O/0695/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001728476 IN THE NAME OF
NANJING GENSCRIPT BIOTECH CO., LTD.
FOR THE FOLOWING TRADE MARK:

GenTitan

IN CLASS 42

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 443497 BY
AFFYMETRIX, INC.

BACKGROUND AND PLEADINGS

1. NANJING GENSCRIPT BIOTECH CO., LTD. ("the holder") is the holder of the International Registration ("the IR") shown on the cover page of this decision. The IR was registered on 15 March 2023 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 11 August 2023. The holder seeks protection in the UK for the following services:

Class 42:	Technological research; research and development of new products for others; scientific laboratory services; clinical trials; structural and functional analysis of genomes; medical research; medical laboratory services; stem cell research services; research and development services in the field of antibodies; research in the field of physics; biological research and analysis; bacteriological research and analysis; genetic testing for scientific research purposes; biotechnology research; testing of pharmaceuticals; DNA screening for scientific research purposes; biomedical research services; biological cloning services.

2. The IR derives from an earlier Chinese trade mark which was filed on 7 March 2023. As a result, the IR benefits from that date as the priority date in these proceedings.

3. On 9 October 2023, the IR was opposed by Affymetrix, Inc ("the opponent"). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following mark:

GENETITAN
UK registration no. 914182216

Filing date 29 May 2015; registration date 24 September 2015
Relying on all goods, namely:

Class 9: Laboratory equipment for genetic and genomic analysis.
("the opponent's mark").

4. The opponent's mark is a comparable mark based on an earlier EUTM. 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 existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

5. The opponent's position under its section 5(2)(b) ground is that the marks are near identical, differing in only one letter. Further, it is claimed that the goods and services at issue are similar to a high (or at least a medium) degree. As such, the opponent claims that there exists a likelihood of confusion on the part of the public, either directly or indirectly.

6. Under the section 5(3) ground, the opponent claims that its mark enjoys a reputation and, as a result of the high degree of similarity between the marks and the goods and services, the relevant public will establish a link between them. As a result of this link, the opponent's position is that use of the IR would result in the holder gaining an unfair advantage due to the power of attraction associated with the opponent's mark. Further, it is claimed that use of the IR would cause detriment to the reputation and distinctive character of the opponent's mark.

7. The holder filed a counterstatement wherein it denied the claims against it and made a request that the opponent provide proof of use for its mark.

8. The opponent is represented by HGF Limited and the holder is represented by Murgitroyd & Company. Only the opponent filed evidence in chief. No hearing was

requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

9. 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

10. The opponent's evidence in chief came in the form of the witness statement of Kenya Williams. The evidence is undated but I note that it was filed on 3 June 2024. Ms Williams is the Director, Trademark & Copyright Counsel of Thermo Fisher Scientific, Inc ("Thermo") being a position she had held for over three years prior to the witness statement being filed. The evidence confirms that Thermo acquired the opponent in 2016.[1] The opponent is, therefore, a subsidiary of Thermo meaning that Ms Williams is duly authorised to file evidence on the opponent's behalf. Lastly, I note that Ms Williams's evidence is accompanied by 22 exhibits and was adduced in order to prove genuine use and a reputation in the opponent's mark.

11. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

[1] Exhibit 1

DECISION

Proof of use

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> > (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
> >
> > (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;
> >
> > (ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.
> >
> > […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

13. Section 6A is also relevant. It reads:

"(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."

14. Section 100 of the Act is also relevant. It reads:

"100. 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."

15. As the opponent's 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".

16. Given its filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark completed its registration process over five years prior to the priority date of the IR. As set out above, the holder requested that the opponent provide proof of use in respect of its mark. As a result, the opponent's mark is subject to the proof of use assessment.

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

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax*

Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at

[70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

18. While section 6A of the Act (cited above) is silent on the issue of IRs, the Trade Marks (International Registration) Order 2008 sets out that this section of the Act extends to apply to IRs. As such, the relevant period for the present assessment is the five-year period prior to the priority date of the IR, being 7 March 2023. The relevant period is, therefore, 8 March 2018 to 7 March 2023 ("the relevant period").

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[2] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

Evidence of use

20. Firstly, I will say that having considered the evidence in full, I note that it is very technical in nature as the goods for which the opponent has sought to demonstrate use relate to complex scientific/medical machinery. As such, there is a wide range

[2] *Jumpman* BL O/222/16

of content across the evidence that I have not been able to understand because (1) it is not accompanied with any explanation as to what it means in plain terms and (2) I am by no means an expert in the field of medical research. That being said, this does not mean that the evidence cannot be of any assistance and I simply raise the point here because the technical nature of the evidence has rendered it somewhat difficult to summarise the evidence in full. As a result, I will only aim to summarise the evidence insofar as I deem it necessary.

21. The evidence begins with a discussion surrounding the acquisition of the opponent by Thermo. On this point, and given the relationship between Thermo and the opponent, I accept that insofar as any of the use provided in evidence is by Thermo, it can be taken as use with the opponent's consent. For the avoidance of doubt, where this is the case, I will simply refer to the use as still being use by the opponent.

22. The narrative evidence sets out that the opponent has been around for over 30 years, is a leader in the biotechnology field and is considered a "leading provider of microarray-based products and services for the global industry".[3] A printout taken from the website of the International Society of Genetic Genealogy Wiki is provided which confirms that the company was founded in 1992.[4] The narrative evidence claims that these vague statements mean that the opponent is considered well-known in the industry. While that may very well be the case, I note that this evidence speaks to the actual company as a whole and not the 'GENETITAN' branding. On this point, I note that the Wiki printout makes reference to "GeneChips", not "GENETITAN" so I fail to see its relevance to the present case.

[3] See paragraph 2 of Ms Williams's statement
[4] Exhibit 2

23. In support of the above, the opponent refers to an article from ‘thepharmaletter’, which is a UK website.[5] This website states that the opponent is a global leader in its industry but, again, there is no reference to the ‘GENETITAN’ branding.

24. In terms of actual use of the ‘GENETITAN’ brand, the opponent sets out that it is used in relation to a “scanner and fluidics station that integrates hybridization, washing and imaging in a single instrument to provide automated array processing.”[6] The evidence confirms that the mark was first used in 2007 and has been used continuously since then. A data sheet for this product is provided in evidence and the narrative evidence confirms that it has been available online since 2010.[7]

25. A brochure is provided that the narrative evidence confirms as being one that covers the details of the opponent’s field of interest.[8] This brochure is confirmed as being launched on 30 January 2023, which is at the very end of the relevant period. From looking through the document, it appears that the opponent’s focus is on genomes, genotyping and DNA. Further, there is reference to the same array processing unit that is shown in the evidence discussed in the preceding paragraph. Lastly, it is noted that as well as reference to ‘GENETITAN’, there are numerous other brands discussed such as Savant, SpeedVac, Ion Torrent Genexus, Multidrop, Multiscan, Axiom myDesign, CarrierScan and PharmoScan.

26. In respect of advertising, the opponent has provided a spreadsheet that details the advertising budgets for brochures that it planned to launch via LinkedIn and Facebook.[9] The spreadsheet lists the budget in dollars and there is nothing to suggest (1) whether it was aimed at consumers in the relevant territory and (2), even if it was, how many people viewed this brochure once launched. In addition,

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[5] Exhibit 3
[6] See paragraph 4 of Ms Williams’s statement
[7] Exhibit 4
[8] Exhibit 5
[9] Exhibit 6

the budget is meant to cover a specific period, which is set out as being "2/1/23 to 3/12/23". Given that the budget is in dollars, I take this to be an American presentation of the dates and, as such, find that it covers the period of 1 February 2023 to 12 March 2023. Firstly, this covers a very short period of time and, secondly, it covers a period that sits at the very end of the relevant period and even exceeds it by a number of days.

27. A leaflet is provided that contains a QR code on it which is stated as being a code that users can scan to learn more about the GENETITAN instrument.[10] The evidence then goes on to discuss a brochure from 2017.[11] While noted, it is from prior to the relevant period and, in any event, it does not particularly offer anything beyond the brochures I have already discussed above. Discussed next is a printout from the opponent's website where consumers can apparently find the 'GENETITAN' product and enquire about it.[12] While all of this is noted, it is of no real assistance to the issue of proof of use (or reputation, for that matter). I say this because there is nothing to demonstrate how many users in the UK (or the EU prior to IP Completion Day) have accessed these documents or whether they are even targeted at them.

28. The evidence then moves to discuss sales figures. The narrative evidence states that the figures provided relate to use of the 'GENETITAN' instrument in the UK since 2018. The figures are as follows:

Sums of revenue	
Calendar Year	**Revenue**
2018	390,500
2019	7,811
2020	17,419

[10] Exhibit 7
[11] Exhibit 8
[12] Exhibit 9

2021	1,839
2022	633,218
2023	393,761
Total:	**1,444,547**

29. The figures are not listed in any currency. However, the paragraph immediately following the presentation of the table refers to the GENETITAN instrument costing approximately $378,000 USD (see paragraph 13 of Ms Williams's statement). From this, and the fact that most other figures in evidence are provided in US dollars, I will take the above figures as if they are in US dollars.

30. In terms of the product cost referred to above, this information was provided to demonstrate that the product is highly specialised so will not be purchased by an everyday consumer. As such, the opponent claims that small sales are, therefore, sufficient to prove genuine use. While I agree that high-cost goods will inevitably attract a lower level of sales volume, it does not automatically follow that a low level of sales is sufficient just because the price is high. As set out in the case law above, my assessment must also take into account the nature of both the goods at issue and the market at issue.

31. The evidence goes on to discuss the fact that the 'GENETITAN' instrument is sold via eBay. A printout of the listing is provided.[13] This is confirmed as being a second hand good. While noted, I have three issues with this evidence. Firstly, the printout is dated over a year after the relevant period expired and no listing date is provided. As such, there is nothing to suggest when this listing was made. Secondly, there is nothing to suggest that the product was actually sold or not. On this point, it is my understanding that eBay listings may not necessarily result in a sale. Lastly, the offering for sale of the product is facilitated by Salford Scientific Supplies. Clearly, this is not use by the opponent and I have nothing to suggest that the

[13] Exhibit 10

opponent consented to such use. I appreciate that the sale of second-hand goods (so long as the owner is actually using the mark in accordance with its essential function), may contribute to use by the owner of a mark.[14] However, I do not consider that the eBay listing provided is use of the mark is within the meaning of the case-law. Therefore, it is of no assistance here.

32. While on the point of second-hand use, I note that a printout is provided from the website of Akribis.co.uk.[15] This printout is dated over a year after the relevant period expired and shows a 'GeneTitan MC Instrument'. The product is specifically listed as being in a used condition. As was the case with the eBay listing above, this is a second-hand sale and, further, it is not use by the opponent. There is nothing to suggest that the opponent had any involvement in (or gave any consent to) this resale so it cannot be said to be use in accordance with the essential function of a trade mark. Again, the listing is from after the relevant period and there is nothing to suggest that it ever sold.

33. The evidence then turns back to use actually undertaken by the opponent. This comes in the form of invoices to customers across the EU.[16] Having considered these invoices, I note that they show sales to customers in Portugal and Spain between 2018 and 2020. The invoices show the sale of four new GeneTitan MC systems and two refurbished for a total of six GeneTitan MC's sold. I note that only one transaction (being the Spain transaction for 2018) shows the cost of the product, being €135,954. For the remaining goods covered, it is not shown how much they cost. On this point, it is noted that the price given in the invoice differs considerably from the price of the goods set out in the narrative evidence (being that discussed at paragraph 29 above). No explanation is given for this difference but, regardless, the goods sold are clearly very expensive.

[14] Joined Cases C-720/18 & C-721/18, EU:C:2020:854, *Ferrari SpA v DU*,
[15] Exhibit 11
[16] Exhibit 12

34. The evidence then discusses its distributors across the globe but I see no reason to discuss this in any detail here as it is of no assistance. I say this because, for the most part, it relates to non-EU countries and even where EU countries are listed, there is nothing to suggest any level of sales obtained by the distributors.

35. The European Human Genetics Conference is then discussed in some detail.[17] However, the evidence mostly focuses on the 2023 conference that took place in June of that year. Given that this is after the conclusion of the relevant period, it is of no assistance to these proceedings. That being said, I do note that the evidence does mention that conferences also took place in both 2020 and 2022. The 2020 event was held remotely due to the COVID-19 pandemic and the 2022 event was held in Vienna, Austria. While noted, the events appear to have been attended and sponsored by Thermo and not the opponent itself. Further, there is nothing to suggest the presence of the 'GENETITAN' brand at these events. As I have set out above, the materials provided cover a wide range of other brands associated with the opponent or Thermo so it does not follow that their attendance means that the 'GENETITAN' brand must have also been present. Therefore, while I do not doubt Thermo's presence at these events, the lack of reference to 'GENETITAN' is something that renders this evidence of no assistance here.

36. In terms of an online presence, the opponent provides three examples of its mark being referred to online. The first example of this comes via reference to a YouTube video detailing the 'GENETITAN' product. This video is shown via printouts taken from YouTube.[18] While the video may have been available in the UK, the printout shows only a total of 281 views (as opposed to the 4,900 referred to in the narrative evidence). The second example is an online article taken from 'News Medical Life Sciences' which shows the 'GeneTitan MC' product.[19] The narrative evidence on this point claims that this article lists other goods under the 'GeneTitan' mark. While

[17] See paragraphs 19 to 26 of Ms Williams' witness statement and Exhibits 13 to 18.
[18] Exhibit 19
[19] Exhibit 20

this claim is noted and there are additional goods shown, they are referred to as being ‘other equipment by this supplier’ and make no reference to the ‘GeneTitan’ brand. Another article provided is one from ‘imperialls.com’ that shows the ‘GeneTitan MC’ instrument. In considering these two articles, they are both undated and I have nothing to suggest their reach across the relevant territory during the relevant period. As such, they are of very little assistance here.

37. Lastly, the evidence turns to discuss a research article which featured the ‘GeneTitan’ instrument. The article is shown as being ‘received’ on 14 October 2019 and ‘accepted’ on 25 June 2020. It is of a very medical nature so I have no understanding of the actual content of the article. However, I do note that it does refer to the ‘GeneTitan’ product, albeit only briefly. In terms of the authors of the publication, the narrative evidence confirms that it was a joint publication of several authors, some of which were located in Edinburgh and others in Poland. While noted, I have nothing to suggest the reach of this article across the relevant public or the relevant territory.

Assessment of the evidence

38. While my assessment is to be based on the evidence as a whole, I will begin by focusing on the opponent’s level of sales. As set out above, the opponent has provided evidence of a UK turnover between 2018 and 2023 which stands at $1,444,547. On this point, this figure includes the entirety of the year 2023. Given that the relevant period concluded at the beginning of the March of that year, it is likely that the majority of the figures for 2023 are not relevant here. I have no way to calculate how much is relevant and how much is not. On the basis that the relevant period covers just over two months of 2023, I consider it appropriate to discount the 2023 figures altogether. As such, I consider that the turnover provided for the UK is closer to $1,050,786. Clearly, this represents a very low level of use given that the ‘GENETITAN’ instruments are confirmed as costing either €135,954 or $378,000. In addition to the reference to UK turnover, I have evidence of the

sale of six ‘GeneTitan’ instruments to customers in the EU between 2018 and 2020. Such figures are relevant as this is prior to IP Completion Day so use in the EU is of assistance. As I have set out above, only one of these invoices show the cost of the ‘GeneTitan’ product so it is not possible to determine how much turnover these invoices accrued. That being said, given the high individual cost of the goods, I consider it reasonable to infer that these sales are likely to have resulted in a considerable additional turnover.

39. Outside of the sales figures, I do not consider that the additional evidence provided by the opponent is of particular assistance to the issue of genuine use. I say this because the majority of the evidence involves the simple reproduction of technical brochures discussing the opponent’s goods. Further, there are website printouts provided but outside of discussing the actual product itself, they do not point to a level of awareness of the same throughout the relevant territory. Even where such evidence is confirmed as being available during the relevant period, there is nothing before me to suggest how many of these brochures were issued across the relevant territory or whether or not they led to further sales of the ‘GENETITAN’ product.

40. All of the above being said, I do remind myself that use need not be quantitative in order for it to be deemed genuine. In considering such assessments, I am mindful that I am to consider the level of use in the context of the goods and the market at issue. Dealing with these points in turn, I note that the ‘GENETITAN’ product is a high end, expensive good that is technical in nature (being a product that relates to automated microarray processing in support of genotyping research). It is, therefore, likely to be either a one-off purchase or something that is purchased very infrequently. Turning to the market at issue, I appreciate that I have no direct evidence in relation to this. However, I am of the view that it is likely to be a very niche market. As such, the opponent is not necessarily required to provide evidence of a high volume of sales in order to shown genuine use.

41. Taking all of the above into account and even bearing in mind the low level of use shown in evidence, I am of the view that in light of the nature of the goods at issue and in the context of the relevant market, the opponent has genuinely attempted to create or preserve a market share for its goods. In making this finding I, again, remind myself that use need not be quantitively significant in order for it to be deemed genuine.

42. Turning now to the goods relied upon, I remind myself that the opponent's term is "laboratory equipment for genetic and genomic analysis". In the present case, the evidence shows use of just one product, being that which is referred to as the 'GeneTitan MC Instrument', with 'GeneTitan' clearly being the indicator of origin. As above, there are multiple references to other types of goods but these all come under various other brands that I have listed at paragraph 25 above.

43. While the evidence is technical in nature, I am content to conclude that the 'GeneTitan' product shown throughout is a piece of laboratory equipment that is used for the genetic and genomic analysis. On this point, I remind myself that it is not the task of the Tribunal to describe the use made by the trade mark in the narrowest possible terms unless that is what the average consumer would do.[20] For example, I note that in the case of *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. Whilst I have given some consideration as to whether consumers would describe the use as covering "an instrument for automated array processing", I am of the view that this is too narrow an interpretation and, instead, applying the principles discussed in the case law cited above, I find that the average consumer would describe the opponent's product by using the term relied upon by the opponent. As a result, I am content to proceed on the basis that the opponent's case relies upon the term "laboratory equipment for genetic and genomic analysis".

[20] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

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

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

"(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 or association with the earlier trade mark."

45. Section 5A of the Act states as follows:

"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."

46. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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:

(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

47. The competing goods and services are as follows:

The opponent's goods	The holder's services
<u>Class 9</u> Laboratory equipment for genetic and genomic analysis.	<u>Class 42</u> Technological research; research and development of new products for others; scientific laboratory services; clinical trials; structural and functional analysis of genomes; medical research; medical laboratory services; stem cell research services; research and development services in the field of antibodies; research in the field of physics; biological research and

	analysis; bacteriological research and analysis; genetic testing for scientific research purposes; biotechnology research; testing of pharmaceuticals; DNA screening for scientific research purposes; biomedical research services; biological cloning services.

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

> "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".

49. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

50. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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."

51. The holder's position, as set out in its counterstatement, is that the goods and services at issue are different in their natures, methods of use and purposes. Further, the holder argues that the goods and services are not complementary. As for trade channels, the holder's position is that consumers will not consider that the provider of specialist goods (such as those in the opponent's specification) would also provide services concerned with the generation, dissemination and application of scientific field and knowledge. As a result, the holder claims that the goods and services are dissimilar.

52. The opponent's submissions in respect of the goods and services at issue are that they are complementary, share the same end user and have the same use. In making its submissions, the opponent refers to a claim that the opponent is a world

leader and extremely well-known in the industry at issue here. While this claim is noted, it has no impact on the comparison of the goods and services at issue. I say this because the assessment I am required to make here is notional and involves carrying out the comparison of the goods and services based on the specifications before me, not the claimed reputation of the parties.

Scientific laboratory services; clinical trials; structural and functional analysis of genomes; medical research; medical laboratory services; stem cell research services; research and development services in the field of antibodies; biological research and analysis; bacteriological research and analysis; genetic testing for scientific research purposes; biotechnology research; DNA screening for scientific research purposes; biomedical research services.

53. The above services are either specific to medical or biological research, or are sufficiently broad enough that they can all reasonably be said to cover different types of medical or biological research. Genetics and genomes clearly fall within the field of medicine and biology. As such, I consider that the above services can cover research into genetics and genomes. In comparing the above to the opponent's term (being "laboratory equipment for genetic and genomic analysis"), I am of the view that they plainly differ in nature and method of use. As for purpose, I appreciate that while they differ at their cores (one being an actual research service, the other being a machine for analysing genetics/genomes), there is some degree of overlap because the opponent's goods will be used to provide information/data for research purposes. Both goods and services can, therefore, be said to have research purposes.

54. In terms of trade channels, it is my understanding that the opponent's goods will be provided by specialist scientific/medical undertakings. Such undertakings are also likely to offer research services to the end consumer. As such, I find that the goods and services here overlap in trade channels. In respect of complementarity, in the context of genetic/genome research, I consider that the laboratory goods of

the opponent are important to the above research services. I say this because the holder's research services are likely to be undertaken whilst using the opponent's goods. This relationship is such that the end consumer of the goods and services will believe that the research provider is also responsible for the goods on which the research is undertaken.[21] Therefore, I consider that the goods and services are complementary to one another. Lastly, I do not consider that the user of the opponent's goods will be the user of the above services. This is on the basis that someone looking to receive research services is unlikely to select the goods that are used during said research. Taking all of this into account, I find that the goods and services are similar to a medium degree.

Technological research.

55. In considering the above term, I have given thought as to whether it could be said to solely relate to 'technology' in the sense of computers and software. Having done so, I am of the view that to construe the term in such a way would be a result of too narrow an interpretation. Instead, it is my conclusion that the above service will be viewed as sufficiently broad so as to cover research topics relating to technology used in many different sectors. As alluded to above, this can include research in fields of computing but I consider that it can also include research into technology used in sciences, such as biology. Additionally, technology is used across different medical fields so can cover this topic too. As a result, I consider that the comparison made in the preceding assessment is applicable here. Therefore, find that the above service is similar to a medium degree with the opponent's "laboratory equipment for genetic and genomic analysis" on the basis that there is some overlap in purpose, an overlap in trade channels and a complementary relationship between them.

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[21] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06

Testing of pharmaceuticals.

56. The above service is one that will form part of the overall development of a new pharmaceutical. It will not be part of the research stage but will, instead, be a service that is likely to be provided after the research takes place in order to gather results relating to a new pharmaceutical. It is my understanding that ‘pharmaceuticals’ is a very broad term that covers a vast array of drugs of different compositions (which may include those that alter DNA, for example). The nature and the testing of such goods may very well require use of the opponent’s “laboratory equipment for genetic and genomic analysis” in order to analyse the genetic response of a test subject to a new drug. It is my view that, in this context, it is likely that the opponent’s goods and the holder’s services are those that are likely to be offered by the same undertakings meaning that they overlap in trade channels. In addition, I consider that the opponent’s goods are important to the holder’s services to the point that consumers would believe them to be the responsibility of the same undertaking. As a result, the goods and services at issue are complementary to one another. Overall, I consider that these two factors are sufficient in order to give rise to a finding that these goods and services are similar to a low degree.

Biological cloning services.

57. The above service relates to the cloning of living things. Clearly, the genetic nature of cloning is such that the opponent’s goods (being “laboratory equipment for genetic and genomic analysis”) will be important to this service. This relationship is, as far as I am aware, likely to lead consumers to believe that they are the responsibility of the same undertaking. In terms of trade channels, I am of the view that the present services, like those I have already discussed above, will be offered by the same undertaking that produces and sells the opponent’s goods. As such, there is an overlap in trade channels. While all other factors differ, I am of the view

that these factors are sufficient to give rise to a finding that these goods and services are similar to a low degree.

Research and development of new products for others.

58. The above services could reasonably be said to be research and development services relating to medical or scientific products. While that may be the case, I do not consider that they are similar to the opponent's "laboratory equipment for genetic and genomic analysis". Such goods and services plainly differ in nature, method of use and purpose. As for trade channels, I accept that the opponent's goods will have originated as a result of research and development. However, this does not mean that the producer of the opponent's goods would offer research and development of new products to others. On this point, I have nothing before me to suggest otherwise and, therefore, find that there is no overlap in trade channels. Further, I see no reason why there would be any meaningful overlap in user between the goods. Lastly, I do not consider that the goods and services are complementary or competitive in nature. As a result, I find that the above services are dissimilar to the opponent's goods.

Research in the field of physics.

59. While physics is a scientific field, it is not biology and, as far as I understand it, it has nothing to do with the medical field or genetics/genomes and there is no evidence before me to suggest otherwise. As a result, I find that these services and the opponent's goods do not share any obvious overlap in nature, method of use, purpose, trade channels and user. In addition, the goods and services are not complementary or competitive in nature. As a result, I find that these services are dissimilar to the opponent's goods.

Conclusion of the goods and services comparison

60. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) grounds.[22] In light of my findings above, it follows that the present ground of opposition fails against the dissimilar services. It will, however, proceed against the following services, being those I have found to be similar:

Class 9:	Scientific laboratory services; clinical trials; structural and functional analysis of genomes; medical research; medical laboratory services; stem cell research services; research and development services in the field of antibodies; biological research and analysis; bacteriological research and analysis; genetic testing for scientific research purposes; biotechnology research; testing of pharmaceuticals; DNA screening for scientific research purposes; biomedical research services; biological cloning services; technological research.

The average consumer and the nature of the purchasing act

61. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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. (as he then was) described the average consumer in these terms:

[22] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

> "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."

62. The opponent's position in respect of the average consumer for the goods and services at issue is that they will be medical professionals and scientific experts. I agree. In terms of how the goods and services reach the market, I am of the view that this will be via specialist providers. The selection process will be both visual and aural. I say this because while the goods and services will be selected after having viewed them on images online or in brochures, or having considered lists on websites or in physical pamphlets, their specialist nature is such that the consumer will undoubtedly engage in discussions surrounding them with sales representatives of the providers.

63. The goods and services at issue are likely to be expensive ones that will either be one off purchases or selected on a very infrequent basis. Given their specialist nature, I am unable to comment on the factors that will require consideration when selecting the goods and services at issue. That being said, I am willing to conclude that the level of attention paid when selecting the goods and services at issue will be high. I note that this is a position that the parties have shared by way of their counterstatement or submissions.

Comparison of the marks

64. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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 the trade marks, bearing in mind their distinctive and dominant components.

65. 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."

66. It would be wrong, therefore, to artificially dissect the trade marks, 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.

67. The respective trade marks are shown below:

The opponent's mark	The IR
GENETITAN	GenTitan

68. I have submissions from both parties in respect of the comparison of the marks. While I do not intend to reproduce those in full here, I can confirm that I have given them due consideration.

Overall impression

69. The opponent's mark is a word only mark that consists of the word 'GENETITAN'. I consider that the mark will be viewed as the conjoining of two words, being 'GENE' and 'TITAN'. I consider that it is the letters 'TITAN' that will play the greater role in the overall impression of the mark with 'GENE' playing a lesser role. My reasons for this will be discussed further below.

70. As for the IR, this is also a word only mark that is presented as 'GenTitan'. I consider that a similar approach to that taken above applies here, namely that the mark will be viewed as the conjoining of two elements, being 'Gen' and 'Titan'. I find that 'Titan' will play the greater role in the overall impression of the mark with 'Gen' playing a lesser role. Again, I will discuss my reasons for this below.

Visual comparison

71. In comparing the marks, I consider it necessary to briefly set out that the opponent's mark is capable of being presented as 'GeneTitan'. On this point, I note that in *Herno S.P.A. v Miss Sparrow Ltd.* BL O/954/22, Mr Purvis QC, sitting as the Appointed Person, in considering the mark 'mr heron', observed that it is a word mark and stated at paragraph 15:

> "… the mark applied for ('mr heron') is a word mark, and therefore the monopoly is not limited by any features such as fonts or capitalisation appearing on the Register.
>
> **MR HERON**
> **mr heron**
> **Mr Heron**
> **Mr HERon**
> Mr HERON

would therefore all be considered to be 'identical' to the registered mark for the purposes of assessing infringement under s10."

72. As such, I do not consider that the different use of cases across the marks at issue acts as a point of visual distinction between them. As a result, the only point of difference between the marks lies in the letter 'e' that sits roughly in the middle of the opponent's mark. All other letters across the parties' marks, being 'G-E-N-T-I-T-A-N' are identical. Further, the points of similarity make up the entirety of the IR. Taking all of this into account, I find that the marks are visually similar to a high degree.

Aural comparison

73. I consider that the opponent's mark will be pronounced as 'JEEN-TIE-TUHN'. As for the IR, my primary finding is that it will be pronounced as 'JEN-TIE-TUHN', though I do not discount the fact that some consumers will pronounce it as 'JEEN-TIE-TUHN'. In respect of the latter pronunciation, the marks are clearly aurally identical. However, in respect of the former pronunciation, they will not be. On this point though, I note that the marks are of the same length and while their first syllables are not the same, they are still similar to a degree. Further, the second and third syllables are identical. Taking all of this into account, I find that where the marks are not aurally identical, they are aurally similar to a high degree.

Conceptual comparison

74. As above, I consider that the parties' marks will both be viewed as the conjoining of two words, being 'Gen Titan' and 'Gene Titan'. This will form the basis of my conceptual comparison.

75. Conceptually, I consider that the letters 'Gen' in the IR will be seen as a reference to 'genetics' or 'genes'. As such, this element will be understood as a reference to the '*study of heredity and how quality and characteristics are passed from one generation to another by means of genes*'[23] or '*part of a cell in a living thing that controls its physical characteristics, growth and development*',[24] respectively. This is allusive of the holder's services as they can all be said to cover biological/medical services.[25] As for 'Titan', I consider that this will have multiple meanings including '*a person of great strength or size*', '*the largest satellite of the planet Saturn*' or '*a race of deities in Greek mythology*'.[26] In combination, I do not consider that the IR forms any obvious unitary meaning outside of the different elements within it.

76. As for the opponent's mark, I consider that 'Gene' will be clearly identified as a reference to genes, the understanding of which will follow the definition I have provided above. In the context of the goods in the opponent's specification, I find that this word will be viewed as allusive to the fact that they will be used in the study of genetics. 'Titan' will also be understood in the same way that element is perceived in the IR, again following the definitions I have provided above. As a whole, the mark has no obvious meaning outside of the words within it.

77. In comparing the marks, I am of the view that in the event that 'Gen' in the IR is understood as a reference to 'genes', the marks will be conceptually identical. However, if the letters 'Gen' are simply seen as a reference to 'genetics' and 'not 'genes' specifically, then the marks will still share a significant point of similarity. I say this because 'genetics' has an obvious connection to the word 'gene' on the basis that 'genetics' is the study of genes. As such, if the marks are not conceptually identical then I find that they are still conceptually similar to a very high degree.

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[23] https://www.collinsdictionary.com/dictionary/english/genetics
[24] https://www.collinsdictionary.com/dictionary/english/gene
[25] I appreciate that, as per the case of *EMILIANA* (Case BL O/054/22), conceptual comparisons are usually done without reference to the goods or services at issue. However, in the present case, I am of the view that the nature of the research services at issue will inform the consumers' understanding of the letters 'Gen'.
[26] https://www.collinsdictionary.com/dictionary/english/titan

Distinctive character of the opponent's mark

78. 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)."

79. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the

opponent has filed evidence to that effect. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

80. As I have discussed above, the opponent's mark will be viewed as the combining of two words, being 'Gene' and 'Titan'. 'Gene' will be allusive to the fact that the goods relied upon relate to genetics/genomes. As for the word 'Titan', this will have a well-known meaning but it is not descriptive or allusive to the goods at issue. That being said, it is not a particularly remarkable word from a trade mark perspective given that it will have an immediately graspable meaning. Regardless of the weaker role that the word 'Gene' plays in the opponent's mark, I am of the view that, in considering the mark as a whole, it enjoys a medium degree of inherent distinctiveness.

81. I turn now to consider whether the evidence is sufficient to give rise to a finding that the opponent's mark enjoys an enhanced degree of distinctiveness. In short, I do not consider that it does. While I have accepted that the evidence was sufficient to give rise to a finding of genuine use, I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking. In short, I am of the view that the low level of use associated with the opponent's 'GENETITAN' brand (being turnover in the sum of approximately $1 million in the UK and six total sales of goods to the EU) is not sufficient to give rise to a finding that the consumer would be aware of the mark as a result of the use made of it. As a result, I find that the inherent position applies.

Likelihood of confusion

82. 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 the marks and the goods and services down to the responsible undertakings 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 respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registrations, the average consumer for the goods and services 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 they have retained in their mind.

83. In respect of the goods and services at issue, I have found them to be similar to either a low or a medium degree. The average consumer base is formed of medical professionals and scientific experts who will select the goods and services via both visual and aural means. I have concluded that the average consumer will pay a high degree of attention when selecting the goods and services at issue. I have found the marks to be visually similar to a high degree, either aurally identical or similar to a high degree (depending on how the IR is pronounced) and either conceptually identical or similar to a very high degree (depending on how the consumer understands the ‘Gen’ element in the IR). Lastly, I have found the opponent’s mark to possess a medium degree of inherent distinctive character.

84. Taking all of the above factors into account and bearing in mind the principle of imperfect recollection, I am of the view that the high degrees of similarity (or, in

some instances, identity) between the marks are such that the consumers would not be able to accurately recall or remember the marks for one another. I say this because not only are the beginnings of the marks identical, but their ends are too. On this point, I remind myself that beginnings of the marks are where consumers tend to focus[27] and, further, there is case law which suggests that similar ends are also capable of giving rise to confusion.[28] In addition, the only point of difference between the marks is subsumed into the body of the opponent's mark so is prone to being overlooked in light of the aforesaid identical beginnings and ends. Lastly, I consider that this finding is further supported by the fact that the conceptual identity or very high degree of similarity between the 'Gen' and 'Gene' elements is such that consumers would not necessarily notice any difference in the meanings of the marks, both of which referring to genetics or genomes. In reaching this finding, I have borne in mind that the average consumer for the goods and services at issue will play a higher degree of attention. While noted, I do not consider that this will offset the higher level of similarity between the marks. Consequently, I find that there exists a likelihood of direct confusion between the marks at issue. For the avoidance of doubt, this applies regardless of the level of similarity of the goods and services at issue. I say this because the high degree of similarities between the marks are sufficient, based on the principle of interdependence, to offset any lower degree of similarity between the goods and services at issue.

85. Given that I found some services to be dissimilar, the present ground succeeds in respect of the similar services only. As there remains a section 5(3) ground to consider, I will refrain from summarising my section 5(2)(b) ground here and will, instead, summarise the overall outcome of my decision below.

Section 5(3)

86. Section 5(3) of the Act states:

[27] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[28] *Bristol Global Co Ltd v EUIPO,* T-194/14

“5(3) A trade mark which –

> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

87. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L’Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

    (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; General Motors, paragraph 24.

    (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.

    (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Salomon, paragraph 29 and Intel, paragraph 63.

    (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

88. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the IR. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

89. I have assessed the opponent's evidence of use at paragraphs 20 to 37 above. While I do not intend to reproduce it in full here, I remind myself that it covers UK sales of $1 million and sales of six items to consumers in the EU prior to IP Completion Day. In my view, this level of use is too low to warrant a finding that the mark enjoyed a reputation in the relevant territory at the relevant date. In saying this, I appreciate that I have found the use to be sufficient to demonstrate genuine use. However, much like my assessment of enhanced distinctiveness above, the burden to prove a reputation is much higher than that which is required for genuine

use. On this point, I remind myself that in order for there to exist a reputation, the opponent is required to prove that the mark relied upon is known by a significant part of the relevant public in the relevant territory. Regardless of the niche nature of the market within which the opponent operates, this is simply not borne out in the evidence and, as such, I find that the opponent’s section 5(3) ground fails at the first hurdle.

90. For the avoidance of doubt, even if there were to exist a reputation in the opponent’s mark, this would not be sufficient to advance the opponent’s case beyond that which was found under the section 5(2)(b) ground above. I say this because whilst I acknowledge that the present ground can succeed in respect of dissimilar goods and services, the evidence before me is far from sufficient to result in a finding that consumers would be caused to wonder if the marks at issue were linked for the dissimilar goods and services.

CONCLUSION

91. The opposition succeeds in part and, subject to any successful appeal of my decision, the IR is hereby refused protection in the UK for the following services:

Class 42: Scientific laboratory services; clinical trials; structural and functional analysis of genomes; medical research; medical laboratory services; stem cell research services; research and development services in the field of antibodies; biological research and analysis; bacteriological research and analysis; genetic testing for scientific research purposes; biotechnology research; testing of pharmaceuticals; DNA screening for scientific research purposes; biomedical research services; biological cloning services; technological research.

92. However, given that the opposition has only partially succeeded, the IR is, again, subject to any successful appeal of my decision, hereby granted protection in the UK for the following services:

Class 42:	Research and development of new products for others; research in the field of physics.

COSTS

93. The opponent has enjoyed the majority of success and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. That being said, I do consider it appropriate to reduce the award to some degree to reflect the holder's partial success in defending some services.

94. In the circumstances, I award the opponent the sum of £1,300 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and Considering the counterstatement:	£300
Filing evidence:	£600
Filing written submissions in lieu:	£400
Sub-total:	£1,300
Reduction:	*-£200*
Official fees (not subject to reduction):	£200
Total:	**£1,300**

95. I hereby order NANJING GENSCRIPT BIOTECH CO., LTD. to pay Affymetrix, Inc the sum of £1,300. The above 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 25th day of July 2025

A COOPER
For the Registrar