

O/0671/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO.

WO0000001661102

IN THE NAME OF:

BIOIBERICA, S.A.U.

FOR THE TRADE MARK:

DAOgest

IN CLASSES 1 AND 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 435427

BY: STADA ARZNEIMITTEL AG

Background and pleadings

1. On 18 March 2022, BIOIBERICA, S.A.U. designated the International Registration (“IR”) shown on the front cover of this decision for protection in the United Kingdom. The designation was accepted and published on 3 June 2022. Protection is sought for the following goods:

Class 1: Chemical products for the pharmaceutical, nutraceutical, food and cosmetic industry; biological preparations for the pharmaceutical, nutraceutical, food and cosmetic industry; ingredients based on diamine oxidase for use in the manufacture of dietetic and functional foods, nutraceuticals, nutritional and food supplements and pharmaceutical products for medical and veterinary use, as well as cosmetic products.

Class 5: Pharmaceutical products, preparations for medical and veterinary use; hygienic and sanitary products for medical use; dietetic food and substances for medical or veterinary use, food for babies; food supplements for persons or animals; disinfectants; products based on diamine oxidase for use in pharmaceuticals, dietetic and functional foods, nutraceutical foods and nutritional and food supplements.

2. On 8 August 2022, STADA Arzneimittel AG opposed the designation on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK trade mark number 906385355 for the mark DAOSIN, which was filed on 23 October 2007 and registered on 29 September 2008.¹ The opponent relies upon all goods for which the mark is registered, namely *Dietetic substances for medical use* in class 5.

¹ The earlier mark was initially registered at the European Union Intellectual Property Office (EUIPO). The opponent’s mark is a comparable mark based on the opponent’s pre-existing EUTM, being EUTM 6385355. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

3. The opponent claims that the marks are highly similar and that the respective goods are either identical or highly similar, with the result that there is a likelihood of confusion.

4. The holder filed a counterstatement admitting that the goods “*dietetic substances for medical use*” are identical but denying that the remaining goods are similar and denying that the marks are similar; therefore, it denies any likelihood of confusion. The holder also put the opponent to proof of use in respect of its earlier mark.

5. The opponent is represented by Potter Clarkson LLP and the holder is represented by WP Thompson.²

6. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Both parties filed submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following careful consideration of all the papers.

7. 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.

EVIDENCE

8. The opponent’s evidence in chief was filed in the form of a witness statement dated 20 June 2023 from Vanessa Maniura, the Manager of Trade Marks of the opponent’s company. The witness statement included seven exhibits. The purpose of

² The holder was previously represented by Bout Wade Tennant LLP, however, they appointed WP Thompson as their new representative on 20 November 2023.

the evidence is to demonstrate that the earlier mark has been put to genuine use for the goods on which the opponent relies.

9. The holder's evidence was filed in the form of a witness statement dated 21 August 2023 from Ai Ling Lim-Lee, a chartered trade mark attorney at Boulton Wade Tennant LLP, the holder's previous representatives. The witness statement included two exhibits. The evidence includes printouts of online searches in connection with the words "dao" and "diamine oxidase" and an online journal article from "Food Science and Biotechnology".

10. The opponent's evidence in reply came in the form of a witness statement dated 12 October 2023 from Vanessa Maniura. The witness statement included four exhibits. The evidence is in response to Ai Ling Lim-Lee's witness statement.

11. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

13. The trade mark relied upon by the opponent qualifies as an earlier trade mark pursuant to section 6 of the Act. As the mark had completed its registration process more than 5 years prior to the filing date of the mark at issue, it is consequently subject to proof of use pursuant to section 6A of the Act.

Proof of use

14. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the goods relied upon.

15. The relevant statutory provisions are set out in Section 6A of the Act, which 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.”

16. 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”.

17. Section 100 is also relevant, which reads:

“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.”

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application at issue i.e **19 March 2017 to 18 March 2022**.

Relevant case law

19. 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 Bunderversammlung 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].”

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Genuine use

21. I take the following from the opponent’s evidence:

- The opponent’s company is a pharmaceutical company dedicated to the production of generic, specialty pharma and non-prescription healthcare products.³
- Packaging and information leaflets for Daosin products are provided in exhibit VM2 and include the following:



³ Paragraph 6 of the first witness statement of Vanessa Maniura



- I note that neither the packaging nor the leaflets provided in VM2 are in the English language however, the Daosin mark is displayed clearly. I further note in exhibit VM11, a website called “Pharmacyclub” describes Daosin as “...a food supplement used for the dietary management of DAO deficiency (histamine intolerance).”
- The opponent claims that their Daosin products are sold in numerous European countries including; Austria, Belgium, Bulgaria, Croatia, Czech Republic, Finland, Germany, Hungary, Italy, Lithuania, Netherlands, Romania, Slovakia, Slovenia and Spain. In exhibit VM3, the opponent has provided screenshots of their Daosin products available for sale on websites in these countries all dated within the relevant period (and before the date of IP Completion).⁴
- The opponent’s company has had an annual turnover of over EUR 4,000,000 in the European Union (excluding the UK) between 2016-2019 and a turnover of over EUR 5,000,000 in 2020.⁵ However, it is not specified what proportion of these figures relate sales of Daosin products.
- The number of sales of Daosin branded products in the UK during the relevant period are as follows:

⁴ Paragraph 8 of the first witness statement of Vanessa Maniura

⁵ Paragraph 9 of the first witness statement of Vanessa Maniura

Year	Sales (In excess of)
2017	50,000
2018	67,000
2019	78,000
2020	102,000
2021	7,000
Total	304,000

- To support these claims, a sample of invoices displaying the Daosin mark have been provided at exhibit VM4. The invoices are of sales to various distributors in Germany and dated between 2019 and 2020.
- Further invoices have been provided in exhibit VM9 regarding sales of Daosin branded products sold to UK distributors. The invoices are dated within the relevant period and addressed to distributors in Bristol, Gloucester and Devon.
- The opponent claims that they advertise their products through social media platforms such as Instagram and YouTube and provides extracts showing Daosin products being promoted on these platforms within the relevant period.
- The opponent has also provided the following figures in respect of advertising expenditure in Germany:

Year	Expenditure (EUR)
2017	412,118
2018	381,938
2019	305,380
2020	145,447

22. In its submissions, the holder made several criticisms of the opponent's evidence. These included:

- Exhibit VM1 containing general information on the opponent's company and no evidence of commercial use of the opponent's mark.
- Exhibit VM2 and VM3 comprising of untranslated material making it impossible to ascertain the nature and purpose of any goods produced by the opponent.
- Exhibit VM4 containing invoices from an extremely short time span, relating to only one EU country, demonstrating an insubstantial volume of sales and no evidence of UK sales. (I note here that the opponent provided invoices demonstrating sales made in the UK in their evidence in reply).
- Exhibit VM5 containing untranslated and undated evidence.
- Exhibit VM6 relating solely to dietary supplements for the reduction of histamine and not demonstrating use across the breadth of the opponent's goods.
- Exhibit VM7 not demonstrating use during the relevant period.

23. Whilst I note these criticisms, I keep in mind that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.⁶ In assessing whether genuine use has been made of the earlier mark, I am not making a judgment about the commercial success of the mark in relation to the goods for which it is registered. It depends upon a variety of factors, including the nature of the goods and the characteristics of the market; the consistency of sales over time and whether the use is warranted to create or maintain a share in that market.

24. The opponent's evidence is not without its shortcomings, however, I have no reason to dispute the sales figures and advertising expenditure put forward by the opponent. Whilst I note that the holder comments upon the level of sales made by the opponent, it does not seek to challenge these figures. Considering the sum of the evidence, including invoices and sales figures during the relevant period and the use of the mark shown on various websites and social media platforms, I find that the use made by the opponent is more than merely token and is clearly an attempt to create or maintain a market for the goods relied upon in the UK (or a member state of the

⁶ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T-415/09

EU prior to IP Completion Day). Accordingly, I conclude that the evidence before me establishes that there has been genuine use of the mark at issue during the relevant period.

Fair Specification

25. I must now consider the extent to which the evidence shows use of the earlier mark in relation to the goods relied upon. As for devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,⁷ Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

26. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“*Thomas Pink*”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

⁷ BL O/345/10

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

27. In their submissions, the holder claims that the evidence relates solely for dietary supplements for the reduction of histamine.⁸ I keep in mind that the opponent does not have to show use in respect of all terms relied upon and I do not wish to constrict the opponent's specification too narrowly. I am of the view that the average consumer would describe the opponent's goods as a dietary supplement which is akin

⁸ Paragraph 7(g) of the holder's submissions

to *Dietetic substances for medical use*. The opponent can therefore rely upon its specification as originally worded.

Section 5(2)(b) - Case law

28. The following principles are gleaned from the decisions of the courts of the *European Union 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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.*

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

29. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

30. Guidance on this issue has also 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

31. In *Les Éditions Albert René v OHIM*, Case T-336/03, the General Court (“GC”) found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

32. The goods to be compared are as follows:

Opponent's goods	Holder's goods
<p>Class 5: Dietetic substances for medical use.</p>	<p>Class 1: Chemical products for the pharmaceutical, nutraceutical, food and cosmetic industry; biological preparations for the pharmaceutical, nutraceutical, food and cosmetic industry; ingredients based on diamine oxidase for use in the manufacture of dietetic and functional foods, nutraceuticals, nutritional and food supplements and pharmaceutical products for medical and veterinary use, as well as cosmetic products.</p> <p>Class 5: Pharmaceutical products, preparations for medical and veterinary use; hygienic and sanitary products for medical use; dietetic food and substances for medical or veterinary use, food for babies; food supplements for persons or animals; disinfectants; products based on diamine oxidase for use in pharmaceuticals, dietetic and functional foods, nutraceutical foods and nutritional and food supplements.</p>

Class 1

Chemical products for the pharmaceutical, nutraceutical, food and cosmetic industry; biological preparations for the pharmaceutical, nutraceutical, food and cosmetic industry; ingredients based on diamine oxidase for use in the manufacture of dietetic

and functional foods, nutraceuticals, nutritional and food supplements and pharmaceutical products for medical and veterinary use, as well as cosmetic products.

33. The Nice Classification Guide explanatory note describes goods in class 1 as “mainly chemical products for use in industry, science and agriculture, including those which go to the making of products belonging to other classes.”⁹ With this in mind, I take the holder’s class 1 goods to be chemical products, preparations and ingredients that are used for the manufacturing of other products such as pharmaceutical goods. The nature of the respective goods differ; the holder’s goods are ingredients to make products such as dietary supplements whereas the opponent’s *dietetic substances for medical use* are a finished product. The respective goods differ in purpose and method of use; the holder’s goods are to be used in combination with other ingredients in order to make a different product whereas the opponent’s goods are dietetic substances that are consumed in order to help with a particular medical condition. I consider that users of the holder’s goods would be professional users such as pharmaceutical manufacturing companies whereas users of the opponent’s goods would comprise members of the general public or healthcare professionals. The respective goods would reach the market via different trade channels. Further, I do not consider that the goods have a competitive relationship. There is an important relationship between the goods insofar as one could be used in the production of the other, however, I do not consider that this relationship would be to the extent that consumers would believe that they are derived from the same undertaking.¹⁰ As such, the goods are not complementary. Weighing up these factors and in line with the reasoning outlined above in *Les Éditions Albert René*, I do not consider there to be any similarity between these goods.

Class 5

Pharmaceutical products, preparations for medical and veterinary use.

⁹ [Nice Classification \(wipo.int\)](http://wipo.int)

¹⁰ See *Boston Scientific Ltd v OHIM*, Case T-325/06

34. I consider the above term would encompass the opponent's *Dietetic substances for medical use*. As such, these terms are identical on the principle outlined in *Meric*.

Dietetic food and substances for medical or veterinary use, food for babies; food supplements for persons or animals; products based on diamine oxidase for use in pharmaceuticals, dietetic and functional foods, nutraceutical foods and nutritional and food supplements.

35. The opponent's term *Dietetic substances for medical use* would encompass the above goods. They are therefore identical in line with *Meric*.

Hygienic and sanitary products for medical use; disinfectants.

36. The above goods are all means of sanitising medical equipment, surfaces or the body. They therefore differ in terms of nature, purpose and method of use compared to the opponent's *Dietetic substances for medical use*. The respective goods are not in any competition, nor do they possess a complementary relationship. There could be an overlap in users and trade channels, however, I do not consider that this would be sufficient to warrant a finding of similarity. As such, I find these goods to be dissimilar.

37. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against the goods of the application that I have found to be dissimilar.¹¹ For the avoidance of doubt, the remainder of my decision will focus upon the following goods of the IR:

Pharmaceutical products, preparations for medical and veterinary use; dietetic food and substances for medical or veterinary use, food for babies; food supplements for persons or animals; products based on diamine oxidase for

¹¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

use in pharmaceuticals, dietetic and functional foods, nutraceutical foods and nutritional and food supplements.

The average consumer and the purchasing act

38. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

39. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

40. The opponent submits that the relevant consumer for the goods at issue are the public at large. Given the nature of the goods, they state that the degree of attention may vary from medium to high, however, the assessment of a likelihood of confusion must be carried out from the perspective of the relevant consumer displaying the lowest degree of attention (medium, in this case).¹² The holder has not made any submissions regarding the average consumer.

¹² Paragraph 17 of the opponent's submissions in lieu

41. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, the GC considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 [...]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision –

which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness.”

42. I am of the view that the average consumer for the goods will comprise medical professionals and the general public. For members of the general public, they are likely to be concerned with their own personal wellbeing, whereas medical professionals will be concerned with the wellbeing of the patient. The frequency at which the goods are purchased will vary, depending on whether they are required for occasional use or as part of ongoing treatment. The goods are likely to vary in price depending on their nature, but the price is not likely to be at the highest end of the spectrum. Overall, I find that both consumer groups would pay a higher than average degree of attention in the selection process, considering factors such as quality, suitability, effectiveness, and possible side effects.

43. The purchasing process for the goods and services is likely to involve perusal of goods on shelves or perusal of a website. Consequently, visual considerations are likely to dominate the purchasing process. However, given that requests may be made over the counter, and consumers may have discussions with healthcare professionals or seek advice from retail assistants, I do not discount that aural considerations will also play a part.

Comparison of trade marks

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

46. The respective trade marks are shown below:

Opponent's mark	IR holder's mark
DAOSIN	DAO gest

47. The opponent's mark is in word-only format and consists of the word "DAOSIN". As there are no other components, the overall impression of the mark resides in the word itself.

48. The holder's mark consists of the word "DAOgest". The first three letters "DAO" are presented in a bold, upper-case typeface, and the remaining four letters "gest" are presented in a lower-case typeface. The overall impression lies in the word "DAOgest".

49. Visually, the marks overlap in the first three letters "DAO". I keep in mind that, generally, the beginnings of marks typically have more of an impact on consumers (than their endings).¹³ Given that the opponent's mark could be used in any font or colour, I do not consider that the differences in upper/lower case makes any

¹³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

meaningful difference. There is a point of difference in the end of the respective marks- “SIN” at the end of the opponent’s mark and “gest” in the holder’s mark. On balance, I consider that this results in a medium degree of similarity.

50. It is likely that the opponent’s mark will be pronounced in two syllables as “DAO” (as in “cow”) and “SIN”. The holder’s mark will also likely be pronounced in two syllables as “DAO” (as in “cow”) and “GEST” or “JEST”. The first syllable in the respective marks will therefore be pronounced identically, however, the second syllables are different. Overall, I consider there to be a medium degree of aural similarity.

51. 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] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

52. The holder contests that the common element “DAO” will be understood as an abbreviation of “Diamine Oxidase” amongst relevant consumers. In support of this, they have provided extracts from online pharmaceutical articles and scientific journals that use the term “Diamine Oxidase” followed by its abbreviation “DAO”.¹⁴

53. The opponent disagrees with this assertion and has provided internet search engine results of the term “DAO” to demonstrate that this term alone is recognised to be an acronym for “decentralised autonomous organisation” or a Chinese philosophy.¹⁵

54. I do not discount that fact that the term “DAO” is used as an abbreviation for “Diamine Oxidase”, however, there is no evidence before me to demonstrate the reach of the articles that the holder has evidenced nor is there any evidence to show that this term is widely known to end users being the general public. Whilst some medical professionals may understand that “DAO” is an abbreviation of “Diamine Oxidase”, I do not find that this would be the case for the general public. For the opponent’s suggestions, no evidence has been provided to establish that relevant consumers

¹⁴ Exhibits AL01 and AL02 of the witness statement of Ai Ling Lim-Lee

¹⁵ Paragraph 5 of the second witness statement of Vanessa Maniura and exhibit VM8

would understand “DAO” as an acronym for “decentralised autonomous organisation” or a Chinese philosophy; internet search results do not have much probative value on their own. I consider that both marks as a whole will be perceived as coined terms without any conceptual meaning rendering the marks conceptually neutral.

55. For the avoidance of doubt, I intend to proceed with the rest of my decision on the basis that a significant proportion of consumers would not understand the term “DAO” as having any conceptual meaning.

Distinctive character of the earlier mark

56. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

57. 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. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

58. I will begin by initially assessing the inherent distinctiveness of the opponent's mark.

59. As previously outlined in the conceptual comparison, the earlier mark will not convey any meaning to a significant proportion of average consumers and therefore the mark does not describe or allude to the goods which are relied upon in the opposition. I find the opponent's mark to be inherently distinctive to a high degree.

60. I will now consider whether the evidence filed by the opponent demonstrates that the distinctiveness of the earlier mark has been enhanced through use. I rely on the summary of the opponent's evidence that I provided in paragraph 21 earlier in this decision. The relevant date for this assessment is the designation date of the IR being 18 March 2022 and the relevant market for assessing enhanced distinctiveness is the UK market.

61. I note from the opponent's evidence that it sold a total of 304,000 Daosin branded products in the UK between the years 2017 to 2021. The supporting invoices provided are addressed to distributors in Bristol, Gloucester and Devon.

62. Clearly, the opponent has made sales in the UK market. However, they are not particularly extensive when considering the likely size of the UK market in relation to *Dietetic substances for medical use*. I have no information about the advertising expenditure in the UK or any activities taken to promote the opponent's goods in this jurisdiction. Instead, the promotional activities and advertising expenditure for the opponent's goods only appear to be in relation to the German market. Whilst I found the opponent's evidence sufficient to show genuine use, I remind myself that the bar for proving enhanced distinctiveness is considerably higher. This is because it requires

a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the goods as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for goods under the mark. Taking into account all the evidence, I am not satisfied that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of confusion

63. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

65. Earlier in this decision I concluded that the competing goods are identical. I concluded that the average consumer would comprise medical professionals and members of the general public. I found that both consumer groups would pay a higher than average degree of attention during the purchasing process. I found that the goods would be selected primarily by visual means, although I did not discount an aural aspect to the purchasing process. I found the respective marks to be visually and aurally similar to a medium degree. I concluded that the marks were conceptually neutral. I found the earlier mark to be inherently distinctive to a high degree but the level of distinctiveness has not been enhanced through use.

66. In respect of a likelihood of confusion, I am guided by the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41,

wherein Kitchin LJ concluded that if a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement. While this case was an infringement case, the principles apply equally to oppositions under section 5(2) of the Act. As previously outlined, I will focus my assessment of a likelihood of confusion on the significant proportion of consumers who do not understand “DAO” as having any conceptual meaning. It follows that if there is a likelihood of confusion amongst this significant proportion of consumers, it is sufficient for the opposition against the application to succeed.

67. I have taken all of the relevant factors into consideration in reaching my decision and I am of the view that there is a likelihood of direct confusion. This is due to the earlier mark possessing a high degree of inherent distinctiveness, the respective marks being visually and aurally similar to a medium degree and the goods at issue being identical. I find that the first three letters of the marks are likely to stick in the mind of the average consumer and when factoring in imperfect recollection, they may overlook the differing endings. As previously outlined in this decision, as a general rule, the beginning of marks tend to have more of an impact than their endings. Further, I remind myself that I found the marks to be conceptually neutral so neither mark has a meaning which could help consumers differentiate between them. I recognise that the average consumer will in many cases be paying a higher than average level of attention and that this may point away from direct confusion. However, it is important to remember that the average consumer for medical goods includes members of the general public. Whilst they will be paying a higher level of attention, they will be far less familiar with the names of pharmaceutical products than professional users and, consequently, it is likely that they may mistakenly recall the endings of names that are otherwise so similar.

Conclusion

68. The opposition under section 5(2)(b) of the Act has been partially successful. Subject to any successful appeal, protection of the IR may be granted in the UK for the following goods:

Class 1: Chemical products for the pharmaceutical, nutraceutical, food and cosmetic industry; biological preparations for the pharmaceutical, nutraceutical, food and cosmetic industry; ingredients based on diamine oxidase for use in the manufacture of dietetic and functional foods, nutraceuticals, nutritional and food supplements and pharmaceutical products for medical and veterinary use, as well as cosmetic products.

Class 5: Hygienic and sanitary products for medical use; disinfectants.

69. Subject to any successful appeal, the IR will be refused protection in the UK for the following goods:

Class 5: Pharmaceutical products, preparations for medical and veterinary use; Dietetic food and substances for medical or veterinary use, food for babies; food supplements for persons or animals; products based on diamine oxidase for use in pharmaceuticals, dietetic and functional foods, nutraceutical foods and nutritional and food supplements.

Costs

70. Both parties have enjoyed a share of success. As both parties have achieved what I consider as a roughly equal measure of success, I direct that each party should bear their own costs.

Dated this 16th day of July 2024

Catrin Williams
For the Registrar