

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER 1,351,755 AND 1,353,839 AND THE REQUEST BY OVENTUS MEDICAL LTD TO PROTECT THE MARKS IN THE UNITED KINGDOM

AND IN THE MATTER OF AN APPEAL FROM THE DECISIONS OF HEATHER HARRISON DATED 24 JANUARY 2019 (O/49/19)

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DECISION

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### Introduction

1. This is an appeal from the decision of Ms Heather Harrison, for the Registrar, dated 24 January 2019, in which she dismissed the opposition of O<sub>2</sub> Worldwide Limited to the request of Oventus Medical Ltd for an international trade mark to be protected in the United Kingdom. The opposition was based on ss 5(2)(b) and 5(3) of the Trade Marks Act 1994. O<sub>2</sub> appeals the decision in relation to the section 5(2)(b) ground only.
2. The first international registration (No 1,352,755) is for the mark O2vent and the second international registration (No 1,353,839) is for OVENTUS O2VENT; both registrations cover the following goods in Class 10:

Apparatus for breathing purposes (artificial respiration); apparatus for the alleviation of breathing difficulties; apparatus for the treatment of breathing difficulties; connections for use with breathing apparatus for artificial respiration; inserts for breathing apparatus for medical use; inserts for breathing apparatus for surgical use; inserts for breathing masks for medical use; inserts for breathing masks for surgical use; medical apparatus for assisting breathing; medical apparatus for training breathing techniques; portable breathing apparatus for artificial respiration; protective breathing masks for artificial respiration; protective breathing masks for medical applications; protective breathing masks for surgical applications; protective breathing masks made of non-woven materials for medical applications; protective breathing masks made of non-woven materials for surgical applications; respiratory breathing apparatus, other than for medical use; self-contained breathing apparatus for artificial respiration; surgical breathing masks; ventilator breathing apparatus for artificial respiration; artificial sleep apparatus; continuous positive airway pressure nasal apparatus for the treatment of sleep apnoea; medical masks.
3. The opposition was based on four earlier marks for O2 and O<sub>2</sub> (EUTM 13,108,139; EUTM 9,279,456; EUTM 15,167,307; UK No 2,279,371). Each earlier mark covered goods in a variety of classes.
4. Before the Hearing Officer it was accepted by Mr Stobbs, for the Opponent, that its best case under section 5(2)(b) rested on goods covered by the #307 mark in Class 10 namely “surgical, medical and veterinary apparatus and instruments; parts and fittings for all the aforesaid goods”. The Hearing Officer proceeded on the basis that all the goods covered by the international registrations are identical to goods covered by the #307 mark. This was not disputed on appeal.

## Standard and grounds of appeal

4. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out by in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC and more recently by the Supreme Court in *Actavis Group PTC EHF v ICOS Corporation* [2019] UKSC 15. I will apply these principles.
5. The Appellant, represented by Mr Stobbs, made numerous challenges to the Hearing Officer's decision: first, Mr Stobbs argued that the Hearing Officer wrongly determined the characteristics of average consumer in relation to some of the goods covered by the international registration; secondly, that she improperly assessed the distinctive character of the earlier trade mark; thirdly, that she did not properly conduct the comparison of the earlier trade mark with the international registrations; and finally, that she was wrong in her assessment of the likelihood of confusion. I will address each criticism in turn.

## Average Consumer

6. Mr Stobbs's first ground of appeal was that the Hearing Officer's assessment of the average consumer was flawed because she did not consider all the relevant goods when making her assessment. The Hearing Officer's findings regarding the average consumer are in paragraphs 41 to 43 of her Decision:

41. My view is that the vast majority of the goods at issue are specialist goods which are most likely to be purchased by a professional, whether a medical professional or a procurement professional in the relevant field. I do not consider that any of the goods at issue could properly be described as for mass consumption but I accept that goods specifically for the treatment of sleep apnoea may be both prescribed/purchased by professionals and bought directly by members of the public.

42. The identical goods at issue are concerned with breathing. Given the critical importance of breathing to human life, as well as factors such as sterility, technical adequacy and rates of airflow, combined with the potentially serious consequences of unsatisfactory goods, I consider that all of these goods, irrespective of the consumer group involved, will be purchased with at least a reasonably high degree of attention. In some cases (for example, ventilator breathing apparatus, or artificial sleep apparatus, which strikes me as relating to anaesthesia), a high degree of attention will be employed.

43. The goods at issue are most likely to be purchased following the inspection of catalogues and websites, with the result that the purchase is likely to be dominated by visual considerations. For both groups of consumer, however, there may also be an aural aspect to the purchase, given that discussions with medical professionals or sales representatives may form part of the process.

7. The Appellant concentrated its challenge on two of the goods covered by the international registrations. These are: "continuous positive airway pressure nasal apparatus for the treatment of sleep apnoea"; and "medical masks". Mr Stobbs accepted that some of the other goods would involve the average consumer exercising a high degree of attention or a reasonably high degree of attention to the purchasing decision, but he suggested that in respect of at least these two goods much less attention would be paid by the purchaser. He emphasised that both goods could be bought by members of the public, were relatively

low value and, in the case of medical masks, were disposable. These factors, he submitted, would suggest that the level of attention paid was lower than that attributed by the Hearing Officer.

8. It is clear that “medical mask” includes “surgical masks”, that is, masks worn to protect patients from microorganisms in the surgeon’s breath during medical procedures, and this was the meaning which was given to the term during the hearing before me. I will therefore take the two terms to be synonymous.
9. Like the Hearing Officer, I reject Mr Stobbs’s submission that medical masks are sold for “mass consumption” and that they cost pennies as neither proposition is supported by evidence. However, I do accept that a medical mask is a much cheaper and more routine purchase for a hospital than many of the other goods covered, such as artificial respiration apparatus. I also accept his submission that medical masks and continuous positive airway pressure nasal apparatus for the treatment of sleep apnoea might be bought by members of the public without medical supervision. The Hearing Officer also expressly accepted this second point.
10. Sleep apnoea is a serious, occasionally life-threatening, condition and those seeking to address it, even if they do so without medical supervision, are likely to think carefully about the purchase. Accordingly, it is my view the Hearing Officer was right that a reasonably high degree of attention would be paid to the purchase.
11. The Hearing Officer gave no individual reasoning in relation to medical masks and so it falls to be considered as part of her general comments. When medical or procurement professionals buy medical masks, they are likely to be buying in bulk and each purchase would be made with some degree of circumspection (often involving purchase orders and similar). I accept, however, that in some cases medical masks will be purchased by the general public (when they have a cold for instance) and in such cases the level of attention would be lower. I accordingly accept the Appellant’s submission and find that an average degree of attention would be paid to the purchase of medical masks by the general public.

#### **Distinctiveness of earlier mark**

12. The Hearing Officer found the earlier marks to have a low to fairly low degree of inherent distinctive character when used in relation to the goods in question (Decision, paragraph 50). Her reasoning was set out in paragraph 49:

Taking all of the above into account, it seems to me that “O2” is likely to be taken by the average consumer as highly allusive of a function of the goods, namely the provision of oxygen, and that it therefore has only a low degree of inherent distinctive character. Some of the goods, such as protective breathing masks, may have a weaker connection to the provision of oxygen. However, I consider that the average consumer is likely in those circumstances to perceive the reference to “O2” as suggesting, for example, effective or improved airflow. The distinctiveness of “O2” may be slightly improved in respect of such goods but it remains, in my view, fairly low.

13. Mr Stobbs criticised these findings on the grounds that no explanation was given as to why the use of O2 in relation to some goods would suggest effective or improved airflow. He went on to submit that some of the products, such as medical masks, were intended to

prevent contaminants being breathed in by the user and so it would have been illogical to suggest improved airflow. I do not accept this as medical masks are used mainly to stop micro-organisms getting out (from the doctor to patient) rather than the other way and so improved airflow might be relevant.

14. While the Hearing Officer did not address medical masks specifically, her comments relating to protective breathing masks would extend to other types of protective masks (such as medical masks). It is my view that where a good involves covering the mouth or changing its shape or function then O2 would be allusive to the process of respiration at least to some degree. Accordingly, the Hearing Officer was entitled to make the findings that the use of O2 suggests effective or improved airflow and I dismiss this ground of appeal.

### **Similarity of marks**

15. The Appellant's next criticism of the Hearing Officer related to her assessment of the similarity of the marks. Mr Stobbs, both before the Hearing Officer and before me, suggested that the word "vent" is non-distinctive or descriptive as it means "an opening that allows air, gas, or liquid to pass out of or into a confined space".
16. The Hearing Officer's conclusion on this issue was set out in paragraph 59 when she said: "I accept that the word "vent" has little distinctiveness in relation to the goods at issue."
17. The Appellant says that as "vent" is a characteristic of the goods she must have gone further and found this element to be entirely descriptive. This argument was one limb of a two-part argument. The second limb was that it would be wrong to attribute O2 the same level of distinctiveness as "vent" (due to its descriptive nature) and so O2 would be the dominant element of the marks in issue.
18. While Mr Stobbs made various submissions regarding why "vent" was a characteristic of the goods, I do not believe any of them really assisted him. If his submission was right and the term "vent" is being used descriptively, then it is describing a vent for the flow of air and/or oxygen. Therefore, as "vent" becomes more descriptive in the mark "O2vent" so does O2. In the circumstances, while my reasoning might be slightly different, I agree with the conclusion of the Hearing Officer in paragraph 59:

I accept that the word "vent" has little distinctiveness in relation to the goods at issue. However, it will be apparent from my consideration of the earlier marks' distinctive character that I do not consider "O2" particularly distinctive either. In my view, any distinctiveness which "O2" might have is weakened when it appears in the combination "O2vent". Neither "O2" nor "vent" is materially more dominant in the overall impression than the other. The mark is most likely to be viewed as an invented whole, with its distinctiveness in that whole rather than its (at best) weakly distinctive parts, though I accept that the consumer will identify both elements.

19. The Appellant also made a subsidiary point in relation to the similarity of the marks, namely that the visual comparison of O2 and O2vent should be the same as that of O2 and O2vent. The former was found to be visually similar to a fairly low degree and the latter to a medium degree. This submission was largely predicated on the Hearing Officer's earlier finding that the distinction between O2 and O2 for consumers of relevant goods

would be narrow, and in both cases consumers would make the connection between O2 and oxygen (Decision, paragraph 50). This argument is fundamentally flawed. The discussion of O2 in the earlier paragraph related to the meaning of the word and not its visual representation. It would be quite wrong for the Hearing Officer to make a *visual* comparison of the mark O<sub>2</sub> in the form O2 (matters may be different for aural and conceptual similarity of course). Therefore, I do not need to consider this point further.

### **Likelihood of confusion**

20. The Appellant's final challenge to the Hearing Officer's decision was that she did not properly consider the likelihood of confusion. Mr Stobbs made two points as to why the Hearing Officer's assessment was wrong. I will address each in turn.
21. First, Mr Stobbs submitted that the Hearing Officer did not place enough weight on the identity of the goods and the degree of similarity of the marks. This criticism was based on the opening part of paragraph 67 of the Decision:

In terms of potential confusion between the earlier "O2" mark and the contested "O2vent" (the most similar of the marks and the strongest position for the opponent), even for those consumers who will pay no more than a reasonably high level of attention and proceeding, as I have, on the basis of identical goods, I do not consider that there is a likelihood of confusion. Notwithstanding the weak distinctive character of the word "vent", the visual and aural differences created by its presence in the mark and the conceptual meaning attributable to the mark as a whole are sufficient to avoid the mark being misremembered or otherwise directly confused with the earlier mark, even bearing in mind the effects of imperfect recollection.

22. At the end of this passage there was the following footnote:

Small differences have been held to be sufficient to distinguish marks of low distinctiveness on a number of occasions. See, for example, *Envirotecnic v Gutterclear UK Limited*, [2015] EWHC 3450 (Ch) and *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch).

23. Mr Stobbs submits that the cases cited by the Hearing Officer suggest this passage is essentially saying that "O2" is not distinctive and the slight difference of adding "vent" to the end of the mark is sufficient. The cases cited, he went on to submit, involved purely descriptive elements being common to the respective marks and other differences avoiding any likelihood of confusion. Thus, he submitted, the Hearing Officer must have assessed that O2 has a low distinctive character.
24. This submission is quite confusing taken on its own, but it was based on other aspects of the appeal being found in the Appellant's favour. In any event, the Hearing Officer did assess O2 as having a low to fairly low distinctive character and said as much (Decision, paragraph 50). Furthermore, in the composite mark O2vent she said that O2's distinctiveness had weakened (Decision, paragraph 59). Accordingly, her conclusions are entirely consistent, and so I reject the criticisms of Mr Stobbs.
25. The general criticisms the Appellant made regarding the weight given to certain factors are challenges to value judgments made by the Hearing Officer. In other words, they represent an attempt to have a rehearing of the issue. An appeal is a review and not a rehearing, and so I need not consider them further.

26. Secondly, it was suggested that the Hearing Officer improperly determined that O2 did not have independent distinctive character in the mark O2vent (Decision, paragraph 67). This argument was based on a claim that the Hearing Officer had earlier said consumers would identify both elements of O2vent independently. The relevant statement by the Hearing Officer is in paragraph 59:

The mark is most likely to be viewed as an invented whole, with its distinctiveness in that whole rather than its (at best) weakly distinctive parts, though I accept that the consumer will identify both elements.

27. The Appellant has simply selected the words in that sentence which support its position, namely “identify both elements” and ignored the rest of the sentence. A mark which is viewed as an “invented whole” indicates that neither element has independent distinctive character. Accordingly, the Hearing Officer’s findings are entirely consistent, and I reject the Appellant’s contrary position.
28. Finally, I have found that the Hearing Officer wrongly considered “medical masks” to be purchased by the general public with a reasonably high level of attention. The question arises, therefore, whether the relevant public paying an average level of attention would be confused where one paying a reasonably high level of attention would not. After considering the matter, I do not believe that paying slightly less attention to the purchase would make a sufficient difference to outweigh the other factors identified by the Hearing Officer so as to create a likelihood of confusion. Therefore, the opposition still fails in relation to “medical masks”.

### **Conclusion**

29. I therefore dismiss the appeal and uphold the Hearing Officer’s decision that the opposition should be dismissed in its entirety.
30. As ultimately the Respondent was successful, I order that the Appellant pay the Respondent a contribution of £1,000 towards the costs of the appeal within fourteen days of the date of the order.

PHILLIP JOHNSON  
APPOINTED PERSON  
11 JULY 2019

Representation:

Appellant: Julius Stobbs of Stobbs IP

Respondent: Lee Curtis of HGF