

**O/1100/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 4026409  
BY MGL ASSOCIATES LTD T/A MEDIZ  
TO REGISTER THE FOLLOWING TRADE MARK:**

**MEDIZ**

**IN CLASSES 5 AND 10**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 448386  
BY MÉDIS - COMPANHIA PORTUGUESA DE SEGUROS DE SAÚDE, S.A.**

## BACKGROUND AND PLEADINGS

1. On 15 March 2024, MGL ASSOCIATES LTD T/A MEDIZ (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 29 March 2024, and registration is sought for goods in classes 5 and 10.<sup>1</sup>

2. On 1 July 2024, the application was opposed in full by MÉDIS - Companhia Portuguesa De Seguros De Saúde, S.A. (“the opponent”), on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following earlier comparable United Kingdom Trade Mark (“UKTM”)<sup>2</sup> for its opposition:



UKTM 917870128

Filing date: 7 March 2018

Registration date: 12 November 2020

For goods and services in classes 9, 10, 16, 36, 41 and 44.

For the purpose of these proceedings the opponent relies upon some of its goods and services, namely all those in classes 10 and 44.<sup>3</sup>

3. The opponent claims that the marks are highly similar and that the goods and services are identical or highly similar, resulting in a likelihood of confusion on the part of the public, which includes a likelihood of association.

4. The applicant filed a counterstatement denying the ground of opposition.

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<sup>1</sup> See goods and services comparison at paragraph [21].

<sup>2</sup> 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, the opponent’s mark was 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. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

<sup>3</sup> See goods and services comparison at paragraph [21].

5. The opponent's mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all the goods and services for which the earlier mark is registered without having to establish genuine use.

6. Neither party filed evidence. Only the opponent filed written submissions.<sup>4</sup> Neither party requested a hearing nor filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.

7. The opponent is represented by Tennant IP Limited; the applicant represents itself.

## **PRELIMINARY ISSUES**

8. Several points have been raised by the applicant in its counterstatement. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

### Language of marketing materials

9. The applicant states that the trade marks at issue operate in different linguistic contexts, on the basis that their mark 'MEDIZ' is marketed exclusively in English, while the opponent's mark, uses Portuguese in its branding, and as such, differences in the language used in marketing materials can reduce the likelihood of confusion. It is noted that the applicant has not provided any evidence in support of its claim. Furthermore, it is important to note that likelihood of confusion is determined by the perception of the relevant consumer. The opponent's earlier mark and the applicant's contested mark are both UK trade marks, therefore, the target market is the relevant UK consumer, who will primarily speak English. As such, in terms of the opponent's earlier UK trade mark, it is highly likely that the opponent will use English language in

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<sup>4</sup> Filed on 20 December 2024.

its marketing material, when directed at a UK market. Therefore, I find that this line of argument does not assist the applicant.

### Goods comparison and the target market

10. The applicant points to the differing target markets of the respective parties and their goods and services, submitting that such differences will prevent a likelihood of confusion. However, for the avoidance of doubt, I must carry out a notional assessment based upon the parties' respective marks and the goods and services contained in their specifications. The actual target market and the activities they carry out are not relevant to my assessment.<sup>5</sup>

### **RELEVANCE OF EU LAW**

11. 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.<sup>6</sup>

### **DECISION**

#### **Section 5(2)(b): legislation and case law**

12. Section 5(2)(b) and 5A of the Act read as follows:

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

(a) [...]

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<sup>5</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66]; *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

<sup>6</sup> See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

(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.

[...]

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.”

13. I am guided by the following principles, gleaned from the decisions of the CJEU in *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;

(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

14. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned, ... 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”.

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

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

16. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

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 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 goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.<sup>7</sup>

19. In the case of goods and services, the terms used should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36*, at [365].

20. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

21. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense. Meanwhile, in *RALEIGH INTERNATIONAL Trade Mark [2001] RPC 11*, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.

22. The competing goods and services are as follows:

### Applicant's goods

#### *Class 5*

Dressings, medical; Medical dressings; Medical and surgical dressings; Medical plasters; Gauze; Gauze for dressings; Gauze compresses; Gauzes for use as dressings; Surgical bandages; Elastic bandages [dressings]; Antiseptic cotton;

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<sup>7</sup> Paragraph 5

Bandages for dressings; Compression bandages [dressings]; Ear bandages; Wadding for dressings; Pressure bandages [dressings]; Adhesive bandages for skin wounds; Absorbent cotton wadding; Bandages (Hygienic -); Aseptic cotton; Cotton wool for surgical use; Adhesive dressings; Absorbent cotton; Bandages for skin wounds; Wound dressings; Adhesive dressing strips; Cotton wool swabs for medical use; Menstruation bandages; Bandages (Menstruation -); Surgical dressings; Dressings (Surgical -); Surgical plasters; Medical wound dressings; Absorbent cotton wool [for medical purposes]; Elastic dressings; Medicated swabs; Cotton wool for medical use; Cotton wool for pharmaceutical purposes; Cotton wool for medical purposes; Cotton wool in the form of buds for medical use; Cotton swabs for medical use; Cotton wool in the form of sticks for medical use; Cotton for medical use; Absorbent cotton for medical purposes; Cotton swabs for medical purposes.

#### *Class 10*

Medical devices; Medical gloves; Medical gowns; Medical masks; Plaster for medical or surgical purposes; Compression bandages; Adhesive bandages (Suspensory -); Triangular bandages; Elastic bandages, not for dressings; Sterile sheets, surgical; Anaesthetic drapes; Adhesive drapes for surgical use; Sheets [drapes] for use in surgery; Surgical drapes; Elastic compression bandages for surgical purposes; Adhesive bandages (Supportive -); Suspensory bandages; Bandages (Suspensory -); Orthopaedic bandages; Sponge cloths for surgical use; Surgical examination drapes.

#### Opponent's goods and services

#### *Class 10*

Veterinary apparatus and instruments; Surgical apparatus and instruments; Dental apparatus and instruments; Medical apparatus and instruments; Artificial limbs; Eyes and teeth; Orthopaedic articles; Suture materials.

#### *Class 44*

Provision of health care; Consultancy in relation to personal wellbeing (health); Human hygiene and beauty care.

## **Class 5 of the contested application**

Dressings, medical; Medical dressings; Medical and surgical dressings; Medical plasters; Gauze; Gauze for dressings; Gauze compresses; Gauzes for use as dressings; Surgical bandages; Elastic bandages [dressings]; Bandages for dressings; Compression bandages [dressings]; Ear bandages; Wadding for dressings; Pressure bandages [dressings]; Adhesive bandages for skin wounds; Bandages (Hygienic -); Adhesive dressings; Bandages for skin wounds; Wound dressings; Adhesive dressing strips; Surgical dressings; Dressings (Surgical -); Surgical plasters; Medical wound dressings; Elastic dressings

23. The contested goods are all various forms of medical and surgical dressings used to, inter alia, protect wounds from infection, absorb excess fluid such as blood, to keep the wound clean and dry, and to create an optimal environment for healing by controlling moisture and providing a barrier against contaminants, etc. Whilst I note that these goods are not present in the opponent's specification, I am of the view that they share a degree of similarity with the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments* and *medical apparatus and instruments* in class 10. Though it is acknowledged that the contested goods are not *apparatus and instruments* per se, they are a type of medical equipment, which is likely to be used alongside the opponent's stated goods, during surgical procedures and medical treatments, etc. Accordingly, whilst their nature differs, their purpose, users and channels of trade can overlap. Therefore, I consider that the contested goods and the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments* and *medical apparatus and instruments* are similar to a medium degree.

Menstruation bandages; Bandages (Menstruation -)

24. The above goods are a type of pad designed for absorbency of menstrual fluid during menstruation and are an alternative to other sanitary products such as a tampon. Whilst I note that the opponent's earlier mark contains the broad terms *medical apparatus and instruments* and *surgical apparatus and instruments* in class 10, I am of the view that such goods would be used for, amongst other things, the diagnosis of diseases and/or for performing medical treatments and surgeries, etc.

The contested goods are not intended for use in medical procedures, nor would they be used as a substitute for a surgical dressing, on the basis that they are not designed for wound care, for example. Therefore, I find the nature, method of use and purpose of the goods at issue to differ. Furthermore, they are not likely to be manufactured by the same producers, coincide in trade channels or target the same end users. Moreover, the competing goods are not in competition nor are they complementary. Accordingly, in the absence of any evidence or submissions to the contrary, I am of the view that the contested goods and the opponent's *medical apparatus and instruments* and *surgical apparatus and instruments* in class 10 are dissimilar. The same conclusion also applies to the opponent's remaining goods in class 10 and its services in class 44, on the basis that they share no direct similarities with the above contested goods.

Antiseptic cotton; Cotton wool for surgical use; Cotton wool for medical use; Cotton wool for pharmaceutical purposes; Cotton wool for medical purposes; Absorbent cotton wadding; Absorbent cotton; Absorbent cotton wool [for medical purposes]; Cotton for medical use; Absorbent cotton for medical purposes

25. Broadly speaking, the above goods are used in medical settings to, inter alia, clean, pad and cushion wounds, and to absorb bodily fluids. These goods are not present in the opponent's specification. However, I find that they share a degree of similarity with the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments* and *medical apparatus and instruments* in class 10. Whilst it is acknowledged that the contested goods are not *apparatus and instruments* per se, they are a type of medical equipment, which is likely to be used alongside the opponent's stated goods, during surgical procedures and medical treatments, etc. Accordingly, whilst their nature differs, their purpose, users and channels of trade can overlap. Therefore, I consider that the contested goods and the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments* and *medical apparatus and instruments* are similar to a low degree.

26. Likewise, I am of the view that the above finding also applies to the contested Cotton wool swabs for medical use; Medicated swabs; Cotton wool in the form of buds

for medical use; Cotton swabs for medical use; Cotton wool in the form of sticks for medical use; Cotton swabs for medical purposes.

27. These contested goods are used for a variety of medical tasks, such as cleaning wounds, applying ointments and collecting microbiological or DNA samples, etc. Accordingly, whilst the contested goods are not *apparatus* and *instruments* per se, they are a type of medical equipment, which may be used alongside the opponent's stated goods, for example, during surgical procedures and medical treatments, etc. Whilst their nature differs, their purpose, users and channels of trade can overlap. Therefore, I find that the contested goods and the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments* and *medical apparatus and instruments* are similar to a low degree.

### **Class 10 of the contested application**

#### Medical devices

28. Broadly speaking, the contested *medical devices* are instruments and articles intended for a medical purpose, such as preventing, diagnosing, or treating disease or other conditions. They can range from simple items like bandages and wheelchairs to complex technologies, like pacemakers and MRI scanners. As such, I find that the above contested goods fall within the opponent's broad term *medical apparatus and instruments* in class 10. These goods are therefore considered identical according to the principle outlined in *Meric*.

#### Plaster for medical or surgical purposes

29. The contested plaster for medical or surgical purposes is formed from 'Plaster of Paris', being a fine white powder made from heated gypsum that hardens when mixed with water. The contested goods are fundamental in orthopaedics, as plaster is used to create, amongst other things, casts and splints for immobilising fractures, for treating conditions such as club foot and for supporting ligaments, etc. As such, I find that the contested goods fall within the opponent's broad term *orthopaedic articles* in

class 10. These goods are therefore considered identical according to the principle outlined in *Meric*.

#### Sponge cloths for surgical use

30. Broadly speaking, the above sterile goods are a type of medical device used in surgical procedures to, inter alia, absorb fluids, such as blood and other bodily fluids during surgery, to keep a clear and dry surgical area. As such, I find that the above contested goods fall within the opponent's broad term *surgical apparatus and instruments* in class 10. These goods are therefore considered identical according to the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective goods are similar to a high degree, on the basis that the goods are likely to overlap in purpose, can coincide in producers, channels of trade and end users.

#### Medical gloves; Medical gowns; Medical masks

31. The above goods are all attire to be worn during surgery and other medical procedures. I consider that these goods share a degree of similarity with the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments and medical apparatus and instruments*. Whilst it is acknowledged that the contested goods are not apparatus or instruments per se, they are designed for use during veterinary, surgical, dental and medical treatments and procedures. Their purpose differs on the basis that the contested goods are intended to provide sanitary protection to the medical professional or patient during a medical procedure, for example, while the opponent's goods are related to the actual treatments or procedures. However, I find that there will likely be an overlap in users as both are used by medical, surgical, dental and veterinary professionals. The nature differs as the above goods are typically formed of flexible, wearable materials, while the opponent's goods are likely to be devices, tools and machines, etc., most likely manufactured from plastic and metal. However, their trade channels will likely overlap as both may be purchased through specialist wholesalers to dental, medical and veterinary practices and hospitals, etc. The goods are not in competition and whilst the contested goods are likely to be essential to veterinary, surgical, dental and medical treatments and procedures, I do not consider that this would lead consumers

to believe that the same entity is responsible for both, therefore I do not find the goods to be complementary. Overall, I find that the contested goods and the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments and medical apparatus and instruments*, are similar to a low degree.

Sterile sheets, surgical; Anaesthetic drapes; Adhesive drapes for surgical use; Sheets [drapes] for use in surgery; Surgical drapes; Surgical examination drapes

32. Broadly speaking, the above goods are accessories for use during medical or surgical treatments and procedures, to inter alia, create a sterile field during surgery, prevent the spread of germs and maintain sterility around the patient and the surgical site, etc. These goods are considered most similar to the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments and medical apparatus and instruments*. Whilst it is acknowledged that the contested goods are not apparatus and instruments per se, they are intended for use during veterinary, surgical, dental and medical treatments and procedures. The specific purpose of the goods differs, however I find that there is an overlap in their purpose. Their users will also overlap as the goods at issue will all be used by veterinary, surgical, dental, and medical professionals. Additionally, their trade channels can overlap as both the contested goods and the opponent's goods can be purchased through specialist wholesalers to, for example, dental, veterinary and medical practices and hospitals, etc. However, there is no competition or complementarity between the goods. Overall, I find that the contested goods and the opponent's *veterinary apparatus and instruments; surgical apparatus and instruments; dental apparatus and instruments and medical apparatus and instruments*, similar to a low degree.

Compression bandages; Adhesive bandages (Suspensory -); Triangular bandages; Elastic bandages, not for dressings; Elastic compression bandages for surgical purposes; Adhesive bandages (Supportive -); Suspensory bandages; Bandages (Suspensory -); Orthopaedic bandages

33. The above goods are all various forms of bandages, used to, inter alia, provide stability, support, and compression for injuries like fractures and sprains, by restricting movement and managing swelling, etc. As such, bandages are commonly used in orthopaedics as they are a fundamental tool in managing bone, joint and soft tissue injuries. As such, I find that the contested goods all fall within the opponent's broad term *orthopaedic articles* in class 10. These goods are therefore considered identical according to the principle outlined in *Meric*.

34. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail.<sup>8</sup> For ease of reference, the opposition under section 5(2)(b) fails against the following goods:

Class 5        Menstruation bandages; Bandages (Menstruation -).

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

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

36. 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

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<sup>8</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37. The average consumer for the goods at issue is likely to be a professional user from within the healthcare sector, though it is acknowledged that in relation to some of the goods at issue, such as plasters and bandages, etc., the average consumer will also comprise members of the general public. Given the range of goods at issue, the price and frequency of purchase will vary depending on their nature and type. The average consumer is likely to consider various factors when selecting the goods, such as quality, suitability, functionality, compatibility and price. Consequently, given the goods at issue are health related, members of the general public are likely to be paying a higher-than-average degree of attention when purchasing the goods (although, in my view, not the highest). Whereas professional users from within the healthcare sector may pay a high degree of attention given the role the goods are intended to play and that they could directly affect the health or wellbeing of patients.

38. The goods are likely to be selected by eye from the pages of a catalogue or publication in the relevant field, or from the shelves of a pharmacy, for example. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component given that advice may be sought from medical professionals or retail assistants.

### **Comparison of the marks**


39. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

41. The trade marks to be compared are as follows:

<b>The opponent’s mark</b>	<b>The applicant’s mark</b>
	MEDIZ

#### Overall impression

42. The opponent’s mark comprises the word ‘médis’, presented in a blue, bold, standard lowercase typeface. Positioned above the word is a figurative device element featuring a decorative design, presented in the colours blue, white and green. However, I find that the eye is naturally drawn to the element of the mark that can be read, resulting in the word ‘médis’ playing the greater role in the overall impression, with the figurative device playing a slightly lesser role.

43. The applicant’s mark comprises the word ‘MEDIZ’, presented in a standard, uppercase typeface. The overall impression resides in this single element.

### Visual comparison

44. Visually, the marks each contain a five-letter word. The first four letters of the words identically coincide. This similarity appears at the beginning of the respective words, being where consumers tend to focus<sup>9</sup> as this position is generally considered to have more impact due to consumers in the UK reading from left to right. I bear in mind that notional and fair use of the marks would include use in both upper and lower case,<sup>10</sup> so the difference in letter case is irrelevant to the comparison, as is colour.

45. The marks differ in their last letters, being 's' in the opponent's mark, and 'Z' in the applicant's mark; and the figurative device element and diacritical mark (acute accent) placed above the letter 'é' in the opponent's mark, neither of which are replicated in the applicant's mark. With regards to the acute accent present in the earlier mark, I am of the view that this element will be overlooked by at least a significant proportion of the relevant consumers. Whilst the device in the opponent's mark will not be overlooked, as previously stated, I find that the word 'médis' will play the greater role in the overall impression. Consequently, I find that the marks are visually similar to between a medium to high degree.

### Aural comparison

46. The marks identically coincide in the string of letters 'MEDI'. They differ in their last letters 's' and 'Z' respectively. However, I am of the view that due to their positioning in the words, the letters 's' and 'Z' will be phonetically highly similar, if not identical. The device element in the opponent's mark will not be articulated. As for the acute accent present in the opponent's mark, given the relevant UK public, I am of the view that this element will be overlooked. On balance, I find the marks to be aurally highly similar.

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<sup>9</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>10</sup> *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

## Conceptual comparison

47. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

48. I consider it unlikely that the opponent's mark 'médis' and the applicant's mark 'MEDIZ' will convey any conceptual message to the average consumer on the basis that they appear to be invented words, with no clear meaning. The figurative device element in the opponent's mark, will be seen as just that, and therefore, will not, in my view, convey any particular message to the consumer. Overall, I find the conceptual position of the marks to be neutral.

## **Distinctive character of the opponent's mark**

49. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

51. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to the earlier mark. Consequently, I have only the inherent position to consider

52. The earlier mark is a composite mark, comprising the word ‘médís’ along with a figurative device element. The word ‘médís’ appears to be an invented word with no allusive qualities or clear meaning in relation to the goods and services relied upon. With regards to the device element, this is likely to be perceived merely as a decorative element with no obvious meaning in relation to the goods and services at issue. Consequently, I consider the earlier mark to be inherently highly distinctive.

### **Likelihood of confusion**

53. 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 the marks are not the same but puts the similarity that exists between them and the goods being down to the responsible undertaking 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 goods and vice versa. It is necessary for me to keep in mind the distinctive

character of the earlier mark, the average consumer for the goods 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 between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

54. Earlier in the decision I found that:

- The parties' goods and services vary from being identical to dissimilar.
- The average consumer for the goods at issue is a member of the general public or a professional user from within the healthcare sector, who will pay at least a higher-than-average degree of attention during the purchasing process (although for professional users, the level of attention may be high).
- The purchasing process for the goods is predominantly visual, although I do not discount an aural component.
- The marks are visually similar to between a medium and high degree and aurally similar to a high degree. The conceptual position is neutral.
- The earlier mark is inherently distinctive to a high degree.

55. Whilst it is acknowledged that the higher-than-average/high degree of attention paid is a factor in favour of the applicant, this, in my view, is counteracted by the degree of similarity between the marks. Given the visual and aural similarities between the marks this is likely to result in one being mistakenly recalled for the other, particularly when factoring in the principle of imperfect recollection. Whilst I bear in mind that some of the goods are similar to only a low degree, I consider that the effect of the interdependency principle is such that there will still be confusion for these goods. Consequently, I am of the view that there is a likelihood of direct confusion for all goods that I have found to be identical or similar to varying degrees.

## CONCLUSION

56. The opposition under section 5(2)(b) is partially successful. Therefore, the applicant's mark is hereby, subject to any successful appeal of my decision, refused registration for the following goods:

Class 5      Dressings, medical; Medical dressings; Medical and surgical dressings; Medical plasters; Gauze; Gauze for dressings; Gauze compresses; Gauzes for use as dressings; Surgical bandages; Elastic bandages [dressings]; Antiseptic cotton; Bandages for dressings; Compression bandages [dressings]; Ear bandages; Wadding for dressings; Pressure bandages [dressings]; Adhesive bandages for skin wounds; Absorbent cotton wadding; Bandages (Hygienic -);Aseptic cotton; Cotton wool for surgical use; Adhesive dressings; Absorbent cotton; Bandages for skin wounds; Wound dressings; Adhesive dressing strips; Cotton wool swabs for medical use; Surgical dressings; Dressings (Surgical -);Surgical plasters; Medical wound dressings; Absorbent cotton wool [for medical purposes]; Elastic dressings; Medicated swabs; Cotton wool for medical use; Cotton wool for pharmaceutical purposes; Cotton wool for medical purposes; Cotton wool in the form of buds for medical use; Cotton swabs for medical use; Cotton wool in the form of sticks for medical use; Cotton for medical use; Absorbent cotton for medical purposes; Cotton swabs for medical purposes.

Class 10     Medical devices; Medical gloves; Medical gowns; Medical masks; Plaster for medical or surgical purposes; Compression bandages; Adhesive bandages (Suspensory -);Triangular bandages; Elastic bandages, not for dressings; Sterile sheets, surgical; Anaesthetic drapes; Adhesive drapes for surgical use; Sheets [drapes] for use in surgery; Surgical drapes; Elastic compression bandages for surgical purposes; Adhesive bandages (Supportive -); Suspensory bandages; Bandages (Suspensory -); Orthopaedic bandages; Sponge cloths for surgical use; Surgical examination drapes.

57. The applicant's mark can proceed to registration in respect of the following goods for which the opposition has been unsuccessful:

Class 5      Menstruation bandages; Bandages (Menstruation -)

## **COSTS**

58. The opponent has achieved a greater measure of success and is therefore entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice (TPN) 1/2023. In the circumstances, I award the opponent the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a notice of opposition and considering the counterstatement:	£300
Filing written submissions:	£300
<b>Total:</b>	<b>£700</b>

59. I therefore order MGL ASSOCIATES LTD T/A MEDIZ to pay MÉDIS - Companhia Portuguesa De Seguros De Saúde, S.A. the sum of £700. This sum should 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 24<sup>th</sup> day of November 2025**

**Sam Congreve**

**For the Registrar**