O-1021-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3970827

IN THE NAME OF INVICTUS GLOBAL LIMITED

FOR THE FOLLOWING MARK:

IN CLASSES 10 & 35

AND

OPPOSITION THERETO (UNDER NO. 600003274)

BY

IMPERATIVE TRAINING LIMITED

BACKGROUND

1) On 23 October 2023, Invictus Global Limited ('the applicant') applied to register the trade mark shown on the cover page of this decision ('the applicant's mark') in respect of the following goods and services:

> **Class 10:** Defibrillators; defibrillator monitors; external defibrillators; automated external defibrillators; defibs; implantable defibrillators; electrodes for external defibrillators; cardioversion and/or defibrillator leads; monitors for defibs.
>
> **Class 35:** Retail services relating to defibrillators, defibs, defibrillator monitors, external defibrillators, automated external defibrillators, implantable defibrillators, electrodes for external defibrillators, cardioversion and/or defibrillator leads, monitors for defibs; Online retail services relating to defibrillators, defibs, defibrillator monitors, monitors for defibs, external defibrillators, automated external defibrillators, implantable defibrillators, electrodes for external defibrillators, cardioversion and/or defibrillator leads.

2) The application was published in the Trade Marks Journal on 12 January 2024 and notice of opposition, under the fast-track procedure, was subsequently filed by Imperative Training Limited ('the opponent'). It is claimed that the applicant's mark offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). In support of that ground, the opponent relies upon the following trade mark registration:

- **UKTM 908306656**

> **Class 10:** Defibrillators.

Class 35: Retail services relating to the sale of defibrillators.

Filing date: 18 May 2009
Date of entry in register: 29 March 2010

3) It is claimed that there is a likelihood of confusion between the parties' marks under section 5(2)(b) of the Act.

4) The applicant is represented by Brandsmiths SL limited; the opponent is represented by MLP Law Ltd.

5) The mark relied upon by the opponent is an 'earlier mark' in accordance with section 6 of the Act. As the earlier mark completed its registration procedure more than five years prior to the date on which the applicant's mark was filed, the earlier mark is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services covered by the earlier mark. The opponent also filed evidence of use with its notice of opposition (Form TM7F) as required under the fast-track procedure. The evidence comes from Amelia Denton, of MLP Law Ltd (the opponent's legal representatives) and includes exhibits 1-8.

6) The applicant filed a counterstatement. It admits that the parties' goods and services are identical or highly similar. However, it denies a likelihood of confusion. This is primarily on the basis that the common words in the marks, 'defibshop', are descriptive of the relevant goods and services and, as such, are entirely non-distinctive. The applicant denies that the opponent's evidence is sufficient to show genuine use for any of the goods and services covered by the earlier mark.

7) Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that: "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit." The net effect of these changes is to require parties to seek leave in order to file evidence in fast-track oppositions (aside from proof of use evidence). Further, rule 62(5) (as amended) states that arguments in fast-track

proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8) In its counterstatement, the applicant made a request to file evidence. A preliminary view was given to allow the applicant's request. However, it was stipulated in the preliminary view that such evidence should be confined to the matter of challenging the opponent's evidence of use. The parties were given a period of 14 days in which to object to that view.[1] No objection was made by either party within the time allowed and, accordingly, the preliminary view was automatically confirmed. The applicant subsequently filed evidence which takes the form of a witness statement in the name of Stephen Lowry with exhibit SXL01 thereto. I note that, despite this evidence going to a matter other than that stipulated in the preliminary view, it was, nevertheless, admitted into the proceedings and the opponent was afforded the opportunity to file evidence in reply if it wished to do so.[2] The opponent opted not to file any evidence in reply. Subsequently, and although these are fast-track proceedings in which neither party has an automatic right to an oral hearing, it appears that the parties were then provided with the opportunity to file written submissions or to request a hearing before the substantive decision was made.[3] The applicant duly requested a hearing.[4]

9) Despite the tribunal having afforded both parties the opportunity to request a hearing, and the applicant confirming that it wished for a hearing to be appointed, I note that the tribunal then informed the applicant that, as these are fast-track proceedings, it should provide reasons as to why a hearing was necessary and proportionate to the matter to be determined.[5] The applicant duly provided reasons in support of allowing the request for a hearing. These included being allowed to elaborate upon the content of its own evidence and to comment upon the deficiencies in the opponent's evidence of use; it also requested that the subject proceedings be

[1] Official letter of 29 November 2024
[2] Official letter of 07 February 2025
[3] Official letter of 08 April 2025
[4] Applicant's email of 22 April 2025
[5] Official email of 15 May 2025

transferred to the standard opposition route.[6] The opponent, for its part, confirmed that it did not consider a hearing to be necessary.[7] It appears that the tribunal then conducted a review of the content of the applicant's evidence. During that review it seemingly become apparent to the tribunal that the evidence had not, in fact, been confined to the matter of challenging the opponent's evidence of use (which had been the basis for allowing the applicant leave to file any evidence). Instead, the applicant's evidence went to a completely different matter, for which leave to file evidence had not been granted. As such, the tribunal informed the parties that there did not appear to be anything in the applicant's evidence that required the proceedings to be converted to a standard opposition or to necessitate an oral hearing. The parties were, therefore, allowed a period in which to file written submissions in lieu of a hearing. The deadline for any such submissions being 17 June 2025.[8] The applicant filed final written submissions on that date.

The Case Management Conference ('CMC')

10) The opponent filed its final written submissions two days late, on 19 June 2025. The applicant objected to the late filing of those submissions and this ultimately gave rise to the appointment of a CMC before me on 17 July 2025. Prior to the CMC, the parties were advised that I would hear their submissions on the admissibility of the opponent's late submissions and that I would then give my decision on that procedural matter as a preliminary point in the main substantive decision.[9] I reiterated at the CMC that I considered it appropriate to take this approach and neither party voiced any objections.

11) At the CMC, the opponent was represented by Ms Michelle Kellet of MLP Law Ltd; the applicant was represented by Mr Parminder Dyal of Brandsmiths SL Limited.

12) Having considered the arguments made to me at the CMC by both representatives, I have no hesitation in concluding that the opponent's late

[6] Applicant's email of 22 May 2025
[7] Opponent's email of 22 May 2025
[8] Official letter of 03 June 2025
[9] Official email of 04 July 2025

submissions of 19 June 2025 will be admitted and I will take them into account in reaching my decision on the pleaded grounds before me under section 5(2)(b) of the Act. In reaching this view, I have borne in mind the following factors, in particular:

i) These are fast-track proceedings in which there is no automatic right to an oral hearing. To refuse to admit the opponent's final written submissions would effectively deprive of its fundamental right to be heard (in writing) before the substantive decision is made. In my view, I should be slow to deprive the opponent of that right.

ii) As I pointed out to Mr Dyal at the CMC, the cases he referred me to, namely 'Crunch'[10] and 'Kix'[11], are irrelevant to whether the opponent is entitled to an extension of time to file submissions. Both of those cases concerned the late filing of a Form TM8/TM8(N) and counterstatement. The deadline for filing those forms is non-extendable by virtue of being listed in Schedule 1 of The Trade Marks Rules 2008. The discretion available to the tribunal to allow the admission of a late TM8/TM8(N) is therefore a narrow one which requires the existence of 'extenuating circumstances'. The same is not true of the deadline for filing final submissions.

iii) As Ms Kellett pointed out, the opponent's submissions were filed only two days late which is far from a significant delay.

iv) Despite Mr Dyal's submission that the applicant has incurred extra costs and time of having to deal with the opponent's late submissions, including having to attend the CMC, I cannot see that there has been any real prejudice to the applicant.

13) I will now make the decision under section 5(2)(b) of the Act having carefully considered all the papers before me.

[10] BL O/1223/24
[11] BL O/035/11

Irrelevant issues

14) Q13 of the Form TM7F states: 'Please provide any other information which you consider to be relevant'. In response to this, the opponent provides information relating to a domain name dispute. A copy of the decision in that dispute is provided in exhibit 7. Further, at paragraph 4 of the opponent's final written submissions, it states:

> '4.1 The inclusion of the Opponent's domain in the Applicant's mark is especially concerning. The Applicant is attempting to monopolise a domain-based identifier that belongs to the Opponent this is unjust and misleading.
>
> 4.2 The Opponent further notes the UDRP proceedings, which confirmed the Opponent's prior rights in the DEFIBSHOP mark and domain and found bad faith registration by the Applicant's predecessor. While distinct in legal basis, this reinforces the risk of confusion and improper motive.' (my emphasis)

15) As the opponent itself concedes, the domain name dispute to which it refers, and the grounds of opposition pleaded before me are 'distinct in legal basis'. The domain name dispute, and the findings made therein, are irrelevant to an opposition under section 5(2)(b) of the Act and therefore I will make no further mention of exhibit 7. Furthermore, any suggestion that the applicant may have acted in bad faith is also irrelevant under section 5(2)(b) of the Act. The relevant section of the Act under which to advance such an argument is section 3(6) which has not been relied upon and neither has there been any request to amend the pleadings to add such a ground.

16) The opponent also submits that the applicant has submitted no evidence of use of its mark. The lack of any such evidence from the applicant is also irrelevant.

17) The only issues which I need to decide in the instant case are i) does the evidence before me establish that the earlier mark been put to genuine use during the relevant period and ii) if genuine use is proven for at least some of the goods and services relied upon, is there a likelihood of confusion under section 5(2)(b) of the Act. It is to those issues which I now turn.

Proof of use

18) Section 6A of the Act states:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

19) As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union."

20) Further, Section 100 of the Act states that:

> "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

21) Consequently, the onus is upon the opponent to prove that genuine use of its mark was made in the relevant period.

22) In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

23) In the instant case, the relevant period is the five-year period ending on the date of filing of the applicant's mark, namely **24 October 2018 to 23 October 2023.**

24) Ms Denton states that the earlier mark has been used throughout the UK for all goods in class 10 and all services in class 35.[12]

- Examples of use are provided in exhibits, as follows:

    - **Exhibit 1**: This consists of undated snapshots from the opponent's social media pages. There is one post from each of the following: Facebook, LinkedIn, Twitter, Instagram, TikTok. Each snapshot shows use of the earlier mark. I note that the Linkedin post states: 'defibshop, the

[12] Form TM7F, Q7 – Q8.

independent, impartial supplier of defibrillators, we are passionate about creating heartsafe places' and the Twitter post refers to the opponent as a 'top defibrillator distributor in the UK'. However, the images of defibrillators which are visible on all the posts are not branded with the earlier mark. Instead, they bear another mark, namely, 'Zoll'.

- **Exhibit 2:** This consists of a single undated page from the opponent's website, www.defibshop.co.uk. The earlier mark is present in the top left-hand corner of the page. The categories on the ribbon at the top of the page include 'defibrillators', 'pads & batteries', 'storage & signage', 'maintenance & servicing', 'training courses'. The category 'Storage & Signage' has been expanded. None of the 'Brands' available in that category include the earlier mark. They include numerous other brands, including 'ZOLL', 'Schiller', 'AED Armor' etc. There are no defibrillators or other goods clearly visible on the page (the images of goods at the bottom of the page are obscured).
- **Exhibit 3:** This is an undated 'order confirmation form'. The earlier mark is present at the top of the form. The customer is based in the UK. The invoice is for 'Cardiac Science Powerheart G5 Adult Defibrillation Pads' (quantity of 1).
- **Exhibit 4:** This is described as an 'expiry/replacement email', informing a customer that their defibrillator electrode pads are due for replacement and that they can be ordered through their account. The email is undated. The earlier mark is present at the top of the email.
- **Exhibit 5:** This is described as a 'service email', informing a customer that their defibrillator is coming up to its annual service date. It is undated. The earlier mark is present at the top of the email.
- **Exhibit 6:** This is a single undated page entitled 'Defibrillator Buyers Guide' bearing the earlier mark.
- **Exhibit 8:** This is a page from www.defibshop.com dated 22 October 2021. Ms Denton states that this website is run by the opponent's US partners. The website page shows a US trade mark owned by the opponent (this looks the same as the earlier mark but is absent the words '.co.uk' in the heart device). This evidence is not relevant as it relates to use in the US.

25) Ms Denton also provides the following information regarding sales that have been made under the earlier mark[13]:

Jan 19 – Jan 20: £5,747,401.31, Jan 20 – Jan 21: £4,260,219.78, Jan 21 – Jan 22: £6,784,236.42
Jan 22 – Jan 23: £6,282,443.25, Jan 23 – Jan 24: £5,968,112.37

Indication of the typical unit price for the products/service: Defibrillators - £1,121, Electrode Pads - £92.34 Batteries - £218.35, Storage - £320, Service - £165.50, Installation - £165.50 and, Training Course - £445

26) The following marketing budget figures are also provided:

Yearly marketing budgets:	
2019-2020	£210,943
2020-2021	£242,583
2021-2022	£196,830
2022-2023	£256,600
2023-2024	£327,250

27) That completes my summary of the opponent's evidence of use.

Class 10: Defibrillators

28) I am not satisfied that the evidence is sufficient to show that the earlier mark has been used on/in relation to defibrillators per se in the relevant period. Firstly, none of the relevant evidence in the exhibits is dated and therefore it is not clear that any of it comes from the relevant period (the US use is dated but not relevant). Secondly, the nature of the use shown of the earlier mark appears to be in relation to a retail service connected with the sale of third-party branded defibrillators, such as those branded 'ZOLL' (along with some other goods/services such as 'servicing defibrillators'). Thirdly, although the unit price for a defibrillator has been provided, the total sales figures for the relevant period have not been broken down. As such, I cannot tell what

[13] Form TM7F, Q11.

proportion, if any, of those figures relate to the sale of defibrillators themselves, let alone if the earlier mark was used on or in relation to, any such defibrillators as a badge of origin (as opposed to third-party marks being used on/in relation to the same). Similarly, the marketing figures have also not been broken down. In the absence of any other evidence to clearly show use of the earlier mark on/in relation to defibrillators per se, I find no genuine use for defibrillators.

Class 35: Retail services connected to the sale of defibrillators.

29) I have already noted that the nature of the use shown before me includes, amongst other services such as 'servicing defibrillators', a retail service connected with the sale of defibrillators. That said, I must still be satisfied that there has been 'real commercial exploitation of the mark' for such services in the relevant territories in the relevant period (namely, in the EU between 24 Oct 2018 and 31 Dec 2020 and in the UK thereafter up to 23 October 2023).

30) The difficulty for the opponent is that all of the relevant evidence in the exhibits showing use of the earlier mark is not only very thin but also undated (the dated page from the US website is irrelevant as it does not show use in the relevant territory). Therefore, I cannot tell if the examples of use shown in the evidence are representative of the use which took place in the relevant period or not. Further, the sales figures which have been provided, although impressive on their face, are not broken down to clearly indicate what proportion of them relate, specifically, to 'retail services connected to the sale of defibrillators'. In this connection, I note that the 'typical unit prices' provided alongside the total sales figures include 'Storage', 'Service' and 'Training courses', none of which are covered by the earlier mark. I cannot tell what proportion of the total sales figures relate to those goods/services as opposed to the actual services being relied upon. It is, therefore, not possible to gauge the scale of use within the relevant period for 'retail services connected to the sale of defibrillators'. A further problem for the opponent is that the marketing figures are not broken down such that it is impossible to know what proportion of them, if any, relate to marketing efforts in relation to 'retail services connected to the sale of defibrillators'. For all these reasons, I am not satisfied that there has been real commercial exploitation of the

mark for the relevant services in the relevant period. I find no genuine use for 'Retail services connected to the sale of defibrillators'.

31) The opponent has failed to establish genuine use in relation to any of the goods and services relied upon in the relevant period. Consequently, the opponent cannot rely upon its earlier mark under section 5(2)(b) of the Act and the opposition must fail.

OUTCOME

32) **The opposition fails.**

COSTS

33) The applicant has been successful and is entitled to an award of costs. I make no award in respect of the applicant's evidence which has been of no assistance to me. Using the guidance in Tribunal Practice Notice ('TPN') 1/2023, which updated the scale set out in TPN 2/2015, I award the applicant costs on the following basis:

Preparing a statement and considering the other side's statement	£250
Written submissions	£350
Total:	**£600**

34) I order Imperative Training Limited to pay Invictus Global Limited the sum of **£600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of October 2025

Beverley Hedley, For the Registrar