

O/0661/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004033617

BY FIONA ELLWOOD

TO REGISTER THE TRADE MARK:

**Society of British Dental Nurses**

IN CLASSES 41 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 448660 BY

BRITISH ASSOCIATION OF DENTAL NURSES

## BACKGROUND AND PLEADINGS

1. On 2 April 2024, Fiona Ellwood (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 19 April 2024 and registration is sought for the following services:

Class 41 Education, teaching and training; Educational information provided on-line from a computer database or the internet; Providing online publications, not downloadable; Teaching services relating to the dental field; Teaching of dental care.

Class 44 Providing health information; Information services relating to health care; Dental clinic services.

2. On 18 July 2024, the application was opposed by British Association of Dental Nurses (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The section 5(3) ground was subsequently withdrawn and so the opposition proceeds on the basis of the section 5(2)(b) ground only.<sup>1</sup>

3. Under section 5(2)(b) of the Act, the opponent relies upon the following trade marks:

THE BRITISH ASSOCIATION OF DENTAL NURSES

UKTM no. 2421840

Filing date 15 May 2006; registration date 17 November 2006

(“the First Earlier Mark”)



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<sup>1</sup> The withdrawal of the section 5(3) ground is confirmed in the opponent’s letter dated 29 October 2024.

UKTM no. 2421838 (series of 2)

Filing date 15 May 2006; registration date 17 November 2006

("the Second Earlier Mark")

(together "the earlier marks")

4. The opponent relies upon all services for which the earlier marks are registered in classes 41 and 44, as set out in the Annex to this decision. The opponent claims that the marks are similar, and the services are identical or similar, with the result that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the grounds of opposition.

#### **THE HEARING AND REPRESENTATION**

6. A hearing took place before me on 23 June 2025, by video conference. The applicant was represented by Mark Kingsley-Williams of Trade Marks Direct. Mr Kingsley-Williams filed a skeleton argument in advance of the hearing.

7. The opponent has been represented throughout these proceedings by Freeths LLP. Whilst the opponent elected not to attend the hearing, it did file written submissions in lieu.

#### **EVIDENCE AND SUBMISSIONS**

8. Only the applicant filed evidence. This took the form of the witness statement of the applicant herself, dated 19 December 2024. The applicant's statement was accompanied by 5 exhibits (FE1 to FE5).

9. The opponent filed written submissions in lieu dated 19 June 2025.

## **RELEVANCE OF EU LAW**

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **PRELIMINARY MATTER**

11. In his skeleton argument, Mr Kingsley-Williams referred to the absence of any evidence of confusion in this case, despite the applicant having been using the mark applied-for in the marketplace for the last 9 years. In this regard, the applicant's evidence discusses her own personal successes, the operations of the Society of British Dental Nurses and the fact that there has been no evidence of confusion. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

12. I have no evidence before me of how (or to what extent) the earlier marks have been used in practice. Consequently, it is impossible to assess whether the absence of evidence of confusion is due to the fact that the marks are not confusingly similar or due to other matters related to the way in which the marks have been used (or not, as the case may be). This line of argument does not, therefore, assist the applicant in this case.

## **DECISION**

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

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

(a)...

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

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

14. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

15. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had completed their registration process more than 5 years prior to the filing date, it was open to the applicant to request that the opponent prove use of its marks pursuant to section 6A of the Act. However, the applicant did not do so. Consequently, the opponent can rely upon the services identified, without having to demonstrate that the earlier marks have been put to genuine use for those services.

16. 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 services**

17. At the hearing, Mr Kingsley-Williams accepted that the parties' services are identical. I will proceed on that basis.

### **The average consumer and the nature of the purchasing process**

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

19. 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.”

20. The average consumer for the services will be professionals within the field of dentistry or members of the general public. I have no evidence before me as to the cost of the services. However, it seems likely to me that these will be relatively infrequent purchases that are likely to involve at least some degree of consideration on the part of the average consumer. For example, factors such as reputation of service provider, specific subject matter and location are likely to be taken into account. Consequently, I consider that at least a medium degree of attention is likely to be paid during the purchasing process (although I recognise that it may be higher for some of the services).

21. The average consumer is likely to purchase these services following perusal of websites and advertisements. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that word-of-mouth recommendations may play a part.

### **Comparison of trade marks**


22. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

23. It would be wrong, therefore, to dissect the trade marks artificially, 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.

24. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="252 577 735 725">THE BRITISH ASSOCIATION OF DENTAL NURSES (the First Earlier Mark)</p>  <p data-bbox="309 1072 679 1108">(the Second Earlier Mark)</p>	<p data-bbox="871 577 1326 613">Society of British Dental Nurses</p>

The Overall Impression

25. The applicant's trade mark consists of the words Society of British Dental Nurses. The overall impression of the mark lies in the combination of these words as a unit.

26. The First Earlier Mark consists of the words THE BRITISH ASSOCIATION OF DENTAL NURSES. The overall impression of the mark lies in the combination of these words as a unit.

27. The Second Earlier Mark consists of the same words as the First Earlier Mark, but presented in a roundel, with a geometric device at the centre, within which the words FOUNDED 1940 appear. The eye is naturally drawn to the elements of the mark that can be read, but the words FOUNDED 1940 will be immediately recognised as indicating the date of origin (and will, therefore, be attributed no trade mark significance). Consequently, the words THE BRITISH ASSOCIATION OF DENTAL

NURSES and the roundel/device play the greater role in the overall impression, with the words FOUNDED 1940 playing the lesser role.

### Visual Comparison

28. As per the opponent's submissions, the First Earlier Mark and the application clearly share the words DENTAL NURSES, BRITISH and OF. The words DENTAL NURSES are in the same position. The words BRITISH and OF are in different positions. Whilst both marks end with the same words, the beginnings are clearly different (THE BRITISH ASSOCIATION OF vs SOCIETY OF BRITISH). I bear in mind that consumers tend to pay more attention to the beginnings of marks than the ends.<sup>2</sup> In my view, the marks are visually similar to a medium degree.

29. The same is true of the comparison with the Second Earlier Mark, although the device/roundel and additional wording are further points of difference. The marks are visually similar to a low degree.

### Aural Comparison

30. The First Earlier Mark and the application are both made up of dictionary words, which will be given their ordinary English pronunciation. In my view, the marks are aurally similar to a medium degree.

31. Clearly, the only elements of the Second Earlier Mark that can be articulated are the words. In my view, the words FOUNDED 1940 are unlikely to be pronounced as they will not be seen as indicative of origin. Consequently, the same aural comparison applies as discussed above. However, if I am wrong in that finding, then the marks will be aurally similar to a low degree.

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<sup>2</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

## Conceptual Comparison

32. In my view, there is no difference between the conceptual message conveyed by the First and Second Earlier Marks (other than the non-distinctive message conveyed by the words/numbers FOUNDED 1940). The marks all convey the concept of being bodies (albeit different types, ASSOCIATION vs SOCIETY) of which dental nurses can be members. In relation to the application, the body is for British dental nurses. In relation to the earlier marks, it is a British body for dental nurses. In my view, the marks are conceptually highly similar.

### **The distinctive character of the earlier marks**

33. 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-2779, 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).”

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

35. As the opponent did not file any evidence, I have only the inherent position to consider. The First Earlier Mark consists of the words THE BRITISH ASSOCIATION OF DENTAL NURSES. In my view, this is low in distinctiveness for the relevant services. I recognise that the presentation of the Second Earlier Mark increases its distinctiveness, resulting in a medium (or average) degree of distinctive character.

36. I should also add, at this point, that it is the distinctiveness of the common element that is key.<sup>3</sup> The common elements in this case are the words DENTAL NURSES, OF and BRITISH. Plainly, these words are non-distinctive for the relevant services.

### **Likelihood of confusion**

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

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<sup>3</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

38. I have found as follows:

- a. The services are identical.
- b. The average consumer for the services is a professional within the dentistry industry or a member of the general public, who will pay at least a medium degree of attention (although it may be higher for some of the services).
- c. The purchasing process is predominantly visual, although I do not discount an aural component.
- d. The First Earlier Mark and the application are visually and aurally similar to a medium degree, and conceptually highly similar.
- e. The Second Earlier Mark and the application are visually similar to a low degree, aurally similar to a low or medium degree (depending on how the Second Earlier Mark is pronounced) and conceptually highly similar.
- f. The First Earlier Mark is distinctive to a low degree and the Second Earlier Mark is distinctive to a medium (or average) degree.

39. In my view, there are sufficient differences between the marks, both visually and aurally, to avoid one being mistaken for the other, even when used on identical services. Whilst I recognise that the marks are conceptually highly similar, the average consumer will not overlook the different beginnings of each mark.

40. I will now consider whether there is a likelihood of 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

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

41. The common elements (being the words DENTAL NURSES, OF and BRITISH) certainly cannot be said to fall into category a) described in *LA Sugar*. This is not the

case of a non-distinctive addition as per category b). The change of SOCIETY for ASSOCIATION (or vice versa) would not be consistent with a brand extension as per category c). Whilst I bear in mind that the above categories are not exhaustive, I can see no other basis upon which indirect confusion should be found.

42. I am reminded of the words of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, in which he stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

43. In my view, the same is true here. I do not consider there to be a likelihood of direct or indirect confusion.

## **CONCLUSION**

44. The opposition is unsuccessful and, subject to any appeal, the application may proceed to registration.

## **COSTS**

45. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In making this award, I bear in mind that whilst a hearing did take place, it was extremely short. Consequently, I award the applicant the sum of **£1,350**, calculated as follows:

Preparing a counterstatement and considering the Notice of opposition	£350
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Preparing and filing evidence	£600
Preparation for and attendance at hearing	£400
<b>Total</b>	<b>£1,350</b>

46. I therefore order British Association of Dental Nurses to pay Fiona Ellwood the sum of **£1,350**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 17<sup>th</sup> day of July 2025**

**S WILSON**

**For the Registrar**

## ANNEX

### THE FIRST EARLIER MARK

#### Class 41

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; entertainment services, education services, publishing services, production, editing and rental of sound and video recordings and films, organising games and competitions, instructional services, rental of consumer domestic electric and electronic goods, namely, rental of amusement machines, audio and visual apparatus and equipment, camcorders, compact disc players and compact discs, fruit machines, cassette players, cassette recorders, cassette tapes, audio tapes, video cameras, video cassettes, video discs, video tapes, CD-Roms, radio sets and television sets, rental of toys, games and playthings; providing training; sporting and cultural activities, gymnasium services, audio recording services and hire of sound and/or video recording apparatus, recording of music; examination services, training, educational testing services; organising, setting and marking of examinations, issuing and awarding of certificates, library services, competition services, instructional services, lecturing, showing of films, slides or videos, production of films, videos, and slide shows, arranging and conducting prize giving ceremonies, conferences, colloquiums, symposiums, and seminars; cultural affairs; publishing training and examination materials in electronic or paper format; academic services, vocational services, assessment services, testing services; information, advisory and consultancy services relating to the foregoing; information, advice and consultancy services relating thereto; including but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the worldwide web.

#### Class 44

Medical services, dentistry services; hygiene services for human beings, pharmacy advice, medical analysis services relating to the treatment of persons, chiropractic services, medical clinics, convalescent homes, health care services, hospital services, medical assistance, nursing services, physiotherapy, surgery; advice, information and

consultancy services relating to the foregoing; including but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the worldwide web.

## **THE SECOND EARLIER MARK**

### Class 41

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; entertainment services, education services, publishing services, production, editing and rental of sound and video recordings and films, organising games and competitions, instructional services, rental of consumer domestic electric and electronic goods, namely, rental of amusement machines, audio and visual apparatus and equipment, camcorders, compact disc players and compact discs, fruit machines, cassette players, cassette recorders, cassette tapes, audio tapes, video cameras, video cassettes, video discs, video tapes, CD-Roms, radio sets and television sets, rental of toys, games and playthings; providing training; sporting and cultural activities, gymnasium services, audio recording services and hire of sound and/or video recording apparatus, recording of music; examination services, training, educational testing services; organising, setting and marking of examinations, issuing and awarding of certificates, library services, competition services, instructional services, lecturing, showing of films, slides or videos, production of films, videos, and slide shows, arranging and conducting prize giving ceremonies, conferences, colloquiums, symposiums, and seminars; cultural affairs; publishing training and examination materials in electronic or paper format; academic services, vocational services, assessment services, testing services; information, advisory and consultancy services relating to the foregoing; information, advice and consultancy services relating thereto; including but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the worldwide web.

### Class 44

Medical services, dentistry services; hygiene services for human beings, pharmacy advice, medical analysis services relating to the treatment of persons, chiropractic

services, medical clinics, convalescent homes, health care services, hospital services, medical assistance, nursing services, physiotherapy, surgery; advice, information and consultancy services relating to the foregoing; including but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the worldwide web.