

O/535/21

TRADE MARKS ACT 1994

IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL  
REGISTRATION NO. 1304627

AND THE REQUEST

BY

THERMO RAMSEY INC

TO PROTECT THE FOLLOWING TRADE MARK IN THE UK  
IN CLASS 9

**XPERT**

AND OPPOSITION THERETO UNDER NUMBER 409038

BY

MALVERN PANALYTICAL BV

## Background and Pleadings

1. Thermo Ramsey, Inc (“the Holder”) applied to designate the International Registration (“the IR”) “XPert” numbered 1304627 for protection in the UK on 23 May 2016. It was accepted and published in the UK Trade Marks Journal on 20 January 2017 in respect of the following goods in class 9, namely, *food safety inspection apparatus using x-ray transmission to detect foreign objects and find quality defects in the processing and packaging of foods; food safety inspection apparatus to detect foreign objects and find quality defects in the processing and packaging of foods.*

2. On 13 April 2017, Malvern Panalytical B.V.<sup>1</sup> (“the Opponent”) filed an opposition to the application for designation under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on its earlier EU registered trade mark “X’Pert<sup>3</sup>” number 14562235 which was filed on 15 September 2015 and registered on 13 May 2020.<sup>2</sup> For the purpose of this opposition the Opponent relies on all the goods and services for which its registration is protected in classes 9, 37 and 42 as set out below.

Class 9: Scientific and measuring apparatus and instruments relating to X-ray diffraction; X-ray analytical apparatus relating to X-ray diffraction; diffractometers; X-ray diffraction apparatus, X-ray diffractometers; X-ray analysers relating to X-ray diffraction; wafer analysers; X-ray tubes and X-ray apparatus relating to X-ray diffraction; computer software and hardware relating to X-ray diffraction and X-ray diffraction apparatus; parts and fittings for all the aforesaid; none of the aforesaid goods relating to X-ray fluorescence spectrometers or to X-ray fluorescence spectrometry.

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<sup>1</sup> The opposition was originally filed in the name of PANalytical B.V., however, by way of email dated 29 May 2020 the original Opponent notified the registry that it had changed its name to Malvern Panalytical B.V.

<sup>2</sup> Although the UK has left the EU and the EUTM relied upon by the Opponent now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

Class 37: Construction and repair of scientific and measuring apparatus and instruments, X-ray diffraction apparatus, diffractometers, X-ray diffractometers, X-ray analysers, wafer analysers and X-ray tubes; installation of scientific and measuring apparatus and instruments, X-ray diffraction apparatus, diffractometers, X-ray diffractometers, X-ray analysers, wafer analysers and X-ray tubes; information, advisory and consultancy services all relating to the aforesaid; none of the aforesaid services relating to X-ray fluorescence spectrometers or to X-ray fluorescence spectrometry.

Class 42: Scientific and technological services and design relating thereto; industrial analysis and research services; leasing and rental of scientific and measuring apparatus and instruments, X-ray analytical apparatus, X-ray apparatus, X-ray diffraction apparatus, diffractometers, X-ray diffractometers, X-ray analysers, wafer analysers and X-ray tubes; design of scientific and measuring apparatus and instruments, X-ray analytical apparatus, X-ray apparatus, X-ray diffraction apparatus, diffractometers, X-ray diffractometers, X-ray analysers, wafer analysers and X-ray tubes; provision of advice and consultancy services relating to the selection, operation, and use of scientific and measuring apparatus and instruments, X-ray analytical apparatus, X-ray apparatus, X-ray diffraction apparatus, diffractometers, X-ray diffractometers, X-ray analysers, wafer analysers and X-ray tubes; none of the aforesaid services relating to X-ray fluorescence spectrometers or to X-ray fluorescence spectrometry.

3. Under section 5(2)(b) the Opponent claims that as a result of the similarity between the respective marks and the identity/similarity between the respective goods and services there exists a likelihood of confusion on the part of the relevant consumer in the UK, including the likelihood of association. Specifically, the Opponent argues that the marks are visually and phonetically similar and that there is a conceptual link between the marks because the marks are or contain phonetic equivalents to the word “expert”. Furthermore it submits that the Holder's goods are encompassed within the Opponent's terms “scientific and measuring apparatus and instruments; X-ray

analytical apparatus” and its remaining goods are similar to the Opponent’s other goods and services.

4. The Holder filed a defence and counterstatement denying the claims made, notably that the marks are visually, phonetically and conceptually dissimilar. Furthermore it denies that all the contested goods are comprised within or similar to the goods and services of the earlier mark. It denies that there is a risk of a likelihood of confusion.

5. In these proceedings the Opponent relies on its EUTM which qualifies as an earlier trade mark under section 6 of the Act. It completed its registration process no more than five years before the date of publication of the Holder’s designation for protection in the UK and consequently there is no requirement to prove use pursuant to section 6A of the Act. The Opponent may rely, therefore, upon the full breadth of its specification without restriction.

6. The Opponent is represented by Elkington and Fife LLP whereas the Holder is represented by HGF Limited. During the evidence rounds the Holder filed evidence and the Opponent filed initial submissions and evidence in reply. A hearing took place before me via video conference on 11 May 2021. Mr Chris McLeod of Elkington and Fife LLP appeared for the Opponent, whereas Ms Tanya Waller of HGF Ltd attended on behalf of the Holder. Both parties filed skeleton arguments prior to the hearing.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

## **Evidence**

### **Holder’s evidence**

8. The Holder’s evidence is in the form of the witness statement of Sergey Moskalenko dated 18 December 2020 accompanied by one exhibit marked SM1. Mr Moskalenko

is an engineer in the Research and Development team of Thermo Fisher Inc, employed in this role for over 12 years.

9. Mr Moskalenko's sets out his qualifications and expertise stating that he gained a masters of science degree in electrical engineering in 2004 from the University of Minnesota. He states that he has accumulated a great deal of knowledge and expertise in the field of x-ray apparatus and equipment, through his studies and in the course of his career. He is authorised to complete the statement on behalf of Thermo Fisher Inc.

10. The purpose of Mr Moskalenko's statement is to explain the difference between the Opponent's x-ray diffractometry and the Holder's products. In this regard he states as follows:

“4. X-ray diffractometry (XRD) uses the x-ray diffraction principle to illuminate a sample with monochromatic (filtered) and collimated x-ray beams at various incident angles and to detect diffraction beams at those angles. This method allows measurement of the sample's crystalline grid properties or molecular structures if they are in crystalline form.

5. In contrast x-ray absorptiometry (XRT) (a broader term) as used in the [Holder's] brand, is where a moving food sample gets illuminated by non-monochromatic collimated x-ray beams at a 90 degree angle. The x-ray passes through the sample in a plane that is orthogonal to movement and gets projected on an array of photodetectors that generate a continuous map of attenuations as the x-ray beam passes through the product. Attenuations are proportional to the absorption rates of the food or other inspected materials.

6. The fundamental difference, regardless of the outcome, between the two technologies is that the XRD [diffraction] method uses non-penetrating x-ray beam whereas the XRT [absorption] method uses fully penetrating through sample x-ray beams.” (my emphasis)

11. Mr Moskalkenko states that x-ray diffraction “produces results that allow you to judge sub-nano meter structures” whereas the Holder’s product produces “results measured in millimetres at the best.” Furthermore he considers that these differences in x-ray technology would be fully understood by the relevant consumer and would be an important consideration in their purchasing decision.

12. Mr Moskalkenko produces at exhibit SM1 print outs of various “independent documents” said to support his conclusions. The exhibit includes several undated printouts of documents from various sources. Those extracts on pages 7 to 15 appear to be taken from a document produced by the Opponent and those numbered 19 and 20 appear to be a product information sheet produced by Thermo Fisher Scientific. The documents purport to explain how diffraction works and how the Opponent uses this technology which differs from that of the Holder’s goods.

### **Opponent’s evidence in reply**

13. The Opponent’s evidence is in the form of the witness statement of Mr Stephen Manton dated 4 March 2021, accompanied by three exhibits marked SM1-SM3.

14. Mr Manton is the director of Intellectual Property at Malvern Panalytical Ltd a position he has held since 2012. Both Malvern Panalytical Ltd and Malvern Panalytical BV are subsidiaries of Spectris Group Holdings Ltd and he is authorised to make the statement on behalf of the Opponent.

15. The purpose of Mr Manton’s statement is to provide evidence in reply to Mr Moskalkenko’s witness statement.

16. Mr Manton points out that Mr Moskalkenko is an engineer in the research and development team of Thermo Fisher Inc but has failed to provide an explanation of the connections between this company and the Holder, Thermo Ramsey Inc.

17. Mr Manton challenges Mr Moskalkenko’s evidence to the extent that it attempts to explain the differences between diffraction and transmission x-ray techniques arguing that Mr Moskalkenko in fact explains the differences between x-ray diffractometry and

x-ray absorptiometry and has failed to take into account the wording of the contested specifications since neither include x-ray absorptiometry. He states that Mr Moskalenko's evidence has little bearing on the matters in issue.

18. Mr Manton states that x-ray transmission could incorporate x-ray diffraction and therefore the apparatus would be identical or if not then there is at least similarity between the goods by virtue of the use of x-ray technology.

19. Mr Manton provides extracts of dictionary definitions of the word "transmission" stating that it is defined as "transferring something from one position to another"<sup>3</sup> and that it "encompasses transmitting by any means, such as reflection, refraction or by passing through a medium. As such the term includes both diffractometry and absorptiometry."

20. On this basis it is contended that the Holder's specification would include x-ray diffraction apparatus and be regarded as being encompassed by the term scientific and measuring apparatus relating to x-ray diffraction. The Opponent submits that the contested goods are therefore similar.

21. Mr Manton states that both x-ray absorptiometry and x-ray diffraction are methods of using x-ray technology, sharing the same basic concept namely where an "x-ray beam is directed towards a target and the output is detected and processed."

22. Mr Manton produces an extract taken from "www.chandra.harvard.edu/tech" which he states mention the respective goods as uses of x-ray technology confirming they are similar.<sup>4</sup>

23. Mr Manton challenges Mr Moskalenko's assertion that the differences between the two technologies would be fully understood by the relevant consumer and would be an important consideration in their purchasing process. He argues that since the Holder's specification does not include the term x-ray absorptiometry that the

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<sup>3</sup> Exh SM2

<sup>4</sup> Exh SM3

consumer's degree of understanding of the differences between the x-ray methods is immaterial.

24. The Opponent also filed submissions dated 2 October 2020. Whilst I have noted the contents of these submissions I do not propose to summarise them here but will refer to them as appropriate later in my decision.

### **Preliminary issues in relation to the evidence**

25. In relation to both parties' evidence the authors of the respective witness statements each confirm that they are experts in their fields and therefore intimate that I should consider their statements as expert evidence and give due weight to their content. However, whilst I have taken the contents of each into account neither party sought the permission of the tribunal to treat these witness statements as expert witnesses in accordance with the rules.<sup>5</sup> On this basis I shall treat these statements solely as evidence of fact and that they are introduced to assist me in understanding the technical nature of the goods and services under consideration.

26. Furthermore, Mr Manton called in to question Mr Moskalenko's position to provide a statement on behalf of the Holder in so far as he is an engineer in the research and development team of Thermo Fisher Inc, but has failed to provide an explanation of the connections between this company and the Holder, Thermo Ramsey Inc. Whilst I accept that this lack of clarity is unhelpful, nothing further was submitted in relation to this issue, either in the Opponent's submissions or at the hearing, nor did the Opponent apply to cross examine Mr Moskalenko. I note that Mr Moskalenko's statement was signed and accompanied by a statement of truth, and since this evidence was filed on behalf of the Holder, I will proceed on the basis that Mr Moskalenko does have the requisite authority. In relation to Mr Moskalenko's status as an expert witness I have already addressed this point above.

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<sup>5</sup> TPN 2/2012



## Decision

27. Section 5(2)(b) of the Act states as follows:

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

(a) ....

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

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

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

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

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

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

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

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

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

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

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

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

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

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

## Comparison of the goods and services

29. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

30. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

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

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

32. In its submissions, the Opponent relied primarily on its class 9 goods submitting that this provided it with its best case. At the hearing Mr McLeod accepted that I should approach the matter on the same basis. I shall therefore consider the goods and services comparison initially based on the Opponent’s class 9 goods only returning to the Opponent’s remaining goods/services if it becomes necessary to my decision. In addition Mr McLeod accepted that the term “relating to” within the Opponent’s specification should be regarded as a limitation.

33. At the hearing Mr McLeod and Ms Waller put forward their clients’ respective positions regarding the identity/similarity or otherwise of the contested goods and services in particular focussing their attentions on the differences between x-ray diffraction and x-ray transmission technology. Mr McLeod’s submissions broadly followed those as contained in his skeleton argument, namely, submitting that the term “x-ray transmission is sufficiently broad a term to encompass diffraction because it is inherently necessary to transmit x-rays in order to then produce diffraction.” He submitted that:

“11....there is an overlap between the term food safety inspection apparatus using x- ray transmission to detect foreign objects and find quality defects in the processing and packaging of foods.. and scientific and measuring apparatus and instruments relating to x-ray diffraction. The later mark clearly covers apparatus using x-rays and use of x-ray technology.

12... the term transmission encompasses transmission by any means including x-ray diffraction as stated in Steven Manton's witness statement and shown in exhibit 2. X-ray technology includes x-ray diffraction as well as the use of x-ray transmission ..as shown in exhibit 3 of Steven Manton's witness statement.

13...the term "food safety inspection apparatus to detect foreign objects and find quality defects in the processing and packaging of foods" in the specification of the later mark could cover x-ray apparatus, which is similar to the class 9 goods which the early mark covers."

34. Furthermore, Mr McLeod argued that even omitting the words x-ray transmission from the Holder's "food safety inspection apparatus to detect foreign objects and find quality defects in the processing and packaging of foods" this term would be sufficiently broad to cover the Opponent's goods particularly its "scientific and measuring apparatus and instruments relating to X-ray diffraction; X-ray analytical apparatus relating to X-ray diffraction; diffractometers; X-ray diffraction apparatus, X-ray diffractometers; X-ray analysers relating to X-ray diffraction". He argued that the Holder's terms covered any x-ray apparatus irrespective of the actual technology.

35. Ms Waller on the other hand argued that the respective terms and technology were distinct and that they would have different applications and therefore were dissimilar. In particular Ms Waller contended that the Opponent's goods would have no application in the food safety industry. It was argued that the Opponent's evidence sets out a list of fields in which x-ray diffraction is used but does not mention food safety. She submitted that "x-ray diffraction is used to study the crystalline structure of materials. This is a different functionality and field of use to the applied for goods"

36. For the purposes of this opposition the goods and services under consideration are those specifications as registered and applied for. Whilst taking note of the different market sectors, my analysis is based on a notional and fair test of the specifications as listed and not how they are actually used in the market place.

37. In this regard both parties' specifications include apparatus and instruments that use x-ray technology. In the Holder's case (where x-ray technology is referenced) that

technology is x-ray transmission, whereas the Opponent's goods are specifically related to use by x-ray diffraction. However the Holder's "*food safety inspection apparatus to detect foreign objects and find quality defects in the processing and packaging of foods*" is a broad term which does not include a limitation relating to x-ray technology and therefore in my view would include the Opponent's goods on the *Meric* principle.

38. In relation to the Holder's "*food safety inspection apparatus using x-ray transmission to detect foreign objects and find quality defects in the processing and packaging of foods*" to my mind both parties' goods are apparatus and instruments that use x-ray technology. Even if the differences between the methods of x-ray technology was understood and recognised by the average consumer (and I am not satisfied on the evidence produced that they would) there is sufficient overlap in the techniques for this to be immaterial to the actual goods at issue. There is nothing in the evidence or the specifications to suggest that both could not be used for the same end purpose in the same industry. Nothing in the evidence of Mr Moskalenko dissuades me that the contested goods are dissimilar and I accept the Opponent's submissions that "*food safety inspection apparatus using x-ray transmission to detect foreign objects and find quality defects in the processing and packaging of foods could include "scientific and measuring apparatus and instruments relating to X-ray diffraction; X-ray analytical apparatus relating to X-ray diffraction; diffractometers; X-ray diffraction apparatus, X-ray diffractometers; X-ray analysers relating to X-ray diffraction"* and vice versa.

39. Even if I am wrong in this regard, then I consider that the competing goods are highly similar overlapping in both nature and purpose. Even if the x-ray technology used in the goods differ, the Holder's goods are inspection/detection apparatus and the Opponent's goods are measuring, scientific and analysing apparatus both of which use x-ray technology. To my mind the actual x-ray technology used, be it transmission or diffraction, makes little difference as the purpose of the apparatus is the same namely to detect, identify and differentiate between materials and to provide information as to the physical properties of those material. I consider that there could be competition between the respective goods where the different x-ray technology may produce more accurate results with greater resolution in one type of apparatus

over the other, as stated by Mr Moskalenko who agreed that “diffraction produces results that allow you to judge sub-nano meter structures whereas in absorptiometry this produces results measured in millimetres at best.” Furthermore, I consider that the channels of trade and end users would overlap. Whilst the Holder’s goods are limited to the food industry the Opponent’s specification is not limited to a particular sector. Therefore in absence of any evidence to the contrary, they could both be used in the same industry, for the same purpose and by the same users.

40. On this basis I consider that the Holder’s goods are identical according to *Meric* or if I am wrong in this regard at least similar to a high degree to the Opponent’s “*Scientific and measuring apparatus and instruments relating to X-ray diffraction; X-ray analytical apparatus relating to X-ray diffraction; diffractometers; X-ray diffraction apparatus, X-ray diffractometers; X-ray analysers relating to X-ray diffraction; none of the aforesaid goods relating to X-ray fluorescence spectrometers or to X-ray fluorescence spectrometry.*”

### **Average consumer and the purchasing process**

41. When considering the opposing trade marks, I must determine, first of all, who the average consumer is for the goods and services. I must then determine the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer’s level of attention is likely to vary according to the category of goods and services in question.<sup>6</sup>

42. 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

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<sup>6</sup> Lloyd Schuhfabrik Meyer, case C-342/97.

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.”

43. The Opponent did not file any submissions regarding the average consumer prior to the hearing however when pressed Mr McLeod conceded that they would not be the general members of the public but those with a degree of expertise.

44. Ms Waller submitted both in her skeleton and at the hearing that the goods in question are

“4...specialized goods directed to the specialised public. They are complex technological products that are expensive and infrequently purchased and so will be selected with considerable care by knowledgeable and discriminating consumers.

5. The average consumer is therefore a specialised professional purchasing food safety apparatus and instruments, for example, to insert in a food production line to improve consumer safety. As such the level of attention to detail should be considered to be high. ”

45. Taking account of both parties’ submissions, I agree that the average consumer is a specialised user rather than a general member of the public. I consider that the apparatus are likely to be expensive and not purchased on a frequent basis. In my view visual considerations will dominate with the selection of the goods taken from brochures or online. I do not discount aural considerations, however, as a result of word of mouth recommendations or conversations with sales representatives. Overall, since the goods will be required for a specific purpose, I consider that a higher than average level of attention will be undertaken in the purchasing process but not considerably so. This is because in my view a manufacturer seeking to purchase food safety apparatus would not necessarily differentiate between the x-ray technology used behind the mechanics of the apparatus but concentrate on the accuracy of the results and the machine’s cost effectiveness.



## Comparison of the trade marks

46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

47. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

48. In his skeleton arguments and at the hearing Mr McLeod argued that:

“Visually: the marks contain the same string of letters namely XPERT.

Phonetically: the earlier mark will be pronounced as expert three and the later mark will be pronounced as expert.

Conceptually: as both marks contain the same string of letters they evoke the dictionary word expert.

The differences as a result of the apostrophe and the superscript 3 are insufficient to override the similarities that exist between the marks.”

49. Furthermore, at the hearing, Mr McLeod submitted that the apostrophe and the superscript were minor elements, with the overwhelming impression of the mark residing in the remaining letters “XPERT”. Mr McLeod submitted that the Opponent’s intention was for the superscript to be pronounced as the “number three” but accepted that it may also be pronounced as “cubed” as argued by Ms Waller.

50. Ms Waller on the other hand submitted that:

“there is a striking visual difference between the marks in that the earlier mark incorporates 4 elements namely X, an apostrophe, the term PERT and the symbol “<sup>3</sup>” which is the mathematical symbol for the term “cubed” whereas the contested mark comprises of the single word XPERT.”

51. In relation to the pronunciation of the superscript, Ms Waller submitted that since the average consumer was from a scientific background they were more likely to see it as the mathematical symbol for cubed than otherwise. Ms Waller accepted that the same five letter word was common to both marks, however, argued that as a result of the additional elements present in the earlier mark the overall appearance of the marks are quite different. Furthermore, conceptually, as a result of the apostrophe and the cubed symbol the earlier mark’s meaning is not immediately or precisely clear whereas the IR alludes to the high quality and specialism of the goods. Ms Waller did not advance submissions regarding the nature of the additional conceptual meanings arising from the earlier mark’s additional elements, but, nevertheless, submitted that these additional elements were sufficient to give rise to a clear conceptual difference between the marks. Whilst accepting that both marks include “XPERT” Ms Waller argued that this term is not highly distinctive given its meaning in the context of the nature of the goods and the average consumer.

52. The respective marks are as follows:

Opponent’s trade mark	Holder’s IR
X’Pert <sup>3</sup>	XPERT

## **Overall impressions of the trade marks**

53. The Opponent's mark consists of the word XPert in combination with an apostrophe (between the letters "X" and "P") and the number 3 in superscript following the letter "t" at the end. The overall impression of the earlier mark resides in the word XPert given its relative size in relation to the mark as a whole. Whilst contributing to the mark, I consider that the superscript number three will play a lesser role in the overall impression of the mark as a whole. The apostrophe may be overlooked due to its position but if it is noticed its role is limited. The Holder's mark is a word only mark with no additional elements or stylisation and therefore the overall impression of the mark resides in the totality of the word.

## **Visual considerations**

54. Whilst there are differences in casing between the respective marks this will have no bearing on the visual comparison since notional and fair use allows marks to be presented in any font or case and therefore it would not, for example, prevent the Holder's mark being presented in upper or lower case or a combination of the two.<sup>7</sup>

55. As set out at the hearing both parties agree that the similarities between the marks lie with the identical word XPERT and the differences arise as a result of the apostrophe and the superscript number three in the earlier mark. Ms Waller submits that these differences are such to render the marks visually similar only to a low degree. I disagree. Both marks contain the identical word XPERT differing only in the symbols as outlined. I do not consider that the apostrophe will necessarily be noticed by the consumer due to its position and size and, therefore, weighing up the differences and similarities between the remaining elements, I consider that visually the marks are similar to a high degree.

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<sup>7</sup> Paragraph 47 *Sadas SA v. OHIM* Case T-364/04.

## **Aural comparison**

56. At the hearing, Mr McLeod submitted that the Opponent's mark will be pronounced as either EXPERT or EXPERT THREE (no pronunciation being afforded to the apostrophe). Whilst he didn't discount the possibility of the superscript being pronounced as cubed, he considered this unlikely. Ms Waller argued that the Opponent's mark would be pronounced as four distinct separate elements as a result of the apostrophe and that the superscript number three would be pronounced as cubed. She considered therefore that the application would be pronounced as one fluid word "EXPERT", whilst the earlier mark would be broken down as the letter "X" followed by the words "PERT" and "CUBED", thus leading to only a low degree of aural similarity.

57. I do not agree with Ms Waller's submissions. I consider that aurally the element XPERT in both marks will be perceived and pronounced as the recognisable word "EXPERT". As a result of the superscript number three I consider that the earlier mark will either be pronounced as EXPERT THREE or EXPERT CUBED (depending on how the superscript number three is perceived). The apostrophe will not be pronounced nor will its presence alter the pronunciation of the element XPERT or separate the letter X from the remaining letters as submitted by Ms Waller. On this basis, I consider that aurally the marks are similar to a between a medium and high degree.

## **Conceptual comparison**

58. Both parties argued that their respective marks would allude to the word expert. However, Ms Waller submitted that in the IR's case it would allude to the high quality and specialism of the Holder's goods whereas the earlier mark's meaning may not be immediately or precisely clear to the average consumer as a result of the presence of the apostrophe and the cubed symbol. In addition Ms Waller submitted that the earlier mark would be seen as a combination of the 'X' from x-ray and the shortening of the term expert. Mr McLeod, at the hearing, submitted that if the consumer perceives the Opponent's mark in this way then it will apply equally to the IR. Having taken into account the submissions, I consider that the element XPERT in both marks will be

perceived as the word expert and be given its ordinary dictionary definition (namely a reference to a highly skilled or knowledgeable person). If the number three impacts conceptually on the earlier mark it will either be seen purely as a number indicating the third version or the power of three meaning an expert three times over ie a particularly knowledgeable or skilled expert. On the basis that both marks give rise to the concept of an expert, I consider that they are highly similar.

### **Distinctive character of the earlier mark**

59. 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).”

60. Registered trade marks possess varying degrees of inherent distinctive character; descriptive words tend to have a low level of inherent distinctiveness, whereas invented words are regarded as possessing a high level of distinctive character and dictionary words that are neither descriptive nor allusive are somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The distinctive character of a mark can be enhanced by virtue of the use made of it.

61. The Opponent did not file evidence regarding use of its mark and at the hearing Mr McLeod accepted that it was not advancing an argument that the earlier mark's distinctive character had been enhanced. I must therefore assess the matter based on the earlier mark's inherent characteristics.

62. Ms Waller considers that the earlier mark is not greatly distinctive being low in distinctive character whereas Mr McLeod argues that the earlier mark is not exclusively descriptive of the goods and services or a characteristic of them and therefore has an average level of distinctiveness. Taking into account the nature of the goods, I consider that the earlier mark whilst alluding to the word expert is not descriptive of the goods. The omission of the letter e and the presentation of the mark by the addition of the superscript adds to its distinctive character but not considerably so. On this basis I consider that overall it possesses an average degree of inherent distinctiveness.

### **Likelihood of confusion**

63. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods and services originate from the same or related source.

64. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity

between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind. Mr James Mellor, as the Appointed Person, directed that a common sense approach should be undertaken in any assessment where “every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts” applying “the well-established propositions for assessing the visual, aural and conceptual similarities.”<sup>8</sup>

65. Earlier in my decision I proceeded with the assessment only on the basis of the Opponent’s goods in class 9 as Mr McLeod accepted this provided the Opponent with its best case. I found that the contested goods were either covered by the Opponent’s broader term under *Meric* (or vice versa) or alternatively similar to a high degree. I consider that the trade marks are visually similar to a high degree and aurally similar to between a medium to high degree whether the superscript is pronounced as three or cubed. I consider that conceptually the marks gave rise to highly similar concepts. I found that the Opponent’s earlier mark has an average degree of inherent distinctive character. In terms of the purchasing process, given the nature of the goods, I assessed that a higher than average level of attention would be undertaken in the purchasing process using predominantly visual means but not discounting aural considerations. I identified that the average consumer would be from a manufacturing or scientific background rather than a general member of the public.

66. Taking account of these conclusions I remind myself that I must assess the matter as to how the marks are perceived on first impressions and from the perspective of the consumer’s immediate and instinctive reaction to the marks on first encounter.<sup>9</sup> Having regard to my assessment that a higher than average level of attention would

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<sup>8</sup> *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20

<sup>9</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

be undertaken in the selection process, I do not consider that the number three in the earlier mark (despite it being presented in superscript) will be overlooked by the average consumer or go unnoticed, unlike the apostrophe, particularly for goods purchased predominantly via visual means. I consider it unlikely therefore that the marks will be misremembered or imperfectly recalled one for the other. As a result I do not find that there would be direct confusion.

67. I must now consider whether there would be indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

68. Both marks include the element XPERT which is identical other than how they are presented, as I have already outlined. I have already assessed that the apostrophe has little impact on the overall impression of the earlier mark, however, I cannot discount the number three, despite its size.

69. Whilst a shared common element alone does not necessarily lead to a likelihood of confusion,<sup>10</sup> despite the marks being short, the addition of the number three in

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<sup>10</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17



superscript is not so significant a difference that it acts to distinguish the marks as being from different undertakings.

70. I note that the earlier mark's distinctive character is no more than average, but I cannot disregard the similarities between the marks in terms of their visual, aural and conceptual presentations as well as (at its lowest) the high similarity of the goods. The common element in both marks will result in my view in the average consumer believing that there is an economic connection between them or that they are variant marks from the same or related undertaking. Bearing in mind my assessment of the overall impression and the role each element plays when coming across the respective marks, I find that the average consumer even paying a higher than average level of attention will consider that the same provider is responsible for the goods and that the IR is a sub-brand or that the goods are another model within the same range. On this basis I consider that this would lead to indirect confusion.

71. Having found confusion based on the Opponent's goods in class 9 I need not consider the Opponent's remaining goods and services as this will not place it in any stronger position.

## **Conclusion**

72. The opposition succeeds in its entirety under section 5(2)(b). Subject to any successful appeal the application is refused.

## **Costs**

73. As the Opponent has been successful it is entitled to an award of costs. Mr McLeod made an application for a costs award on the standard scale as set out in Tribunal Practice note 2 of 2016. Applying this guidance I award costs to the Opponent on the following basis:

Preparing an opposition and  
statement of grounds:

£200

Preparing initial submissions and evidence in reply and considering the Holder's evidence	£600
Preparing for and attending a hearing including drafting skeleton arguments	£800
Official Fee	£100
<b>Total</b>	<b>£1700</b>

74. I order Thermo Ramsey, Inc to pay Malvern Panalytical B.V. the sum of £1700 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 16<sup>th</sup> day of July 2021

Leisa Davies

For the Registrar