

O/0699/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001754803

DESIGNATING THE UK

IN THE NAME OF GLUCOX BIOTECH AB

FOR THE FOLLOWING TRADE MARK:

Glucox

IN CLASS 5

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 506863 BY GLUCORX LTD

BACKGROUND AND PLEADINGS

1. The international registration shown on the cover page of this decision (“the contested mark”) was registered on 18 July 2023 in the name of Glucox Biotech AB (“the proprietor”). With effect from the same date, the proprietor designated the UK as a territory in which it sought to protect the contested mark pursuant to the Protocol to the Madrid Agreement. Protection in the UK was granted on 28 December 2023 and the contested mark stands registered for the following goods:

Class 5 Dietetic foods adapted for invalids; dietetic foods for use in clinical nutrition; dietetic substances adapted for medical use; dietetic substances adapted for veterinary use; chemical preparations for medical purposes; chemical preparations for veterinary purposes; chemical reagents for medical or veterinary purposes; pharmaceutical preparations; veterinary preparations and substances.

2. On 3 January 2024, GlucoRX Ltd (“the applicant”) applied to invalidate the contested mark pursuant to sections 47 and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) of the Act, the applicant relies upon the following mark:¹



UKTM no. 3884789

Filing date 3 March 2023

Registration date 9 June 2023

3. The applicant relies upon all goods for which the earlier mark is registered, as set out in the Annex to this decision. The applicant pleads its case as follows:

¹ The applicant also originally relied upon UKTM no. 3116259. The proprietor requested that the applicant provide proof of use of that mark. However, as no evidence was filed by the applicant by the deadline provided for the filing of evidence, reliance upon that mark was deemed withdrawn, and the case proceeds in relation to the earlier mark listed here only.

“The Registered Mark “GLUCOX” is highly similar to the Cancellation Applicant’s prior registration for the mark “GLUCORX (stylised). The Goods covered by the Registered Mark in class 5 are identical to those covered by the Cancellation Applicant’s prior rights. In view of the high level of similarity between the respective mark and the identity of the goods, there is a likelihood of confusion on the part of the relevant public in the UK. The application must therefore be cancelled in respect in its entirety pursuant to Section 5(2)(b) of the UK Trade Marks Act 1994.”

4. The proprietor filed a counterstatement denying the claims made, and noting that the term “Gluko” will be understood as referring to sugar or glucose and that “Rx” is a recognised medical prescription symbol.

5. Neither party requested a hearing, and only the proprietor filed written submission in lieu. This decision is taken following a careful consideration of all the papers on file.

REPRESENTATION

6. The proprietor is represented by HGF Limited.

7. The applicant is represented by Marks & Clerk LLP.

EVIDENCE AND SUBMISSIONS

8. Only the proprietor filed evidence. This took the form of the witness statement of Stephanie Loeffler-Reading dated 3 October 2024, which is accompanied by 4 exhibits (SLR1 to SLR4). Ms Loeffler-Reading is a Trade Mark Attorney acting on behalf of the proprietor.

9. The proprietor filed written submissions dated 9 December 2024.

RELEVANCE OF EU LAW

10. 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.

DECISION

11. Section 5(2)(b) has application in invalidation proceedings by virtue of section 47 of the Act, the relevant parts of which read as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

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. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. Given its earlier filing date, the trade mark upon which the applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years prior to the designation date, it is not subject to the use provisions in section 47 of the Act. Consequently, the applicant can rely upon all of the goods identified, without having to show that the earlier mark has been put to genuine use for those goods.

15. 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 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 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 to mind the earlier mark, 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

16. In its written submission in lieu, the proprietor accepts that the following goods in its specification are identical to those of the applicant:

Chemical preparations for medical purposes; chemical preparations for veterinary purposes; chemical reagents for medical or veterinary purposes; pharmaceutical preparations; veterinary preparations and substances.

17. I will, therefore, only conduct a comparison in relation to the remaining terms in the proprietor's specification. I have included only those goods from the applicant's specification in the table below which I consider represent the applicant's best case. With that in mind, the competing goods are as follows:

Applicant's goods	Proprietor's goods
<u>Class 5</u> Pharmaceutical and chemical preparations for treating diabetes.	<u>Class 5</u> Dietetic foods adapted for invalids; dietetic foods for use in clinical nutrition; dietetic substances adapted for medical use; dietetic substances adapted for veterinary use.

18. When making the comparison, all relevant factors relating to the goods 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:

"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.”

19. 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 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.

20. The proprietor accepts that there is a moderate degree of similarity between these goods and the applicant's goods. In my view, the goods will overlap in trade channels as they are all goods that might be sold through pharmacies and retailers specialising in products for use by diabetic patients. The purpose of the goods will overlap to the extent that they can all be used to treat diabetes (the applicant's goods being specifically for that purpose and the proprietor's goods being dietetic, which could include those for use in the treatment/management of diabetes). The method of use and nature of the goods is likely to differ, as the applicant's goods are likely to be in the form of medicines or tablets, whereas the proprietor's goods are (or are more likely to be) food products. Plainly, the user may overlap, as they can all be used by patients

suffering from diabetes. There may be some competition, although this is likely to be limited; in my view, it is more likely that these products would be used together. Taking all of this into account, I consider the goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

21. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

22. 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.”

23. The average consumer for the goods will be members of the general public (who are suffering from diabetes) or healthcare professionals. The cost of the goods is likely to vary, but they are likely to be reasonably frequent purchases (given that diabetes is a chronic illness). The average consumer is likely to take into account factors such as medication content, suitability for their particular needs (including dietary requirements) and effectiveness of the treatment. Given that the goods are likely to have an impact upon the wellbeing of average consumer themselves (or their patients in the case of health care professionals), considerable care is likely to be taken during their purchase. Consequently, I consider that a high degree of attention will be paid during the purchasing process.

24. The goods are likely to be purchased following perusal of physical signage (in catalogues or on packaging) or online equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase, given that orders may be placed by telephone and advice may be given to the general public verbally by healthcare professionals.

Distinctive character of the earlier mark

25. 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-2779, 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).”

26. 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

27. The applicant has not filed evidence of use and, consequently, I have only the inherent position to consider. The earlier mark consists of the word GLUCO followed by the letters R and X. In my view, the letters GLUCO will be understood as a shortening of the word GLUCOSE and will, therefore, be allusive for the goods in issue. I am fortified in this by the evidence before me which demonstrates that the letters GLUCO are in common use on packaging for diabetic products.² The connection between glucose and diabetes is something that I can take upon judicial notice. The proprietor claims that the letters RX are a recognised symbol for prescription.³ The evidence filed to demonstrate this consists of a list of Google search results and one print out from a website called verywellhealth.com.⁴ It is not clear whether this website is from the UK or not. The Google search results do include a reference to *Collins* which confirms the definition as British English. However, in the absence of anything more to confirm that this definition would actually be known (either to the general public or healthcare professionals), I am unable to find that the meaning suggested by the proprietor would be known to the average consumer. The stylisation plays some role in the distinctiveness of the earlier mark. Overall, I consider the earlier mark to be distinctive to between a low and medium degree.

Comparison of trade marks

28. It is clear from *Sabel* 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 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:

² Exhibit SLR3

³ Exhibit SLR4

⁴ Exhibit SLR4

“... 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.”

29. 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 to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The respective trade marks are shown below:

Applicant's trade mark	The contested mark
 The applicant's trade mark consists of the word "Gluco" in white font on a blue rectangular background, followed by "Rx" in blue font on a white background.	GLUCOX

Overall Impression

31. The applicant's mark consists of the word GLUCO presented in a white font on a blue background. Following that word, are the letters RX presented in blue font on an off-white background, with the letter R appearing in a larger font than the letter X. As noted above, the word GLUCO is allusive for the relevant goods. In my view, the overall impression lies in the combination of these elements, with the inverted use of colour also contributing to the overall impression.

32. The contested mark consists of the word GLUCOX. The overall impression resides in the word itself.

Visual Comparison

33. The marks coincide in that the first word in the applicant's mark is subsumed within the contested mark i.e. the letters GLUCO. They also coincide in that they share an X at the end of the marks. However, they differ in that the applicant's mark includes the letter R between the GLUCO and X elements, which is presented as a capital and, therefore, creates the impression of a new word. This is in contrast to the contested mark which appears as one word. I bear in mind that the beginning of marks tend to make more of an impact than the ends.⁵ However, in this case, the beginning of the marks (being GLUCO) is likely to be understood by the average consumer as a reference to glucose in the context of goods used to treat diabetes. In my view, the marks are visually similar to a slightly higher than medium degree.

Aural Comparison

34. The contested mark is likely to be viewed as a single invented word which will be pronounced GLUE-COX. The applicant's mark is likely to be recognised as GLUCO followed by the letters R and X, partly due to the capitalisation used but also partly due to the way the colours separate these elements. Consequently, I consider that the applicant's mark is likely to be pronounced GLUE-COE-ARE-EXX. The first syllable is identical, and there are some similarities in the sounds contained within the second and fourth syllable of the applicant's mark and the second syllable of the contested mark. In my view, the marks are aurally similar to between a low and medium degree.

Conceptual Comparison

35. The contested mark is likely to be viewed as an invented word which, due to the inclusion of the letters GLUCO at the start, alludes to the inclusion of glucose in the products upon which it is used. The applicant's mark will also allude to the inclusion of glucose, by virtue of the presence of the word GLUCO. Whilst this conceptual message is identical, it is not distinctive. The letters RX will not convey any message for the average consumer.

⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Likelihood of confusion

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods 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 marks may be offset by a greater degree of similarity between the goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

37. I have found as follows:

- a. The goods are identical or similar to a medium degree.
- b. The average consumer will be either a member of the general public or a healthcare professional, who will be paying a high degree of attention during the purchasing process.
- c. The purchasing process will be predominantly visual, although I do not discount an aural component.
- d. The marks are visually similar to a slightly higher than medium degree and aurally similar to between a low and medium degree. Both marks convey the same conceptual meaning, but this is not distinctive.
- e. The earlier mark is inherently distinctive to between a low and medium degree.

38. It is important to bear in mind that it is the distinctiveness of the common element which is key.⁶ The common element in this case is the letters GLUCO, which are allusive for the relevant goods. In my view, an average consumer will be able to distinguish between the marks, notwithstanding the visual similarity between them. This is because the visual similarity will be offset by the lower level of distinctiveness of the earlier mark and the high level of attention being paid by the average consumer. As a result, I do not consider there to be a likelihood of direct confusion.

39. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

⁶ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

40. This case does not appear to me to fall within any of the categories identified within *LA Sugar*. The common element is not so strikingly distinctive that the average consumer would consider only one undertaking to be using it (indeed, quite the contrary is true, in my view). This is also not a case of a non-distinctive addition. The differences between the marks are not, in my view, consistent with a brand extension. Their change from the earlier mark which appears as a word plus two letters to the contested mark, which appears as one invented word, would not be a logical brand extension. Whilst I bear in mind that the categories listed above are not exhaustive, I can see no other basis upon which indirect confusion could arise, nor has the applicant identified any.

CONCLUSION

41. The application for invalidation is unsuccessful and, subject to any appeal, the contested mark may remain registered.

COSTS

42. The proprietor has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the proprietor the sum of **£1,300**, calculated as follows:

Preparing a counterstatement and considering the Notice of invalidity	£300
Preparing and filing evidence	£600
Written submissions	£400
Total	£1,300

43. I therefore order GlucoRX Ltd to pay Glucox Biotech AB the sum of **£1,300**. This sum is to 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 28th day of July 2025

S WILSON
For the Registrar

ANNEX

Class 5

Pharmaceutical and chemical preparations or treating diabetes; medical reagents for diabetes monitoring; medical test strips for use in monitoring blood glucose levels; medical test strips for use in monitoring blood ketone and other analytes levels; diagnostic test strips, for determining levels of glucose in blood; control solutions used for quality checks on blood glucose monitors and diagnostic test strips all for medical diagnostic use, lancets and control solutions all for medical diagnostic use.

Class 10

Medical test kits for diabetes monitoring for home use; blood glucose monitor; blood glucose monitoring kit consisting of a blood glucose monitor, diagnostic meters and blood lancets; sensor-based glucose monitors; sensor based ketone and other analytes monitors, non-invasive glucose and other analytes monitors, disposable needles; lancet devices and lancets for medical purposes; insulin pumps and infusion sets including accessories included in this class; medical devices, including sensors for monitoring glucose and other analyte levels, including, receivers, sensor housings and sensor insertion devices.