

O-137-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2496870

BY

JOHNSON ELECTRIC HOLDINGS LIMITED

TO REGISTER THE TRADE MARKS (A SERIES OF TWO):

MEDTECH

MEDTECH

IN CLASSES 07, 09, 10, 35, 40 AND 42

AND

THE OPPOSITION THERETO

UNDER NO 98857

BY

DORNIER MEDTECH GMBH

Trade Marks Act 1994

**In the matter of application no 2496870
by Johnson Electric Holdings Limited
to register the trade marks (a series of two):**



**in classes 7, 9, 10, 35, 40 and 42
and the opposition thereto
under no 98857
by Dornier MedTech GmbH**

1) On 5 September 2008 Johnson Electric Holdings Limited (Johnson) applied to register the above trade marks. The application for registration was published for opposition purposes on 12 December 2008 with the following specification:

electric motors, piezoelectric motors, electric motors with gearbox, electric motor driven pumps; piezoelectric motor and gear assemblies; gear assemblies (not for land vehicles); gears, pinions, cogs, worms and worm wheels, gearboxes, gear trains and transmission systems for machines and motors; electric motor driven fans and blowers; valves being parts of machines; parts and fittings for all the aforesaid goods;

flexible printed circuit boards; electric and electronic sensors; motorised electric actuators for opening, closing, locking, moving and controlling electric and electronic apparatus and instruments; servo-motors and servo-motorised actuators; electronic controllers for electric motors; electric and electronic solenoids, solenoid switches and solenoid valves; electric and electronic switches; motor electronics, namely brushless motor controllers, stepper motor controllers, motor controllers, noise suppression circuits, motor protection relays, over current and/or over voltage protection circuits and speed controllers; digital camera lens modules; electric motor assembly for moving moveable lenses; iris meters and lens shutters; parts and fittings for all the aforesaid goods;

sensors for medical use including neuropathy sensors, blood glucose strips, blood oximetry and cardio sensors; surgical apparatus, medical apparatus, veterinary apparatus; parts and fittings for all the aforesaid goods;

business management and business consultancy including supply chain management services;

custom manufacturing including contract manufacturing; mold fabrication; fixture fabrication; metal stamping and forming; precision machining;

design and development services including product design, rapid prototyping, program management, medical device development, development of machining techniques, precision gear design, mold design, fixture design; Testing services including reliability testing; Engineering services including plastic injection molding; Industrial analysis and research services;

The above goods and services are in classes 7, 9, 10, 35, 40 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 12 March 2009 Dornier MedTech GmbH (Dornier) filed a notice of opposition to the registration of the trade mark. In a letter dated 16 September 2009 Dornier limited its ground of opposition to section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

3) Dornier relies upon two earlier trade mark registrations:

- International registration no 842976 of the trade mark:



The registration was designated in the United Kingdom on 1 June 2004 with an international priority claim date of 19 December 2003. It was published for opposition purposes on 25 January 2008. There being no opposition to the granting of protection to the trade mark in the United Kingdom, the registration was protected from 26 April 2008. (Consequently, the registration is not open to a requirement of proof of use.) The registration is protected in respect of the following goods and services:

scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and

teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; electrical and electronic apparatus and instruments included in this class, namely computers, workstations and computer networks, comprising of computers, cables, connectors for data exchange or data control (included in this class) and network access apparatus; impedance control apparatus, fiber optic applicators, interstitial and intraluminal antennas; apparatus for data processing, data input, data output, apparatus for controlling, monitoring and performing industrial processes or scientific research in laboratories; electric and electronic alarm apparatus consisting in particular of sensors and signalling and monitoring apparatus; parts of all the aforementioned goods; pre-recorded and/or blank data storage media, in particular, tapes, chips, CD's and CD ROMS; data processing and computer programs used for controlling medical technical apparatus; software for medical use, used for collecting and processing patient data and for controlling diagnostic and therapeutic processes in medical technical apparatus; all of the aforementioned goods being provided in the field of medicine or having medical application and none of the aforementioned goods relating in any way to personnel, recruitment, training or evaluating staff;

surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials; catheters used for diagnostic and therapeutic purposes; endoscopes; apparatus for receiving, recording, transmitting and reproducing signals, images and/or sound (included in this class), in particular, X-ray apparatus, ultrasound diagnostic apparatus, optical recording apparatus, monitors, and displays; controlling, measuring, monitoring and recording apparatus and instruments for medical use, in particular, patient monitoring apparatus, patient handling apparatus, diagnostic and interventional workstations; sensors for medical use; image processing apparatus for medical use, in particular, for transforming visual information into electronic signals and vice versa; medical shock wave generators for the treatment of human and animal cells; shockwave and acoustic wave generators, microwave generators for medical purposes; urological work stations, namely integrated units for urological diagnosis and treatment consisting of x-ray apparatus, patient table, endoscopic, surgical and/or micro invasive instruments; lithotripters and urological tables; medical devices; micro invasive instruments; lithotripters; medical apparatus used for pain therapy, orthopedic therapy, extra-corporeal shockwave therapy; electro-medical apparatus used for diagnosis and therapy; apparatus for generating laser beams; acupuncture apparatus, in particular acupuncture lasers, surgical lasers; medical apparatus and instruments, in particular

light guides for therapeutic application; diode component of a laser for medical and cosmetic surgical uses;

advertising; business management; business administration; office functions; data processing; providing medical technical personnel to end users for the treatment of patients;

insurance; financial affairs; monetary affairs; real estate affairs; loan financing and insurance administration in the field of electrical, electronic, medical and medical technical apparatus and instruments and of data processing and computer programs; leasing of electrical, electronic, medical and medical technical apparatus and instruments and of data processing and computer programs; all of the aforementioned services being provided in the field of medicine or having medical application and none of the aforementioned services relating in any way to personnel, recruitment, training or evaluating staff;

building construction; installation services, installation, maintenance and repair of medical and medical-technical apparatus and instruments; all of the aforementioned services being provided in the field of medicine or having medical application and none of the aforementioned services relating in any way to personnel, recruitment, training or evaluating staff;

clinical training on the operation of medical devices and apparatus as applied to the treatment of patients; technical training on the maintenance and repair of medical devices and apparatus;

production and maintenance of computer programs; technical counselling and providing technical expert opinions and technical instructions for manufacturing, operating and maintaining of electrical and electronic apparatus and instruments, product development for others, engineering services, namely the layout and installation of medical devices and apparatus; technical planning services; technical project supervising services, technical systems analysis of scientific, physical and technical processes; installation and maintenance of data processing and computer programs and applications; technical support services, namely installation, monitoring, repair of and providing information on medical devices and their interfacing devices; all of the aforementioned services being provided in the field of medicine or having medical application and none of the aforementioned services relating in any way to personnel, recruitment, training or evaluating staff;

medical services; medical-technical services, namely renting and leasing of equipment to end users for the treatment of patients; surgical services, in particular, shock wave treatment of cells which allows molecular transfer of pharmaceuticals.

The above goods and services are in classes 9, 10, 35, 36, 37, 41, 42 and 44 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Community trade mark registration no 317412 of the trade mark **DornierMedTech**. The application for registration was filed on 15 July 1996, with an international priority claim date of 20 May 1996. The registration procedure was completed on 10 September 1998. Consequently, the registration is subject to proof of genuine useⁱ for the period from 13 December 2003 to 12 December 2008. Johnson has required proof of use of the trade mark in respect of all of the goods and services for which it is registered. It is registered for the following goods and services:

electrotechnical and electronic apparatus and equipment; equipment apparatus for receiving, recording, transmitting and reproducing signals, images and/or sound; regulating, controlling, checking (supervision), measuring, monitoring and recording equipment and apparatus; sensors, probes; scientific apparatus and instruments for research; data processing apparatus, data input apparatus, data output apparatus, image processing apparatus, the latter in particular for transforming visual information into electronic information signals and vice versa; apparatus for controlling, regulating and/or conducting industrial processes or scientific tests; electric and electronic alarm installations, in particular of sensors, electrotechnical and/or electronic and signalling and monitoring apparatus; parts for all the aforesaid goods. recorded and/or unrecorded data carriers; data processing and computer programs, software; parts for aforesaid goods, included in class 9;

medical and technical medical equipment and instruments; diagnostic and therapeutic apparatus for medical purposes, in particular using shock waves, acoustic waves, ultrasound, electromagnetic waves, microwaves, magnetic fields, electric current, light, laser beams, X-rays and micro systems technology; equipment and instruments for reducing concretions, for treating pain and orthopaedic treatment; ultrasound image recording apparatus; surgical and urology workstations; optical diagnostic apparatus; surgical lasers; nuclear therapy apparatus; patient monitoring apparatus; sterilised products, catheters and applicators; parts for the aforesaid goods, included in class 10;

financing, hire-purchase financing and insurance for: electrotechnical and electronic apparatus and equipment; apparatus for receiving, recording, transmitting and reproducing signals, images and/or sound; regulating, controlling, checking (supervision), measuring, monitoring and recording equipment and apparatus; sensors, probes; scientific apparatus and

instruments for research; data processing apparatus, data input apparatus, data output apparatus, image processing apparatus, the latter in particular for transforming visual information into electronic information signals and vice versa; apparatus for controlling, regulating and/or conducting industrial processes or scientific tests; electric and electronic alarm installations, in particular of sensors, electrotechnical and/or electronic and signalling and monitoring apparatus; parts for all the aforesaid goods. recorded and/or unrecorded data carriers; data processing and computer programs, software; medical and technical medical equipment and instruments; diagnostic and therapeutic apparatus for medical purposes, in particular using shock waves, acoustic waves, ultrasound, electromagnetic waves, microwaves, magnetic fields, electric current, light, laser beams, X-rays and micro systems technology; equipment and instruments for reducing concretions, for treating pain and orthopaedic treatment; ultrasound image recording apparatus; surgical and urology workstations; optical diagnostic apparatus; surgical lasers; nuclear therapy apparatus; patient monitoring apparatus; sterilised products, catheters and applicators;

maintenance, care, repair and servicing for electrotechnical and electronic apparatus and equipment; apparatus for receiving, recording, transmitting and reproducing signals, images and/or sound; regulating, controlling, checking (supervision), measuring, monitoring and recording equipment and apparatus; sensors, probes; scientific apparatus and instruments for research; data processing apparatus, data input apparatus, data output apparatus, image processing apparatus, the latter in particular for transforming visual information into electronic information signals and vice versa; apparatus for controlling, regulating and/or conducting industrial processes or scientific tests; electric and electronic alarm installations, in particular of sensors, electrotechnical and/or electronic and signalling and monitoring apparatus; parts for all the aforesaid goods. recorded and/or unrecorded data carriers; data processing and computer programs, software; medical and technical medical equipment and instruments; diagnostic and therapeutic apparatus for medical purposes, in particular using shock waves, acoustic waves, ultrasound, electromagnetic waves, microwaves, magnetic fields, electric current, light, laser beams, X-rays and micro systems technology; equipment and instruments for reducing concretions, for treating pain and orthopaedic treatment; ultrasound image recording apparatus; surgical and urology workstations; optical diagnostic apparatus; surgical lasers; nuclear therapy apparatus; patient monitoring apparatus; sterilised products, catheters and applicators;

medical and technical medical services; computer programming and maintenance of computer programs; data processing for others; writing and maintenance of recording programs for clinical data; data processing and evaluation for others; development, design, planning, project

management and technical consultancy and writing of system analyses of a scientific, physics and technical nature, of technical expert reports and instructions for the manufacture, operation and maintenance for: electrotechnical and electronic apparatus and equipment; apparatus for receiving, recording, transmitting and reproducing signals, images and/or sound; regulating, controlling, checking (supervision), measuring, monitoring and recording equipment and apparatus; sensors, probes; scientific apparatus and instruments for research; data processing apparatus, data input apparatus, data output apparatus, image processing apparatus, the latter in particular for transforming visual information into electronic information signals and vice versa; apparatus for controlling, regulating and/or conducting industrial processes or scientific tests; electric and electronic alarm installations, in particular of sensors, electrotechnical and/or electronic and signalling and monitoring apparatus; parts for all the aforesaid goods. recorded and/or unrecorded data carriers; data processing and computer programs, software; medical and technical medical equipment and instruments; diagnostic and therapeutic apparatus for medical purposes, in particular using shock waves, acoustic waves, ultrasound, electromagnetic waves, microwaves, magnetic fields, electric current, light, laser beams, X-rays and micro systems technology; equipment and instruments for reducing concretions, for treating pain and orthopaedic treatment; ultrasound image recording apparatus; surgical and urology workstations; optical diagnostic apparatus; surgical lasers, nuclear therapy apparatus; patient monitoring apparatus; sterilised products, catheters and applicators.

The above goods and services are in classes 9, 10, 36, 37 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Dornier claims that it has used the trade mark in respect of the following goods and services:

Therapeutic and diagnostic medical devices; the provision of orthopaedic shockwave therapy; research and development services in the area of orthopaedics; electro-magnetic shockwave emitters; ultrasound imaging systems; shockwave therapy systems; lithotripters; shockwave devices; urotables; medical and surgical lasers; diagnostic services; patient tables; x-ray arms; imaging systems; x-ray systems; ultrasound systems; urological work stations; data management systems; data processing systems; data storage systems; data monitoring systems; computer software; training services; product installation and repair and support services; product leasing and rental services; imaging services; laser devices; accessories for laser devices.

4) In the letter of 16 September 2009 Dornier states:

“The Opponent acknowledges the Applicant’s claim that the element MEDTECH is a descriptive term meaning “medical technology” or “medical technologies”. However, the Opponent notes that both the Applicant’s mark and the Opponent’s earlier trade marks cover a range of goods and services which cannot be aptly described in such a way. Consequently, the term does have at least some independent role within the marks of the respective parties and the inclusion of the identical term in the respective mark cannot simply be disregarded or dismissed.”

5) Johnson denies the grounds of opposition. It states that the term med tech is completely descriptive of goods and services relating to medical technology.

6) Both parties filed evidence, neither requested a hearing. Both parties filed written submissions.

EVIDENCE

Evidence for Dornier

7) This consists of a witness statement made by Michael Lerch. Mr Lerch is the managing director and general manager of Dornier MedTech Europe GmbH, which is a wholly owned subsidiary of Dornier. Dornier MedTech Europe GmbH is the subsidiary of Dornier which is responsible for the sales, servicing and maintenance of all devices produced by Dornier MedTech Systems GmbH and Dornier MedTech Laser GmbH. The latter is a wholly owned subsidiary of Dornier and Dornier owns 80% of the former. The structure of the Dornier group is such that each subsidiary plays a specific rôle in the organisation and in specific geographical locations.

8) Mr Lerch states that Dornier has either itself, or via wholly owned subsidiaries, used the trade mark DORNIER MEDTECH throughout Europe since 1996 in respect of the following goods and services:

Therapeutic and diagnostic medical devices;
the provision of orthopaedic shockwave therapies;
research and development services in the area of orthopaedics;
electro-magnetic shockwave emitters;
ultrasound imaging systems;
shockwave therapy systems;
lithotripters;
shockwave devices;
urotables;
medical and surgical lasers;
diagnostic services;

patient tables;
x-ray arms;
imaging systems;
x-ray systems;
ultrasound systems;
urological work stations;
data management systems;
data processing systems;
data storage systems;
data monitoring systems;
computer software for use within “our systems and products”;
training services;
product installation, repair and support services;
product leasing and rental services;
imaging services;
laser devices;
accessories for laser devices.

9) Exhibited at DM1 are copies of brochures. Mr Lerch states that the brochures have been distributed to EMEA countries. There is no indication if EMEA is referring to Europe, the Middle East and Africa or the European Medicines Agency or something else. The brochures are as follows:

- Dornier Medilas D LiteBeam+. The product is used for performing endovenous laser treatment of varicose veins as well as a variety of surgical applications using cutting and coagulation techniques. A trade mark similar to that of the international registration appears on the brochure and pictures of the product. The brochure appears to have been published in February 2007.
- Dornier Medilas H20. The product is designed for lithotripsy using a laser. A trade mark similar to that of the international registration appears on the brochure. The brochure appears to have been published in April 2007.
- Dornier Compact Sigma modular lithotripter. The brochure includes details of the Dornier Relax+ patient table. There are references to being able to attach an x-ray C-arm, however, there is no indication that Dornier produce them: “It is the preferred link for a number of C-arms from well-known manufacturers”. The references to an ultrasound scanner identify the manufacturer as B-K Medical. A trade mark similar to that of the international registration appears on the brochure and on pictures of the lithotripter. There is no indication as to the date of publication of the brochure.
- Dornier fibertom 8100. The product is a surgical laser. A trade mark similar to that of the international registration appears on the brochure and the product. The brochure appears to have been published in August 2006.

- Dornier Medilas D MultiBeam. The product is a medical laser for use in the treatment of varicose and spider veins as well as a variety of surgical applications. A trade mark similar to that of the international registration appears on the brochure and the product. The brochure appears to have been published in December 2006.
- Dornier Lithotripter S II premium multifunctional urological workstation. There is reference to ultrasound functions, supplied by B-K Medical. There is reference to being DICOM (The Digital Imaging and Communications in Medicine) compatible. A trade mark similar to that of the international registration appears on the brochure. The brochure appears to have been published in February 2004.
- Dornier AR2 orthopaedic shockwave device with smart focus technology. A trade mark similar to that of the international registration appears on the brochure and the product. The brochure appears to have been published in November 2007.
- Dornier Opus II UMS digital urology imaging system. The product has a DICOM interface. A trade mark similar to that of the international registration appears on the brochure. The brochure appears to have been published in November 2006.
- Dornier MedTech brochure. A trade mark similar to that of the international registration appears on the brochure. The brochure identifies four types of products: lithotripters, urotables, orthopaedic shock wave devices and medical-aesthetic lasers. References to Dornier MedTech appear in the brochure. A trade mark similar to that of the international registration appears on the brochure. There is no indication as from when the brochure emanates.
- Dornier Compact Sigma modular lithotripter. This appears to be the same brochure that is referred to above.
- Dornier Epos Ultra orthopaedic shock wave therapy for the treatment of plantar fasciitis. This appears to be an American brochure. It begins with stating that “Dornier MedTech is pleased to introduce the Epos Ultra for the treatment of plantar fasciitis in the United States. The only address given in the brochure is in the United States.

10) Exhibited at DM2 is a selection of invoices for products and services sold or provided by Dornier MedTech Europe GmbH. Mr Lerch states that the invoices are addressed to companies in the United Kingdom, Germany, Belgium, Italy, Greece, Spain and Denmark. He states that the invoices “are for a range of goods and services namely for the Dornier MedTech’s Delta, Dornier MedTech’s medilas lasers”. The invoices bear a trade mark similar to that of the international registration. They also bear the company name Dornier MedTech Europe GmbH. The invoices are for the following dates: 15 February 2008, 22 February 2008, 13 May 2008, 16 November 2007, 11 April 2007, 18 May 2007, 20 December 2006, 21 December 2006, 25 November 2005, 30 May 2005, 16 June 2005, 23 July 2004, 16 April 2004, 16 July 2004 and 17 June 2003. The invoices show some goods that are not being sold by reference to the trade

marks of Dornier eg BKU Scanner Falcon, which from the evidence of the brochures is a product of B-K Medical. Consequently, the invoices are not of themselves evidence of goods being sold by reference to the trade mark Dornier MedTech. The invoices need to be considered in conjunction with the brochures and the statement of Mr Lerch.

11) Mr Lerch states that in the last five years (his statement is dated 16 September 2009) Dornier MedTech Europe GmbH has had a gross revenue in excess of 30 million euros. Mr Lerch states that the Dornier group had a gross revenue close to 100 million euros. It is not clear from the statement if these figures are annual figures or total figures. It is also not clear if these figures relate solely to the European Union. It is also unclear if these figures include the sale of goods from others eg B-K Medical and Xerox (for the latter see page 98 of DM2).

12) Mr Lerch states that all of the products bear the trade mark DORNIER MEDTECH. Mr Lerch states that at DM3 examples of advertisements are exhibited:

- *EAU Congress News* of 25 March 2004 from Vienna. An article which refers to “The Dorma Compact Sigma shock wave system” and the Relax + table. The article is headed “DornierMedTech Receives Design Award”. An advertisement which shows use of a trade mark similar to that of the international registration. It advertises the Dornier Urological Workstation, the Dornier Compact Sigma, the Dornier Relax+, Ultrasound system Merlin by B-K Medical, X-ray C-arm.
- *HNO-Nachrichten* of February 2004 (in German). An advertisement for the Dornier Medilas. The advertisement shows use of a trade mark similar to that of the international registration.
- *EAU Congress News* of 13 March 2003 from Madrid. An advertisement which shows use of a trade mark similar to that of the international registration. The advertisement is for the Dornier Opus which is described as a multifunctional urological workstation. Another advertisement, for the Dornier Lithotripter S. The advertisement shows use of a trade mark similar to that of the international registration.
- *Urologische Nachrichten* of November 2003 (in German). An advertisement which shows use of a trade mark similar to that of the international registration. The advertisement is for the Dornier Lithotripter SII.
- *HNO-Nachrichten* of February 2003. An advertisement which shows use of a trade mark similar to that of the international registration. The advertisement is for the Dornier Medilas.
- *THW-Journal* of March 2006. An advertisement which shows use of a trade mark similar to that of the international registration. It is a general advertisement, not for any particular product.

- *EAU Congress News* of 6 April 2006 from Paris. An article about Dornier lithotripters. There are references to Dornier MedTech in the article. An advertisement for the Dornier Lithotripter S II. The advertisement shows use of a trade mark similar to that of the international registration.
- *Medical Laser Application 21 (2006)*. An advertisement which shows use of a trade mark similar to that of the international registration. The advertisement is for the Dornier Medilas fibertom 8100.
- *LinkXPress.Com*, date unknown. An advertisement which shows use of a trade mark similar to that of the international registration. The advertisement is in Castellano. It is for the Dornier AR2. The same pages are reproduced in an English version.
- *WCF Congress News* of 25 August 2005 from Amsterdam. An article headed "Compact Delta II Lithotripter by Dornier Med Tech". An advertisement which shows use of a trade mark similar to that of the international registration. The advertisement is for the Compact Delta II.
- *EAU Congress News* of 18 March 2005 from Istanbul. An article about a prototype lithotripter produced by Dornier which is to be housed in the EAU central office in Arnhem.
- A press release of 23 March 2005 from Dornier MedTech Europe GmbH (in German).
- *EAU Congress News* of 28 March 2008 from Milan. An advertisement which shows use of a trade mark similar to that of the international registration. It advertises the Dornier Medilas H20 and the DUR-D ureteroscope from Gyrus ACMI. A further advertisement bearing a trade mark similar to that of the international registration. It invites readers of the advertisement to visit the stand of Dornier MedTech Europe GmbH at the EAU 2008 Milan.
- *Donauwörther Anzeiger* of 3 February 2004. An advertisement appears on the page. Owing to the lack of quality of the copying, it is not possible to clearly ascertain the contents of the advertisement.
- A page from unidentified publication in German of 20 February 2004. Parts of an advertisement for the Dornier Opus II can be seen. The advertisement shows use of a trade mark similar to that of the international registration.
- *Hospital Post* of January 2004. An article about Dornier Medtech's Compact Sigma lithotripter.
- Publicity for a conference – Laser in der HNO, held on 12 and 13 November 2004. An advertisement appears which shows use of a trade mark similar to that of the international registration.

13) Mr Lerch states that Dornier has attended conferences in Europe at which it promoted goods and services under the DORNIER MEDTECH brand. Exhibited at DM4 is evidence of Dornier's attendance at trade shows. Page 153 has a list of exhibitors at EAU Berlin 2007. Dornier is listed. Also listed are B-K Medical and Gyrus ACMI. Also included in the exhibit is a booth plan for the EAU in Paris in April 2006, which shows a space for Dornier MedTech Europe GmbH. A list of

exhibitors at WCE 2005, with a booth plan, is exhibited. Dornier MedTech Europe GmbH appears, as does Gyrus ACMI. The exhibit also includes copies of photographs of stands at trade shows. On two of the photographs a sign bearing the name Dornier MedTech can be seen. Underneath Dornier MedTech the words “We Offer Solutions in Urology” can be seen.

Findings of fact in relation to the evidence for Dornier

14) The evidence of Dornier has been furnished in order to prove genuine use of its Community trade mark.

15) A convenient summary of the criteria relating to genuine use was given by the General Court (GC) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07*:

“99 In interpreting the concept of genuine use, account should be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and judgment of 8 November 2007 in Case T-169/06 *Charlott v OHIM – Charlo (Charlott France Entre Luxe et Tradition)*, not published in the ECR, paragraph 33).

100 There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (Case C-234/06 P *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 72; see also, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and externally (*Silk Cocoon*, paragraph 99 above, paragraph 39; *VITAFRUIT*, paragraph 99 above, paragraph 39; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 34; see also, by analogy, *Ansul*, paragraph 37).

101 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (VITAFRUIT, paragraph 99 above, paragraph 40; Charlott France Entre Luxe et Tradition, paragraph 99, paragraph 35; see also, by analogy, Ansul, paragraph 100, paragraph 43).

102 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (VITAFRUIT, paragraph 99 above, paragraph 41, and Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 36).

103 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P Sunrider v OHIM [2006] ECR I-4237, paragraph 71).

104 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (VITAFRUIT, paragraph 99 above, paragraph 42; Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 37; see also, by analogy, Ansul, paragraph 100 above, paragraph 39).

105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT) [2002] ECR II-5233, paragraph 47).”

16) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 the GC stated:

“32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).”

17) In *Laboratories Goemar SA's Trade Mark* [2002] ETMR 34 Jacob J stated:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye, to ensure that use is actually proved, and for the goods or services of the mark in question. All the ‘t’s should be crossed and all the ‘i’s dotted. In the present cases there was a difference between the total sales figures and relevant sales. Mr Mellor, for the applicants for revocation, told me that sorting out the wheat from the chaff involved a lot of work. In the end, however, he accepts that some very small potentially relevant sales under the marks were proved.”

18) In terms of sales in relation to specific products the evidence of Mr Lerch lacks specificity. He claims use on a variety of goods and services, the use in relation to some of them has no substantiation. He claims use in relation to ultrasound systems when the evidence shows that these are provided by B-K Medical under another trade mark. Part of the claim to use is based on Mr Lerch effectively dividing the parts of complete products and claiming use in relation to the parts. Most cars nowadays have computers in them, this does not mean that the manufacturer is maintaining or creating a market in computers. The invoices list a number of products but there is a lack of certainty in relation to some of these products as to the trade mark in use in relation to them, as shown by the B-K products which are included on the invoices. In relation to the services that are claimed there is evidence in the invoices of supplying technical training and

installation of the products. There are also warranties provided. Some of these warranties are identified as being for parts only; it can be assumed from this that the other warranties include parts and labour.

19) The brochures and advertising that has been furnished give a clear view of the products in relation to which Dornier is creating or maintaining a market. These products are lithotripsy products, laser treatment products, patient tables, surgical laser, urological workstations, orthopaedic shockwave devices, digital urology imaging system and medical-aesthetic lasers. All of the goods are for medical/surgical use. Taking into account the evidence of the invoices, there has been use in relation to the installation and repair of these products and training in respect of their use.

20) The vast majority of the use shown is not that of DornierMedTech but of Dornier *MedTech* with the stylised device of a human, as per the international registration, to the left of the words, and, occasionally, of Dornier *MedTech*. It is necessary to consider if this is use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. Lord Walker stated:

“43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vaultlike trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the

registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who normally perceives a mark as a whole and does not proceed to analyse its various details."

In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

"15. It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect."

There is some evidence of use of Dornier MedTech, although not a great deal. In *Atlas Transport GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM)* T-482/08 the GC considered that use of the trade mark sometimes with additional elements and sometimes without may lead to the conclusion that there has not been an alteration of the distinctive character of the trade mark as registered:

"36 Ferner kann der Umstand, dass die eingetragene Marke manchmal mit und manchmal ohne zusätzliche Elemente benutzt wird, eines der Kriterien darstellen, aus dem geschlossen werden kann, dass die Unterscheidungskraft nicht beeinflusst wird (vgl. in diesem Sinne Urteile des Gerichts vom 8. Dezember 2005, Castellblanch/HABM – Champagne Roederer [CRISTAL CASTELLBLANCH], T-29/04, Slg. 2005, II-5309, Randnr. 35, und vom 27. September 2007, La Mer Technology/HABM – Laboratoires Goëmar [LA MER], T-418/03, nicht in der amtlichen Sammlung veröffentlicht, Randnr. 75). Wie die Beschwerdekammer in Randnr. 23 der angefochtenen Entscheidung festgestellt hat, wird im vorliegenden Fall das Element „Atlas Transport“ auf zwei der 19 Rechnungen, die im maßgeblichen Zeitraum erstellt wurden, ohne das Element „The Duesseldorfer“ verwendet. Die beiden Elemente sind also nicht immer miteinander verbunden."

21) The device of the stylised human is to one side to the words Dornier *MedTech*, the perception of the average consumer is likely to be of a device trade mark and a separate trade mark combining the name Dornier with the nature of the product, a medtech product. It is not uncommon for undertakings to use a device trade mark and a word trade mark, eg with cars. The consumer is used to identifying and has been taught to perceive the trade marks as separate

entities. The consumer is likely to perceive two trade marks, a word only one and a device only one. Owing to the presence of the descriptive element MedTech the trade mark DornierMedTech will naturally be perceived as falling into the Dornier and MedTech components. The differences between Dornier *MedTech* and DornierMedTech are the absence of conjoining Dornier to the second element; the consumer will naturally perceive a separation between the elements owing to their different natures, and the presentation of *MedTech* in a standard italic script. There is nothing in these differences which alters the distinctive character of the trade mark from the form in which it was registered. The use shown, therefore, satisfies the requirements of section 6A(4)(a) of the Act.

22) In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-234/06 P* the CJEU stated:

“86 In any event, while it is possible, as a result of the provisions referred to in paragraphs 81 and 82 of the present judgment, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.”

In this case the differences in relation to the international registration are such, especially the presence of the letters DMT, that the use being considered is not use of the other trade mark in a slightly different form. Consequently, the use does not fall within the parameters of the finding of the CJEU.

23) The use relates to use of a Community trade mark. The decision of The Fourth Board of Appeal of the Office for Harmonization in the Internal Market in *ILG Ltd v Crunch Fitness International Inc* [2008] ETMR 17 is noted:

“11 The relevant period is October 1998 to October 2003. Use in one country of the Community, such as Italy, is sufficient (Joint Statements by the Council and the Commission entered in the Minutes of the Council meeting at which the CTMR was adopted, No.B.10, OH OHIM 1996, 607, 613), provided that is it [*sic.*] genuine.”

In *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07 the CJEU considered the requirements for establishing a reputation in respect of a Community trade mark:

“30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark

must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

It would be anomalous if reputation in one member state may be enough to satisfy the requirement of Article 9(1)(c) but use in one (or two) member state(s) could not satisfy the use requirement. In this case use has been shown in a number of member states. Use has been shown over an extended period of time. The use shown is not token use and it is external use. In considering whether genuine use is established it is necessary to consider, within the context of the European Union as a whole, the sector of the industry in which Dornier operates and the nature of the goods, whether the use is warranted in the market place and if the use creates and preserves an outlet for the goods in the marketplaceⁱⁱ. Taking into account all of the above factors, it is considered that the use shown establishes genuine use within the European Union.

24) It is necessary to decide upon a fair description for the goods and services for which genuine use has been shown and which fall within the parameters of the specification. The description must not be over pernicketyⁱⁱⁱ. It is necessary to consider how the relevant public, which for these goods and services would be the medical professionals, describe the goods and services^{iv}. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at

a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. 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.”

25) Taking into account the wording of the specification and the details in the brochures about the products, it is considered that a fair specification of the goods is:

diagnostic and therapeutic apparatus for medical purposes; equipment and instruments for reducing concretions, for treating pain and orthopaedic treatment; surgical and urology workstations; optical diagnostic apparatus; surgical lasers; parts for the aforesaid goods included in class 10;

installation and repair of the above goods;

training in respect of the above goods.

Evidence for Johnson

26) This consists of a witness statement, dated 9 November 2010, made by Mr Gareth Peter Jenkins, who is a trade mark attorney. The purpose of the statement of Mr Jenkins is to show that MEDTECH is a “known descriptive term”. However, in Dornier’s letter of 16 September 2009, Dornier states:

“The Opponent acknowledges the Applicant’s claim that the element MEDTECH is a descriptive term meaning “medical technology” or “medical technologies”. However, the Opponent notes that both the Applicant’s mark and the Opponent’s earlier trade marks cover a range of goods and services which cannot be aptly described in such a way.”

27) Exhibited at GPJ1 is a copy of the examination report of the Intellectual Property Office, dated 2 October 2008. An objection was raised under sections 3(1)(b) and (c) of the Act in the following terms:

“This is because the mark consists exclusively of the dictionary abbreviation ‘MEDTECH’ and the second and third marks of the same word plus a small triangular shape, being a sign which may serve in trade to designate the kind and nature of the goods/services e.g. electric motors, motor parts, sensors, business management, manufacturing and design and development services all relating to medical technology.”

The Dictionary of Medical Acronyms & Abbreviations defines ‘Med Tech’ as ‘*Medical Technology, medical technologist*’.”

28) Exhibited at GPJ2 are the following documents:

- Page from medical-dictionary.thefreedictionary.com which defines Med Tech as being an abbreviation for medical technician.
- Pages from encyclopedia.thefreedictionary.com defining medical technologist.

29) Exhibited at GPJ3 are the following documents:

- Pages relating to The 10th MedTech Investing Europe Conference to take place from 18 – 19 February 2010 in Lausanne. The conference is promoted as being “Europe’s Premier Med Tech Events for Investment Opportunities” and as giving an opportunity to “Meet med tech entrepreneurs looking for investment funding”. There is a reference to the “Benefits of MedTech Company participation”.
- Pages promoting MedTECH Manchester Medical Technology Development Centre. Reference is made to companies operating in the “MedTECH sector” and to “medtech business start-ups”.

- Pages from Oxford Intelligence relate to “The MedTech Report 2008”, published in September 2008. It refers to “49 key global MedTech clusters”.
- Pages from Cambridge Consultants which “Offers med-tech industry guidelines for reconstituted drug injection device development”.
- Pages from biodundee.co.uk relating to an event held on 26 August 2009. The heading is: “Life Sciences Scotland Support Service – Med Tech Forum”. There are references to MedTech products and MedTech initiatives.
- A page from medtechpartners.nl.
- Pages from Wikipedia which state, inter alia, that MED or med may refer to medicine or medical.

SECTION 5(2)(B) – LIKELIHOOD OF CONFUSION

30) The fundamental premise of likelihood of confusion is that the average consumer of the goods and services concerned will believe that the parties are the same or economically linked as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97:

“30. The answer to be given to the second part of the question must therefore be that there may be a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

In relation to medtech (used in the descriptive and generic manner) goods and services and goods and services directly related to medtech goods and services, the trade mark of Johnson will not indicate origin. With the exception of part of the class 35 services of the international registration (*advertising; business management; business administration; office functions; data processing*), all of the goods and services of Dornier’s two registrations are medical either per se or by the limitations of the specification. Consequently, other than for the class 35 services identified, the MEDTECH element of the trade marks of Dornier will not indicate origin to the average consumer; it will be seen as an indicator of the nature of the goods and services or as being non-distinctive in relation to the goods and services. As, with the exception of the class 35 services identified, the MEDTECH element of Dornier’s trade marks does not have any significance as an indicator of origin the claim of a likelihood of confusion fails the *Canon* test of what constitutes a likelihood of confusion and Dornier cannot succeed under section 5(2)(b) of the Act in relation to these goods and services.

31) Consequent upon the above the only goods and services of Dornier that will be considered are *advertising; business management; business administration; office functions; data processing*.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

32) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”^{vi}. In relation to *advertising; business management; business administration; office functions; data processing* the average consumer will be a business. They are services that will be purchased as the result of a careful decision. Consequently, the effects of imperfect recollection will be lessened. The services will be primarily bought through brochures, written quotations, tenders etc and so visual similarity will be of greater importance, in relation to likelihood of confusion, than aural similarity.

33) The goods of the application are all of a technical and/or medical nature. The class 7 and 9 goods could be bought by a large range of persons. However, the nature of the goods is such that their purchase will be the result of a careful and educated decision. The class 10 goods will be purchased by medical and veterinary professionals. The goods are of a specialist nature, they will be purchased with a good deal of care. The nature of the goods and the purchasing process lessens the potential effects of imperfect recollection. The primary purchasing decision will be made through looking at brochures and technical literature, in print or electronic form. Consequently, visual similarity will be of more importance than aural similarity in considering likelihood of confusion. The average consumer of the services of the application will be businesses and professionals. They are services which will be bought with a good deal of care and consideration. Consequently, the potential effects of imperfect recollection will be diminished. The services will be primarily bought through brochures, written quotations, tenders etc and so visual similarity will be of greater importance, in relation to likelihood of confusion, than aural similarity.

Comparison of goods and services

34) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”^{vi}. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning^{vii}. Consideration should be given as to how the average consumer would view the goods or services^{viii}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{ix}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^x. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*

(OHIM) Case T- 325/06 the General Court (GC) explained when goods were complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xi}. Goods/services can be considered as identical when the goods/services designated by the earlier mark are included in a more general category, designated by the trade mark application^{xii}. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

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

35) Dornier gives no clear analysis of why it considers the respective goods and services to be similar. It relies on the assertion:

“These goods and services are identical or highly similar to the applicant’s goods and services in classes 7, 9, 10, 35, 40 and 42 and will be marketed to the same consumers in the same industry.”

The above assertion is somewhat contrary to the submission that it makes that the trade marks of Dornier and Johnson “cover a range of goods and services which cannot be aptly described in such a way” ie relating to medical technology. If the goods and services cover a range of goods and services, there would not appear to be one set of consumers.

36) Consequent upon the finding above (paragraphs 30 and 31), the only goods or services of the earlier trade marks that will be considered are: *advertising; business management; business administration; office functions; data processing*. Within the parameters of the case law there is no meaningful conjunction between these services and the goods of the application. There is an absence of any obvious conjunction with the class 40 and 42 services of the application and *business management and business consultancy including supply chain management services* of the earlier trade mark and Dornier has put

forward no coherent argument as to why these services would or could be similar to the class 40 and 42 services of the application. **This leaves the class 35 services of the application: *business management and business consultancy including supply chain management services*. These services will be encompassed by *business management and business administration* of the earlier trade mark. Consequently, the respective services are identical.**

Comparison of trade marks

37) Owing to the findings above (paragraphs 30 and 31) it is only necessary to consider the international registration as confusion could not arise in relation to the Community trade mark owing to the nature of the goods and services, medtech being descriptive or non-distinctive in relation to them. The only goods or services which are identical (or similar) and which could give rise to a likelihood of confusion are the class 35 services considered immediately above. Consequently, the trade marks will be compared upon this basis (the nature of the services affects the perception of the average consumer). The trade marks to be compared are:



38) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xiii}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xiv}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xv}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xvi}.

39) The upper mark of the series has an inverted triangle in orange. In *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of

the Opponent's device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions."

In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

"119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course."

As Dornier's trade mark is registered in black and white it is necessary to drain the colour from Johnson's trade mark when comparing the trade marks.

36) The comparison of the trade marks is being made within the context of the class 35 services which are limited neither by nature nor description to medical services and so MEDTECH will not be descriptive or non-distinctive in relation to such services that are not medical related.

37) In the international registration, owing to their size and position, the dominant and distinctive components are the highly stylised device of a human and the letters DMT. The name Dornier is distinctive but owing to its size and position it is not a dominant component of the trade mark. In the context now being considered, MEDTECH is neither descriptive nor allusive to the services at large. It, therefore, has distinctiveness and in relation to the other elements it has an independent rôle; but owing to its size and position and its qualification of the DORNIER element, it is not a dominant component, the only element of the trade mark of less dominance is the oval.

38) Johnson argues that its trade marks were accepted on examination on the basis of their stylisation. The word element is in a normal type face in upper case. The stylisation is the small inverted triangle that sits within the v of the letter M. This is not likely to have an impact upon the perception of the average consumer for any goods or services. It does not act as a balance against the position and size of the word MEDTECH. As noted above MEDTECH, for the services under consideration, is neither descriptive nor allusive. In the trade marks of Johnson the word MEDTECH is the dominant and distinctive component.

39) The trade marks of the parties coincide in relation to the MEDTECH elements. The presence of this common element must give a degree of visual, aural and conceptual similarity. Dornier's trade mark contains a large amount of alien matter, however, balanced against this is that for the average consumer Johnson's trade mark is simply a MEDTECH trade mark, in relation to this element there is complete coincidence.

Likelihood of conclusion

40) Consequent to the findings above the likelihood of confusion can only relate to the class 35 services of the application.

41) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xvii}. In this case the respective services are identical. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xviii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xix}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods/services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xx}. Dornier's trade mark is neither allusive nor descriptive of the services concerned. Considering Dornier's trade mark in its entirety, it is highly distinctive. However, this case turns on the effects of one element of that trade mark, the word MEDTECH. In respect of the broad spectrum of services that are covered by the specification of the international registration, MEDTECH is neither descriptive nor allusive and so enjoys a good deal of inherent distinctiveness per se but is only a minor part of the composite trade mark.

42) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC considered the effects of the principal nature of the purchasing decision:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

The nature of the services means that for the average consumer in the average purchasing situation, the visual effect of the trade marks is of more importance than the oral effects and so of greater importance in considering the similarity of the trade marks.

43) In *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case C-498/07 P the CJEU stated:

“62 In that regard, the Court has also held that, according to established case-law, the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43 and the case-law cited).”

(Underlining added) In *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 the CJEU stated:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the

third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

Taking into account the broad spectrum of services encompassed by the class 35 services of the application, the MEDTECH element of Dornier’s trade mark does have an independent distinctive rôle, if most certainly a minor one. In the context of the earlier trade mark DORNIER MEDTECH is likely to be seen as identifying the provider of the services. (As decided, the effect of visual similarity will have a greater effect than aural similarity.) Owing to the differences between the trade marks there will not be direct confusion between the trade marks, however, taking into account the rôle of the DORNIER MEDTECH component in the earlier trade mark and the overwhelming dominance of MEDTECH in the application, the average consumer will believe that the services “come from the same undertaking or, as the case may be, from economically-linked undertakings^{xxi}” and consequently there is a likelihood of confusion.

44) The application is to be refused under section 5(2)(b) of the Act in respect of the class 35 services ie: *business management and business consultancy including supply chain management services*. The opposition fails in relation to all the other goods and services of the application.

COSTS

45) Johnson, having for the most part been successful, is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Preparing a statement and considering the statement of Dornier:	£300
Preparing evidence and considering the evidence of Dornier:	£500
Written submissions:	£200
Total:	£1,000

Dornier MedTech GmbH is ordered to pay Johnson Electric Holdings Limited the sum of £1,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26 day of April 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(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 period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

ⁱⁱ See *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01:

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services

of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

and *MFE Marienfelde GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-334/01*:

“34 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, paragraph 43).

35 Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other.

36 In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, the Court has held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39).

37 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

ⁱⁱⁱ *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is

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

^{iv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

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

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

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

^v *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

^{vi} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{vii} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{viii} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

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

^{ix} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^x *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xi} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

“(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.”

^{xii} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{xiii} *Sabel BV v Puma AG* Case C-251/95.

^{xiv} *Sabel BV v Puma AG* Case C-251/95.

^{xv} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xvi} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xvii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xviii} *Sabel BV v Puma AG* Case C-251/95.

^{xix} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xx} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xxi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.