

O/0904/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003966292
IN THE NAME OF OSCARTECH UK LTD
TO REGISTER THE FOLLOWING TRADE MARK:**

OscarTech UK

IN CLASSES 5 & 10

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000445418
BY BIOTRONIK AG**

Background and pleadings

1. On 11 October 2023, OscarTech UK Ltd (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 27 October 2023 in respect of the goods in classes 5 and 10.
2. On 22 January 2024, BIOTRONIK AG (“the Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application, as shown in the table under paragraph 13 of this decision. The Opponent relies upon the following mark:

OSCAR

UK Registration no. UK00801531307

Filing date: 02 March 2020

Date of registration: 08 October 2020

Relying upon the following goods and services:

Class 10: Vascular, cardiovascular and peripheral implants and devices; catheters, catheters for balloon dilatation, introducer sheaths and reinforced introducer sheaths for use in percutaneous vascular procedures, medical dilators, coronary and peripheral balloon catheters, catheters for percutaneous transluminal coronary angioplasty (PTCA catheters), catheters for percutaneous transluminal angioplasty (PTA catheters); balloons for medical use, peripheral and coronary balloons, drug-coated balloons, drug eluting balloons, drug releasing balloons; stents, balloon expandable stents, drug eluting stents; all the above goods not in the field of orthopaedics.

Class 44: Medical services, namely, services in the area of medical and surgical therapies, vascular therapies, cardiovascular and peripheral therapies; all the above services not relating to orthopaedics.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, each of the opponent's marks were converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹
4. The Opponent submits that there is a high degree of similarity between the marks and that the goods are identical or highly similar.
5. The Applicant filed a counterstatement within which is denied the claims made.
6. Neither party filed evidence. Neither party requested a hearing, however, the Opponent filed submissions in lieu. This decision is taken following a careful consideration of the papers.
7. The Applicant is not professionally represented; the Opponent is represented by Sonder & Clay.
8. 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 issues

9. Within the TM8, the Applicant submits that many third-parties have registered 'OSCAR' marks in classes 5 and 10. The Applicant did not submit any evidence

¹ See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

that such trade marks have genuinely been used in the marketplace. Whilst I acknowledge the Applicant's comments, I find that the existence of some registered third-party marks consisting of or containing the word "OSCAR" does not provide much assistance in relation to the assessment of similarity between the marks at hand. In accordance with the comments of the General Court ("GC") in *Zero Industry Srl v OHIM*,² the presence on the UK register of marks containing the same or shared elements is not evidence of how many of such trade marks are in fact used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks. The decision I am required to make is based on a notional assessment of the likelihood of confusion; whether there has already been confusion in the marketplace or not is irrelevant to my assessment.

DECISION

Section 5(2)

10. The opposition is based upon Sections 5(2)(b) of the Act, which read 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".

11. By virtue of its earlier filing date, the Opponent's above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed the registration process more than five years before the filing date of

² Case T-400/06.

the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.

12. 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 great degree of similarity between the marks, and vice versa; Page 8 of 20

(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.

Comparison of goods and services

13. The goods and services for comparison are as follows:

Opponent's goods and services	Applicant's goods
<p><u>Class 10:</u> Vascular, cardiovascular and peripheral implants and devices; catheters, catheters for balloon dilatation, introducer sheaths and reinforced introducer sheaths for use in percutaneous vascular procedures, medical dilators, coronary and peripheral balloon catheters, catheters for</p>	<p><u>Class 5:</u> Medical and surgical dressings; Surgical bandages; Dressings (Surgical -); Surgical dressings; Surgical plasters; Surgical glues; Surgical tape; Surgical dyes; Surgical spirits; Surgical cements; Anesthetics for surgical use; Bone cement for surgical and orthopaedic purposes; Implants (Surgical -) [living</p>

<p>percutaneous transluminal coronary angioplasty (PTCA catheters), catheters for percutaneous transluminal angioplasty (PTA catheters); balloons for medical use, peripheral and coronary balloons, drug-coated balloons, drug eluting balloons, drug releasing balloons; stents, balloon expandable stents, drug eluting stents; all the above goods not in the field of orthopaedics.</p> <p><u>Class 44:</u> Medical services, namely, services in the area of medical and surgical therapies, vascular therapies, cardiovascular and peripheral therapies; all the above services not relating to orthopaedics.</p>	<p>tissues]; Bone cement for surgical and orthopedic purposes; Tissues for surgical use; Materials for surgical casts.</p> <p><u>Class 10:</u> Medical and surgical laparoscopes; Surgical sutures; Surgical forceps; Surgical instruments for use in orthopedic surgery; Medical and surgical catheters; Surgical retractors; Surgical instruments for use in spinal surgery; Surgical bougies; Surgical catgut; Surgical staplers; Dressing forceps [for surgical use]; Surgical splints; Splints, surgical; Surgical perforators; Prostheses for surgical treatment; Surgical instruments; Surgical scissors; Surgical gowns; Surgical drapes; Surgical gloves; Surgical masks; Surgical mesh; Surgical staples; Surgical knives; Surgical needles; Surgical pliers; Sponges (Surgical -); Surgical sponges; Cutlery [surgical]; Surgical cutlery; Surgical blades; Surgical drills; Surgical skin staplers; Surgical robots; Surgical saws; Surgical examination drapes; Surgical catguts; Surgical amputaters; Surgical probes; Surgical clips; Clips, surgical; Surgical cutting instruments; Shears [surgical instruments]; Compressors [surgical]; Plaster for medical or surgical purposes; Cardiac vascular prosthesis for surgical</p>
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	<p>protheses; Surgical headlamps; Catheters for surgical use; Cardiac valves for surgical prostheses; Surgical raspatories; Surgical lamps; Blunt curettes [for surgical use]; Catgut for surgical purposes; Grafts for surgical use; Staplers for surgical purposes; Artificial surgical implants; Medical instruments for percutaneous tracheostomy; Surgical caps; Endoscopes for surgical use; Surgical thread; Thread, surgical; Plates in the nature of orthopaedic surgical implants; Surgical mirrors; Hammers for medical or surgical use; Catgut for surgical use; Incision foils for surgical use; Surgical and wound treating equipment; Ureteral stents being surgical support; Surgical apparatus and instruments; Surgical instruments and apparatus; Plates in the nature of orthopaedic surgical instruments; Bandages [supportive] for surgical purposes; Corsetry for surgical purposes; Gowns for surgical use; Surgical bypass devices; Electric scalpels [for surgical purposes];Surgical devices and instruments; Surgical apparatus and instruments for medical use; Medical apparatus for use in cardiac surgery; Splints for surgical use; Sterile sheets, surgical; Surgical apparatus and instruments for dental use; Surgical tubing for wound drainage; Needles for</p>
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	<p>surgical purposes; Inflation syringes for medical or surgical use; Tweezers for surgical use; Suture materials for surgical use; Surgical apparatus and instruments for veterinary use; Compressing screws in the nature of orthopaedic surgical implants; Compressing screws in the nature of orthopaedic surgical instruments; Knives for surgical purposes; Lasers for surgical use; Intraocular lenses for surgical implantation; Intraocular prostheses [lenses] for surgical implantation; Prostheses (Intraocular -) [lenses] for surgical implantation; Lenses [intraocular prostheses] for surgical implantation; Armboards [surgical splints]; Cutlery for surgical purposes; Lenses [intraocular prosthesis] for surgical implantation; Tubes for surgical purposes; Lag screws in the nature of orthopaedic surgical implants; Sterile clothing for surgical use; Staples for surgical use; Surgical implants [artificial materials]; Surgical breathing masks; Pads (Abdominal -) for surgical use; Ophthalmic microsurgical knives; Transplant sutures for use in surgery; Knives for surgical use; Ultrasonic diagnostic instruments for surgical use; Lag screws in the nature of orthopaedic surgical instruments; Electronic</p>
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	endoscopes for surgical use; Saws for surgical purposes.
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14. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

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

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

- a. The respective uses of the respective goods or services;
- b. The respective users of the respective goods or services;
- c. The physical nature of the goods or acts of service;

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

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

18. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

19. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information*

Ltd [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

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

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

“Implants (Surgical -) [living tissues]; Tissues for surgical use”

21. I consider that the Applicant’s above goods share the same user as the Opponent’s “vascular, cardiovascular and peripheral implants and devices”, namely medical professionals. Although the goods at issue are all for use on a patient during surgical procedures to improve health, their nature may differ as the Applicant’s goods are biological tissues, while the Opponent’s goods will encompass both natural and artificial implants, as well as devices. There could also be an overlap

in purpose to the extent that living tissue may be used in the treatment of the cardiovascular or vascular system. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospital procurement departments, and the average consumer may believe that the same entity is responsible for both. I do not consider the goods to be complementary, nor do I consider them to be in competition and I have no evidence to that point. Overall, I find the goods to be similar to a medium to high degree.

“Surgical dyes”

22. In the absence of any submissions from the parties, I understand the Applicant’s above goods to be a type of dye used to colour tissue during surgery. I consider that the Applicant’s above goods share the same user as the Opponent’s “stents, balloon expandable stents, drug eluting stents”, namely medical professionals. Although the goods at issue are all intended for use on a patient during surgical procedures, their purpose differs, as the Applicant’s goods are designed to aid the surgeon in identifying tissue and checking function during a medical procedure. In contrast the Opponent’s goods are used to cure or treat specific medical conditions. The goods also differ in nature, with surgical dyes being in the form of a liquid, while a stent is likely to be made from metal or polymers. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals’ procurement departments and may derive from the same undertaking. There is a degree of complementarity as the goods may be used alongside one another, as surgical dye may be required during surgery to ensure the correct positioning or function of a stent. However, I do not consider the goods to be in competition. Overall, I find the goods to be similar to a medium degree.

“Anesthetics for surgical use”

23. I consider that the Applicant’s above goods overlap in user with the Opponent’s “vascular, cardiovascular and peripheral implants and devices” being medical professionals. The nature and purpose of the goods differ, with the Applicant’s goods being a substance (usually provided in gas or liquid form) used to stop the patient feeling pain during an operation, and the Opponent’s goods being medical

implants and devices which I have mentioned will encompass natural (made of living tissue) or artificial implants (likely made of metal or polymers). There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments and may derive from the same undertaking. While anaesthetics will be required when performing surgery to implant a cardiovascular device, the goods themselves are not indispensable to one another and I therefore do not consider them to be complementary in the way set out by *Boston Scientific Ltd v OHIM* above. I do not consider the goods to be in competition as a cardiovascular device will not be chosen instead of an anesthetic. Considering all of the above, I am of the view that these goods are similar to a low degree.

“Bone cement for surgical and orthopaedic purposes; Bone cement for surgical and orthopedic purposes”

24. The Applicant's above goods are bone cements for surgical and orthopaedic purposes. While I note that the Opponent's goods are limited to “not in the field of orthopaedics”, there is still an overlap in user with the Opponent's “vascular, cardiovascular and peripheral implants and devices”, being medical professionals. Although the goods are both for use on a patient during surgery, there is a difference in nature and purpose, as the Applicant's goods are cements specifically for orthopaedic use, while the Opponent's goods are implants and devices related to the cardiovascular and vascular system. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments. I do not consider that the goods are in competition, nor are they complementary. Considering all of the above and, bearing in mind that the Opponent's goods are not in the field of orthopaedics, I am of the view that these goods are similar to a low degree.

“Medical and surgical dressings; Surgical bandages; Dressings (Surgical -); Surgical dressings; Surgical plasters; Surgical glues; Surgical tape; Surgical spirits; Surgical cements; Materials for surgical casts”

25. The Applicant's above goods and the Opponent's "vascular, cardiovascular and peripheral implants and devices" will all be used by medical professionals (or more specifically surgeons). Due to the specialist nature of the Opponent's goods (e.g. vascular implants) an undertaking which produces those goods would not ordinarily be expected to also produce surgical dressings and bandages. I do, however, consider that there is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments. The Opponent submits that the goods at issue share the same purpose, namely the treatment of patients³, however, this is a very broad purpose, and I am mindful that the specific purposes of the goods may differ. To my mind, the purpose of "vascular, cardiovascular and peripheral implants and devices" is limited to being devices or implants for use on a person's heart or veins to improve health. This differs to the core purpose of the Applicant's goods, which is to clean, cover or close wounds. Following this same logic, I do not consider that the goods overlap in nature and consider that there is no competition between them. While the goods at issue may be used alongside each other during surgery, I do not consider there to be complementarity in the manner set out in caselaw. Overall, I therefore consider the goods to be similar to a low degree.

Class 10:

"Medical and surgical catheters; Catheters for surgical use"

26. The Applicant's above goods fall within the Opponent's wider category "catheters, catheters for balloon dilatation, introducer sheaths and reinforced introducer sheaths for use in percutaneous vascular procedures, medical dilators, coronary and peripheral balloon catheters, catheters for percutaneous transluminal coronary angioplasty (PTCA catheters), catheters for percutaneous transluminal angioplasty (PTA catheters)". They are therefore identical on the principle outlined in *Meric*.

"Cardiac vascular prosthesis for surgical prostheses; Cardiac valves for surgical prostheses"

³ Opponent's submissions in lieu, paragraph 15.

27. I understand the Applicant's above goods to be types of surgical prostheses used to support the heart and its functions. I consider they fall within the Opponent's wider "vascular, cardiovascular and peripheral implants and devices". They are therefore identical on the principle outlined in *Meric*.

"Grafts for surgical use; Artificial surgical implants; Surgical implants [artificial materials]; Surgical implants [artificial materials]; Prostheses for surgical treatment"

28. I understand a graft to be a type of implant, as it involves the surgical transplantation of tissue or other material into the body to repair or replace a defective part of an organ/body part. I also consider a prostheses for surgical treatment to be a device surgically implanted inside the body to replace or improve the function of an organ/body part. In view of this, I consider that all of the Applicant's above goods are types of implants, which are not limited to a specific type of surgery or by which area of the body they are used upon. In the absence of any evidence to the contrary, I consider that this will encompass implants used on the vascular and cardiovascular systems. I therefore consider the Opponent's "vascular, cardiovascular and peripheral implants and devices" fall within the Applicant's above wider goods. They are therefore identical on the principle outlined in *Meric*. If, however, I am wrong in this finding, I consider the respective goods overlap in user (being medical professionals/surgeons) and nature, as the Opponent's goods may encompass both natural (such as tissue grafts) and artificial (such metal or polymer) implants and devices. There is an overlap in purpose to the extent that the Applicant's goods are used on the vascular or cardiovascular systems to repair or treat problems within the body. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospital procurement departments, and the average consumer may believe that the same entity is responsible for both. I do not consider the goods to be complementary, however there would be a degree of competition where the respective implants/devices can both be used to treat the same problems within the vascular or cardiovascular systems. Overall, I consider the goods to be similar to a high degree.

"Surgical bypass devices"

29. In the absence of any submissions from the parties, I understand the Applicant's above goods to be devices which temporarily take over the function of part of the body, such as the lungs or heart. As they can be used to replace the function of the heart, I consider that they fall within the Opponent's wider "vascular, cardiovascular [...] devices". They are therefore identical on the principle outlined in *Meric*.

"Medical apparatus for use in cardiac surgery"

30. I understand 'medical apparatus' to be pieces of equipment intended for medical purposes (e.g., to diagnose, monitor, or treat diseases). I consider that the Opponent's "stents, balloon expandable stents, drug eluting stents" are a type of medical apparatus that can be used in cardiac surgery. I therefore consider that it falls within the Applicant's above wider goods and are therefore identical on the principle outlined in *Meric*. If I am wrong in this finding, I still consider the goods to be similar. I consider that the Applicant's above goods have the same user, being medical professionals, as the Opponent's "stents, balloon expandable stents, drug eluting stents". I consider the exact nature of the goods will vary, however, there is an overlap in purpose and use as the goods can all be used during cardiac surgery. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments and the average consumer will likely expect them to derive from the same undertaking. Due to the specialist nature of the goods, I do not consider them to be in competition, however, there is a degree of complementarity between the goods, being used alongside one another during cardiac surgery, with the apparatus potentially being essential to the fitting of surgical stents. Considering all of the above, I am of the view that these goods are similar to a high degree.

"Surgical instruments and apparatus; Surgical apparatus and instruments for medical use; Surgical apparatus and instruments"

31. As the Applicant's above goods are not limited to any specific type of surgery, I consider that the Opponent's "stents, balloon expandable stents, drug eluting

stents” are a type of surgical apparatus. For the same reasoning outlined in paragraph 30, I consider the goods at issue are identical on the principle outlined in *Meric*. If I am wrong in this finding, for the reasoning set out in paragraph 30, I still consider that the goods are similar to a high degree.

“Surgical apparatus and instruments for veterinary use”

32. The Applicant’s above goods are specifically for veterinary use; however, I note that the Opponent’s goods are not limited to use on humans. While I bear in mind the guidance of *SkyKick* not to apply too liberal an interpretation to the natural meaning of the goods at issue, as neither party have filed submissions on this point, I consider that the Opponent’s “vascular, cardiovascular and peripheral implants and devices” could encompass those intended for use on animals. I consider that where the Opponent’s vascular, cardiovascular and peripheral implants and devices are used on animals, they would have the same user as the Applicant’s above goods, being medical professionals (including veterinarians). While the exact nature of the goods will vary, there is an overlap in purpose and use as the goods are all for use during surgery. There is an overlap in trade channels as the goods will be provided by specialist retailers to medical centres or veterinarians. Due to the specialist nature of the goods, I do not consider them to be in competition, however, there is a degree of complementarity between them, being used alongside one another during surgery, with the apparatus potentially being essential to surgery for implants and devices. Considering all of the above, I am of the view that these goods are similar to a high degree.

“Medical and surgical laparoscopes; Surgical sutures; Surgical forceps; Surgical retractors; Surgical bougies; Surgical catgut; Surgical staplers; Dressing forceps [for surgical use]; Surgical perforators; Surgical instruments; Surgical scissors; Surgical mesh; Surgical staples; Surgical knives; Surgical needles; Surgical pliers; Sponges (Surgical -); Surgical sponges; Cutlery [surgical]; Surgical cutlery; Surgical blades; Surgical drills; Surgical skin staplers; Surgical robots; Surgical saws; Surgical catguts; Surgical amputaters; Surgical probes; Surgical clips; Clips, surgical; Surgical cutting instruments; Shears [surgical instruments]; Compressors [surgical]; Plaster for medical or surgical purposes; Surgical headlamps; Surgical raspatories; Surgical

lamps; Blunt curettes [for surgical use]; Catgut for surgical purposes; Staplers for surgical purposes; Medical instruments for percutaneous tracheostomy; Surgical caps; Endoscopes for surgical use; Surgical thread; Thread, surgical; Surgical mirrors; Hammers for medical or surgical use; Catgut for surgical use; Incision foils for surgical use; Surgical and wound treating equipment; Ureteral stents being surgical support; Bandages [supportive] for surgical purposes; Corsetry for surgical purposes; Electric scalpels [for surgical purposes]; Surgical devices and instruments; Surgical apparatus and instruments for dental use; Surgical tubing for wound drainage; Needles for surgical purposes; Inflation syringes for medical or surgical use; Tweezers for surgical use; Suture materials for surgical use; Knives for surgical purposes; Lasers for surgical use; Cutlery for surgical purposes; Tubes for surgical purposes; Staples for surgical use; Pads (Abdominal -) for surgical use; Ophthalmic microsurgical knives; Transplant sutures for use in surgery; Knives for surgical use; Ultrasonic diagnostic instruments for surgical use; Electronic endoscopes for surgical use; Saws for surgical purposes”

33. I consider that the Applicant's above goods would have the same users, being medical professionals, as the Opponent's "vascular, cardiovascular and peripheral implants and devices". There is an overlap in purpose as the goods are all to assist in the implementation of medical treatment in a surgical setting. However, the exact nature of the goods will vary, as the Opponent's goods are specifically for use on the vascular and cardiovascular systems, while the Applicant's goods will be utilised in a broad range of surgical procedures. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments. There is a degree of complementarity between the goods in that some of the Applicant's goods will be required when performing surgery to, by way of an example, implant a vascular device. Due to the specialist nature of the goods, I do not consider them to be in competition; I say this because, by way of example, a customer is not going to purchase a vascular implant in place of surgical forceps. Considering all of the above, I am of the view that these goods are similar to a medium degree.

“Splints, surgical; Splints for surgical use; Surgical splints; Armboards [surgical splints]”

34. I understand a splint to be a rigid support for restricting movement of part of the body, such as a bone or joint. In the Applicant's above goods, I note these splints are specifically for use during surgery. I consider that the Applicant's above goods would have the same users, being medical professionals, as the Opponent's "vascular, cardiovascular and peripheral implants and devices". While the goods at issue are all for use during surgery, their exact nature and purpose differs, with the Applicant's goods being primarily for bones and the Opponent's goods being primarily for the cardiovascular and vascular system. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments. However, due to the specialist nature of the goods, the average consumer would not expect the goods to derive from the same undertaking. I do not consider the goods to be in competition; I say this because, by way of example, a customer is not going to purchase a vascular implant in place of an armboard. Considering all of the above, I am of the view that these goods are similar to a low degree.

"Surgical instruments for use in orthopedic surgery; Surgical instruments for use in spinal surgery; Plates in the nature of orthopaedic surgical implants; Plates in the nature of orthopaedic surgical instruments; Compressing screws in the nature of orthopaedic surgical implants; Compressing screws in the nature of orthopaedic surgical instruments; Lag screws in the nature of orthopaedic surgical implants; Lag screws in the nature of orthopaedic surgical instruments"

35. The Applicant's above goods are all instruments and equipment for use in orthopaedic surgery. While I note that the Opponent's goods are limited to "not in the field of orthopaedics", there is still an overlap in user with the Opponent's "vascular, cardiovascular and peripheral implants and devices", being medical professionals. There is a difference in nature and purpose, as the Applicant's goods are specifically for use in orthopaedic and spinal surgery, while the Opponent's goods are specifically for use on the cardiovascular and vascular systems. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments. I do not consider that the goods are in competition, nor are they complementary. I say this because the Applicant's goods are specifically for orthopaedic/spinal surgery, of which

orthopaedic usage is specifically discounted in the Opponent's specification. Considering all of the above, I am of the view that these goods are similar to a low degree.

“Intraocular lenses for surgical implantation; Intraocular prostheses [lenses] for surgical implantation; Prostheses (Intraocular -) [lenses] for surgical implantation; Lenses [intraocular prostheses] for surgical implantation; Lenses [intraocular prosthesis] for surgical implantation”

36. The Applicant's above goods are all surgical lens implants for eyes. There is an overlap in user with the Opponent's "vascular, cardiovascular and peripheral implants and devices", being medical professionals. There is a difference in nature and purpose, as the Applicant's goods are specifically lenses for implantation, while the Opponent's goods are specifically for use on the cardiovascular and vascular systems. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments. I do not consider that the goods are in competition, nor are they complementary. Considering all of the above, I am of the view that these goods are similar to a low degree.

“Sterile sheets, surgical; Surgical drapes; Surgical examination drapes”

37. I understand 'surgical drapes' to be sterile sheets used to cover a patient during surgery. The Applicant's above goods therefore share the same user as the Opponent's "vascular, cardiovascular and peripheral implants and devices", namely medical professionals. Although the goods at issue are all for use on a patient during surgical procedures, they differ in nature as the Applicant's goods are sterile fabric sheeting, whereas the Opponent's goods are implants and devices, will encompass natural (made of living tissue) or artificial implants (likely made of metal or polymers). Their purpose differs as the Applicant's goods are intended to provide sanitary protection for the patient during a medical procedure, while the Opponent's goods are for the treatment of specific medical conditions. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments, however, I do not consider that

this is sufficient to lead consumers to believe that the same entity is responsible for both, as due to the specialist nature of the Opponent's goods (e.g. vascular implants) an undertaking which produces those goods would not ordinarily be expected to also produce surgical drapes or sterile sheets. I do not find the goods to be complementary, nor that they are in competition. Overall, I find the goods to be similar to a low degree.

“Surgical gowns; Surgical gloves; Surgical masks; Gowns for surgical use; Surgical breathing masks; Sterile clothing for surgical use”

38. The Applicant's above goods share the same user as the Opponent's “vascular, cardiovascular and peripheral implants and devices”, namely medical professionals. Although the goods at issue are all for use during surgical procedures, they differ in nature as the Applicant's goods are items of clothing to be worn during surgery, whereas the Opponent's goods are implants and devices to be used on patients. Their purpose differs as the Applicant's goods are intended to provide sanitary protection to the medical professional or patient during a medical procedure, while the Opponent's goods are used in the surgery itself to treat a medical condition. The Applicant's goods are essential to medical and surgical therapies which may include use of the Opponent's goods. There is an overlap in trade channels as the goods will be provided by specialist retailers to hospitals' procurement departments, however, due to the specialist nature of the Opponent's goods (e.g. vascular implants) an undertaking which produces those goods would not ordinarily be expected to also produce surgical clothing or gloves. I do not find the goods to be complementary, nor that they are in competition. Overall, I find the goods to be similar to a low degree.

Comparison of the marks

39. The respective trade marks pleaded under 5(2)(b) are shown below:

Earlier trade mark	Contested trade mark
OSCAR	OscarTech UK

40. The Opponent's mark consists of the word "OSCAR". The overall impression of the mark resides in the mark in its entirety.
41. The Applicant's mark consists of three elements, conjoined words "Oscar" and "Tech" and the initials "UK". The mark will be seen as separate elements, despite their conjunction, as they are common English words and because of the capitalisation of the 'O' in Oscar and the 'T' in tech and the initials UK. I consider "Oscar" plays a greater role in the overall impression of the mark, with "Tech" and "UK" both playing a lesser role. I say this because "UK" would be understood as indicating the geographic location of the organisation, and "Tech", would be understood as an abbreviation of the word "technology", and therefore allusive/suggestive in relation to the goods at issue.
42. Visually, the marks coincide the word "Oscar" which makes up the entirety of the Opponent's mark and is positioned at the beginning of the Applicant's mark, which the average consumer tends to pay more attention to.⁴ The Opponent's mark is presented in upper case and the Applicant's mark is a mixture of upper and lower case, however, I note that registration of a word only mark covers use in any standard typeface.⁵ A point of visual difference is the additional words "Tech" and "UK" in the Applicant's mark, which are not negligible, despite their allusive/geographical meanings. Taking all of the above into account, I consider that the marks are visually similar to a medium degree.
43. Aurally, the Opponent's mark will be pronounced as OSS-CAR. The Applicant's mark will be pronounced as OSS-CAR TECK YOU-KAY. The marks coincide in the first two syllables, which make up the entirety of the Opponent's mark and is positioned at the beginning of the Applicant's mark. A point of aural difference is the additional words "Tech" and "UK" in the Applicant's mark, which despite their allusive/geographical qualities are not negligible or aurally invisible⁶. Overall, I consider the marks are aurally similar to a medium degree.

⁴ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

⁵ *La Superquímica v EUIPO*, Case T-24/17, paragraph 39.

⁶ *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22

44. Conceptually, the word “Oscar” which will be recognised as an ordinary forename typically assigned to boys. This meaning would be recognised by the average consumer in both marks. I remind myself that Philip Harris, sitting as the Appointed Person in *Georgine Ratelband v Walmart Apollo, LLC* (BL O/1212/23) considered the question of the conceptual comparability of names. He held that conceptual comparison between names is perfectly possible, even where the names do not give rise to a concept over and above that of their being recognised as names. As such, the marks share this key concept. However, the applicant’s mark also gives rise to the lesser concepts of technology and the UK geographical region. Overall, I find the marks to be conceptually similar to a medium degree.

Average consumer and the purchasing act

45. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

46. 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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:

“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.”

47. While the goods at issue will be used on members of the public during operations, the user of the goods will be medical professionals, with purchase of the goods being through procurement departments that buy on behalf of hospitals and health boards. Medical professionals (and procurement departments within the healthcare sector) will ensure the goods are suitable for their needs, especially given their importance to patient health. The frequency of purchase and cost will vary depending on the specific goods. By way of example, I consider that “surgical gloves” are likely to be low cost and purchased frequently, however, other goods such as “surgical robots” are likely to be expensive and will be purchased infrequently. The average consumer will, however, likely take many of the same factors into consideration such as the cost, quality of the goods, and the suitability for their specific needs.

48. The purchasing process will be primarily visual from websites, catalogues and marketing material from specialist retailers, although I do not discount aural considerations from recommendations or presentations provided by medical representatives. Taking the above into account, I consider that the level of attention paid during the purchasing process for the goods will vary between a medium and high degree, dependant on the cost and frequency of purchase of the goods.

Distinctive character of the earlier trade mark

49. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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).”

50. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

51. As the Opponent has not filed any evidence to show that the distinctiveness of its earlier registration has been enhanced through use, I only have the inherent position to consider.

52. As highlighted above, the Opponent’s earlier mark comprises of the word “OSCAR”, which will be recognised as a boy’s name. I do not consider that this is suggestive/ allusive or descriptive of any of the services upon which the Opponent relies. I consider that it is inherently distinctive to a medium degree.

Likelihood of confusion

53. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle

that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

54. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

55. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually, aurally and conceptually similar to a medium degree.
- I have found the Opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be medical professionals and procurement departments purchasing on behalf of hospitals and health boards who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium to high degree of attention will be paid during the purchasing process (which will vary slightly dependant on the cost and frequency of purchasing each of the goods).
- I have found the parties goods to be between identical and similar to a low degree.

56. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I bear in mind that descriptiveness does not make an

element invisible⁷ and I consider that this extends to the “Tech” and “UK” elements in the Applicant’s mark, which are allusive to the goods at issue, or indicate the geographic location. Their allusive nature does not make the elements negligible, and I consider they will still be noticed by the average consumer, creating a visual, aural and conceptual point of difference between the parties’ marks. Even where the goods are identical, considering the high degree of attention being paid by some of the average consumers, I consider that the additional elements in the Applicant’s mark will be used to distinguishing such marks from each other. Consequently, I do not consider that there exists a likelihood of direct confusion.

57. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting 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

⁷ *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22

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).”

58. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.⁸

59. Furthermore, in *Liverpool Gin*,⁹ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

60. I consider that the shared common use of the “Oscar” element, which I found plays the greater role in the applicant’s mark and is the entirety of the opponent’s mark, will lead the average consumer to conclude that they originate from the same or

⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

⁹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

economically linked undertakings. This is on the basis that the word ‘Tech’ will, in my view, be seen as an indication that ‘Oscar’ has extended into producing goods that are technologically advanced. Similarly, the presence of the initials “UK” will, in my view, be seen as an indication that it is a UK based arm of the ‘Oscar’ brand. As a result, I consider that the differences between the marks will be seen as either indications of a sub-brand or brand extensions of each other. As the word ‘Oscar’ is not descriptive or allusive of the goods at issue, I do not consider that its shared use will be viewed as coincidental. Taking all of this into account and bearing in mind the comments of Arnold LJ in the preceding paragraph, I find that there is a likelihood of indirect confusion between the marks at issue for all goods that are similar to at least a low degree, due to the effect of the interdependency principle.

CONCLUSION

61. The opposition based upon 5(2)(b) has succeeded, and the application subject to any appeal, will be refused for all goods.

COSTS

62. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 1/2023. Applying the guidance in the TPN, I consider the following to be fair:

Official fee for opposition form	£100
Filing a notice of opposition and considering the Applicant’s counterstatement	£250
Preparing and filing written submissions in lieu	£350
Total:	£700

63. I therefore order OscarTech UK Ltd to pay BIOTRONIK AG the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period

or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of September 2025

**Emma Rees
For the Registrar**