairs for transporting people down stairs. The evidence shows that significant investment had been made in promoting the mark to the relevant public, particularly through trade fairs. The Opponent had a wide range of prominent customers and I consider that the evidence shows that the relevant consumer had been exposed to the mark with the effect that they will view the goods sold under the mark as originating from the Opponent. Overall, I consider that the distinctive character of the Opponent's 569 mark had been enhanced to a medium degree of distinctive character.

#### *Likelihood of confusion*

71. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all of the factors, weighing them, and looking at their combined effect, in accordance with the authorities set out earlier, in particular at my paragraph 37.

72. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking.

Indirect confusion was explained by Mr Iain Purvis QC (as he was then), sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

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

*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 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. That the three categories in that case are non-exhaustive has recently been confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.<sup>18</sup> Arnold LJ said, of the explanation given about how indirect confusion arises in LA Sugar:

*“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”*

74. In my decision, I have taken the goods to be identical. I have found the Opponent's 425 and 569 marks to be visually, aurally and conceptually similar to the Applicant's mark to a medium degree. I have found the Opponent's mark to possess a low degree of distinctive character, which has been enhanced to a medium degree through use and I have found the average consumer to include the professional public, as well as the general public, both paying a high degree of attention, meaning that they are more likely to notice the differences between the marks.

75. I consider that the average consumer will notice the different words “STAIR” and “CHAIR”/“+CHAIR” and also the additional letter “U” in the Applicant's mark, which creates a third syllable and different sound to the Opponent's marks. I find that there is no likelihood of direct confusion.

76. As for whether there is a likelihood of indirect confusion, I note that in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

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<sup>18</sup> [2021] EWCA Civ 1207.

*“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”*

77. I consider that the Opponent has adopted a word element “EVAC” that is used in its field of activity. While I have found that the distinctive character of the Opponent’s mark had been enhanced, the shared elements giving rise to a medium degree of visual, aural and conceptually similarity are allude to the nature of the goods and the Opponent cannot monopolise a non-distinctive/descriptive term. Given this, the differences between the marks and the high degree of attention paid in respect of the relevant goods, I find that it is unlikely that the marks would be indirectly confused and the opposition under section 5(2)(b) fails in respect of the Opponent’s 569 and 425 marks.

78. I consider that the Opponent’s 006 mark “EVAC+POWER” does not put the Opponent in any better position as the marks themselves are further apart due to the word “POWER”, which has no counterpart in the Applicant’s mark. In addition to this, the evidence does not show any enhancement of the distinctive character of the 006 mark. Given that I have assumed the goods to be identical in my assessment, the 844 mark does not put the Opponent in any better position under section 5(2)(b).

*Outcome under section 5(2)(b)*

79. The section 5(2)(b) ground of opposition fails.

#### **Section 5(4)(a)**

80. Section 5(4)(a) states:

*“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-*

*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,*

*(aa) [...]*

*(b) [...]*

*A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”*

81. Subsection (4A) of section 5 states:

*“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”*

82. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

*“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.*

*56. In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it*



*is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21)."*

83. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

*"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:*

*(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*

*(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.*

*While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.*

*In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:*

*(a) the nature and extent of the reputation relied upon;*

*(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*

*(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;*

*(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and*

*(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”*

*In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”*

84. The Applicant has not filed any evidence that it has used its mark. This means that the position under section 5(4)(a) must be assessed at the dates when the Applicant applied to register its trade mark, 20 May 2021.<sup>19</sup>

85. Sufficient goodwill, although an evidence-based assessment, is different from the questions looked at earlier in this decision, for enhanced distinctive character and reputation of the earlier registered marks. The Opponent relies on the plain word sign “EVAC+CHAIR” in respect of the following goods:

*Surgical and medical instruments and apparatus; apparatus for use as mobility aids for the disabled; intensive care patient transporting apparatus; aeromedical patient transporting apparatus; neonatal patient transporting apparatus; paediatric patient transporting apparatus; patient examination tables; ambulance stretchers; stretchers; stretcher mattresses; cushions and pillows for medical purposes; patient immobilising apparatus; apparatus to assist patients into and out of baths; parts and fittings for the aforesaid goods.*

86. The Opponent must show that its business had sufficient goodwill which was distinguished by use of “EVAC+CHAIR” at the relevant date so that it can be

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<sup>19</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person.

concluded that misrepresentation would occur, and damage would follow. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1902] AC 217 at 223:

*“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”*

87. In its submissions in lieu of a hearing, the Applicant refers to the same arguments about deficiencies in the Opponent's evidence and submits that the evidence fails to demonstrate the Opponent had acquired goodwill in the sign.

88. Of the list of goods, which I have repeated at my paragraph 85, it is notable that none are wheeled chairs for transporting people down stairs, or “*escape chairs*” as the Opponent defines the market in which it operates. The Opponent's submissions in lieu of a hearing do not specify how goodwill has been shown in respect of the goods claimed, instead referring simply to “*sales of its branded products*” and referring to its submissions on different grounds.

89. On the basis of the evidence, which, as I have previously found, concerns wheeled chairs for transporting people downstairs, I consider that goodwill has not been shown for the majority of the goods claimed, as no use has been shown at all for most of the goods. The only term claimed that I consider could include wheeled chairs for transporting people down stairs is “*apparatus for use as mobility aids for the disabled*”. With escape chairs generally being used by those with disabilities, I consider that these goods could fall within the bracket of a mobility aid. I have also considered whether the evidence shows use in respect of the claimed medical apparatus and patient handling apparatus. While Mr Wallace's witness statement makes reference to medical equipment, trolleys and stretchers, Mr Wallace does not make any reference to exhibits showing use on such goods, and it appears to me that no such evidence has been provided.

90. On the basis of the evidence filed, I accept that actionable goodwill had been acquired under the “EVAC+CHAIR” sign prior to the relevant date in relation to “*wheeled chairs for transporting people down stairs*” at least as far as these goods fall within the claimed “*apparatus for use as mobility aids for the disabled*” and that “EVAC+CHAIR” is distinctive of that goodwill. I note that this list is no wider than the list of the Opponent’s goods where I found genuine use had been made and that have been assessed under section 5(2)(b). I do not consider that the section 5(4)(a) ground puts the Opponent in any stronger position than its 5(2)(b) case and although the test for misrepresentation requires that a substantial number of members of the public are deceived rather than whether the average consumer is confused, it has been recognised in *Marks and Spencer PLC v Interflora* that it is doubtful whether the difference between the legal tests will in general produce different outcomes.<sup>20</sup> I consider that for those goods in relation to which I have found no likelihood of confusion, the differences in the Opponent’s sign and the Applicant’s mark would be sufficient to avoid a substantial number of consumers being misled into believing that the Applicant’s goods are those of the Opponent or an entity linked to it. Consequently, this ground of opposition does not take the Opponent any further and I reject it in respect of all of the Applicant’s goods.

*Outcome under section 5(4)(a)*

91. The opposition under section 5(4)(a) fails.

### **Section 5(3)**

92. Section 5(3) of the Act states:

*“(3) A trade mark which-*

*(a) is identical with or similar to an earlier trade mark,*

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<sup>20</sup> [2012] EWCA (Civ) 1501.

*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*

*(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.*

93. The relevant case law in respect of section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a

reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

94. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier mark is similar to the Applicant's mark. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

95. The Opponent claims a reputation for its 425 and 569 marks. In respect of these marks, the first condition of similarity between the marks is satisfied: as found earlier in my decision, the Opponent's marks are visually, aurally and conceptually similar to the Applicant's mark to a medium degree.

96. The next condition is reputation. I found earlier in my decision that the Opponent had shown use in respect of "*wheeled chairs for transport of people in staircase; wheeled chair with runners for use by a person for transporting another person down stairs particularly from an upper floor of a building in an emergency; wheeled chairs equipped with intermediate wheels allowing, in case of emergency, evacuation of a person by another by staircase rings, earrings and watches*". Under this ground of opposition I must consider whether the Opponent had a reputation amongst a significant proportion of the relevant public at the relevant date. In *General Motors*, the CJEU held that:

*"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined. Page 40 of 52* 26. *The degree of knowledge required must be*

*considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.*

*27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.*

*28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."*

#### Reputation

97. Earlier in this decision, I found the distinctive character of the Opponent's marks to have been enhanced through use. The same evidence demonstrates that the Opponent has the requisite reputation too.

#### Link

98. As I noted above, my assessment of whether the public will make the required mental "link" between the marks must take account of all relevant factors. The factors identified in *Intel* are:

#### *The degree of similarity between the conflicting marks*

99. Earlier I found a medium degree of visual, aural and conceptual similarity to exist between the Applicant's mark and the Opponent's marks.



*The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between the goods and the relevant section of the public*

100. Earlier in my decision, I commented that certain goods are identical, and then went on to treat all of the goods as identical. I will do the same here.

*The strength of the earlier mark's reputation*

101. I consider that the Opponent has shown a reasonable reputation in respect of “*wheeled chairs for transport of people in staircase; wheeled chair with runners for use by a person for transporting another person down stairs particularly from an upper floor of a building in an emergency; wheeled chairs equipped with intermediate wheels allowing, in case of emergency, evacuation of a person by another by staircase*”.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

102. As identified earlier in this decision, the Opponent's marks possesses a low degree of inherent distinctive character which had been enhanced through use, resulting in a medium degree of distinctive character.

*Whether there is a likelihood of confusion*

103. There is no likelihood of confusion, as found earlier in this decision.

104. Although a likelihood of confusion is not necessary to find there is a link, I find that there will be no link.<sup>21</sup> Given the common use of “EVAC” in the market, the differences between the marks and the high degree of attention paid by the average consumer, I consider that even for identical goods, no link would be formed in the minds of the relevant section of the public between the respective marks.

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<sup>21</sup> Intra-Press SAS v OHIM, Joined cases C-581/13P & C-582/13P, CJEU.

### Unfair advantage/detriment to reputation or distinctive character

105. In the absence of the relevant public making a mental link between the marks, the Opponent's claims of unfair advantage and/or detriment cannot succeed. I consider that, even if I am wrong and a section of the public would make a link between the marks, the opposition under section 5(3) would still fail. I consider that the strength of any link would be weak due to the descriptive connotations of "EVAC" and the differences that exist between the Applicant's and Opponent's marks. For these reasons, I consider it to be unlikely that there would be any economic consequences, either increasing sales under the contested mark, or reducing sales under the earlier mark, if a section of the public were to make a mental link between the marks. For the same reasons I consider it unlikely that any detriment to the distinctive character or reputation would occur.

#### *Outcome under section 5(3)*

106. The section 5(3) ground of opposition fails.

#### **Overall outcome**

107. The grounds of opposition under section 5(2)(b), 5(3) and 5(4)(a) have all failed. The opposition therefore fails and the Applicant's mark may proceed to registration.

## Costs

108. The Applicant has successfully defended the opposition and is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£400
Preparing evidence and considering and commenting on the other side's evidence	£1,200
Preparing submissions in lieu of a hearing	£400
TOTAL	£2,000

109. I order Evac+Chair International Limited to pay Invictus Global Limited the sum of £2,000. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2nd day of February 2023**

**Charlotte Champion**

**For the Registrar**