

O-453-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 160 244
ADENTO IN THE NAME OF BILLERICAY DENTAL SUPPLY CO
LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 407120
BY ADENTA GMBH

Background and pleadings

1. Billericay Dental Supply Co Limited (the applicant) applied to register the trade mark ADENTO under No 3 160 244 in the UK on 19th April 2016. It was accepted and published in the Trade Marks Journal on 6th May 2016 in respect of the following goods and services:

Class 03:

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and mouthwashes: toothpaste; non-medicated oral health care products; mouth rinses; mouth washes; chew sticks; toothpastes and tooth gels; medicated toothpastes; teeth cleaning lotions; oral hygiene preparations; cleaning preparations for the teeth; disclosing tablets for personal use in indicating tartar on teeth; dental bleaches.

Class 05:

Dental ceramics; dental remedies; medicated cotton; dental filling materials and impression compounds for dental purposes, casting aids, tooth lacquers; tooth filling materials; materials for preparation and filling of root canals; dental cement; disinfectants; mouth flushes for medical purposes; dental wax and dental impression materials, material for stopping teeth; dental relining material; dental fixative; dental lacquers, dental wax; antibiotics for use in dentistry; moulding wax for dentists; disinfectants for hygiene purposes: Medicated oral care preparations; medicines for dental purposes; medicated oral care products; medicated mouthwash; medicated dental rinses; dental lacquer; Pharmaceutical and medicinal preparations and substances; vaccines.

Class 16:

Printed matter; magazines and publications.

Class 21:

Dental cleaning articles; toothbrushes; electric toothbrushes; dental floss; interdental cleaners; dental applicator brushes.

Class 35:

Advertising and publicity services; all included in Class 35, provision of advertising information; advice on how to advertise; conducting surveys; conducting of public opinion polls; Online business networking services; advertising, marketing and promotion services for businesses; compilation and systemization of information into computer databases; providing an online searchable database featuring employment and career opportunities and business, employment and professional queries and answers; providing information about and making referrals concerning products, events and activities; organizing and conducting job fairs; job placement services, human resources consulting services; business research and survey services; monitoring services, namely tracking online references to businesses, organizations and business topics; promoting the goods and services of others via computer and communication networks; facilitating the exchange and sale of services and products of third parties via computer and communication networks; on-line retail store services in the field of digital media, clothing, footwear, headgear, printed matter, stationery, office requisites, bags, games, toys and pins; charitable services, namely promoting public awareness about charitable, community service, and volunteer activities; providing online career networking services and information in the fields of employment, recruitment, job resources, and job listings; providing online interactive employment counseling; recruitment and placement services; hosting

of exhibitions, conferences and seminars for business purposes; business management consulting services for the medical and hygiene industry; business management and business administration for the medical hygiene industry; business management, business administration and office functions; preparation of statistics for research; employment and recruitment; employment and recruitment services; accountancy; careers advice; information, advice and consultancy services relating to all the aforesaid; Business services; administration of medical practices and surgeries; management of medical practices and surgeries.

Class 36:

Payment plan services; payment administration services; collection and processing of payments; brokerage and arrangement of health and dental insurance; administration and management of health and dental insurance; computerised services for the broking, arranging, administration and management of health and dental insurance; information relating to health insurance, dental insurance and payment plans, provided on-line from a computer database, computer network, global computer network or the Internet; information, organisation, customer care and telephone help-line services relating to all of the aforesaid services.

Class 38:

Telecommunications services; telecommunication of information (including web pages), electronic mail services; provision of telecommunication access and links to computer databases and the Internet; telecommunication services providing access to financial and insurance information, services and transactions; telecommunications services relating to electronic commerce; Internet communication services; operating of chat rooms; transmission of written and digital

communications; provision of news and news information via a computer network and/or the Internet; advisory and consultancy services relating to the aforesaid.

Class 41:

Operation of a publishing website; electronic publishing of magazine, periodicals and journals; Educational and training services; providing electronic publications (not downloadable), providing on-line electronic publications, publication of electronic books and journals on-line; providing publications from a global computer network or the Internet which may be browsed, all relating to business administration and management; arranging and conducting of educational conferences, seminars, exhibitions and symposiums, training courses and lectures.

Class 44:

Internet services, namely provision of information relating to dentistry and dental care services on the Internet, the provision of information relating to the aforesaid services on-line from databases on the Internet; medical services; Dentistry; advice relating to medical services and dentistry; orthodontistry services; cosmetic dentistry; cosmetic medical services; teeth whitening service; advice relating to medical, health, dentistry and orthodontistry; treatments for aesthetic improvement in the dental, orthodontic and facial regions; medical care services and advice relating to medical care services provided in personal and via the Internet.

2. Adenta GmbH (the opponent) opposes the trade mark on the basis of Section 5(2)(b), Section 5(3), Section 5(4)(a) and Section 3(6) of the Trade Marks Act 1994 (the Act). In respect of the first two grounds of opposition, this is on the basis of its earlier European Union (formerly Community) Trade Mark No 137

265 18: adenta. The following goods and services are relied upon in this opposition:

Class 10:

Dental and dental technology instruments and apparatus, Namely bite guards, Occlusal splints, Teeth regulating [bracing] devices; Dental apparatus and tools, hand-operated; Orthodontic brackets [braces] for use in straightening teeth; Models for measuring and analysing impressions of the jaw; Orthodontic products in the form of apparatus and metallic components, ceramic components and plastic components, namely wires, preformed wires, wire bends, bridges, attachments, brackets, buccal tubes, bands, springs, screws, tension screws, and parts for the aforesaid goods, included in class 10.

Class 41:

Providing of training and Teaching services relating to the dental field and Orthodontics, namely seminars, refresher courses.

3. Under Section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar. As regards Section 5(3), the opponent claims that it enjoys a reputation in its earlier trade mark and that use of the later trade mark will take unfair advantage.
4. In respect of Section 5(4)(a), the opponent relies upon use of ADENTA in respect of orthodontic products, which it claims has been taking place in the UK since 1995. Use of the later trade mark will amount to a misrepresentation causing it damage.
5. Under Section 3(6), the opponent claims that the applicant had previously signed a distribution agreement on the part of the opponent and as such was well aware of its use. As such, in applying for this trade mark, it is acting in bad faith.

6. The applicant filed a counterstatement denying all the claims made (and requesting that the opponent provides proof of use of its earlier trade mark relied upon).
7. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
8. A Hearing took place on 4th July 2017, with the opponent represented by Mr Nick Zweck of Counsel, instructed by Dummett Copp LLP and the applicant by Alan Fiddes of Urquhart-Dykes & Lord LLP.

Evidence

Proof of use

Relevant statutory provision: Section 6A:

9. "Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

10. Section 100 of the Act states that:

“100. 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.”

11. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to

secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Evidence

12. This is a witness statement, dated 11th February 2017, from Ms Julia Schendell-Gröling, the Director of Sales and Marketing of the opponent. The following relevant points are contained therein:

- According to Ms Schendell-Gröling, the ADENTA trade mark has been used in relation to dental instruments and apparatus, orthodontic and education services in relation to dentistry and orthodontics in the EU since 1994. Further, that ADENTA products have been sold in the UK since 1995. Exhibit JSG1 are catalogues and users manuals showing the relevant products, including brackets, wires, bonding systems, coils and coil systems, typodonts (braces), tubes, lip bumpers, glide springs.
- The opponent has made the following websites available to customers (including those in the UK): www.adenta.com; www.adentausa.com; www.adenta.de.
- In the EU, the opponent sells its products either direct to orthodontists or via distributors. The latter is the route to market in the UK. The opponent claims that it markets to all of the 400 orthodontic specialists in the UK and 41,000 dentists who offer orthodontic services.
- Between 2009 and 2016, the opponent spent £1500 per annum on advertising, with the exception of 2015, when £8000 was spent. Exhibit JSG3 is an example of an email marketing campaign. Examples of email addresses to which the materials were sent are also included in the exhibit. It is noted that these include UK addresses.
- In 2015, the opponent attended the World Federation of Orthodontists Congress in London. The conference is held every five years in different countries and around 7000 orthodontists from many countries, including the UK attend. Exhibit JSG4 includes the relevant invoice, photographs from the

event. Other participating events include that for the European Orthodontic Society which is held in a different European country every year and is focused on research within the orthodontic field with special programmes for orthodontic universities, residents and students of all EU universities.

- The opponent's products appear in a number of magazine publications which are distributed to orthodontists around the world, including the UK. Exhibit JSG5 includes a selection. It is noted that in the exhibit, many of the articles published are in English and also German.
- The total turnover of goods sold in the UK under the ADENTA trade mark from 2009 to 2016 is approximately £300,000. Exhibit JSG6 consists of copies of printouts showing UK sales in corroboration.
- The opponent also supplies educational services in the dental field. This includes sharing information via video making (YouTube); demonstrations of the products on offer via its websites; information regarding specific tasks, such as making impressions of teeth (also via its websites). Further, the opponent holds educational two day seminars in various EU countries, such as Croatia, UK, Italy, Belgium, Poland and Spain. Exhibit JSG7 includes materials from these seminars in corroboration (course information, dates, itinerary etc.).
- Examples of the packaging used on the opponent's products are included within Exhibit JSG8. ADENTA is clearly affixed to the products (or outer packaging where appropriate).
- Ms Schendell-Gröling ends her witness statement by explaining that the applicant is a customer of the opponent and has been since November 2015. Further, that the applicant indicated that it was interested in taking the ADENTA brand and selling the opponent's products in the UK due to its reputation and established branding.

DECISION

13. It is noted that the earlier trade mark relied upon is a European Union (formerly Community) trade mark. As such, the following guidance is taken into account: in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create

or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

14. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the

use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is

that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

15. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

16. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

Conclusions on the evidence

17. It is noted from the pleadings that the opponent claims it enjoys a reputation and an enhanced degree of distinctiveness as a result of the use made of it.

Further, that its business, carried out under the unregistered earlier right ADENTA, has acquired a goodwill.

18. In considering the position as regards proof of use first of all and in bearing in mind the case law set out above, it is observed that numerous orthodontic product catalogues are in evidence and in respect of these I am content that they have been targeted at the UK and that products to the tune of £300,000 have been sold in this territory between 2009 and 2016; (this is corroborated by the documents contained within Exhibit JSG6). Examples of packaging are also provided as are examples of magazine articles in respect of the opponent's products. It is noted that these appear in both the English and German language. There is evidence that the opponent provides educational and training services via its website, via YouTube and also by way of attendance at conferences, seminars and the like. In respect of the latter, these have taken place in numerous EU countries, including the UK. The opponent operates three websites. It is noted that one is a German website but another also accommodates UK customers. Bearing in mind all of the aforesaid, it is considered that the opponent has clearly demonstrated genuine use in respect of its earlier EU Trade Mark. Further, that this is shown across all of the goods and services for which it is registered.

19. Whether or not the information filed is sufficient to demonstrate a protectable goodwill and/or reputation will be considered further below.

Section 5(2)(b)

20. Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

21. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

22. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

23. The earlier goods and services are:

Class 10:

Dental and dental technology instruments and apparatus, Namely bite guards, Occlusal splints, Teeth regulating [bracing] devices; Dental apparatus and tools, hand-operated; Orthodontic brackets [braces] for use in straightening teeth; Models for measuring and analysing impressions of the jaw; Orthodontic products in the form of apparatus and metallic components, ceramic components and plastic components, namely wires, preformed wires, wire bends, bridges, attachments, brackets, buccal tubes, bands, springs, screws, tension screws, and parts for the aforesaid goods, included in class 10.

Class 41:

Providing of training and teaching services relating to the dental field and Orthodontics, namely seminars, refresher courses.

24. Comparison of goods in Class 03:

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and mouthwashes: toothpaste; non-medicated oral health care products; mouth rinses; mouth washes; chew sticks; toothpastes and tooth gels; medicated toothpastes; teeth cleaning lotions; oral hygiene preparations; cleaning preparations for the teeth; disclosing tablets for personal use in indicating tartar on teeth; dental bleaches.

25. It is clear that there are a number of products within the contested Class 03 specification that are used to clean teeth. The purpose of such goods is therefore to maintain and improve the overall health of the teeth and gums.

The purpose of the earlier goods is to prevent, correct and treat irregularities in the teeth and jaw. While the broad purpose in respect of both coincides, their exact nature is quite different: cleaning items on the one hand and orthodontic, for example, braces on the other. That said, although it is not ignored that the public at large will be one of the end consumers, it is likely that the other end consumer, namely professionals will coincide here: all are targeted at the dentistry (of which orthodontics is a specialty) industry. Trade channels are also likely to coincide. They are considered similar, albeit to a low degree.

26. In respect of the remaining items, which have no relation to teeth, there is no similarity. These items are: bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, (none being dental hygiene); soaps; perfumery, essential oils, cosmetics, hair lotions.

27. Comparison of goods in Class 05:

Dental ceramics; dental remedies; medicated cotton; dental filling materials and impression compounds for dental purposes, casting aids, tooth lacquers; tooth filling materials; materials for preparation and filling of root canals; dental cement; disinfectants; mouth flushes for medical purposes; dental wax and dental impression materials, material for stopping teeth; dental relining material; dental fixative; dental lacquers, dental wax; antibiotics for use in dentistry; moulding wax for dentists; disinfectants for hygiene purposes: Medicated oral care preparations; medicines for dental purposes; medicated oral care products; medicated mouthwash; medicated dental rinses; dental lacquer; Pharmaceutical and medicinal preparations and substances; vaccines.

28. With the exception of vaccines, which have a specific purpose, to provoke an immunity to particular diseases and which are not administered by the dentistry profession, the rest of Class 05 would be used by dentistry

professionals, including orthodontists. Trade channels would also coincide. They are similar to a low degree.

29. Comparison of goods in Class 16:

Printed matter; magazines and publications.

30. It is noted that all of the contested goods will include goods where dentistry or orthodontics is the subject matter. The earlier trade mark includes training on the same subject matter. Though different in nature, they are highly similar in purpose as they seek to educate and/or refresh knowledge within the dentistry industry. They will also be targeted at the same end consumer. They are similar to a moderate degree.

31. It is also clear that due to the broad terms contained here, that many of the goods will not be similar to the earlier trade mark, namely those that are unrelated to dentistry or orthodontics. As such, it is considered that the following terms are not similar: Printed matter; magazines and publications, none of the aforesaid relating to dentistry, orthodontics or the treatment of teeth and gums.

32. Comparison of goods in Class 21:

Dental cleaning articles; toothbrushes; electric toothbrushes; dental floss; interdental cleaners; dental applicator brushes.

33. The assessment of similarity here has much in common with that in respect of Class 05 above. Though the public at large is not ignored, these items would also be used by dentistry professionals, including orthodontists. Trade channels would also coincide. They are similar to a low degree.

34. Comparison of services in Class 35:

Advertising and publicity services; all included in Class 35, provision of advertising information; advice on how to advertise; conducting surveys; conducting of public opinion polls; Online business networking services; advertising, marketing and promotion services for businesses; compilation and systemization of information into computer databases; providing an online searchable database featuring employment and career opportunities and business, employment and professional queries and answers; providing information about and making referrals concerning products, events and activities; organizing and conducting job fairs; job placement services, human resources consulting services; business research and survey services; monitoring services, namely tracking online references to businesses, organizations and business topics; promoting the goods and services of others via computer and communication networks; facilitating the exchange and sale of services and products of third parties via computer and communication networks; on-line retail store services in the field of digital media, clothing, footwear, headgear, printed matter, stationery, office requisites, bags, games, toys and pins; charitable services, namely promoting public awareness about charitable, community service, and volunteer activities; providing online career networking services and information in the fields of employment, recruitment, job resources, and job listings; providing online interactive employment counseling; recruitment and placement services; hosting of exhibitions, conferences and seminars for business purposes; business management consulting services for the medical and hygiene industry; business management and business administration for the medical hygiene industry; business management, business administration and office functions; preparation of statistics for research; employment and recruitment; employment and recruitment services; accountancy; careers advice; information, advice and consultancy services relating to all the aforesaid; Business services; administration of medical practices and surgeries; management of medical practices and surgeries.

35. It is noted that some of the services are those that a typical dental practice would perform as part of its day to day running, for example administration and human resources. However, this is not relevant as they would not be

provided by a dental practice as a service to others. Such services have nothing in common with the earlier goods and services. They are considered to be not similar. In respect of promotion of goods and the retail of, these are also clearly not similar to any of the earlier goods and services.

36. Comparison of services in Class 36:

Payment plan services; payment administration services; collection and processing of payments; brokerage and arrangement of health and dental insurance; administration and management of health and dental insurance; computerised services for the broking, arranging, administration and management of health and dental insurance; information relating to health insurance, dental insurance and payment plans, provided on-line from a computer database, computer network, global computer network or the Internet; information, organisation, customer care and telephone help-line services relating to all of the aforesaid services.

37. Again, the contested services are all those that would be provided to third parties. That a typical dental practice would perform such functions as part of its day to day running is therefore not relevant. These services have nothing in common with the earlier goods and services. They are considered to be not similar.

38. Comparison of services in Class 38:

Telecommunications services; telecommunication of information (including web pages), electronic mail services; provision of telecommunication access and links to computer databases and the Internet; telecommunication services providing access to financial and insurance information, services and transactions; telecommunications services relating to electronic commerce; Internet communication services; operating of chat rooms; transmission of written and digital communications; provision of news and news information via a computer network and/or the Internet; advisory and consultancy services relating to the aforesaid.

39. None of the earlier goods and services have anything in common with these contested services. They are self-evidently not similar.

40. Comparison of services in Class 41:

Operation of a publishing website; electronic publishing of magazine, periodicals and journals; Educational and training services; providing electronic publications (not downloadable), providing on-line electronic publications, publication of electronic books and journals on-line; providing publications from a global computer network or the Internet which may be browsed, all relating to business administration and management; arranging and conducting of educational conferences, seminars, exhibitions and symposiums, training courses and lectures.

41. Bearing in mind the educational nature of the earlier services, it is considered that many of the contested services would perform a highly similar purpose: to educate and inform. That the contested services can include the specific areas covered by the earlier trade mark reinforces this view. In respect of the contested educational and training services, they are considered to be identical. Further, arranging and conducting of educational conferences, seminars, exhibitions and symposiums, training courses and lectures are considered to be identical.

42. In respect of the following services, these are considered to be similar to a moderate degree: providing electronic publications (not downloadable), providing on-line electronic publications as these can include materials on the same topics as the earlier services. One would also reasonably expect such services to be provided by an educational/training company.

43. This leaves: operation of a publishing website; electronic publishing of magazine, periodicals and journals; publication of electronic books and journals on-line. In this regard, a publishing service is a step removed from

providing publications. It has nothing in common with the earlier goods and services and so is not similar.

44. Finally, providing publications from a global computer network or the Internet which may be browsed, all relating to business administration and management is also considered to be not similar as the underlying subject matter is very different.

45. Comparison of services in Class 44:

Internet services, namely provision of information relating to dentistry and dental care services on the Internet, the provision of information relating to the aforesaid services on-line from databases on the Internet; medical services; Dentistry; advice relating to medical services and dentistry; orthodontistry services; cosmetic dentistry; cosmetic medical services; teeth whitening service; advice relating to medical, health, dentistry and orthodontistry; treatments for aesthetic improvement in the dental, orthodontic and facial regions; medical care services and advice relating to medical care services provided in personal and via the Internet.

46. It is noted that the earlier services are in respect of education, namely the provision of seminars in respect of dentistry and orthodontics and the earlier goods are orthodontic items. The provision of information and advice in the later services (for example medical services) can include information on dentistry and/or orthodontics. Further, dentistry and orthodontistry is explicitly included. Such services serve a similar purpose to the earlier services: to inform. They are similar, to a low degree.

Comparison of marks

47. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the

average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

49. The respective trade marks are shown below:

ADENTA	ADENTO
Earlier trade mark	Contested trade mark

50. In terms of distinctive and dominant elements, each trade mark is comprised of a single feature and so it is this that is dominant and distinctive respectively.

51. Visually and aurally, the marks coincide entirely with the exception of the final letter – O and A. The A sound is likely to be articulated as “ah” and the O as “oh”, though the English phonetic pronunciation of O (as in the word “or”) cannot be discounted. Either way, there is a high degree of aural similarity and the same of true of the visual comparison.

52. Conceptually, though both allude to dentistry with the inclusion of DENT, it is considered more likely that each will be appreciated as invented words. On balance therefore, the conceptual impact is neutral.

Average consumer and the purchasing act

53. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

54. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied

objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

55. The earlier goods and services are clearly specialist in nature and are targeted at orthodontic professionals and dentists. The same is true of the later similar goods and services. The purchasing act appears to be via specialist suppliers (prospective purchasers having been prior targeted) but can also be via, for example, specialist websites. The cost of the items in question is unclear. However, bearing in mind the nature of their use, i.e. to care for and treat teeth, it is considered that acquiring the correct equipment/product will clearly be crucial. As such, it is concluded that the average consumer will display a higher than average degree of attention during the purchasing process.

Distinctive character of the earlier trade mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

57. The opponent has claimed that it enjoys an enhanced distinctive character in the UK. However, even without considering this directly, it is considered that the earlier trade mark will be appreciated as an invented word. As such, it is concluded that it inherently enjoys a higher than average degree of distinctiveness.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

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

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

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

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

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

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

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

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

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

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

59. It is true that many of the contested goods and services are similar to only a low degree. However, the respective trade marks are self evidently highly similar visually and aurally, with no differentiating conceptual features. This is important as the interdependency principle is in full effect here. Though a higher than average degree of attention is likely to be displayed during the purchasing process, which negates against the impact of imperfect recollection, the earlier trade mark has the look and feel of an invented word and is distinctive to a higher than average degree. . The same is true of the contested trade mark which differs from the earlier trade mark in respect of only one letter. In circumstances such as these, it is considered that direct confusion is not only likely, it is inevitable.

60. In respect of the goods and services found to be identical or similar (to whatever degree), the opposition in so far as it is based upon Section 5(2)(b) succeeds.

61. This is not the end of the matter as some of the goods in Class 03 and the services in Classes 35, 36 and 38 have been found to be not similar. As such, the opposition will continue in respect of the remaining grounds in respect of these classes only.

Section 5(4)(a) – Passing Off

62. It is noted that the basis of the claim under Section 5(4)(a) is narrower than that under Section 5(2)(b), for which the opponent has been successful at least in part (in respect of the goods and services found to be similar). However, unlike Section 5(2)(b), in considering Section 5(4)(a), there is no requirement for the goods and services to operate in the same fields of

activity. As such, the claim under Section 5(4)(a) is worthy of further assessment.

Legislation

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

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

Goodwill

64. *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

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

Customers in the UK are required

65. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

And later said, at paragraph 52:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”

66. The claimant in that case did not have any goodwill in the UK that would give it the right to prevent BSkyB from using the name "NOW TV" in relation to its internet protocol TV service. This was because the customers for Starbucks' broadcasting services under the name NOW were based in Hong Kong. The services could not be bought here. The fact that the service was sometimes accessed via the internet by Chinese speakers in the UK did not mean that Starbucks had customers here.

67. Bearing in mind all of the aforesaid, it is clear that the evidence is conclusive: there has clearly been a business in respect of orthodontic products conducted in the UK. Goodwill is established. That said, it is considered that the goodwill is at the modest end of the spectrum.

68. The remaining goods in Class 03 and services in Classes 35, 36 and 38 are remote from the earlier goods for which goodwill has been established, namely orthodontic products. As such, the following is taken into account: in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs,

who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration:

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

69. In the *Lego* case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.
70. Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.
71. Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another are the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that

the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

72. In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”

73. Though the opponent has established a goodwill, it is modest. Bearing in mind this, together with the gap in the respective fields of activity, it is difficult to see how there can be a misrepresentation. It is considered that the claim under Section 5(4)(a) therefore does not strengthen the opponent's position and so is dismissed.

Section 3(6) – Bad Faith

74. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

75. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the

allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT*

WEEKLY Trade Mark [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

76. It is noted that the opponent describes the negotiations that took place between the parties prior to the contested trade mark being applied for. These

negotiations were in respect of a distribution agreement which was in fact signed in March 2016. According to the opponent, this knowledge of the opponent's trade mark is tantamount to bad faith. In this regard, I bear in mind the guidance provided by *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others [2009] RPC 9 (approved by the COA in [2010] RPC 16), Arnold J. stated that:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

77. Bearing in mind the foregoing, it is noted that the marks are not identical and that numerous services are not similar and so it is not an unreasonable proposition that the applicant felt both marks could co-exist. In any case, it is considered that the applicant's actions do not amount to bad faith and so this ground of opposition is also dismissed.

Section 5(3) – Reputation

78. The opponent also claims that its earlier trade mark enjoys a reputation in the UK in respect of the earlier trade mark relied upon. The evidence filed in support has already been described above. While the opponent has cleared the hurdle as regards proof of use, its evidence falls short as regards demonstrating it has a reputation. It has not provided any market share information. Its turnover figures are very low (even allowing for wholesaling). It is impossible to gauge the level of recognition among the relevant public in respect of the earlier goods and services in the UK. As such, it is considered that the opponent does not enjoy a reputation in respect of ADENTA. Further, even if it did, it is noted that the relevant goods and services remaining in the contested specification are highly remote from those of the earlier trade mark. The effect of this is that even if a reputation could be proven, it is considered highly unlikely, bearing in mind the gap between the respective goods and services, that the relevant public would ever make a link between the marks.

79. The ground of opposition based upon Section 5(3) therefore fails.

SUMMARY

80. The net result of all this is that the opposition succeeds in respect of contested classes 05, 16, 21, 41 and 44. It also succeeds in respect of some of the contested goods in Class 03.

81. It fails in respect of classes 35, 36 and 38, which can proceed to publication in totality. The following goods in class 03 can also proceed to publication:

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations (none being dental hygiene); soaps; perfumery, essential oils, cosmetics, hair lotions;

COSTS

82. The opponent has been proportionally more successful than the applicant and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1134 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement (plus official fee) - £500

Preparing and filing evidence - £500

Preparation for and attendance at Hearing - £700

TOTAL - £1700

Reduced by 1/3 to reflect proportion of success achieved - £1134.

83. I therefore order Billericay Dental Supply Co Limited to pay Adenta GmbH the sum of £1134. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of September 2017

Louise White

For the Registrar,