

O/0381/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003704508

BY PHARMAOUEST INDUSTRIES S.A.S.

TO REGISTER THE FOLLOWING MARK:

PREVENTIX

IN CLASSES 10, 20 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP600002390

BY PREVENTX LIMITED

Background and pleadings

1. On 30 September 2021, PHARMAOUEST INDUSTRIES S.A.S. (“the applicant”) applied to register the trade mark (shown below) No. UK00003704508 and the application was published for opposition purposes on 25 March 2022. The mark has a priority date of 24 November 2020.

PREVENTIX

2. The registration is sought for the following goods:

Class 10 Cushions for medical purposes; Air cushions for medical purposes; Seat cushions for medical purposes intended for the prevention of pressure sores, cushions of memory foam for medical purposes; Pads for preventing pressure sores on patient bodies; Pressure-relief devices, namely heel supports, Elbow pads, Footmuffs; Cervical pillows; Air pillows for medical purposes; Mattresses and mattress overlays for medical purposes.

Class 20 Bedding, except linen, Beds; Bed fittings, not of metal; Bedding, except linen; Bed bases; Cushions not for medical purposes; Air cushions, not for medical purposes, Mattresses and mattress overlays, not for medical purposes, Air mattresses, not for medical purposes; Pillows and Air pillows, not for medical purposes; Bolsters.

Class 44 Medical services; Hygienic care for human beings; Medical assistance; Hospital services; Medical equipment rental; Medical information and consultancy.

3. Preventx Limited (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent answers Question 11 on their Form TM7F – “Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark and listed at Q1?” - as follows:

“Class 10

A range of devices "for medical purposes" and for use within the medical diagnostic and treatment field.

Class 44

"Medical services"

"Medical equipment" (though it is my understanding this class is not for equipment)

"Medical information and consultancy"

4. While I note that applicant’s submissions on the similarity of the respective goods and services at paragraphs 15 and 16 analyse the level of similarity of all of its Class 10 goods and Class 44 services, I need to consider the opponent’s response to Question 11 which could be said to be ambiguous.

5. I take the text supplied under Class 10 to be the opponent describing the opposed goods at a general level without listing them one by one and so I consider the opponent to be opposing all of the applicant’s Class 10 goods. However, in respect of the Class 44 services, the opponent only refers to some of the terms as they are listed in the applied-for specification, using direct quotes, and I confine the opposition to these terms as follows:

Medical services; Medical equipment rental; Medical information and consultancy.

6. The opposition is reliant upon the mark detailed below.

7. Trade mark No. UK00002573451, filed on 28 February 2011 and registered on 3 June 2011.

PREVENTX

8. The opponent states that it relies upon the following Class 10 goods:

“The terms "apparatus" relating to "health (and health related) conditions".”

9. The Class 10 goods that the opponent has registered are as follows:

Apparatus and kits for instant, rapid and remote (laboratory) diagnostic testing, including analysing for the presence of drugs, alcohol and health (and health related) conditions.

10. If I was to accept the opponent's wording, it would have the effect of widening its specification. Consequently, I concur with the applicant's assertion at paragraph 6 of its submissions that the opponent's relied-upon Class 10 goods should be expressed as follows:

Apparatus for instant, rapid and remote (laboratory) diagnostic testing, including analysing for the presence of health (and health related) conditions.

11. The opponent states that it also relies upon the following Class 44 services, the wording of which I accept:

Medical information, advice, consultancy, diagnosis and treatment services.

12. The opponent filed a Form TM7F, a notice of “fast track” opposition, which can be used when the opposition is based on sections 5(1) and/or 5(2) of the Act. The opponent argues that the similarity of the respective marks will lead to a likelihood of confusion even though its products may appear, at face

value, to lack similarity to the applicant's products. However, I remind myself that I need to consider the question of similarity on a notional basis, looking at the respective specifications, rather than paying regard to the actual goods and services that the parties currently sell.

13. In this instance, the opposition being based on a mark that had been registered for five years or more on the date of the applicant's priority date, the opponent was required to include evidence of use of the mark to demonstrate that the mark had been genuinely used as per section 6A of the Act, which it duly did.
14. The applicant filed a Form TM8 and accompanying counterstatement, denying the claims made.
15. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
16. Except where filing proof of use evidence is a prerequisite, the net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
17. In addition to the opponent's proof of use evidence, which was mandatory, neither party sought leave to file further evidence.

18. An oral hearing was neither requested nor was it considered necessary.
19. The applicant filed written submissions in lieu of a hearing. The opponent did not file any written submissions.
20. The applicant is represented by Page, White & Farrer Limited, while the opponent is representing itself.

Evidence

21. The statement of truth section of the Form TM7F is signed and dated 7 June 2022 by Tim Alston, Co-Founder and Director of the opponent. There are seven questions – Questions 3 to 9 – of which answers are provided for Questions 3 to 5 and 7 to 9. A “List of Exhibits” is provided, along with Exhibit 1 to Exhibit 14.

DECISION

22. Although the UK has left the EU, section 6(3)(a) of the European (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.

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

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

(a)...

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

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

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

“(1) In this Act an “earlier trade mark” means—

(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.

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

25. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined above.

Proof of use

26. The opponent’s mark had been registered for more than five years at the priority date of the applied-for mark and therefore the proof of use provisions apply.

27. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

“(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),

(b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

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

(3) The use conditions are met if-

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

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

(4) For these purposes-

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

mark in the variant form is also registered in the name of the proprietor),
and

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) [...]

(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.”

28. Section 100 of the Act is also relevant, which 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.”

29. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the applicant’s priority date i.e. 25 November 2015 to 24 November 2020.

30. 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 Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken 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].”

Use of the mark

31. The literature and photographs provided by the opponent show the trade mark use of the opponent’s mark as part of an e-mail signature block, on packaging, on presentations and marketing material, and on the side of a building. The mark is shown as “Preventx” with a bold full stop or with the “x” of “Preventx” being in the contrast colour of magenta. It is well established case law that the variation of case from the word mark as registered is acceptable¹ and neither the bold full stop, nor the use of the letter “x” in a different colour alter the distinctive character of the mark. These are acceptable variances.

32. In some cases, the mark with the contrast colour “x” also appears with a strapline of “Integrated Diagnostics” or with the website address www.preventx.com. In this regard, I am mindful of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that (with my emphasis added):

¹ Case T-364/04 *Sadas SA v. OHIM*

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

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

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product

at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

33. I am of the view that, when the earlier mark is used in conjunction with the descriptive strapline of "Integrated Diagnostics" or with the website address www.preventx.com which simply restates the name of the mark, it continues to be perceived as indicative of the origin of the opponent's goods and services. My conclusion is therefore that the use the opponent has made of the earlier mark in conjunction with the strapline or website address is use that counts towards genuine use.

34. There are also other brands on display in the evidence.

35. As explained by the opponent in response to Question 5 in its Form TM7F, "Preventx is the established leader in remote health testing. While services are delivered to consumers via a range of brands, Preventx is the established corporate brand (Ex.2, 11) via which these services are commissioned, and is therefore recognised by National Health Service and Local Authority commissioners and professionals (Ex.12, 14)."

36. To quote from Exhibit 1:

"Preventx is the largest provider of remote sexual health testing in the UK.

We are a trusted partner, supplier and adviser to the NHS and local authorities across the UK, and through Sexual Health London we partner with the NHS to run the largest publicly funded remote testing programme anywhere in the world."

37. Exhibit 1 goes on to explain that Preventx has a range of services – SH.UK, SHL.UK, FREESTESTME, and TEST.ME. These are some of the brands referred to as a "a range of brands" in the opponent's response to Question 5 in its Form TM7F. Consequently, the target consumer of Preventx's goods and services under the Preventx mark is a collective purchaser of

health services – NHS bodies and local authority commissioners of health services.

38. As is noted by the applicant (in paragraph 13 of its submissions), brands other than Preventx feature in Exhibit 3. The web pages on the Freetest.me service feature the freetest.me logo and the NHS logo, but also show the opponent's mark above which is the statement "Proudly operated by Preventx from Sheffield." The web pages on the Sexual Health London service show the Sexual Health London logo and again show the NHS logo. The Sexual Health London information also displays the Preventx mark, the Chelsea and Westminster NHS Trust logo, the Lloyds Pharmacy Online Doctor logo, and the Care Quality Commission logo, above which is the statement "Proudly operated by Preventx (CQC), Chelsea and Westminster NHS Trust (CQC), Lloyds Pharmacy Online Doctor (CQC)" appears.

39. I am reminded of *Castellblanch SA v OHIM, Champagne Louis Roederer SA* [2006] ETMR 61 (General Court) (in which CRISTAL was the product name and Louis Roederer the name of the manufacturer) where it was said, "Joint use of those elements on the same bottle does not undermine the function of the mark CRISTAL as a means of identifying the products at issue." This case is not as straightforward as the CRISTAL case. However, the target consumer is a collective purchaser of healthcare services. Such a consumer would see the specific testing services as branded for end consumers, but they would see Preventx as the means of identifying the testing services that they sought to collectively purchase. The NHS would be recognised as a separate entity. Even where the NHS and local authorities were commissioning such services on a partnership basis, Preventx would be recognised as the mark of a potential supplier of testing services.

Sufficient use

40. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²
41. In response to Question 4 on its Form TM7F about where the mark has been used, the opponent has ticked the box for use throughout the UK. It has also supplied evidence in the form of Exhibit 4 which is a map of the UK showing current national coverage (i.e. post the relevant period). The map is colour-coded according to “service variants”, but there is no further information as to what the service variants are for each colour and extent of sales according to colour-coded area.
42. Some of the exhibits are undated or date from before or after the relevant period. In Exhibit 1, an example email with a corporately branded signature block and a corporately branded ID card are undated. The corporate website has a copyright statement which is dated 2022, the oldest news item being from 25 October 2021.
43. Exhibit 2 features photographs from 2011 and 2017 where Preventx branding is in evidence. The within-the-relevant-period photographs from 2017 show the company offices with a large version of the opponent’s mark on the side of the building (photograph copied below), and office space and a laboratory with the mark prominently displayed on the walls.

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09



44. The web pages for the specific testing services that Preventx operate all have 2022 copyright statements and Exhibit 4 is a map of “current” geographic coverage (i.e. at the date of filing the evidence).

45. Exhibit 5 – photographs of test kits – is undated.

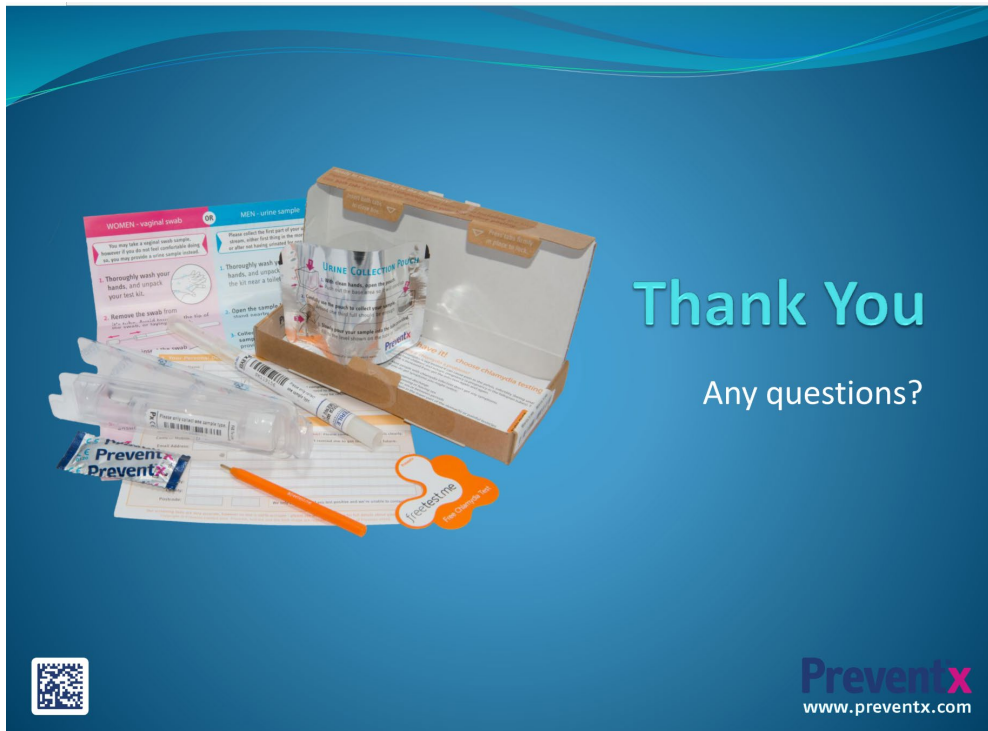
46. Exhibit 6 is “a recent infographic used on our social media as the business passed a significant milestone”. This shows the company’s first testing service being launched on 1 November 2008 and then other milestones being reached between 2011 and 2014. There are then the following milestones that are within the relevant period (assuming the activity on the 2020 milestone began prior to 24 November 2020):

“2018: Launched SHL.UK to provide self-sampling across 30 London boroughs.”

2019: Launched the national SH.UK digital sexual health service.

2020: Supported 87 NHS trusts & local authorities through the Covid pandemic, expanding our services to cover symptomatic testing and contraception.”

47. Exhibit 7 consists of two photographs from a business awards ceremony – one from 2012 and one from 2014, together with a 2014 newspaper article on the awards ceremony. These exhibits pre-date the relevant period.
48. Exhibit 8 consists of screenshots from two Preventx Vimeo videos – a lab tour and instructions on how to take a vaginal swab. The videos are undated.
49. Exhibit 9 is an undated photograph taken from a television programme broadcast. The opponent says it features a Preventx STI kit, but it is too small to be seen.
50. Exhibit 10 is a plaque commemorating the opening of an expanded Preventx laboratory facility in November 2021, post the relevant period.
51. Exhibit 11 is an extract from the Preventx Laboratory Quality Manual. The version control page says that it was originally created in September 2018 (within the relevant period), this version being from August 2021. However, because the manual is an internal document, it is unlikely that it would be seen by the average consumer.
52. Exhibit 12 consists of excerpts from presentations used for “NHS clinical services and public sector commissioners”. The slides, which appear to date from 2016 (within the relevant period), cover Preventx’s services, methods, performance, and feedback received, as well as discussion of testing kits and a photograph of such a kit (see slide below).



53. There are two slides which feature detailed analysis of Preventx's performance from 2008 until 2016. A slide on the freetest.me service shows a graph of weekly sessions peaking at around 17,000 in 2016 (within the relevant period). Another slide shows monthly chlamydia screenings from November 2008 to June 2016 (the data points from November 2015 to June 2016 being within the relevant period).
54. Exhibit 14 consists of two tweets following a conference for professionals in the sexual health field, dated from after the relevant period – March 2022 and June 2022.
55. In response to Question 7 on its Form TM7F ("Please provide details of the number of sales achieved under the mark in the UK (or in the EU if the earlier mark is registered or protected at Community level) during the relevant period, these figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods/services for which use of the mark is claimed; estimates should be provided if exact figures are not readily available"), the opponent has answered the following:

“Preventx UK Revenue (for year ending):

31/03/15	£1,859,500
31/03/16	£2,144,600
31/03/17	£2,900,400
31/03/18	£3,554,000
31/03/19	£9,123,480
31/03/20	£12,327,000
31/03/21	£19,082,400
31/03/22	£24,151,600

Typical prices are £5 per kit apparatus and range from £15-85 for subsequent service (laboratory testing).

These figures are based on products and services sold by Preventx. The goods and services fall under both Class 10 and Class 44 or can be considered a mix of both Classes therefore it is not easily possible to split these sales figures.”

56. Of these revenue periods, the figures for the year end 31/03/15 and 31/03/22 fall outside the relevant period. The total revenue for the financial years ending 31/03/16 to 31/03/21 is £49,131,880. However, only part of year end 31/03/16 and 31/03/21 fall within the relevant period.

57. In paragraph 12 of its submissions, the applicant says the following: “The Opponent states in answer to Q5 of the TM7F form [relating to examples of use of the mark in use in the relevant period] that “While services are delivered to consumers via a range of brands, Preventx is the established corporate brand (ex.2,11) via which these services are commissioned ...”, therefore the revenue figures provided in Q7 cannot be solely attributed to use of the Preventx mark and certainly not directly attributed to use of the mark in relation to “apparatus relating to health (and health related)

conditions” and/or “medical information, advice, consultancy, diagnosis and treatment services”.

58. The opponent has acknowledged that it transacts its business as Preventx directly with the NHS and local authorities as opposed to with end consumers. The evidence, albeit some of it is after the relevant period, tends to corroborate this. The evidence indicates that many of the testing services offered by the opponent are free to the consumer and so it is apparent that they are funded by health bodies who pay the opponent for running the service. There is evidence of health professionals (as opposed to the end consumer) being targeted by the opponent in the form of the Preventx-branded corporate home page (Exhibit 1), excerpts from presentations used for “NHS clinical services and public sector commissioners” (Exhibit 12), and two tweets from a conference for professionals in the sexual health field (Exhibit 14). There is also some material aimed at the end consumer, as in Exhibit 3 which explains the purpose and benefits of the various test services that Preventx operates. On that material, testing services are individually branded and the Preventx mark is shown as that of the testing service operator.

59. Given the above analysis, I consider the revenue figures quoted by the opponent to be valid.

60. While there is no information supplied as to the size of the market, market share, or advertising expenditure, the evidence of annual revenue in respect of testing services is considerable and grew exponentially during the relevant period.

61. The opponent has stated that its mark has been used throughout the UK and has supplied colour-coded evidence of activity on a UK map, albeit with insufficient detail from which to draw precise conclusions. It can also be seen from Preventx’s descriptions of its various testing services that one of them covers London, another one is England-wide, and another covered “over 80 local authorities”.

62. Given the information supplied on revenue and geographic extent, and even allowing for in-date corroborating evidence being relatively modest, I am satisfied that the opponent has demonstrated genuine use of its mark within the UK. Its use of its mark is clearly more than merely token use. I consider there to be real commercial exploitation of the mark on the market for at least some of the relevant goods and services, about which I go into more detail below. The use shown is in accordance with the commercial *raison d'être* of the mark i.e. the use creates or preserves an outlet for the goods and services that bear the mark.

Fair specification

63. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas*

Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

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

65. The evidence provided is primarily of medical apparatus and testing services relating to sexual health. However, while I consider it disproportionate to narrow the opponent's specification to that field of activity alone, it would also be excessive to allow the opponent to retain their wide range of Class 44 services. For example, there is no evidence of the opponent offering any treatment services.

66. I consider a fair specification for the opponent's mark to be:

Class 10 Apparatus for instant, rapid and remote (laboratory) diagnostic testing, including analysing for the presence of health (and health related) conditions.

Class 44 Medical diagnosis services.

Case law

67. 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. That is why this decision continues to make reference to the trade mark case-law of EU courts.

68. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of the goods and services

69. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

70. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

71. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

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

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

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

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

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

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

73. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

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

for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

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

75. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

While on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

76. The goods and services in question are below.

Opponent's goods and services	Applicant's goods and services
<p><u>Class 10</u> Apparatus for instant, rapid and remote (laboratory) diagnostic testing, including analysing for the presence of health (and health related) conditions.</p>	<p><u>Class 10</u> Cushions for medical purposes; Air cushions for medical purposes; Seat cushions for medical purposes intended for the prevention of pressure sores, cushions of memory foam for medical purposes; Pads for preventing pressure sores on patient bodies; Pressure-relief devices, namely heel supports, Elbow pads, Footmuffs; Cervical pillows; Air pillows for medical purposes; Mattresses and mattress overlays for medical purposes.</p>
<p><u>Class 44</u> Medical diagnosis services.</p>	<p><u>Class 44</u> Medical services; Medical equipment rental; Medical information and consultancy.</p>

Class 10

77. The applicant's Class 10 goods are all cushions, pads and supports, some of which are specified as being for medical purposes, while the opponent's goods are diagnostic testing apparatus (such as syringes). While they share a very broad medical purpose, they differ in their specific natures, purposes, and methods of use. They might be sourced from the same broad trade channels, but they would be stocked in different parts of a physical or online chemists or medical supplier. Furthermore, the opponent's goods could be subject to restrictions as to their sale (regulations to do with needles and so forth). The respective goods are neither complementary, nor are they in competition. I find these goods to be dissimilar.

Class 44

78. The applicant's "Medical services" are *Meric* identical to the opponent's "Medical diagnosis services" in that the services designated by the earlier mark are included in a more general category designated by trade mark application.
79. The applicant's "Medical equipment rental" is a general medical service by comparison with the opponent's specific diagnosis service. They differ in nature and method of use to the extent that the former is an equipment rental service, whereas the latter is a packaged service which could include the provision of personnel and premises as well as equipment. In terms of trade channels, while such services would be categorised differently, both would be sold through chemists for individual purchasers and medical suppliers for collective purchase by health bodies. While the services are not complementary, there would be a limited degree of competition where a health body seeking to run a diagnosis service was choosing between the whole package and just the equipment element. I find the respective services to be of low similarity.
80. "Medical information and consultancy" is a general medical service by comparison with the opponent's specific diagnosis service. They differ in nature and method of use to an extent. The former involves the provision of expert advice. The latter, while advice might be offered as part of the service, primarily involves the physical delivery of a medical service. In terms of trade channels, there would be some convergence in that the marketing of a diagnosis service might also entail the provision of advice and consultancy on the possible health conditions for which a diagnosis might be sought. On the other hand, medical advice and consultancy might be offered through an entirely separate portal. While the services are not complementary, there could be a limited amount of competition in that a consumer might choose between a diagnosis service that included advice and consultancy about a health condition that they were concerned with, or they might choose a

freestanding advice and consultancy service. I find the respective services to be of low similarity.

81. As some degree of similarity between the services is required for there to be a likelihood of confusion³, the opposition must fail in respect of the following goods in the applicant's specification:

Class 10 Cushions for medical purposes; Air cushions for medical purposes; Seat cushions for medical purposes intended for the prevention of pressure sores, cushions of memory foam for medical purposes; Pads for preventing pressure sores on patient bodies; Pressure-relief devices, namely heel supports, Elbow pads, Footmuffs; Cervical pillows; Air pillows for medical purposes; Mattresses and mattress overlays for medical purposes.

The average consumer and the nature of the purchasing act

82. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"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. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person.

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

83. The competing services are the opponent’s medical diagnosis services and the applicant’s general medical services, as well as their equipment rental and advice and consultancy services. For individual purchasers of health services, the types of purchase would vary considerably, from routine care to the treatment of potentially life-threatening conditions, and so the extent of the scrutiny of the services and the cost would differ accordingly. Nevertheless, the level of attention paid would be of at least a medium level. Collective purchasers of health services would often need to draw up contracts and patient safety would be paramount, so a high level of attention would be required. Overall, the level of attention paid by the average consumer would be medium to high.

84. Whether it was an individual or collective purchasing process, initial customer contact would be in the form of websites and brochures where visual considerations would predominate. Verbal factors may come into play as the purchasing process develops, so I do not rule those out.

Comparison of the trade marks

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

86. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

87. The respective marks are shown below.

The opponent’s trade mark	The applicant’s trade mark
PREVENTX	PREVENTIX

88. The opponent’s mark consists of the plain word “PREVENTX”. This is the only thing that forms the overall impression of this mark.

89. The applicant’s mark consists of the plain word “PREVENTIX”. This is the only thing that forms the overall impression of the mark.

90. Visually, the words “PREVENTX” and “PREVENTIX” are highly similar. The applicant’s mark only has one additional letter – the letter “I” between the letter “T” and the letter “X”. Otherwise, the marks have the same letters and in the same sequence.

91. Aurally, the comparison is between the opponent’s “PREHVENT-EX” and “PREHVENT-IX”. The respective marks begin identically, the only difference being the very slightly different endings - “EX”/“IX”. The marks are highly similar aurally.

92. Conceptually, the average consumer would see the marks as having two elements – the shared dictionary word “PREVENT” (the act of stopping something from happening) followed by the suffix “X” or “IX”. The “X” would either be seen as a placeholder for a missing word or simply the twenty-fourth letter of the alphabet. No meaning would be ascribed to “IX” other than the two letters being the ninth and twenty-fourth letters of the alphabet. Consequently, for both marks, the average consumer would take away the concept of something which stops something indeterminate from happening. I consider the marks to be highly similar conceptually.

Distinctive character of the earlier mark

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

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

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

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

94. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
95. The earlier mark consists of two elements – the dictionary word “PREVENT” (the act of stopping something from happening) followed by the suffix “X”. The “X” would either be seen as a placeholder for a missing word or simply the twenty-fourth letter of the alphabet. The opponent’s goods and services are medical in nature, and the concept of prevention (as in the well-known phrase “prevention is better than cure”) is closely associated with medical matters. Consequently, I consider the earlier mark to be suggestive of the opponent’s goods and services and I find it to be inherently distinctive to a low degree.
96. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks⁴, the word “PREVENT”. To that extent, I confirm that my view is that the word is inherently distinctive alone to a low degree.
97. Given the evidence filed, I now consider whether the evidence of the earlier trade mark’s use shows that it has an enhanced degree of distinctive character beyond its inherent distinctive character.
98. While there is no information supplied as to the size of the market, market share, or advertising expenditure, the evidence of annual revenue in respect of testing services is considerable and grew exponentially during the relevant period. There is some evidence of the geographical extent of the use of the mark in the form of a colour-coded map of the UK and of

⁴ See, *Kurt Geiger v A-List Corporate Limited*, BL O-075- 13,

particular services covering London, England as a whole, or a number of local authorities. However, the evidence does not strike me as indicative of a level that would lead to the capacity of the mark, measured from the perspective of the average consumer, to more greatly identify the goods and services for which I have determined a fair specification as coming from a particular undertaking, beyond their inherent capability to do so.

99. Overall, I do not find that the evidence shows use of the mark such that the level of distinctiveness can be raised above the findings that I have made for the mark's inherent distinctive character, that of a low degree.

Likelihood of confusion

100. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of Party A's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

101. Earlier in this decision, I found the respective marks to be highly similar visually, aurally and conceptually. I found the respective goods to be

dissimilar, and the contested services to be identical or of low similarity. I have found the earlier mark to be of low inherent distinctiveness.

102. The typical consumers of the competing medical services – individual and collective purchasers of health services – would pay a medium to high level of attention during the purchasing process. Visual considerations would predominate, although I do not rule out verbal factors.

103. The respective marks are highly similar on all the bases of comparison – visual, aural, and conceptual. The marks only vary by one letter and the additional letter appears as the penultimate letter in the applicant's mark. This is an important consideration because it is generally considered that the beginnings of words have the most significance in any comparison and that the differences in longer words may have proportionately less significance than in shorter words.⁵ As a result, I consider it highly likely that the average consumer would mis-recall one mark for the other. Bearing in mind the interdependency principle, the fact that the marks are so similar is a significant factor in my multi-factorial assessment and I find there is a likelihood of direct confusion even where the parties' services are of a low level of similarity (there is no minimum threshold level of similarity between the services that must be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion⁶).

104. Although I found a likelihood of confusion based on my notional assessment, I will briefly mention that the opponent filed evidence of actual confusion in the form of Exhibit 13. This evidence was admitted at the time of filing, albeit strictly speaking the applicant should have sought leave to file it. The applicant did not object to it being admitted.

⁵A view upheld by Professor Ruth Annand, sitting as the Appointed Person, in *Liquid Plastics Limited v Imperial Chemical Industries PLC*, O/274/07

⁶ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

105. The evidence of actual confusion takes the form of instances whereby the opponent's Co-Founder and Chief Engineer received emails which include the term "preventix" as opposed to the correct term "Preventx". The opponent states that 250 such emails have been received since 2015.

106. The applicant says that there is no evidence that these emails were from consumers and/or from multiple parties. While the opponent has not itemised the senders of the emails, it has stated that the emails are from "a mix of both customers and suppliers". While I have not given much weight to this evidence, and I acknowledge that some of the entries could be simple typographical errors rather than evidence of confusion as to the correct name of the opponent's company, I do consider that it corroborates my conclusion that there is a likelihood of confusion between the marks. For the sake of completeness, I should say that I would have reached the same conclusion had that evidence not been filed.

CONCLUSION

107. Subject to appeal, the opposition succeeds in relation to the following of the applicant's contested services:

Class 44 Medical services; Medical equipment rental; Medical information and consultancy.

108. The application will proceed to registration for the following of the applicant's contested goods:

Class 10 Cushions for medical purposes; Air cushions for medical purposes; Seat cushions for medical purposes intended for the prevention of pressure sores, cushions of memory foam for medical purposes; Pads for preventing pressure sores on patient bodies; Pressure-relief devices, namely heel supports, Elbow pads, Footmuffs; Cervical pillows; Air pillows for medical

purposes; Mattresses and mattress overlays for medical purposes.

109. The application proceeds for the applicant's uncontested Class 20 goods.

110. The application also proceeds for the applicant's uncontested services:

Class 44 Hygienic care for human beings; Medical assistance; Hospital services.

COSTS

111. In terms of the contested goods and services, the applicant has been successful with regard to the contested goods and the opponent has been successful when it comes to the contested services. I do not consider either party's level of success as measurably superior to that of the other and so each party will each bear their own costs.

Dated this 24th day of April 2023

JOHN WILLIAMS
For the Registrar