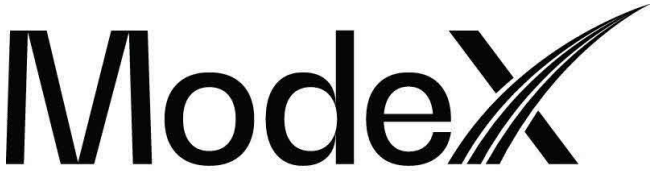
O/0948/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 04037266
BY MODEX THERAPEUTICS, INC.
TO REGISTER AS A TRADE MARK:



IN CLASSES 5 & 42

AND

OPPOSITION THERETO
UNDER NO. 600003450 BY
MADDOX PHARMA SWISS GMBH

Background & Pleadings

1. ModeX Therapeutics, Inc. ("**the applicant**"), applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed on 10 April 2024 and was published on 28 June 2024 in respect of the following goods and services:

> **Class 5:** Pharmaceuticals, therapeutic pharmaceuticals; immunopharmaceuticals; vaccines; therapeutic vaccines; antibodies; antibodies for medical purposes; multi-specific immunotherapeutic compositions for cancer and infectious diseases.
>
> **Class 42:** Medical research; Research and development of pharmaceuticals; research and development services in the field of antibodies, and immunotherapies for the treatment of cancer and infectious diseases; research, development, engineering and testing services in the fields of immunopharmaceuticals and vaccines; pharmaceutical research and development; vaccine research and development services; research and development in the field of immunotherapy.

2. On 27 September 2024, Maddox Pharma Swiss GmbH ("**the opponent**") opposed (using the Fast Track provisions) the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act")[1]. The opponent is the proprietor of the UK registration number 03747289 for the following mark:

MADDOX

[1] 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.

3. The mark was filed on 25 January 2022 and registered on 8 July 2022. The opponent relies on the following goods:

> **Class 3:** cosmetics.
>
> **Class 5:** Pharmaceutical preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides, herbicides; Mineral food supplements; Dietary food supplements; Food supplements for medical purposes.

4. Under Section 6(1) of the Act, the opponent's mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

5. The opponent, in its notice of opposition, claims that the competing marks are aurally almost identical and visually highly similar for identical and similar goods and services, giving rise to a likelihood of confusion.

6. The applicant filed a defence denying that the marks are similar and that "*all of the goods/services covered by the Application are either identical or similar to the goods relied on by the Opponent in this opposition.*" The applicant requests that the opposition be dismissed in its entirety and an award of costs be made in its favour.

Papers Filed and Representation

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. On 7 January 2025, the applicant sought leave to file evidence and be heard orally. The Registry issued a preliminary view on 23 January 2025, granting the applicant leave to file evidence while refusing the applicant's request for leave to hold an oral hearing. However, the applicant objected to the Registry's preliminary view, and the matter was discussed at the CMC, which took place on 25 February 2025. In my post-CMC letter issued on 6 March 2025, I upheld the Registry's preliminary view refusing the applicant's request to grant leave for an oral hearing as insufficient reasons were provided by the applicant to deem an oral hearing as necessary or proportionate without prolonging these fast-track proceedings further.

10. The applicant's evidence comes in the form of two witness statements from: 1) Mr Gary Nabel, the President and CEO of the opponent, whose witness statement is dated 18 February 2025 and is accompanied by seven exhibits (Exhibit 1-7); and 2) Ms Sophie Maughan, a Chartered Trade Mark Attorney at Cleveland Scott York LLP (the legal representative of the opponent in these proceedings), whose witness statement is dated 24 February 2025 and is accompanied by 17 exhibits (Exhibit SM1-SM17). I note that Mr Nabel's evidence focuses on the applicant's R&D and investment activities in developing pharmaceutical products to demonstrate that both marks have been used in the UK market without confusion. In addition, Ms Maughan's evidence aims to shed light on the meaning of the competing marks.

11. Both parties filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. This decision has been taken following a careful consideration of the papers.

12. In these proceedings, the opponent is represented by Liesegang & Partner GmbH, and the applicant is represented by Cleveland Scott York.

Decision

Section 5(2)(b)

13. Section 5(2)(b) of the Act is as follows:

> "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".

14. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):

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

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

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

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

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

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

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

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

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

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

k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods and Services

15. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union ("CJEU") stated that:

> "23. In assessing the similarity of the goods or services concerned, […], 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 complementary."

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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."

17. In *YouView TV Ltd v Total Ltd,* [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words of phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

> "[…] there is a 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."

19. The General Court ("GC") confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

20. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "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."

21. The competing goods and services are as follows:

Opponent's goods	Applicant's goods & services
Class 3: cosmetics. **Class 5:** Pharmaceutical preparations; sanitary preparations for medical purposes; dietetic substances	**Class 5:** Pharmaceuticals, therapeutic pharmaceuticals; immunopharmaceuticals; vaccines; therapeutic vaccines; antibodies; antibodies for medical purposes; multi-specific immunotherapeutic

adapted for medical use, food for babies; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides, herbicides; Mineral food supplements; Dietary food supplements; Food supplements for medical purposes.	compositions for cancer and infectious diseases. **Class 42:** Medical research; Research and development of pharmaceuticals; research and development services in the field of antibodies, and immunotherapies for the treatment of cancer and infectious diseases; research, development, engineering and testing services in the fields of immunopharmaceuticals and vaccines; pharmaceutical research and development; vaccine research and development services; research and development in the field of immunotherapy.

22. The opponent claims that the competing goods are identical and/or highly similar and the contested services are similar to an average degree to the earlier goods in Class 5.

23. Within its written submissions, the applicant admits that: the contested terms "*Pharmaceuticals, therapeutic pharmaceuticals; immunopharmaceuticals*" in Class 5 are identical to the opponent's "*pharmaceutical preparations*"; and the contested terms "*antibodies; antibodies for medical purposes; multi-specific immunotherapeutic compositions for cancer and infectious diseases*" in Class 5 are similar to the opponent's "*pharmaceutical preparations*". Given the applicant's admission, strictly speaking, there is nothing for me to decide. That said, I will need to assess the degree of similarity between the goods.

24. Further, the applicant submitted that "*the remaining goods/services of the Application fall in class 42, a class not covered by the Opponent's Trade Mark*." However, I note that the remaining goods, namely "*vaccines; therapeutic vaccines*", fall in Class 5, rather than Class 42 as the applicant indicated. I consider this to be a simple error or oversight, and I will construe it as a denial of any similarity for those goods and Class 42 services.

25. For the avoidance of doubt, pursuant to Section 60A(1) of the Act, goods or services are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.

26. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[2]

Class 5

Vaccines; therapeutic vaccines; antibodies; antibodies for medical purposes; multi-specific immunotherapeutic compositions for cancer and infectious diseases

27. The contested terms could regulate, stipulate or modify the immune system to help prevent or treat disease, including infections and cancer. I note that the opponent's term "*pharmaceutical preparations"* is a broad term that would include a wide range of goods with therapeutic properties. In this regard, the competing terms could share the same nature and purpose, preventing and/or treating disease. They could also share the same method of use (e.g. injection or oral intake), trade channels, such as pharmacies, and the same users, namely medical professionals and patients. Further, it is common that they may come from the same

[2] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

providers, i.e. pharmaceutical companies, which develop and manufacture a diverse range of medical products with various therapeutic purposes. Therefore, I find the competing terms to be similar to a high degree.

Class 42

Medical research; Research and development of pharmaceuticals; research and development services in the field of antibodies, and immunotherapies for the treatment of cancer and infectious diseases; research, development, engineering and testing services in the fields of immunopharmaceuticals and vaccines; pharmaceutical research and development; vaccine research and development services; research and development in the field of immunotherapy.

28. The contested services largely concern the provision of research and development in the medical field. The opponent directed me to the GC decision of *Emcur Gesundheitsmittel aus Bad Ems GmbH v EUIPO*, Case T-165/17, where the GC found that the Board of Appeal had erred in finding Class 5 goods[3] and Class 42 services[4] to be dissimilar. Thus, the GC concluded that "*the Class 42 services are closely connected to pharmaceutical products*",[5] while stating that "[*i*]*t follows that the relevant public is likely to believe that the same undertaking is responsible for providing those services and manufacturing those goods*."[6] I also note that the opponent refers me to the GC ruling in *AMS American Medical Systems (AMS Advanced Medical Services) v EUIPO,* Case T-425/03. At

[3] Namely "*Pharmaceutical products, except pharmacy-only preparations against cardiovascular diseases, immunotherapeutic agents, cytokines and cancer-inhibiting substances (cytostatics and metastasis inhibitors); veterinary products, phytopharma, medicinal teas, preparations for health care, dietetic substances for medical purposes and food supplements*".

[4] Namely "*chemical research; chemical analysis; biological and pharmaceutical research; bacteriological research; biological research; scientific and technological services and research*".

[5] At paragraph 50.

[6] Ibid.

this point, I note that I am not bound by the findings of the GC in respect of similarity between goods and services.

29. On the other hand, the applicant denied any similarity, arguing that the goods and services have different physical natures, trade channels, methods of use, uses, and they are not in competition or complementary. The applicant also claimed that even if similarity is found, that would be of a low degree.

30. I accept that there will be complementarity between the earlier goods "*pharmaceutical preparations*" in Class 5 and the contested Class 42 services. This is because the opponent's goods may be the subject of research services, and as a result, the competing goods and services will be important for each other. Therefore, the public will believe that they could be provided by the same or commercially linked undertakings. In addition, although the competing goods and services will differ in nature, they share the same users (such as medical professionals), and there may be shared distribution channels (or a perception of shared distribution channels, as outlined in *Emcur* above). Consequently, I find that there is a low degree of similarity between the earlier goods and the contested services.

Average Consumer and the Purchasing Act

31. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

> "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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

32. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the GC considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in Class 5. It said:

> "39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis* v *OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma* v *EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).
>
> 40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be

regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 […]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness."

33. The average consumer for the goods will be a member of the general public or medical professionals. I consider that the goods may either be obtained via a prescription or could be sold over the counter. The purchase process of the goods at issue is likely to be dominated by the visual aspect for both sets of consumers. However, I do not discount the possibility that there may be an aural element to the purchasing process as prescriptions are often requested orally in a pharmacy. As highlighted above, the goods are in relation to the user's health, and the members of the general public would pay a higher than medium degree of attention during the purchasing process, while the medical professionals will pay a high degree of attention.

34. As for the services, the relevant consumer is a professional, who is a specialist in the field, having a level of attention that is particularly attuned to the specialist subject, and therefore is considered to have a higher than medium degree of attention. The purchasing process will also be dominated by the visual aspect as research includes the discovery of

information. However, I do not discount the possibility of an aural element due to the undoubted verbal exchange of information.

Comparison of Trade Marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

37. The marks to be compared are:

Earlier Mark	Contested Mark
MADDOX	

Overall Impression

38. The earlier mark is a word mark. Registration of a word mark protects the word itself.[7]

39. The contested mark consists of the word element "Mode" in a standard typeface and black font, followed by a figurative element which resembles a highly stylised letter 'X'. The first letter "M" is capitalised and appears to be twice the size of the other letters. Further, the highly stylised letter 'X' features a diagonal line topped with three curved lines that extend from the bottom left to the top right corner, all converging at a single point. Despite there being no space between "Mode" and the highly stylised "X", it is my view that they present as two separate elements due to the prominence of the highly stylised "X" letter. The two elements retain independent, distinctive character within the mark, but by virtue of the size, I consider that the overall impression of the mark lies in the combination of both elements.

Visual Comparison

40. The earlier mark consists of six letters, whereas the contested mark consists of four letters and a figurative element, which is nevertheless intended to represent a highly stylised "X". I bear in mind, as a rule of thumb, that the beginnings of marks tend to have more impact than the ends.[8] In this regard, the competing marks share the sequence of letters "M" and "D" in positions one and three, respectively, and both end with the letter 'X' (albeit in different positions), while differing in the remaining letters (MADDOX/ModeX). Although it is not legitimate to perform a comparison between a word mark and a stylised mark by considering specific ways in

[7] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[8] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

which the words might be presented, the typeface[9] and colour[10] in which the contested mark is presented in this case do not provide a point of distinction in themselves. I note that although the figurative element in the contested mark resembles a highly stylised "X", the presence/absence of the stylisation in the competing marks will be a point of difference. Taking into account the overall impression of the marks and the similarities and differences, I consider that the marks are visually similar to a low to medium degree.

Aural Comparison

41. While both parties seem to agree on the number of phonetic syllables and the pronunciation of the first syllable in the marks, they differ in how they articulate the contested mark. In summary, the opponent asserts that the mark will be pronounced as "MO-DEX", whereas the applicant contends it will be pronounced "MODE-X".

42. While I keep in mind that the figurative element at the end of the contested mark will closely resemble a highly stylised 'X' letter, it is my view that the earlier mark will be pronounced as "MAD-DOX" and, because of the high stylisation, a significant proportion of relevant consumers will pronounce the contested mark as "MODE-X". Although the syllables share similar sounds due to the overlapping M, D, and X consonants, the articulation of the vowels in the marks will create a difference in the pronunciation. Specifically, the first syllable of the contested mark, "MODE", has a more elongated vowel sound, in contrast to the shorter vowel sound present in the first syllable of the earlier mark. Thus, I find that the marks are aurally similar to a low to medium degree.

43. For completeness, I consider the possibility that a small minority of consumers may verbalise the respective marks as "MAD-DOX" and "MO-

[9] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

[10] See *Specsavers* [2014] EWCA Civ 1294; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290.

DEX". Again, in this case, the marks will share the same consonants. Although the vowel sounds differ, they are likely to be shorter, which could limit the distinction between them. On this basis, I find that the marks are aurally similar to a medium degree.

Conceptual Comparison

44. The applicant submitted that:

> "24. **Conceptually**, consumers will interpret the Opponent's Trade Mark Maddox as a name that can be both a surname and a forename (like names such as "Hunter" and "Jackson", which can function as both surname and forename). The Applicant has filed evidence that shows that Maddox can and does function as a surname in the UK (see Exhibits SM1 and SM2). Furthermore, evidence filed by the Applicant shows that the forename Maddox has grown in popularity in the UK in recent years due to its connection with celebrity culture following Angelina Jolie choosing the name for her first adopted son in 2002 (see Exhibits SM2 to SM5). The Opponent's Trade Mark will therefore be recognised as a person's name.
>
> 25. Conceptually, consumers will interpret the Application as comprised of the word "Mode" followed by "X". This is due to the fact that the "X" is of such a size compared to the other letters in the mark to show that it is capitalized and due to the fact that the "X" has a stylisation as described above, which is much more distinct that the plain sans serif font of the "Mode" element of the mark. "Mode" is a dictionary word meaning a way of doing something, as shown in the Applicant's evidence (see Exhibits SM6 and SM7). Evidence filed by the Applicant demonstrates that consumers in the UK are accustomed to trade marks comprised of a dictionary word combined with the suffix "X" (pronounced as the letter "X", i.e. as "eks"). Examples of such trade marks include SpaceX, TEDx, Gas-X, Rain-X etc (see Exhibits SM8 to SM15). SpaceX and TEDx are particularly famous examples of such trade marks composed of a dictionary word with an

"X" suffix pronounced "eks", as demonstrated by the evidence showing the renown of these marks in the UK (see Exhibits SM9 and SM11)."

45. The opponent initially claimed that the contested mark may be read as "Modex", having "*no apparent meaning on its own*". However, in its submissions, the opponent appears to have accepted the applicant's position regarding the conceptual comparison of the marks, stating that:

> "The mere fact that the opposing trademark "MADDOX" may be considered a common name does not, in itself, establish that the mark is non-distinctive or descriptive for the registered goods. Such a conclusion is not supported by any inherent characteristic of the mark.
>
> The same applies to the suffix "X" or the term "MODE". Even if "MODE" is a dictionary word, or if a dictionary word is combined with the suffix "X", this does not prove that there is no likelihood of confusion. Similarly, it does not establish that the relevant public perceives the suffix "X" or the word "MODE" as generic for the goods and services covered by the conflicting trademarks."

46. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

47. Considering that both parties agree on the meanings of the marks, I note that the earlier mark, "MADDOX", will be seen as a name/surname,[11] and the contested mark as the ordinary and dictionary word "Mode" followed by the highly stylised 'X' letter, which will be perceived as such. In circumstances where the contested mark is seen as the conjoined word "ModeX", I note that the average consumer will invariably break it down

[11] See also Exhibits SM1-SM5.

into components that suggest a meaning, or resemble words known to them, and, therefore, the word may still be capable of having a conceptual identity.[12] Therefore, I consider that consumers will interpret each of the components ("Mode-" and "-X") in the same manner as advanced above. Regardless of whether the verbal elements of the contested mark are viewed as a conjoined word or not, I find that the competing marks are conceptually dissimilar.

Distinctive Character of the Earlier Trade Mark

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> "In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 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

[12] *Vitakraft-Werke Wührmann v OHIM – Krafft* (VITAKRAFT), Case T-356/02, para 51, and *Mundipharma v OHIM – Altana Pharma* (RESPICUR), Case T-256/04, para 57.

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

49. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

50. 33. The opponent has not shown use of its mark and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of the word "MADDOX", which will be seen as a name/surname. The applicant provided evidence, with which it shows how common the name "MADDOX" is in the UK. Based on its ranking (344 out of 4789) in Exhibit SM4, the name "MADDOX" appears to be relatively common but not overly so. Therefore, I find that the earlier mark is inherently distinctive to a medium degree.

Likelihood of Confusion

51. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[13] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

[13] See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.[14]

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

53. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), sitting 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."

54. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion

[14] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

55. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in Bimbo, on the court's earlier judgment in *Medion v Thomson*. He stated:

> "18 The judgment in Bimbo confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance

which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

56. The comments of Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, are also appropriate in this matter as he considered the relationship between the average consumer and the likelihood of confusion. He concluded that:

> "34. […] v) if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

57. Earlier in this decision I have concluded that:

- the competing goods and services at issue are identical and similar ranging from a high to low degree;

- the average consumer for the goods at issue will be a member of the general public and medical professionals, and the selection process is predominantly visual without discounting aural considerations. The level of attention paid by the general public will be higher than a medium degree and by professionals will be high;
- the competing marks are visually similar to a low to medium degree; aurally similar to a low to medium degree (for the significant proportion of consumers), and conceptually dissimilar;
- the earlier mark has a medium degree of inherent distinctiveness.

58. Taking into account the above factors and considering the identical goods in play, there is no likelihood of direct confusion. Notwithstanding imperfect recollection, the contested mark, in this instance, has a strong and immediate concept, which will be understood as the commonplace word “Mode” followed by the highly stylised “X” letter, in contrast to the earlier mark, which will be viewed as a name/surname. Thus, the lack of a conceptual “hook” or a “semantic bridge” between the two marks will enable the average consumer to effectively distinguish between them, thereby counteracting their visual or aural similarities. In addition, I note that the visual component will dominate the selection process of the goods at issue. This factor together with the higher than a medium degree or the high degree of attention paid by the consumers in this case will enable the consumers to not overlook the differences in the marks. Therefore, the competing marks will not be mistakenly recalled or misremembered as each other.

59. Turning now to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. I see no reasonable basis on which the consumer would be induced to believe that the competing marks are variants or sub-brands of each other nor that the goods and services in question are from the same or economically linked undertakings. Even if the average consumer recalls the points of similarity between the marks, such as that they share the common letters (M, D, and X), I still consider the marks would not be indirectly confused.

Despite the shared letters, the average consumer will recall the marks as a whole.[15] The word elements in the contested mark, "ModeX" (with a highly stylised 'X' letter), convey a different meaning from the earlier mark, "MADDOX". I see no reason why a common origin or an economic connection would be assumed, and so I find that, even where the goods are identical, there is no likelihood of indirect confusion.

60. The above findings extend to the competing goods and services which I found to be similar at any degree.

Final remark

61. I note that the applicant contended that it had used the contested mark in the UK as early as 2023 and that the competing marks had coexisted in the UK without the opponent being able to report any instances of confusion. I note that actual confusion by consumers is not relevant. Although evidence of actual confusion may be persuasive where it exists, the absence of confusion on the marketplace is rarely significant.[16] Against this background, and given the outcome of the opposition, such a defence would not have assisted[17] or put the applicant in any better position, and I will say no more.

[15] Case BL O/547/17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017).

[16] See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, at paragraph 80.

[17] I keep in mind the recent decision BL O/0662/25 of Mr Phillip Johnson, sitting as the AP, where he stated that: "*29. To establish co-existence it is necessary for there to be evidence that both the earlier and later mark are used in the same marketplace at the same time in a way which would (in the absence of evidence) be seen as giving rise to a likelihood of confusion. 30. Accordingly, it is not possible to establish peaceful co-existence with an earlier mark which has not been used (ie where it is less than 5 years old; and so attracts no requirement to prove use). […]*"

Outcome

62. The opposition under Section 5(2)(b) of the Act is **unsuccessful in its entirety**. Therefore, subject to any successful appeal, the application can proceed to registration.

Costs

63. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the other side's statement and preparing a counterstatement	**£250**
Preparing and filing evidence and written submissions	**£350**
Total	**£600**

64. I, therefore, order Maddox Pharma Swiss GmbH to pay to ModeX Therapeutics, Inc the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of October 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General