

**O/514/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE APPLICATION FOR TRADE MARK NO. 3422877  
IN THE NAME OF DATSUN BIOMEDICAL (UK) LIMITED FOR THE TRADE MARK**



**IN CLASS 10**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER 418242**

**BY**

**GBUK GROUP LIMITED**

## Background and pleadings

1. On 21 August 2019, Datsun Biomedical (UK) Limited (“the applicant”) applied for the trade mark shown on the cover page of this decision (number 3422877) in class 10 for *medical devices*.
2. The application was published for opposition purposes in the *Trade Marks Journal*, on 30 August 2019. On 29 October 2019, GBUK Group Limited filed an opposition to the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) and 5(3) grounds are based upon the following earlier registered EU mark:<sup>1</sup>

16818247: filing date 8 June 2017; registered 26 October 2017



Colour Claimed : Red; White; Grey; Violet; Golden Yellow.

Class 10: *Medical apparatus and instruments; surgical apparatus and instruments.*

3. The opponent relies upon all of its goods, claiming that because the parties’ goods are identical and the dominant elements of the parties’ marks are highly similar, there will be a likelihood of confusion under section 5(2)(b) of the Act. Under section 5(3), the opponent claims a reputation in its goods such that the relevant public will believe the parties’ marks are used by the same undertaking or an economically linked undertaking. The opponent also claims that use of the applicant’s mark will erode the

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<sup>1</sup> Although the UK has left the EU, the EUTM is still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (Tribunal Practice Notice 2/2020 refers).

distinctiveness of the earlier mark, damage its repute, and give an unfair advantage to the applicant by virtue of the reputation of the earlier mark.

4. The opponent's section 5(4)(a) ground is based on use of the sign GBUK. The opponent claims that it first used GBUK in July 2008, throughout the UK, in relation to *medical apparatus and instruments; surgical apparatus and instruments; enteral feeding apparatus and instruments; gastrostomy apparatus and instruments; single-use disposable medical, surgical and critical care apparatus and instruments; patient moving and handling systems*. The opponent claims that its goodwill entitles it to prevent the use of the applicant's mark under the law of passing off.

5. The applicant denies all of the grounds of opposition and puts the opponent to proof of reputation and goodwill.

6. A hearing was held on 25 May 2021 at which the opponent was represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP. The applicant had been professionally represented by Murgitroyd & Company until the evidence rounds, but was not professionally represented thereafter. At the hearing, Mr Jonathan Yeung of the applicant made submissions on its behalf.

## **Evidence**

7. The opponent filed evidence which comes from the opponent's Chief Executive Officer, Mr Mark Thompson, in the form of a witness statement dated 26 October 2020, and exhibits. Two of those exhibits, MCT1 and MCT6, are the subject of a confidentiality order. I will refer to the evidence where appropriate in this decision.

## **Decision**

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

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

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

(a) ...

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

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

9. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“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.<sup>2</sup>

### **The principles**

(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

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<sup>2</sup> 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

### Comparison of goods

10. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, General Court ("GC"). The opponent's term *medical apparatus and instruments* encompasses the applicant's goods, *medical devices*. The parties' goods are identical.

### The average consumer and the purchasing process

11. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. Both parties goods are medical devices, apparatus and instruments. These are wide terms. They cover goods for use in GP surgeries, hospital wards and in hospital theatres; they also cover goods for use by the general public, such as asthma inhalers, devices for diabetics, masks, bandages and compression socks. There are, therefore, two groups of average consumer; medical professionals and the general public. It is likely that medical professionals will pay a high degree of attention to selection of the goods. The purchasing process will be primarily visual, although presentations by medical representatives will involve a combination of visual and aural use of the mark. It is also likely that the general public will pay a reasonably high degree of attention so that they make an informed choice in purchasing goods which they require to fulfil a medical purpose. The purchasing process will be primarily visual, from pharmacy and retail establishment shelves, where oral advice may also be sought, and via online retail channels.



## Comparison of marks

12. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not 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 Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

13. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

14. The marks to be compared are:

Opponent's mark	Applicant's mark
	

15. The opponent's composite mark is comprised of a multi-coloured circular device at the front of the mark, the letters and word GBUK Group, and four coloured dots beneath the 'ou' of the word Group. The coloured dots are proportionately much

smaller than the other elements and do not contribute much weight to the overall impression of the mark. The word Group is a common word for a company (or a member of a group of companies) and does not create much of a distinctive impact in the overall impression. Whilst the circular device is large, prominent, and is at the front of the mark, read left to right, the eye is drawn to the central letters, GBUK making it the dominant element.

16. The applicant's mark comprises the letters DBUK placed over the descriptive word Medical. Both words are contained within a rectangle, split horizontally so that each word element sits on a (different) coloured rectangle. The DBUK letters are thick and white and are prominent upon a dark blue background. The word Medical, sitting upon a shaded orange background, is less dominant in the overall impression of the mark because the word is descriptive and because it does not have a visual impact which is as strong as that of the DBUK element.

17. Both marks contain the letters BUK, in that order. The first letter of the 'letter' components is different in each mark, although there are certain visual similarities between the form of a G and a D. I note the colours used in the marks, and that the earlier mark has a colour claim. This helps to distance the marks visually, although the later mark could notionally be used in other colours. The dominant part of the later mark, DBUK, has a visually similar counterpart in the earlier mark, GBUK, which also occupies a dominant position. Consequently, I find that the marks are visually similar to a low to medium degree.

18. The stylisation will play no part in the aural perception of the marks. Group and Medical do not sound similar. The 'letter' components of each mark do not form pronounceable words which means that each letter will be articulated. The second, third and fourth letters are identical. The first letters sound similar, ending in a long, voiced 'ee' sound and both formed by using the teeth to make the initial sound.<sup>3</sup> It is the letter component which will be heard first, followed by the different words, Group and Medical. The marks are aurally similar to a medium degree if Group and Medical

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<sup>3</sup> The letters 'd' and 'g' are both voiced plosives.



are articulated. If they are not, since they are descriptive or non-distinctive, the marks are aurally similar to a high degree.

19. In the context of a trade mark, Group is likely to signify a company or group of companies. Medical is descriptive of medical goods and services. These words are not conceptually similar. The colours and the devices do not have concepts. This leaves the letter components to compare, GBUK and DBUK.

20. The applicant submits that UK will be seen as the abbreviation for United Kingdom and that this is commonly used in company names and brand names. It also claims that average consumers will see the DB part of its mark as the abbreviation of part of its company name, Datsun Biomedical (UK) Limited. I can only consider what is in the mark as applied for and, as Datsun Biomedical (UK) Limited does not form part of the mark, this is not something that I can take into account in comparing the parties' marks.

21. Whilst it is possible that both GBUK and DBUK may be perceived as abbreviations, an abbreviation is not really a concept. I agree that UK may evoke United Kingdom. I have considered whether GBUK may evoke both Great Britain and United Kingdom. However, I think the tautology of this makes it unlikely. If United Kingdom is evoked, the letter components have a low to medium degree of conceptual similarity. If United Kingdom is not evoked, the letter components are conceptually neutral. Overall, weighing up the different meanings of Group and Medical, together with the similar or neutral components, the marks are conceptually similar to a low degree, if United Kingdom is evoked, or conceptually neutral if it is not.

#### Distinctive character of the earlier mark

22. 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.<sup>4</sup> I will begin by considering the inherent distinctive character of the earlier mark *per se*, taking into account the guidance of the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH*

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<sup>4</sup> *Sabel BV v Puma AG*, Case C-251/95.

*v Klijsen Handel BV*.<sup>5</sup> In making my assessment of the earlier mark's distinctive character, I bear in mind that the distinctive character of the earlier mark will only increase the likelihood of confusion where the distinctiveness is provided by an aspect of the mark which has a counterpart in the later mark. If distinctiveness is provided by an element which is not common to the later mark, it will not increase the likelihood of confusion and is more likely to point away from it.<sup>6</sup>

23. The earlier mark is composed of several elements which, in combination, create an average degree of inherent distinctive character. The circular device has an average degree of distinctive character, and the dots and the word GROUP are low in distinctive character. The letters GBUK are not descriptive of the goods but, as the letters UK may signify United Kingdom, this element is of no more than an average degree of distinctive character. It is this element, GBUK, which is the only aspect of the earlier mark which has anything in common with the later mark.

24. I will now look at whether the opponent's evidence entitles it to claim that the mark's distinctive character has been enhanced through use made of it. Mr Yeung, at the hearing, said that he could see that the opponent is successful. However, although this might be seen as a concession, Mr Yeung was referring to the opponent. The assessment I must make is in relation to its earlier mark because distinctive character is a measure of how strongly the mark identifies the goods of the opponent; determined, according to *Lloyd Schuhfabrik Meyer & Co.*, by assessing the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking. This point is fundamental and the evidence is not as clear as it could be in highlighting turnover of goods in relation to which the earlier mark has been used, as opposed to the opponent's turnover. The evidence shows that the opponent has used more than one mark, including the following four marks:

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<sup>5</sup> Case C-342/97.

<sup>6</sup> See *Kurt Geiger v A-List Corporate Limited* BL O/075/13 at paragraphs 38 to 39, Mr Iain Purvis QC, sitting as the Appointed Person.




[gbukhealthcare.com](http://gbukhealthcare.com)

25. Mr Thompson states that the opponent's goods fall into three "brands": GBUK Banana, GBUK Enteral and GBUK Healthcare (these appear to be subsidiaries of the opponent, as well as brands). Mr Thompson concludes his witness statement by stating that the "GBUK trade mark" is central to his company and that it appears "in one form or another" on all of the opponent's products.

26. GBUK Banana sells goods for patient handling and moving. Exhibit MK2 contains extracts from product catalogues dating from 2016 and 2019. The earlier mark does not appear in the 2016 version, but it appears on the back page of the 2019 version. The 2019 version was produced in "08/19", which I take to mean August 2019. This was the month in which the contested application was filed.

27. GBUK Enteral specialises in enteral feeding tubes, syringes, gastrostomy devices and enteral ancillaries. Exhibit MK3 contains extracts from a 2018 product catalogue. The front page carries the following mark:



Other pages carry . The final page shows the earlier mark.

28. GBUK Healthcare specialises in surgical suction and wound drainage devices. Mr Thompson states that the brochures contained in Exhibit MCT4 date from 2018 and 2020. The contested application was filed in 2019, which means that the 2020 brochure is after the relevant date. The 2018 brochure cover page shows this mark:



but I note that page 3 of the brochure also shows the following, which includes the earlier mark:



29. Although Mr Thompson gives details in Exhibit MCT5 of the 1,650 products which the opponent sells to the NHS and the date on which they were first available, there is no indication as to the particular trade marks used in relation to those goods, and it is clear from the above that the opponent has used marks other than the earlier mark relied upon in these proceedings. The search term used to bring back this list on the NHS procurement website was “gbuk”. Mr Thompson states that the earlier mark appears on packaging, including that for ‘drawing up straws and syringes’. Exhibit

MCT7 contains images of such items bearing the earlier trade mark. The photographs are undated. However, some of the items bear dates of manufacture (and expiry). I note that all but three of these date from 2020 or later, after the relevant date in these proceedings. The other three date from March and April 2019, just a few months before the relevant date. Exhibit MCT8 comprises three screenshots from the opponent's website, Twitter and LinkedIn, but these were all downloaded on 17 July 2020. Exhibit MCT9 comprises printouts obtained from the Wayback Machine showing the opponent's website homepage on 5 November 2016, 21 August 2017, 18 January 2018, 3 November 2018, 19 December 2018 and 10 May 2019. Mr Thompson states that the printout for 5 November 2016 bears the opponent's previous branding:



30. I note that the other pages of the opponent's corporate website did show the earlier mark relied upon in these proceedings, along with the brands used by the three subsidiaries, GBUK Banana, GBUK Enteral and GBUK Healthcare. The opponent's 2019 corporate brochure is provided as Exhibit MCT10, showing the earlier mark and also GBUK Group, and the three subsidiary brands. The export brochure shown in Exhibit MCT11 from 2015/2016 shows the opponent's previous branding (shown above this paragraph and earlier in this decision). The earlier branding appears on the opponent's show stands at a major international medical equipment exhibition in Germany in 2015, but the earlier mark is shown from 2017 onwards.<sup>7</sup> An exhibition in Dubai does not show the earlier mark until 2020, after the relevant date.<sup>8</sup> Other exhibitions in the UK and Germany are mentioned in the evidence, but these took place after the relevant date.<sup>9</sup>

31. Whilst the opponent's turnover runs to millions of pounds, it is not clear to me from the evidence how much of that is owing to use of the earlier mark relied upon in these proceedings and how much is down to use of other marks. The product packaging

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<sup>7</sup> Exhibit MCT14

<sup>8</sup> Exhibit MCT15

<sup>9</sup> Exhibit MCT16

either post-dates the application date or is dated from only four or five months prior to it. Although the corporate brochures carried the earlier mark from 2017 onwards, these were corporate brochures. It is unclear what exposure the average consumer would have had to such brochures, as opposed to product catalogues, which bear the other marks for the three subsidiaries. Of the product catalogues shown in the evidence, one dates from the same month as the application date and the other two date from 2018, only a year or less prior to the application date.

32. I have considered whether the use of the other marks can be taken into account where they include GBUK (i.e. not the Banana and circular device composite mark). This is because if the use has been with other trade marks, this is not necessarily a bar to a finding of enhanced distinctive character; it depends on the facts of the case, including the nature of the use and the distinctiveness of the mark itself. In *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, the CJEU held that a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark. The CJEU stated in *Specsavers v Asda* Case C-252/12, at paragraph 23, that it is necessary that “the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking.”

33. The present case does not fall into this category. The earlier mark relied upon is not used as part of another mark or in conjunction with another mark. The other marks differ substantially from the earlier mark. Further, the element common to the various marks, GBUK, is of no more than average distinctiveness, which means that other matter, or a different way of representing GBUK, affects its perception. Looking at all of this in the round, I am unable to conclude that the inherent distinctive character of the earlier mark has been enhanced through use. There is not enough evidence to show that the earlier mark, as opposed to other marks, had been in use long enough and with sufficient exposure to average consumers to make it any more distinctive than it already was.

#### Likelihood of confusion

34. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in

accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the goods are identical. I find that direct confusion is unlikely because the differences between the marks will be noticed by average consumers who will pay a reasonably high degree of attention (or higher).

35. I, nevertheless, find that there is a likelihood of indirect confusion. This type of confusion was explained by Mr Iain Purvis QC, 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 or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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

36. These are not exhaustive categories. Whilst I consider that the applicant’s mark does not fall neatly into any of the above, there is, nevertheless, something about the marks which will cause the average consumer to consider that they belong to the same or to an economically linked undertaking. That something is provided by the common elements GBUK/DBUK which are the dominant elements of the parties’ marks and which do not create different conceptual pictures. The elements do not have to be the same to conclude that there is a likelihood of confusion.<sup>10</sup> I have not forgotten that I should not simply take one component of the applicant’s mark and compare it with the earlier mark, or a component thereof. My conclusion is based upon imperfect recollection of the common, dominant, elements plus the addition of elements which are descriptive, low in distinctive character or non-distinctive. The GBUK/DBUK components have the ring of a company identifier: the opponent’s GBUK is followed by Group, and the applicant’s DBUK is followed by Medical, which describes the goods or the type of company. A succession of letters, such as these, with no pronounced conceptual hook, and with similar sounding first letters, is prone to imperfect recollection, even if a higher level of attention is paid to the purchase, a purchase in which aural perception is likely to feature as well as visual. The other aspects of the parties’ marks are either low in distinctive character (as in example (b) of *L.A. Sugar*) or, as in the circular device, are not of such a nature as to avoid a conclusion that these are variant or sub-brands of the same or economically linked undertakings, for identical goods. The section 5(2)(b) ground succeeds.

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<sup>10</sup> *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch)



## Section 5(2)(b) outcome

37. The ground of opposition under section 5(2)(b) succeeds.

## Section 5(3) of the Act

38. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark 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.”

39. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. 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.

(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 on 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*).

40. 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.<sup>11</sup> 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. In this case, the parties' goods are identical.

41. The first condition of similarity between the marks is satisfied: as found earlier in this decision, the earlier mark is visually similar to the applicant's mark to a low to medium degree; aurally similar to a medium or high degree; and conceptually similar to a low degree, or conceptually neutral.

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<sup>11</sup> A reference was made to detriment to repute in the notice of opposition (TM7), but, in contrast to the claims of detriment to distinctive character and unfair advantage, it was not fleshed out in the accompanying statement of case.

42. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. 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.

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.”

43. Although I bear in mind that the question relates to a knowledge requirement, similar issues arise here as in relation to enhanced distinctive character. The evidence is thin in respect of the earlier mark which is relied upon, as opposed to other marks. The opponent’s use of its earlier mark also commenced only a couple of years prior to the relevant date, and the high point of that part of its evidence relates to corporate brochures and its corporate website, as opposed to product catalogues. There is little showing the mark on packaging prior to the relevant date, and what there is pre-dates the application by five months at the most. Viewing the gaps in the evidence with the relatively short period of time in which the earlier mark had been used, the evidence does not support a finding that the earlier mark was known by a significant part of the

public concerned at the relevant date. As the mark did not have a reputation for the purposes of section 5(3) at the relevant date, the section 5(3) ground fails.

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

44. The ground of opposition under section 5(3) of the Act fails.

### **Section 5(4)(a) of the Act: passing off**

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

“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, or

(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.”

46. The three elements which the opponent must show are well known. 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)."

47. The applicant has not filed any evidence that it has used its mark. This means that the position must be assessed at the date when the applicant applied to register its trade mark: in this case, 21 August 2019.<sup>12</sup>

48. The sign relied upon by the opponent for this ground of opposition is GBUK. The opponent needs to show that its business had sufficient goodwill which was distinguished by use of GBUK at the relevant date so that it can be concluded that misrepresentation would occur and damage would follow. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] 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."

49. Sufficient goodwill, although an evidence-based assessment, is different to the questions looked at earlier in this decision, for enhanced distinctive character and reputation of the earlier registered mark. The sign relied upon is also different to the earlier mark relied upon for the other two grounds of opposition. The letters GBUK are a feature of not only the registered mark which has been used latterly in corporate literature and the corporate website, but is also a feature of the following signs which

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<sup>12</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person.

have been used in product catalogues and on packaging pre-dating the application date<sup>13</sup>:



gbukhealthcare.com



50. Press reports in Exhibit MCT17 refer to GBUK (those which pre-date the relevant date). The turnover for the various arms of the opponent using the different marks which incorporate the letters GBUK run to many millions of pounds, and marketing expenditure has been in the hundreds of thousands of pounds. I find that the opponent enjoyed substantial goodwill in its business distinguished by the sign GBUK at the relevant date for medical apparatus and instruments; surgical apparatus and instruments; enteral feeding apparatus and instruments; gastrostomy apparatus and instruments; single-use disposable medical, surgical and critical care apparatus and instruments; patient moving and handling systems.

51. Earlier in this decision, I discussed the similarities between the earlier registered mark, which comprised elements other than GBUK, and the applicant's mark and found that there is a likelihood of confusion. 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 produce different outcomes.<sup>14</sup> If anything, the opponent is in a stronger position under this ground as the sign GBUK is closer to the applicant's mark than the earlier registered mark, for which I found a likelihood of confusion. I find that there

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<sup>13</sup> Exhibit MCT19

<sup>14</sup> [2012] EWCA (Civ) 1501

would be misrepresentation, even if unintentional, and damage would follow, most likely in the form of diversion of trade. Mr Yeung submitted that it is the medical certification of goods which is important in this trade, not the actual trade marks used. That is not something which I can take into account, even if it were to be the case. This dispute is about the parties' trade marks.

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

52. The ground of opposition under section 5(4)(a) of the Act succeeds.

### **Overall outcome**

53. The opposition succeeds. The application is refused.

### **Costs**

54. The opponent has been successful and is entitled to a contribution towards its costs. Mr Fiddes was content for costs to be awarded from the published scale.<sup>15</sup> The breakdown of the cost award is as follows:

Statutory fee for the opposition	£200
Preparing a statement and considering the counterstatement	£300
Preparing evidence	£700
Attendance at a hearing	£500
Total	£1700

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<sup>15</sup> Tribunal Practice Notice 2/2016.



55. I order Datsun Biomedical (UK) Limited to pay to GBUK Group Limited the sum of **£1700**. 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 6th day of July 2021**

**Judi Pike**

**For the Registrar,  
the Comptroller-General**