O/0791/26

TRADE MARKS ACT 1994

IN THE MATTER OF THE UNITED KINGDOM DESIGNATION OF INTERNATIONAL REGISTRATION NO. WO0000001635628 IN THE NAME OF SUZHOU ABOGEN BIOSCIENCES CO., LTD. FOR THE TRADE MARK:

Abogenbio

IN CLASSES 5 AND 42

AND

AN OPPOSITION THERETO UNDER NO. 435734 BY ABIOGEN PHARMA S.P.A.

BACKGROUND AND PLEADINGS

1. Suzhou Abogen Biosciences Co, Ltd. ("the Holder") is the registered owner of international trade mark registration number 1635628 ("the IR"), shown on the cover page of this decision. The IR is registered with effect from 1 November 2021 and the Holder applied to extend the protection of the IR to the UK from the same date. The designation was published in the Trade Marks Journal on 20 May 2022 in respect of the following goods and services:

Class 5: *Pharmaceutical preparations; drugs for medical purposes; biological preparations for medical purposes; medicines for human purposes; crude drug; biochemical medicines; all of the goods used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy.*

Class 42: *Technological research; quality control; quality testing; cancer research for medical purposes; drug development; drug evaluation; pharmaceutical research; pharmaceutical research services; medical research; development of pharmaceutical preparations and pharmaceuticals; all of the services used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy.*

2. On 22 August 2022, Abiogen Pharma S.p.A. ("the Opponent") opposed, in full, the protection of the IR in the UK based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

3. Under sections 5(2)(b) and 5(3), the Opponent relies upon the following two trade marks:[1]

[1] The Opponent originally relied upon a third mark (UK00003625460), against which there was a pending opposition at the commencement of these proceedings. That opposition, under number 426691, was successful and in a decision of the Registrar dated 22 April 2026 (BL O/0337/26) trade mark number UK00003625460 was refused registration in its entirety. It is, therefore, not a valid earlier mark in accordance with section 6(1)(a) of the Act. Accordingly, the Opponent is not entitled to rely on this mark in these proceedings.

(i) UK00908599862 ("the Opponent's first mark")

Representation:

Filing date: 18 September 2009

Registration date: 1 March 2010

Goods and services relied upon: *Pharmaceutical preparations* in Class 5 and *Research in the pharmaceutical and scientific sector* in Class 42.

(ii) UK00910511665 ("the Opponent's second mark")

Representation: ABIOGEN PHARMA

Filing date: 7 December 2011

Registration date: 29 March 2012

Services relied upon: *Scientific and technological services and research and design relating thereto* in Class 42.

4. The Opponent's first and second marks qualify as earlier trade marks in accordance with section 6(1) of the Act. As they had been registered for more than five years at the designation date of the IR, they are subject to the use requirements specified in section 6A of the Act.

5. On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark ("EUTM"). As a result of the Opponent having EUTMs protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The Opponent's first and second marks in these proceedings are comparable trade marks, which are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

6. Under section 5(2)(b), the Opponent claims that its marks are visually, aurally and conceptually highly similar to the IR and that the respective goods and services are identical or similar, resulting in a likelihood of confusion.

7. Under section 5(3), the Opponent claims to have a reputation in the UK in its marks for the goods and services set out above. The Opponent claims that use of the IR, for all the goods and services in its specification, would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's marks.

8. The Holder filed a defence and counterstatement denying the entirety of the 5(2)(b) and 5(3) grounds of opposition. The Holder put the Opponent to proof of:

(i) genuine use of its first and second marks;

(ii) its claimed enhanced distinctive character in its first and second marks; and

(iii) its claimed reputation in its first and second marks.

9. During the evidence rounds, only the Opponent filed evidence.

10. A hearing took place before me on 13 January 2025. The Opponent was represented by Mr Jamie Muir Wood of Hogarth Chambers, instructed by Boult Wade Tennant LLP. The Holder has been represented throughout these proceedings by Forresters IP LLP but chose neither to attend the hearing nor to file written submissions in lieu of attending.

EVIDENCE

11. The Opponent filed evidence in the form of the witness statement of Massimo di Martino ("MDM WS") dated 21 November 2023 and the witness statement of Jessica Viganò ("JV WS") dated 20 November 2023.

12. Massimo di Martino is the founder, President and Managing Director of the Opponent and their witness statement is accompanied by 12 exhibits ("MDM01 – MDM12") and an addendum setting out changes to page references. The purpose of MDM WS is to support the Opponent's claimed use, enhanced distinctiveness and reputation in its first and second marks.

13. Jessica Viganò is an Attorney at Law, is fluent in Italian and proficient in English. Their witness statement has been provided for the purposes of translating part of MDM WS and providing UK visitor numbers to Italy and Italian visitor numbers to the UK. JV WS is accompanied by five exhibits ("JCV01 – JV05").

14. I have taken the entirety of the evidence into account in reaching this decision and will refer to it below where necessary.

DECISION

Relevance of EU law

15. 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.

Proof of use

Statutory provisions

16. Section 6A of the Act is as follows:

> "(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."

17. As the Opponent's marks are comparable marks, 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."

18. Accordingly, for the purposes of assessing proof of use, the Opponent's marks will be treated as EUTMs for the part of the relevant period before IP completion day and, as such, use in the EU may be sufficient.

19. Section 100 of the Act is also relevant, which 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."

Relevant case law

20. 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]."

21. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander KC as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use. […] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known

to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

22. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs KC as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

'[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.'

> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

23. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the marks.

24. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods and services at issue during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

(i) The scale and frequency of the use shown;
(ii) The nature of the use shown;
(iii) The goods and services for which use has been shown;
(iv) The nature of those goods and services and the market(s) for them; and
(v) The geographical extent of the use shown.

Relevant period

25. For the purposes of these proceedings, the relevant period in which the Opponent must demonstrate genuine use of its first and second marks is the five-year period ending with the UK designation date of the IR, i.e. 2 November 2016 to 1 November 2021.

Assessment of the evidence

Form of the mark

26. Before discussing the sufficiency of the evidence I will briefly address a variant of the first mark shown in the evidence, as below:

27. This variant differs from the Opponent's first mark only in the use of the colour red for the dot in the letter O and the horizontal lines either side of the word PHARMA. These differences are minor: the elements themselves are not particularly distinctive and so the alteration of them from black to red is not such as to alter the distinctive character of the trade mark as a whole.[2] Accordingly, use of this variant is acceptable and any reference I make to the Opponent's first mark includes use of this variant.

Sufficiency of the evidence

28. The Opponent is described as a specialist pharmaceutical company, founded and incorporated in Italy in 1997.

29. There are, in evidence, webpages taken from the Opponent's website 'www.abiogen.it' between January 2017 and July 2021, demonstrating use of the first and second marks.[3] Further webpages list the pharmaceutical preparations manufactured and sold by the Opponent;[4] these are undated but explained as being substantively the same as how the webpages appeared on 31 December 2020.[5] The

[2] As per *Hyphen GmbH v EUIPO,* Case T-146/15 at paragraph 30.
[3] MDM01.
[4] MDM02.
[5] MDM WS at [8].

list includes pharmaceuticals with a wide range of active ingredients (paracetamol, lidocaine hydrochloride, codeine phosphate, vitamin D3 and ketoprofen, for example) available in multiple different forms (such as capsules, effervescent tablets, suppositories, syrups and medicated plasters). This is supported by a list of the Opponent's pharmaceutical preparations authorised in Italy by the Italian Medicines Agency ("Agenzia Italiana del Farmaco"), accurate as of November 2023.[6]

30. Patient information leaflets and packaging shows use of the first and second marks on pharmaceutical preparations.[7] The exhibits are undated, but the narrative evidence is that the patient information leaflet was distributed throughout the relevant period[8] and although the packaging was photographed in November 2023, the packaging was the same or substantially similar throughout the relevant period.[9]

31. In terms of financial information, the Opponent's annual report and financial statement for the year ending 31 December 2020 provides the following turnover figures:[10]

	Italy (General)	**Foreign (General)**	**Total**
2015	131,734,714	2,772,557	134,507,271
2016	150,962,914	5,784,070	156,746,984
2017	166,286,932	7,159,989	173,446,921
2018	178,996,478	10,989,995	189,986,473
2019	176,408,703	13,751,080	190,159,783
2020	160,375,784	18,044,624	178,420,408

32. There is no explanation as to which countries "Foreign" relates to.

[6] MDM05 and MDM WS at [11].
[7] MDM03-04.
[8] MDM WS at [9].
[9] MDM WS at [10].
[10] MDM06.

33. Turnover figures specifically relating to “pharmaceutical preparations; food supplements for humans” are as follows:[11]

Year	Turnover in Euros (in excess of)
2017	153 million
2018	165 million
2019	161 million
2020	149 million

34. The turnover figures are supported by a sample of invoices, described as invoices for pharmaceutical preparations in Italy.[12] The invoices, dated between July 2017 and January 2020, include customer addresses in numerous locations – including Bologna, Matera, Trento, Nola and Cagliari – demonstrating a wide geographical spread across Italy. Each invoice totals tens, or even hundreds, of thousands of euros. Confidential figures provide the number of units sold and market share held by the Opponent for pharmaceutical preparations in 2019 and 2020; they demonstrate that over 30.7 million and 27.8 million[13] packs of pharmaceutical preparations were sold by the Opponent in Italy in 2019 and 2020, respectively.[14]

35. The Opponent’s advertising and promotional spend relating to pharmaceutical preparations is as follows:[15]

Year	Spend in Euros (in excess of)
2017	7 million
2018	9 million
2019	8 million
2020	4 million

[11] MDM WS at [15].
[12] MDM08 and MDM WS at [16].
[13] These figures do not form part of the confidentiality order.
[14] MDM12 (confidential) and MDM WS at [23].
[15] MDM WS at [17].

36. Also in relation to the Opponent's advertising and promotion, there are press articles published in Italy between 2013 and 2020[16] (in Italian but with English translations of the pertinent points provided) and attendance at international conferences in Paris, Frankfurt, Madrid and Milan between 2010 and 2022.[17] All feature one or both of the Opponent's marks. It is not immediately obvious which goods or services this evidence relates to, though the narrative evidence is that attendance at the various conferences is for the promotion of the Opponent's pharmaceutical preparations and research and development services.[18]

37. Lastly, extracts from a sample of academic papers have been provided in order to demonstrate that the Opponent "supports and funds research in the pharmaceutical, scientific and [medical] field".[19] The papers were published between May 2020 and November 2022. It is clear from the papers themselves and the narrative evidence that the research was conducted by multiple authors working in a variety of different institutions (including the University of Verona, the University of Campania and Gaetano Pini Institute (a hospital) in Milan) as well as the Clinical Research department of the Opponent, and that the Opponent provided financial support (either wholly or in part) for the research, authorship and/or publication.

Conclusions

38. I am satisfied that the evidence – comprising webpages, images of pharmaceutical packaging and patient information leaflets, invoices, financial data, and narrative evidence – demonstrates genuine use of the Opponent's first and second marks during the relevant period. Such use has been shown only in Italy, though given the marks are comparable marks and use in the EU prior to 31 December 2020 may be relevant, I am satisfied that the extent of the use in Italy up to that date is sufficient.

[16] MDM09 and MDM WS at [18].
[17] MDM10 and MDM WS at [19].
[18] MDM WS at [19].
[19] MDM11 and MDM WS at [20].

Fair specification

39. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.
>
> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or

subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

40. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the Court of Justice of the European Union ("CJEU") that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

41. The vast majority of the evidence relates to pharmaceutical preparations. Aside from broad references to research and design services on the Opponent's website, and the Opponent's support and funding of the aforementioned research papers, none of the evidence relates to such services. Those two pieces of evidence by themselves are not sufficient for me to determine the scale, frequency, nature or geographical extent of the use of the marks in relation to research or design services.

42. In contrast, those factors are clear in relation to pharmaceutical preparations: vast numbers of a variety of those goods, resulting in substantial turnover figures across Italy satisfy me that there has been genuine use in relation to the goods relied upon. Since the Opponent's second mark is relied upon only for services, the Opponent may rely solely on its first mark for the following goods:

Class 5: *Pharmaceutical preparations.*

Section 5(2)(b)

Statutory provisions

43. Sections 5(2)(b) and 5A of the Act state:

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

[…]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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

Relevant case law

44. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(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

45. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

46. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281 for assessing similarity between goods/services also include an assessment of the users and channels of trade of the respective goods/services.

47. Further, in *Kurt Hesse v OHIM*,[20] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,[21] the General Court ("GC") stated that "complementary" means:

> "…there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

48. I also bear in mind the judgment of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited*:[22]

[20] Case C-50/15 P.
[21] Case T-325/06.
[22] [1998] F.S.R. 16.

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

49. Finally, in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, the GC stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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."

50. The parties' specifications are listed in the table below.

The Opponent's specification (following proof of use)	**The Holder's specification**
Class 5: *Pharmaceutical preparations.*	Class 5: *Pharmaceutical preparations; drugs for medical purposes; biological preparations for medical purposes; medicines for human purposes; crude drug; biochemical medicines; all of the goods used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy.* Class 42: *Technological research; quality control; quality testing; cancer research for medical purposes; drug development; drug evaluation; pharmaceutical*

	research; pharmaceutical research services; medical research; development of pharmaceutical preparations and pharmaceuticals; all of the services used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy.

51. I will take each of the Holder's terms in turn, grouping terms together where I consider they can be compared together.[23]

52. I will deal first with the limitations added to both Classes of the Holder's specification, namely "*all of the goods used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy*" and "*all of the services used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy*". I consider the limitations in respect of the goods and services to be valid, however, the Opponent's goods are not restricted to use in any particular field and therefore include goods which could be used in the same therapeutic areas. Accordingly, I will not include the aforementioned limitations in the goods and services comparison unless it is necessary to inform the meaning of the preceding terms.

Pharmaceutical preparations

53. This term is identical to the same term in the Opponent's specification.

Drugs for medical purposes; biological preparations for medical purposes; medicines for human purposes; biochemical medicines.

[23] *Separode Trade Mark,* BL O/399/10.

54. Pharmaceuticals are compounds manufactured for use as medicinal drugs. Accordingly, the above terms fall within the broader term in the Opponent's specification. In accordance with *Meric,* these goods are identical.

Crude drug

55. Crude drugs are drugs derived from natural substances and used for medicinal purposes. Given that I understand crude drugs to be the foundation for many pharmaceutical products I find they fall within the meaning of the Opponent's *pharmaceutical preparations*. If I am wrong in this conclusion and they differ in their physical nature on the basis of crude drugs going through minimal processing compared to other manufactured pharmaceutical drugs, they are nevertheless highly similar: having the same use as a medicine, the same purpose of treating or preventing disease and overlapping in users, method of use (depending on the form of the drug) and trade channels. There is also an element of competition with users choosing between natural drugs and synthetic variations. These goods are either identical, in line with *Meric*, or highly similar.

Cancer research for medical purposes; drug development; drug evaluation; pharmaceutical research; pharmaceutical research services; medical research; development of pharmaceutical preparations and pharmaceuticals.

56. These services all relate to research, development and evaluation in the medical or pharmaceutical fields. Whilst there are differences among these terms, they can all be compared to the Opponent's goods in the same way and for the same reasons. Whilst goods and services generally differ in their nature and method of use, *pharmaceutical preparations* will go through various processes prior to manufacture, including research, development and evaluation. Accordingly, I consider there to be a complementary relationship between the Holder's services and the Opponent's goods on the basis that the former are important for the latter and consumers may expect a provider of pharmaceutical preparations to have also conducted its own research, development and evaluation of those goods. As a result, users and trade channels may overlap, though there is no competition between the goods and services, which, overall, I find to be similar to between a low and medium degree.

Technological research; quality control; quality testing.

57. These services are, without limitation, much broader than those discussed in the previous paragraph. However, by virtue of the limitation "*all of the services used in the field of mRNA treatment or prevention of diseases, immunotherapy, cell therapy and gene therapy"* these services also fall within the medical or pharmaceutical fields. Even in the specific therapeutic areas listed in the limitation, there is no reason why these services would not form part of the research, control and testing of the Opponent's *pharmaceutical preparations.* Accordingly, the same overlapping factors identified in the previous paragraph apply here and I find the Holder's services similar to between a low and medium degree to the Opponent's goods.

The average consumer and the purchasing act

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

59. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) The average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

60. For the goods, the average consumer will fall into one of two groups: (i) a member of the general public who selects pharmaceutical goods for their own use or (ii) a medical organisation or professional who purchases them for onward distribution, potentially through a procurement process. For different reasons, both groups of consumers will pay a fairly high degree of attention to the selection; the general public are less familiar with pharmaceuticals and will therefore pay attention to ensure the product is suitable for their particular health requirements, and professionals, whilst being more accustomed to seeing these products, will pay attention given their responsibility for the health of end users. Selection of the goods will predominantly be visual, from brochures, leaflets, websites and shelves of physical stores, though there may be an aural aspect to the process in the case of word-of-mouth orders, recommendations or discussions (in person or by telephone).

61. For the services, the average consumer is likely to be a medical organisation or professional requiring the various medical or pharmaceutical services for their specific needs, again, likely chosen through a procurement process involving a multitude of considerations. As such, a fairly high degree of attention will be paid. The selection of the services will involve a visual and a verbal aspect, including by eye from brochures and websites and by word-of-mouth discussions with professionals and service providers. Therefore, visual and aural considerations are equally important.

Comparison of marks

62. 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 trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

63. 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 trade 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.

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

The Opponent's first mark	The Holder's IR
ABIOGEN PHARMA	Abogenbio

Overall impression

65. The Opponent's first mark is a composite mark. The overall impression is dominated by the word 'ABIOGEN', in a basic typeface. Centrally underneath is the word 'PHARMA', also in a basic typeface, though much smaller than 'ABIOGEN'. The mark contains stylisation in the form of a dot in the centre of the letter O and two horizontal lines either side of the word 'PHARMA'. All elements are presented in black. Due to its relative size and positioning, as well as it being an invented word (I will discuss this in more detail in the conceptual comparison), 'ABIOGEN' is the dominant, distinctive element. The word 'PHARMA' describes or strongly alludes to the goods and services at issue; combined with its smaller font, this word plays a lesser role in the overall impression. The stylisation is purely decorative and plays a minimal role in the overall impression.

66. The Holder's IR solely comprises the one word 'ABOGENBIO', in a basic, black typeface presented in title case. The overall impression resides in this sole element.

Visual comparison

67. The marks are similar in that the letters A-B-O-G-E-N appear in the same order in both (representing a large proportion of the respective dominant elements), though not consecutively: the Opponent's mark includes the letter I between the letters B and O, whereas the Holder's does not. The letters 'BIO' at the end of the Holder's IR, as well as the word 'PHARMA' and the stylisation in the Opponent's mark, create visual

differences. Bearing in mind the overall impression of the marks, I find them to be visually similar to a high degree.

Aural comparison

68. The Opponent's mark comprises six syllables: roughly, A-BI-O-GEN-PHAR-MA, in contrast to the Holder's five, A-BO-GEN-BI-O. However, on the basis that secondary or descriptive elements of marks are not necessarily spoken,[24] a significant proportion of consumers are unlikely to articulate the word 'PHARMA' in the Opponent's mark, shortening it to 'ABIOGEN'. Accordingly, when bearing in mind the syllables of the dominant elements, there is a significant overlap between each mark, and I find them aurally similar to a fairly high degree. If I am wrong and consumers do articulate the word 'PHARMA', still bearing in mind the overall impression of the marks, the aural similarity will be of a medium degree. For the avoidance of doubt, consumers may stress different syllables in each mark given they are not ordinary dictionary words, however, in my view this makes no material difference to the comparison.

Conceptual comparison

69. As noted in the overall impression, the dominant element of the Opponent's mark, ABIOGEN, will be seen as an invented word by the average consumer. The same applies to the Holder's IR, ABOGENBIO. Whilst the average consumer may notice the word 'BIO' within the marks, when it is subsumed within a longer, invented word, it is highly unlikely the average consumer will dissect the marks in this manner to associate either with the meaning of 'BIO' (i.e. a prefix meaning 'life' which is commonly used in medicine), which is allusive for the goods and services at issue. Similarly, whilst 'PHARMA' will likely be perceived as a prefix pertaining to pharmaceuticals or pharmacology, given it is descriptive or highly allusive for the goods and services, this is not a strong conceptual hook for the average consumer. When considering the marks as wholes and bearing in mind their distinctive and dominant components, I find no conceptual similarity between them.

[24] See the comments of Mr Phillip Johnson, sitting as the Appointed Person, in the decision BL O/1141/25 at [15]-[17].

Distinctive character of the earlier mark

70. In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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)."

71. 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/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

72. I will assess the inherent position first. The Opponent's first mark comprises the invented word 'ABIOGEN', the descriptive/allusive word 'PHARMA' and some stylisation. The combination of these elements, but particularly the dominant and

distinctive word ‘ABIOGEN’, leads me to find a high degree of inherent distinctiveness in the Opponent’s first mark.

73. Turning to whether the distinctiveness of the first mark has been enhanced through use, I consider the Opponent’s evidence of use, summarised for the purpose of my genuine use assessment earlier in this decision. The relevant public, and therefore the relevant territory, for this assessment is the UK. Returning briefly to the Opponent’s evidence: the list of pharmaceutical preparations includes those authorised by the Italian Medicines Agency; all of the invoices are addressed to customers in Italy; the press articles were published in Italy; and none of the international conferences took place in the UK. Whilst the promotional spend referred to earlier is not explicitly stated as relating solely to Italy, neither is it explained what proportion, if any, was spent on UK advertising. Finally, save for figures referred to as “foreign” – for which there is no suggestion these include, or are limited to, the UK – the turnover relates solely to Italy. On the basis that there is minimal, if any, evidence of use in the UK, I do not find that the distinctiveness of the Opponent’s first mark has been enhanced through use in the relevant territory.

74. For the avoidance of doubt, the number of UK visitors to Italy and the number of Italian visitors to the UK,[25] does not alter my finding: such evidence does not tell me what proportion of the relevant public were exposed to the Opponent’s first mark nor whether they associate that mark with goods and services coming from one undertaking.

Likelihood of confusion

75. 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 consumers 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

[25] See JV WS at [5]-[9] and JV01-05.

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 Opponent's first mark, 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 he/her has retained in his/her mind.

76. I have found the Opponent's first mark and the Holder's IR to be visually similar to a high degree, aurally similar to a fairly high degree (or to a medium degree if consumers articulate 'PHARMA'), but to have no conceptual similarity. I have found the goods and services to vary in similarity from low to medium, to identical. I have found the Opponent's first mark to possess a high degree of inherent distinctive character. I have identified the average consumer to be either a member of the general public or a medical organisation or professional. Both groups of consumers will pay a fairly high degree of attention to the selection of the goods and services. In the case of the goods, the selection will be predominantly visual (though not discounting aural considerations) and for the services, visual and aural considerations are equally important.

77. I will deal with direct confusion first. Notwithstanding the lack of conceptual similarity between the marks, the extent of their visual and aural similarities leads me to conclude that consumers will misremember 'ABOGENBIO' for 'ABIOGEN', or vice versa. The descriptive or strongly allusive nature of the word 'PHARMA' and the purely decorative role of the stylisation in the Opponent's first mark means these differences are likely to be overlooked or forgotten by the average consumer. What remains are two invented words, which have significant visual and aural similarities, with no conceptual hook for consumers to remember them by. Despite the high degree of attention paid by consumers, the structure and composition of the letters A-B-O-G-E-N leads me to conclude that the letters that differ will be misremembered. Taking all of this into account, I find a likelihood of direct confusion between the Opponent's first mark and the Holder's IR. On account of the interdependency principle, I consider this

applies to all of the goods and services, even those for which I have found only a low to medium degree of similarity.

78. For completeness, I will also consider indirect confusion, which was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc:*[26]

> "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 recognised 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 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

[26] BL O/375/10.

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).”

79. The examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.[27]

80. In my view, if I am wrong in my finding of direct confusion on the basis of consumers not overlooking the word ‘PHARMA’ or the stylisation in the Opponent’s first mark, there is a likelihood of indirect confusion whereby consumers nonetheless misremember the word ‘ABOGENBIO’ for ‘ABIOGEN’, or vice versa and assume that the aforementioned differences, given their descriptive/allusive nature or decorative role, are down to a sub-brand relating to pharmaceuticals, thus believing the undertaking to be the same or related. There is a likelihood of indirect confusion for all goods and services, due to the interdependency principle.

Outcome

81. The Opponent’s claim under section 5(2)(b) succeeds in full.

Section 5(3)

Statutory provisions

82. Section 5(3) states:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark […]

[27] See *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17 at [81] to [82].

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

83. Section 5(3A) states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

Relevant case law

84. 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'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and 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; G*eneral 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 Saloman, 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'Oréal 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 proprietor 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'Oréal v Bellure).*

85. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the Opponent must satisfy me that its marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the Opponent's marks being brought to mind by the Holder's IR. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/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

86. In *General Motors,* Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

87. I can deal with this ground fairly swiftly. The Opponent relies on its first and second marks as set out earlier in this decision. Firstly, I did not find genuine use for the second mark in relation to the services relied upon, leaving only the first mark at issue. Secondly, when considering the evidence in relation to enhanced distinctiveness, I explained that it overwhelmingly shows use outside the UK. The Opponent's first mark is a comparable mark and so a reputation in the EU, and even in a single member state, may be sufficient to demonstrate the requite reputation for section 5(3).[28] However, whilst the evidence may show a reputation in Italy, and proceeding on the basis that it does, it is still necessary for the Opponent to prove that there is an awareness of the first mark in the UK to support a finding that the relevant UK public will make a link between that mark and the Holder's mark.

88. In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU held that:

> "If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.

[28] *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07.

> It is apparent from the court's judgment that "a commercially significant part of the [relevant] public" is intended to cover a lesser, but still significant, degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by a third party. This is confirmed by versions of the judgment in other languages. The French version says that a "commercially non-negligible" part of the relevant public in the Member State must be aware of the earlier CTM (now: EUTM) and make a link with the later national trade mark.
>
> It follows that where there is no awareness of the EU trade mark in the UK, or only a negligible level of awareness of it, the relevant UK public will not make the necessary 'link' between the EU mark and the later national mark. Consequently, the use of the national mark will not take unfair advantage of, or be detrimental to, the [EU] reputation and/or the distinctive character of the EU trade mark."

89. There is no evidence to show sales in the UK, any use of the first mark, or any awareness of the first mark by the UK public. There is evidence of UK/Italy visitor figures but, as explained in my enhanced distinctiveness assessment, this tells me nothing of the specific awareness of the mark at issue by the UK public. Therefore, notwithstanding any reputation the Opponent may have established in Italy, I see no reason to conclude that a link would be made in the minds of a significant part of the relevant UK public between the Opponent's first mark and the Holder's mark. There is no link and without a link none of the types of damage could arise.

Outcome

90. The section 5(3) ground of opposition fails.

CONCLUSION

91. The opposition has succeeded under section 5(2)(b) and, subject to any successful appeal against this decision, the designation of the IR in the UK is refused in full.

COSTS

92. The Opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.[29] I award the following:

Preparing a statement of grounds and considering the counterstatement	£250
Preparing evidence	£600
Preparing for and attending a hearing	£700
Official fee	£200
Total	**£1750**

93. I therefore order Suzhou Abogen Biosciences Co, Ltd. to pay Abiogen Pharma S.p.A. the sum of £1750. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 30th day of August 2026

MRS E FISHER
For the Registrar

[29] The proceedings commenced before 1 February 2023.