BL O/1035/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3842545
BY ORIENTAL YEAST CO., LTD.
TO REGISTER THE TRADE MARK:

MatriCOAT

IN CLASS 1

-AND-

THE OPPOSITION THERETO UNDER No. 440311
BY CORNING INCORPORATED

Background and pleadings

1. On 25 October 2022 ORIENTAL YEAST CO., LTD. (**"the Applicant"**) applied to register the word only trade mark 'MatriCOAT' in the UK. It was accepted and published in the Trade Marks Journal on 20 January 2023. Registration is sought for the following goods:

> Class 1
>
> *Chemical test reagents for cell and microbiological research use, other than for medical and veterinary purposes.*

2. On 13 April 2023 Corning Incorporated (**"the Opponent"**) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (**"the Act"**). The opposition is directed at all the applied-for goods. The Opponent relies on its registrations for the word marks 'MATRIGEL' and 'BIOCOAT', details of which are set out below:

Representation of the mark:	MATRIGEL
UK trade mark registration No.:	1542938
Filing date:	27 July 1993
Registration Date:	5 January 1996
Goods: Class 1 *Chemical reagents; biological cell culture substrates; culture media; cell growing medium; basement membrane extracts; chemicals and chemical preparations for use in the laboratory for "in vitro" testing and the like scientific purposes; all included in Class 1.*	

Representation of the mark:	BIOCOAT
Comparable UK trade mark (EU) registration No.:[1]	900348946
Filing date:	1 October 1996
Registration Date:	3 March 1999
Goods: Class 1 *Chemical preparations for scientific purposes.*	

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 'IP Completion Day, i.e. before 1 January 2021, were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

3. By virtue of the earlier filing dates, the trade marks upon which the Opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had been registered for more than five years at the filing date of the contested mark, they are both subject to the use conditions pursuant to section 6A of the Act, and as 'BIOCOAT' is a comparable trade mark (EU) it is additionally subject to the provisions set out in Schedule 2A, Part 1, paragraph 7 of the Act. Accordingly, the Opponent made a statement that it has used its marks in relation to all of the goods for which its marks are registered.

4. The Opponent argues that the contested mark is similar to its earlier marks and that the respective goods are identical or similar, giving rise to a likelihood of confusion. In its statement of grounds the Opponent submits that the contested mark and its earlier mark 'MATRIGEL' *"share the identical prefix 'Matri-', and the elements 'gel' and 'coat' do not detract from the clear similarities"*; and that the contested mark and its earlier mark 'BIOCOAT' *"share the identical suffix '-COAT', and the elements 'Matri-' and 'BIO-' do not significantly detract from the clear similarities, given the applicant's emphasis of the element COAT with lowercase and capital letters."*

5. The Applicant filed a defence and counterstatement and requested the Opponent prove use of the earlier marks in relation to all the goods for which they are registered and relied upon. In its defence and counterstatement the Applicant submitted that overall *"MATRIGEL and MatriCOAT are similar to no more than a low extent"*; *"the marks BIOCOAT and MatriCOAT are not similar"*; and admitted that *"the goods covered by the prior marks are identical to those applied for"* adding that *"of course a proper more detailed comparison will in due course be made to those goods for which actual use is proven"*.

6. However, the Applicant denied any likelihood of confusion submitting that: *"the average consumer for the relevant goods is the professional scientist working in cell and microbiological research. The degree of specialisation is high and they have a high degree of care in selecting and distinguishing goods"*; *"the overall visual impression that each mark makes on the relevant public, having a high degree of attention, may be considered as clearly distinct. The comparison of marks having a somewhat descriptive common element, in a scientific field, require small differences to have a large impact"*; *"consequently, the overall impression of the marks must be*

considered different"; and that *"neither of the prior marks are sufficiently similar for there to be any likelihood of confusion".*

7. During the first stage of the evidence rounds the Opponent filed submissions and evidence in chief. The Opponent submits that the evidence demonstrates that the BIOCOAT mark has been used in relation to the goods for which it is registered i.e. chemical preparations for scientific purposes, which it considers to be identical to the applied-for goods. It also submits that the evidence clearly shows use of the MATRIGEL mark in relation to *"chemical reagents"* and since the Applicant has applied for *"chemical test reagents"* it submits that a finding that the respective goods are identical should be made.

8. The Applicant then filed its submissions, to which the Opponent responded with evidence in reply. At the end of the evidence rounds the Opponent requested a hearing.

9. A hearing took place before me on 3 June 2024, at which the Opponent was represented by Allister McManus of Elkington and Fife LLP. The Opponent filed skeleton arguments ahead of the hearing, in which it advanced an argument that the evidence shows that the MATRIGEL and BIOCOAT marks *"often feature together* [which] *only enhances the likelihood of confusion with the applicant's MatriCOAT mark".*

10. The Applicant has been represented by Sandersons throughout these proceedings, but elected not to attend the hearing, instead it filed submissions in lieu of attendance.

11. I make this decision having taken full account of all the relevant papers before me and the oral submissions made on behalf of the Opponent at the hearing.

Assimilated law

12. 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.

Preliminary Issue

13. The Applicant's combined submissions heavily criticise the Opponent's evidence, pointing to portions of the evidence in chief which are undated or dated outside of the relevant period, and therefore submits that this evidence should not be taken into account.

14. The Applicant's criticisms with regard to the Opponent's evidence in reply relate to its contention that it is not reply evidence, rather it submits that it is new evidence and should therefore not be taken into consideration.

15. Whilst I have taken into account the Applicant's criticisms, for reasons that will become apparent in my analysis and conclusions on the Opponent's evidence, I have not overlooked the undated evidence purely because it is undated. Although to a certain extent I share in the Applicant's criticism of the Opponent's evidence in chief, insofar as parts of it is indeed undated, and it is unclear in other parts whether the evidence relates to the UK, I do not lose sight of the fact that the evidence must be viewed as a whole and each piece of evidence must not be assessed on its own as to whether it shows genuine use or not.

16. Notwithstanding those shortcomings, that evidence still has value because it nonetheless provides useful information to determine what kind of products are sold under the earlier marks. This is because parts of the undated evidence can be corroborated by other parts of the evidence in chief that is in fact dated within the relevant period. I also bear in mind that later evidence still has relevance, particularly if it casts light backwards on the position during the relevant period.[2]

17. Equally, whilst I am critical that the Opponent should have put its best case upfront by providing clear evidence that was all dated within the relevant period, I have determined that the evidence in reply is, for the most part, 'in reply', and does not go substantively further to aid me in establishing what I was already able to establish by

[2] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited,* [2012] EWHC 1929 (Ch).

considering the evidence in chief alone, as a whole. Indeed, my general assessment of the evidence in reply is that, albeit some of the contents looks to be additional and/or different to the evidence in chief (and is also clearly dated), it nevertheless contains essentially the same substantive information about the Opponent's products which was already contained in the evidence in chief – it merely sets it out more clearly, which, to the Opponent's credit, is in reply to the Applicant's criticisms.

18. In this regard I take note of the provisions of the Tribunal section of the UKIPO's Manual of Trade Marks Practice, in particular part 4.8.7 which provides the following in relation to 'evidence in reply' (my emphasis for clarity):

> "The aim of 'evidence in reply' is to achieve finality in the proceedings; evidence in reply must not involve a departure from a case put in chief, but may include comment on the other side's evidence. It should not 'seek to adduce additional evidence…' (Ernest Scragg & Sons Ltd's Application (1972) RPC 679). However, it should be noted that **this is no longer a requirement of the** [Trade Mark] **Rules** [2008]. The Tribunal has the power to direct what evidence should be filed and may specify that the evidence should be limited to evidence in reply. **If the evidence is not in reply it may still be admissible as additional evidence.**"

19. Furthermore, I note that the Applicant had objected to the Opponent's request to file evidence in reply,[3] however, the Registry issued a preliminary view granting the Opponent's request. The Registry gave the Applicant an opportunity to request a hearing if it disagreed with the preliminary view, yet no hearing was requested.

20. I proceed with this decision having taken into full consideration all of the Opponent's evidence before me.

[3] As per the Applicant's correspondence to the Registry dated 21 December 2023.

DECISION

PROOF OF USE

Legislation and case law

21. The relevant statutory provisions are as follows:

Section 6A

(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.

[...]

(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.

Schedule 2A, Part 1, paragraph 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.

22. Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark.[4]

23. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*[5] as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] 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,

[4] Also see *Ferrari SpA v DU*, C–721/18, at paragraphs 73 to 83.
[5] [2023] EWCA Civ 1247.

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. […] 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].

107. […] The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166*] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council [2013] RPC 24* Daniel Alexander QC sitting as the Appointed Person said:

> 19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. …
>
> 22. … 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 … 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 undertaking, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

24. In *Awareness Ltd,* the Appointed Person goes on to say that:

> "28. […] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered […]."

25. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[6] He stated:

> "The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

26. The genuine use provision is not there to assess economic success or large-scale commercial use.[7] An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[8]

27. As regards the territorial scope of the use of an EUTM, in *Walton International,*[9] Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),[10] added the further three principles when assessing genuine use in the EU:

> "118.*The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark "in the Union". In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:
>
> (9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

[6] Case BL O/424/14.
[7] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.
[8] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.
[9] *Walton International Ltd & Anor v Verweij Fashion BV,* [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).
[10] Ibid., paragraphs 114 and 115.

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50]."

28. Therefore, the Opponent can rely on its earlier trade marks only to the extent that the evidence filed establishes that the earlier trade marks had been put to genuine use in respect of the goods for which they are registered, within the five years leading up to the date on which the contested trade mark application was filed. **The relevant period in which the Opponent must establish use of the earlier marks is therefore 26 October 2017 to 25 October 2022.**

29. I note that as the 'BIOCOAT' mark is a comparable mark (EU), use in the EU remains relevant since a part of the relevant five-year period falls prior to IP Completion Day (i.e. before 31 December 2020). Therefore the Opponent can rely upon use of the corresponding EUTM in the EU, including the UK, prior to IP Completion Day. However, any use after IP Completion Day (i.e. 1 January 2021) must relate solely to use in the UK.

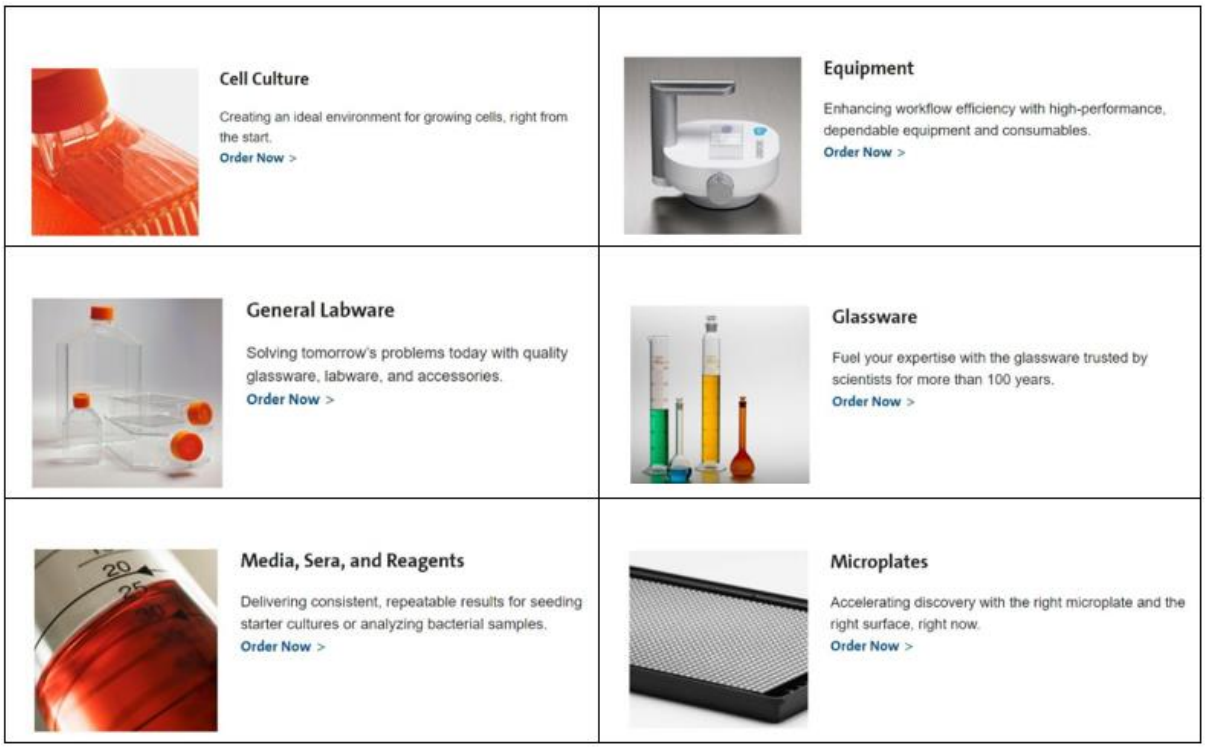
Evidence

30. The Opponent's evidence in chief is provided in the Witness Statement of Ryan T. Hardee dated 15 September 2023. Mr Hardee is the Senior Division Counsel at Corning Incorporated (i.e. the Opponent), its subsidiaries and affiliates. The Witness Statement has 9 accompanying exhibits labelled RTH1 to RTH9. Mr Hardee states that the evidence is provided to show genuine use of the two earlier marks in the UK within the relevant period.

31. The Opponent's evidence in reply is provided in a second Witness Statement of Mr Hardee dated 2 February 2024, with 6 accompanying exhibits labelled RTH10 to

RTH15. Mr Hardee states that the purpose of this evidence is to reply to the Applicant's criticisms raised against his evidence in chief.

32. By way of background, Mr Hardee states that 'Corning' is a world-renowned technology company founded in 1851 with expertise in numerous sectors, including glass science, ceramics science, optical physics and life sciences.[11] Extracts from the Opponent's website dated within the relevant period are provided by way of example of the Opponent's product portfolio. The portfolio list includes, inter alia, the following products:[12]



33. The website evidence also contains the following image:[13]

[11] He includes a link to the Opponent's website stating that more information can be found about the Opponent on the website. A website link is not evidence that has been clearly set out and presented since evidence containing website links is not acceptable. This is because the content of those links is not fixed at a particular point in time and what was at that link when the evidence was filed may not be what is there now. In any case, I am unable to undertake any independent research and so for those reasons, I cannot take this evidence into consideration. *See the 'Manual of trade marks practice – Tribunal section' – paragraph 4.8.4 'Exhibits'.*

[12] Exhibit RTH1.

[13] Exhibit RTH1, dated 20 April 2018.

34. Mr Hardee goes on to state that *"Corning provides 'high quality, innovative life science products enabling people around the world to make and deliver life changing discoveries. The MATRIGEL and BIOCOAT marks have been in use in the life sciences sector for over 30 years.* ***Corning sells biological coatings for cell culture applications under its earlier BIOCOAT mark*** *and* ***solubilized basement membrane preparations under the MATRIGEL mark****"* (my emphasis).

35. At some point during the '30 years' (although no indication as to when is provided by Mr Hardee), 'Corning' purchased the BIOCOAT and MATRIGEL brands, therefore with regard to any use of the marks in conjunction with the *"Corning name"* he states that the marks relied on are *"established independent marks/brands"*.

BIOCOAT

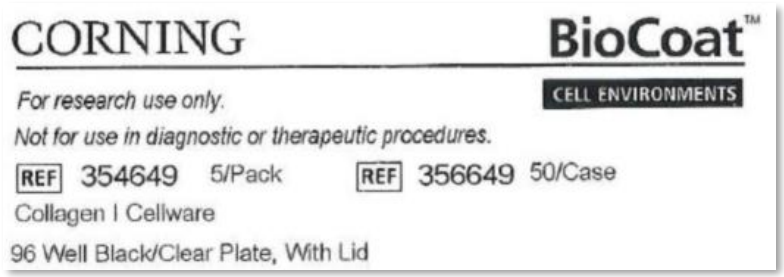
36. The BIOCOAT products are categorised in the Opponent's literature/brochures as *"Biologically-coated surfaces and extracellular matrices"* and are generally described as follows: *"Corning BioCoat™ surface options are ideal for enhanced cell attachment and growth of a variety of primary cells and transformed cell lines in serum-free or serum-containing cultures. A non-treated surface is also available for suspension or non-adherent cell culture and may also be used to study cell-cell or cell-protein interactions in an in vitro system."*[14]

37. The BIOCOAT products are identified throughout the evidence as being 'cultureware', 'cellware', and 'cell culture inserts'. A screenshot from the Opponent's website dated 21 September 2020, contains the following information about *"Corning BioCoat Surface"*:[15]

[14] Exhibit RTH8, pages 6 – 12. I note that the Oxford English Dictionary defines *"in vitro"* as follows: "Especially with reference to scientific experimentation: in a laboratory vessel, test tube, culture dish, etc.; under artificial conditions rather than in a living organism. Contrasted with *in vivo*: i.e. scientific experimentation in a living organism."
[15] Exhibit RTH2, page 3.

38. An example image (albeit undated) of some BIOCOAT products is below:[16]

39. Although the Opponent's evidence in chief lists various iterations of the BIOCOAT products,[17] either because they are coated with different formulations and/or they are in varying formats such as 'culture slides', 'culture dishes', 'flasks', 'plates' or 'microplates' for example, this evidence is largely undated. There is however dated evidence (from 25 January 2017) contained in the evidence in chief in relation to product labels for BIOCOAT product numbers '354663' / '356663' ('Poly-D-Lysine Cellware'), and '354649' / '356649' ('Collagen Cellware') – see examples below:[18]



[16] Exhibit RTH4, page 38.
[17] Exhibit RTH 5.
[18] Exhibit RTH 7, pages 3 and 4.

40. With regard to the above 'cellware' products, the Opponent's brochures refer to them as 'BioCoat cellware',[19] and they are listed for sale on the Opponent's website and described as being comprised of black polystyrene with a uniform application of either *'Poly-D-Lysine – a synthetic compound that enhances cell adhesion and protein absorption'* (product number '356663') or *'rat tail collagen'* (product number '356649'). These specific products are included in the dated invoice evidence which is detailed in my paragraphs 45 and 46. Images of these BIOCOAT 'cellware' products are below:[20]

MATRIGEL

41. Product information provided for *"Corning® Matrigel® Matrix"* describes the product as follows (my emphasis):

> *"Corning Matrigel Matrix*
>
> *Cells behave better **on** Corning Matrigel matrix – the original, trusted **extracellular matrix (ECM)**.*
>
> *Nearly 30 years ago, researchers were looking for a way to grow mouse sarcoma cells. The solution? The development of Corning Matrigel matrix, a*

[19] Exhibit RTH 8, page 8 and 9.
[20] See Exhibit RTH2, page 5 and 10. Albeit these images were taken from a website screenshot taken after the relevant period (dated 09/06/2023), the other evidence of product labelling and invoice evidence corroborates that these specific products were available during the relevant period. Therefore the fact that the images are dated after that period is of no consequence and I include these images for illustrative purposes.

solubilized basement membrane preparation <u>extracted from</u> *the Engelbreth-Holm-Swarm (EHS)* ***mouse sarcoma, <u>a tumor rich in such</u> <u>ECM proteins as laminin</u> (a major component), <u>collagen</u> IV, heparin sulfate proteoglycans, entactin/nidogen, <u>and a number of growth factors</u>.***

Today, this ***natural ECM-based hydrogel*** *is among the most widely used models for 2D and 3D* ***cell culture in vitro****, enabling you to:*

- ***Improve the attachment*** *and differentiation of both normal and transformed anchorage-dependent epitheliod cells, as well as other cell types.*
- ***Better mimic in vivo environments for*** *2D and 3D* ***cell culture*** *applications"*

42. The evidence shows that the 'MATRIGEL' product is available in the following formats:

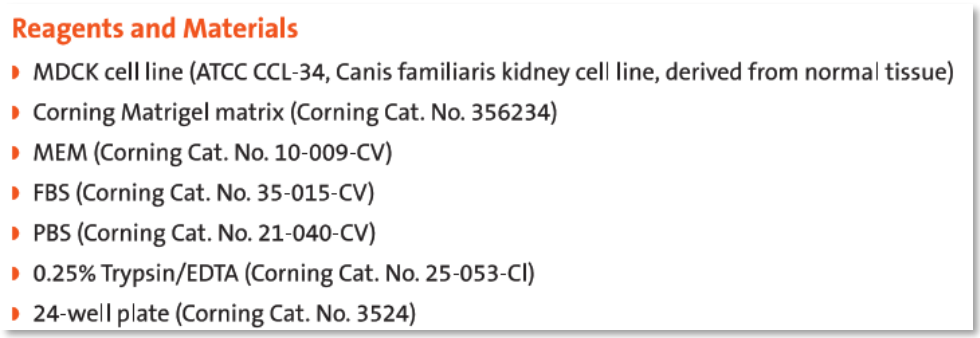
(1) <u>Vials stored at sub-zero temperatures</u>

(a) The product in this format is available in various formulations such as standard formulation; high concentration (HC); growth factor reduced (GFR); phenol red free; and hESC-qualified.[21] An example image of the vials is as follows:[22]

[21] Page 2 of Exhibit RTH3, dated 24 November 2017.
[22] Exhibit RTH2, page 2, dated 19 April 2021.

(b) Literature provided in the evidence (with a copyright notice dated 2017) provides information about the 'MATRIGEL' product and how to reconstitute it from the vials – it lists the *"reagents and materials"* necessary to carry out various protocols using 'MATRIGEL', and sets out the instructions as follows (my emphasis for clarity):[23]

> "Corning® Matrigel® basement membrane matrix is a **soluble basement membrane extract** of the Engelbreth-Holm-Swarm (EHS) mouse tumor **that gels at room temperature** to form a genuine **reconstituted basement membrane**. […]

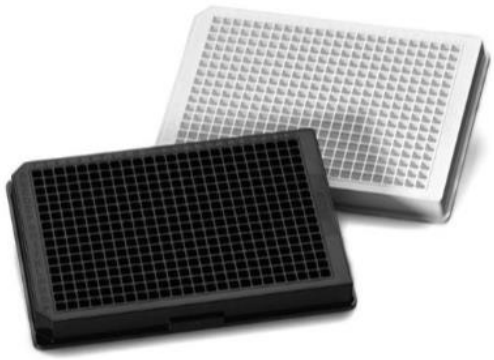


> Protocol 1. […]:
>
> 1. Thaw Matrigel matrix overnight […].
> 2. […] add [it] into each well of a pre-chilled well plate […] then incubate […] to allow the Matrigel matrix **to gel**. Note: **All cultureware or media coming into contact with Matrigel matrix** should be pre-chilled/ ice-cold […] do not overdry the Matrigel matrix during the **gel process**. […]
>
> Protocol 2. […]:
>
> 1. […]
> 2. […] Note: **Keep all <u>cultureware</u> and <u>reagents coming into contact with Matrigel</u> matrix on ice** during the entire operation process. […]."

[23] See the Opponent's evidence in chief, Exhibit RTH5, pages 34 and 35.

(2) Pre-coated 3D plates

The literature states that (my emphasis) *"Corning is pleased to offer **Matrigel matrix-3D plates**, a **pre-coated, ready to use option** available in 96-well and 384-well formats, **Matrigel matrix is pre-dispensed into each well** of these high throughput formats **to support successful 3D cell culture**. […] This **convenient, off-the-shelf option** helps researchers improve productivity […]. The Corning® Matrigel® matrix-3D plates **provide an in vitro assay that allows for growth of cells in 3D for drug discovery applications**."*[24] An image of this product is below.



(3) Various *"BioCoat Options"*

Such as cell culture well plates, inserts for well plates and culture dishes (i.e. petri dishes) all pre-coated with the MATRIGEL product. The BIOCOAT products coated with MATRIGEL (as opposed to other matter identified in the literature such as gelatin, laminin and collagen) are marketed as **'Biocoat Matrigel'**. One particular example is a product called *"BioCoat™ Matrigel™ Invasion Chambers"* which are described as being *"useful for the study of cell invasion of malignant and normal cells.* […] *The Invasion Chambers consist of a Corning Falcon™ Cell Culture Insert with* [a] *PET membrane, uniformly **coated with Corning Matrigel™ Matrix**, packaged ready-to-use in 24 well formats"*.[25] The Opponent's evidence in reply includes references to these products on its website, dated 28 August 2018,[26] and 27 May 2022.[27] These products are also included in the

[24] See the Opponent's evidence in chief, Exhibit RTH5, page 28.
[25] Exhibit RTH8.
[26] Exhibit RTH11, page 6.
[27] Exhibit RTH10, page 76.

Opponent's invoice evidence dated within the relevant period, which was provided in its evidence in chief.[28]

43. Mr Hardee exhibited a copy of a 2022-2024 catalogue produced by one of *"Corning's UK distributors"* in his evidence in reply.[29] It lists several 'Corning' branded products including *"Corning® CoolRacks™"* (an image of which is included below for illustrative purposes). In particular, the catalogue states that one of the applications for this product is to cool MATRIGEL. The specific wording refers to MATRIGEL as a *"reagent"* as follows (my emphasis for clarity): *"Applications include: Cooling* ***reagents such as ECMs, like Corning® Matrigel® matrix*** […]*."* As detailed above, 'ECM' is an abbreviation for the term 'extracellular matrices'.

Revenue

44. Sales revenue figures have been provided in the form of two tables prepared by Mr Hardee (see below). He states that they show the Opponent's *"total UK sales revenue of MATRIGEL and BIOCOAT in relation to the relevant goods exported to the UK, in US dollars and converted to pound sterling"*:

MATRIGEL Sales Revenue:

Year	2019	2020	2021	2022
Matrigel Sales UK	$2,048,521 £1,649,657	$1,800,033 £1,449,552	$2,222,846 £1,790,161	$2,616,931 £2,107,536

BIOCOAT Sales Revenue:

Year	2017	2018	2019	2020	2021	2022
Biocoat Sales UK	$165,132 £132,996	$241,627 £194,679	$194,620 £156,796	$158,521 £127,713	$246,659 £198,724	$175,113 £141,082

[28] Product number 354480.
[29] Exhibit RTH12, pages 19 to 22.

Invoices

45. A total of 19 invoices have been provided consisting of 63 pages of evidence.[30] They are all dated within the relevant period and are for the supply of products to various customers based in the UK. The invoices are all issued by 'Corning' and display 'Corning' in the letterhead. The financial information has been redacted by the Opponent however, the prices of some of the products are listed elsewhere in the evidence.[31]

46. The invoices list product numbers and include a brief description of the products. However, an inordinate amount of the products listed do not contain the details of the brand names they are sold under and instead list generic descriptors such as 'tube', 'plate', 'flask', 'dish', 'syringe', 'bottle', 'vial 2.0ml' and so on (see some examples below – the yellow highlighting is the Opponent's to identify BIOCOAT products).

Product Number	Description
430488	VIAL,2.0ML,RB,SS,INT,PP,S,BK,5 EU Commodity Code:3926.90.97
TF-200-R-S	200ul Universal Fit Filter Tip EU Commodity Code:8479.90.70
353003	Dish 100x20mm TC 20pk 200cs EU Commodity Code:3926.90.97
430825	FLASK,150CM2,CANT,VENT,PS,S,BK EU Commodity Code:3926.90.97
4870	REAGENT RESERV,50ML,WHITE,PS, EU Commodity Code:3926.90.97
10030	HYPERFLASK,CORNING,CellBIND EU Commodity Code:3926.90.97
3471	PLT,6WL,FB,ULA,IND,W/LID,S,1/2 EU Commodity Code:3926.90.97
430281	BOTTLE,250ML,.45MM,PS,W/CAP,S, EU Commodity Code:3926.90.97
430518	BOTTLE,1000ML,.45MM,PS,W/CAP,S EU Commodity Code:3926.90.97

Product Number	Description
000000000001136777	Tube 15mL 17x120mm Conical PP EU Commodity Code:3926.90.97
000000000001136779	Tube 15mL 17x120mm Conical PP EU Commodity Code:3926.90.97
000000000001136783	Tube 15mL 17x120mm Conical PS EU Commodity Code:3926.90.97
000000000001138183	Plate 96w Col I 5pk 50cs EU Commodity Code:3822.90.00

Product Number	Description
356649	Plate 96w Col I BlkClr 50cs EU Commodity Code:3822.90.00

Product Number	Description
356663	Plate 384w PDL BlkClr 50cs EU Commodity Code:3822.90.00

[30] Exhibit RTH6.
[31] See my paragraph 48 below.

47. Mr Hardee states that the *"BIOCOAT product numbers exhibited and highlighted on the invoices are 356649 and 356663"* (these are the same products previously noted for which the Opponent provided examples of product labelling[32]). These products are both described as 'plate' in the invoices, and are included in the invoices dated 27/04/2018; 22/09/2018; 07/12/2018; 21/05/2019; 11/12/2021; 10/02/2022; and 14/12/2022. These products are listed for sale on the Opponent's website with product number '356663' being priced at £1,449.87 per case of 50 units and product number '356649' being priced at £860.07 per case of 50 units.[33]

48. Whilst Mr Hardee has not provided any further narrative evidence to assist with the interpretation of the invoices, having cross-referenced the product numbers listed in the invoices against the entire body of evidence, I have determined, as far as is practicably possible, which products they refer to (even in instances where no brand name is included in the invoice description, only a product number).

49. I have determined that the following 'MATRIGEL' and 'BIOCOAT MATRIGEL' goods listed in the table below were supplied under the invoices. The information contained in the table has been collated from various parts of the evidence based on the product numbers contained in the invoices. I note that the invoices containing the products listed in the table below were dated 20/11/2017; 05/11/2018; 08/02/2021; 15/02/2021; 23/02/2021; 28/04/2021; and 28/06/2022 (all within the relevant period). I also include some images of those products by way of example.

Product Number	Description	Product format
354230/ DL131	*"**Corning® Matrigel®** Growth Factor Reduced (GFR) **Basement Membrane Matrix**, LDEV-Free, 10ml. Price: £496.37 (Excluding VAT at 20%)".*[34]	vial
354234	*"**Matrigel Basement Membrane Matrix**, LDEV-Free, 10 ml - £327.50 each"* [35]	vial
345277	*"**Matrigel hESC Matrix** 5ml - £278.60 each"* [36]	vial
356230	*"**Matrigel Basement Membrane Matrix**, Growth Factor Reduced (GFR), LDEV-Free, 5 ml - £229.70 each"* [37]	vial

[32] See my paragraphs 38 and 39.
[33] See Exhibit RTH2, page 5 and 10.
[34] Exhibit RTH3, page 3 (website evidence dated 25 February 2021).
[35] Exhibit RTH3, page 2 (website evidence dated with a 2017 copyright notice).
[36] Ibid.
[37] Ibid.

356234	*"**Matrigel Basement Membrane Matrix**, LDEV-Free, 5 ml - £215.10 each"* [38]	vial
354262	*"**Matrigel Matrix High Concentration** (HC) Phenol Red-Free, LDEV-Free, 10 ml - £532.80 each"* [39]	vial
356232	*"**Corning® Matrigel® Basement Membrane Matrix**, LDEV-free, 5 x 5ml. Price: £1,344.01 (Excluding VAT at 20%)".*[40]	vial
356235	*"**Matrigel Basement Membrane Matrix**, LDEV-Free, (5 x 10 ml) - £1,378.00 PK5"* [41]	vial
354234	*"**Corning® Matrigel® Basement Membrane Matrix**, LDEV-free, 10ml"*[42] *"£327.50 each"*[43]  	vial
356231	*"**Matrigel Basement Membrane Matrix**, Growth Factor Reduced (GFR), Phenol Red-Free, LDEV-Free, 10 ml - £391.00 each"* [44]  	vial
354480	*"**Corning® BioCoat® Matrigel® Invasion Chambers** with 8.0 µm PET Membrane in two 24-well Plates, 12/Pack, 24/Case"*[45] 	well plate

50. I note that a reagent product, namely *'reagent reserv. 50ml'* (product number 4870) is listed in the extract taken from one of the invoices (see my paragraph 45 above).

[38] Ibid.
[39] Ibid.
[40] Exhibit RTH3, page 3 (website evidence dated 25 February 2021).
[41] Exhibit RTH3, page 2 (website evidence dated with a 2017 copyright notice).
[42] See undated Exhibit RTH 5, from which the product description is obtained. Although that evidence is undated, the product itself is listed in the invoice evidence which is dated within the relevant period.
[43] Exhibit RTH3, page 2 (website evidence dated with a 2017 copyright notice).
[44] Ibid.
[45] See undated Exhibit RTH 5, from which the product description is obtained. Although that evidence is undated, the product itself is listed in the invoice evidence which is dated within the relevant period.

However, I have not been able to identify this as a 'MATRIGEL' product and have not been able to identify what brand this product was sold under (other than it was obviously sold by 'Corning'). With regard to any other remaining products listed in the invoices, I note that I have not been able to identify them by cross-referencing them with the BIOCOAT and MATRIGEL product numbers either, therefore I can only assume those goods were at least sold under the 'Corning' brand (since the invoices are all headed 'Corning'), which is in any event not the mark relied on. Furthermore, the products I have been unable to identify are for the most part products listed with their generic name (for example, 'tube', 'syringe' etc.) which are not in any event goods falling under Class 1 of the Nice Classification System, not least Class 1 of the Opponent's specifications.

Exhibitions and conferences

51. Mr Hardee states the following in his first Witness Statement: *"I attach exhibit hereto as Exhibit RTH9 online extracts showing that Corning attended exhibitions and conferences in 2017 and 2020 respectively."* This evidence relates to two conferences, the first being the *"Drug Discovery 2017"* two-day conference held in Liverpool on the 3rd and 4th October 2017. 'Corning' is included as one of the exhibitors at the 2017 event and the following information is included in the biography for 'Corning' on the exhibition website (my emphasis):

> "Our leading Corning, Falcon, Axygen and Gosselin brands include vessels and differentiated surfaces for cell culture […]. Corning continues to lead the way in developing innovative solutions for cell culture, such as the HYPERFlask® Cell Culture Vessel for increased cell yields, and novel surfaces such as the Corning® CellBIND Surface for enhanced assay performance. **Our portfolio now also includes Extracellular Matrices and Biological surfaces such as Corning Matrigel®, Corning BioCoat™ and Corning PureCoat™."**

52. The second conference is *"SLAS EUROPE 2020 Conference and Exhibition"*, the location of which is not included in the evidence. The same biography as above is included for this conference.

53. I note that no further information is provided about the conferences themselves, neither is any information provided as to the number of attendees nor how the MATRIGEL and BIOCOAT marks were promoted at the conferences or the extent of any such promotion.

54. The evidence in reply includes 'Exhibit RTH15' which Mr Hardee refers to as *"extracts from the Corning Website and other sources demonstrating our attendance at exhibitions in the UK within the relevant period"*. This evidence relates to two conferences, the first being a two-day conference held in Macclesfield, UK on 8-9 June 2022, hosted by 'Corning' on the topic of *'3D Cell Culture and of Bioprocess'*; the second being the 'ELRIG UK Drug Discovery' conference – a two-day conference held in London on 4-5 October 2022 – 'Corning' is listed as one of the exhibitors. No information is provided as to the number of attendees nor how (or if) the MATRIGEL and BIOCOAT marks were promoted at the conferences or the extent of any such promotion.

Marketing

55. With regard to marketing activities, in his evidence in reply, Mr Hardee refers to Exhibit RTH13 as *"samples of marketing materials and literature dated within the relevant period"*. These consist of informational material about MATRIGEL products (the contents of which is not substantively different to any information contained in the evidence in chief). Mr Hardee also refers to the *"online newsletters contained in Corning's Exhibit RTH4"* (of his evidence in chief) as further examples of marketing. However, no information is provided about the readership, distributorship, online hits, nor territorial reach of these newsletters.

56. Exhibit RTH13 of the evidence in reply contains screenshots of the Opponent's videos taken from the 'YouTube' website. They are in relation to instructional videos about *'High Concentration Matrigel'* and *'BioCoat cultureslides'*. No information is included in the evidence about where the viewers of these videos were located nor how many views were gained during the relevant period.

Form of the mark

57. The marks relied on are both word-only marks, therefore the protection afforded by the registrations is not limited by any features such as typeface or capitalisation appearing on the Register. Consequently, use in the forms shown in the evidence i.e. 'BioCoat' and 'Matrigel' (as opposed to 'BIOCOAT' and 'MATRIGEL') would be covered by notional and fair use of the marks and is therefore use upon which the Opponent would be able to rely.

58. The evidence shows that the Opponent has used its marks not just on their own, but also in conjunction with 'Corning' and also in conjunction with each other – the latter use being in relation to co-branded products (i.e. the 'BioCoat Matrigel' products). I also note that where the earlier marks are used in conjunction with another mark, the registered trade mark ® symbol, or the trade mark ™ symbol, are often displayed after each mark, which reinforces the perception of co-branding and that these are separate brands, for instance: '*Corning*® *Matrigel*®*'* and *'BioCoat*™ *Matrigel*™*'*. Notwithstanding the fact that the marks sometimes appear in conjunction with 'Corning' or in conjunction with each other, their distinctive character is not affected and therefore they still continue to indicate origin.[46] Consequently this is use upon which the Opponent would be able to rely.

Conclusions on the evidence

General conclusions

59. It is apparent that a proportion of the evidence in chief contains undated evidence, which was subject to detailed criticism in the Applicant's submissions. Returning to my point made in the preliminary issues section above, whilst I concur that some of the exhibits, which include details about the Opponent's products, are indeed undated, the evidence in chief nonetheless contains corroborative evidence which enables me to determine that those products were sold in the UK during the relevant period. This is because they are listed in the invoice evidence which is actually dated within the relevant period.

[46] *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paragraphs 31 to 35.

60. Therefore, those parts of the evidence in chief which are undated still have value as they have enabled me to determine (as far as is practicably possible) what goods are contained in the invoice evidence, and consequently what goods were sold under the MATRIGEL and BIOCOAT marks to UK customers during the relevant period.

61. The sales revenue for MATRIGEL and BIOCOAT is not broken down into each specific format of the products sold under the brands, but since the evidence overwhelmingly points to the brands being used in relation to specific types of products, which respectively appear to be variations of each other,[47] this is of no consequence.

62. Whilst the invoices are redacted to remove any prices, there is information elsewhere in the evidence which indicates the high price point of the products, this therefore supports the sales revenue figures. The sales revenue for MATRIGEL is only provided for 2019 through to 2022. The absence of the 2018 revenue figures is particularly surprising given that the evidence points to the MATRIGEL product lines having been in circulation for at least the last 30 years. That said, they nonetheless span a significant proportion of the relevant period and show a reasonable number of sales bearing in mind the price point of these products. Comparatively, it would seem that the MATRIGEL products outsell the BIOCOAT products, however, nothing turns on this. The sales revenue for BIOCOAT is still reasonable and is certainly not tokenistic.

63. Although the Opponent has provided various brochures/ informational literature, there are no marketing figures provided in the evidence. Again, this is surprising given the at least 30-year availability of the MATRIGEL products.

64. The Opponent's attendance at various conferences provides no conclusive information as to whether, or how, the marks relied on were promoted at these events. Furthermore, with regard to the 'YouTube' video screenshots, whilst this is evidence which was not included in the evidence in chief, it does nothing to assist the Opponent

[47] For the avoidance of doubt, I am not concluding that the BIOCOAT and MATRIGEL products are variations of each other, rather the BIOCOAT products appear to be variations of a specific type of product; and the MATRIGEL products appear to be variations of a separate specific type of product.

since it provides no conclusive information as to the extent of any marketing efforts conducted via 'YouTube'.

65. With regard to the evidence in reply, although the Opponent has gone to more concerted lengths to ensure the evidence is dated (which critically should have been done in the evidence in chief), having reviewed this body of evidence, I do not consider it introduces anything substantively new, rather it merely clarifies the position as to when the MATRIGEL and BIOCOAT products were made available. This was in any event information which I was able to deduce from the evidence in chief when viewing the evidential picture as a whole – for example, as I have already indicated, the invoices corroborate some of the undated evidence.

66. Whilst there are parts of the evidence in reply which certainly would have been useful to have been provided upfront, such as Exhibit RTH12 containing dated screenshots from the websites of the Opponent's suppliers, which are clearly and unambiguously dated, these screenshots do not put the Opponent in a better position. Having reviewed the evidence in reply I conclude that it essentially includes the same kind of information about the same products, albeit more clearly set out as to the period it relates to. However, I do not consider it to be, in general, an introduction of new evidence nor evidence of the kind which would materially alter the conclusions I have set out below in relation to the use shown.

Conclusions on the proof of use evidence in relation to BIOCOAT

67. Although the Opponent has demonstrated that it has used its BIOCOAT mark during the relevant period, the assessment of genuine use can only be made in relation to whether the use made of the mark is in relation to the goods for which it is registered, and not any goods which do not form part of the registration. For the reasons set out below, I do not consider the use shown of the BIOCOAT mark is use in relation to the goods for which it is registered and is therefore not use on which the Opponent can rely.

68. The Applicant submits that (emphasis added by the Applicant):[48]

> "7. […] the actual products marketed under the [BIOCOAT] mark are described exclusively as **cultureware**, e.g. microplates and dishes having a **bio**logical **coat**ing thereon.
>
> 8. All of the products identified in relation to **BioCoat** relate to cultureware. None of the products identified for actual sale relate to anything other than this.
>
> 9. [With regard to] "BioCoat Matrigel Invasion chambers". […] this […] relates to invasion chamber inserts which are not goods covered by either of the prior marks on which this opposition is based […].
>
> 10. The […] references to "BioCoat Matrigel matrix" [are] only relating specifically to "cultureware", i.e. culture dishes and microplates. Again such goods are not covered by either of the Prior marks on which this opposition is based […].
>
> […]
>
> 15. […] Evidence of use of prior marks in relation to products for which the Opponent has no protection should not be taken into account.
>
> […]
>
> 27. The mark BIOCOAT appears to have been used by the Opponent only in relation to cultureware having a pre-coated surface – that precoating can be a range of different surface cultures. All evidence of use of the mark BIOCOAT submitted by the Opponent relates solely to such culture dishes and microplates.
>
> 28. There is simply no evidence of use in relation to the terms covered by the prior registration, namely "Chemical preparations for scientific purposes". A culture plate forming multiple reaction chambers is not a chemical preparation and is not similar."

69. The Applicant's position is therefore that *"evidence of use of the prior mark BIOCOAT in relation to the goods covered by the prior registration has not been*

[48] Final written submissions of the Applicant, dated 30 May 2024.

provided",[49] because *"any evidence of use is solely in relation to 'cultureware' – i.e. pre-coated culture dishes and microplates."*[50]

70. The Opponent's skeleton arguments state that:

> "31. […] the evidence clearly shows that the earlier BIOCOAT mark is in use in the UK for the BIOCOAT Class 1 goods. At the very least, the Opponent submits that an acceptable specification, based on the evidence of use, would be:
>
> > *"chemical preparations for scientific purposes, namely, cultureware; precoated cultureware; cell cultureware; cell culture applications; cell growth; precoated custom surface coating applications; microplates; collagen type microplates for in vitro use; matrix proteins."*
>
> 32. The Opponent [submits] that it can rely on the BIOCOAT Class 1 specification as filed or at least in the refined scope mentioned above […]."

71. In essence this is a submission that the use relates to *"cultureware"*. At the hearing Mr McManus made submissions in line with the skeleton argument and I asked if he could clarify if he was submitting that 'cultureware' belongs to Class 1, and he confirmed that he was.

72. Aside the issues I have identified in the following paragraphs with regard to the Opponent's 'refined' specification, it is pertinent to note that the parties at least both agree that the use shown of the BIOCOAT mark can be characterised as use in relation to 'cultureware'. I agree, this is because the relevant evidence shows use of the mark during the relevant period in relation to cellware (being cell-plates /well-plates) and cultureware in microplate formats coated with various substances. In addition, I note that the evidence states that the BIOCOAT products are also available with *"a non-treated surface".*

73. However, I disagree with the Opponent that 'cultureware' can be regarded as *"chemical preparations for scientific purposes"*, which goes to the point the Applicant is making in its submissions, i.e. that no use has been shown in relation to the Class

[49] Ibid. paragraph 34.
[50] Ibid. paragraph 34.

1 goods for which the mark is registered, because it submits that 'cultureware' is not a chemical preparation.

74. Firstly, the issue with the first term of the Opponent's 'refined' specification is that 'cultureware' is not a sub-category of the registered term *"chemical preparations for scientific purposes"*. 'Cultureware' is a broad term which includes 'culture dishes; culture plates; and plates for laboratory use', these are all apparatus and instruments included in Class 9 as opposed to chemicals included in Class 1. Albeit the 'cultureware' is 'coated', it is not acceptable for the Opponent to artificially limit *"chemical preparations for scientific purposes"* to *"namely, cultureware"* in order to fit in with the actual use it has made of its trademark.

75. Secondly, everything which comes after the semicolon in the 'refined' specification is not limiting the scope of the registered specification at all, it is actually broadening it, since the addition of a semicolon followed by a list of goods (which in any event are not sub-categories of the registered goods) has the result of adding additional goods to the specification. I therefore cannot accept this either, and certainly could not proceed on the basis of comparing the 'refined' goods with the applied-for goods as Mr McManus proposes.

76. Taking all the foregoing into account, I do not consider the use shown in relation to 'cultureware' is use in relation to the Class 1 goods for which the mark is registered and therefore it is not genuine use on which the Opponent can rely. For the avoidance of doubt, I do not consider use has been shown in relation to *"chemical preparations for scientific purposes".*

Conclusions on the proof of use evidence in relation to MATRIGEL

77. I bear in mind that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole. Notwithstanding its limitations, in the context of an overall assessment of the evidence and of the relevant factors, the evidence lends support to a finding that the Opponent has proved that its MATRIGEL mark has been used in the UK during the relevant period in relation to a solubilized basement membrane preparation (which is described in the evidence as being an

extracellular matrix extracted from a mouse sarcoma), and that that use is sufficient to be deemed to be genuine use.

78. However, I am not satisfied that the genuine use demonstrated is sufficient to enable the Opponent to rely on all the goods for which the MATRIGEL mark is registered, and therefore I move on to framing a fair specification on which the Opponent can rely, which reflects the use shown.

Fair specification – MATRIGEL

79. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,[51] Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as follows:

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

80. The *Titanic Spa*[52] case sets out how to approach the framing of a fair specification as follows:

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink")* at [52].
>
> iv) […] the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

[51] BL O/345/10.
[52] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), paragraph 47.

consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2* it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

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

81. In framing a fair specification, I am required to not only consider the use presented to me but also bear in mind what the terms specified in the Opponent's registration, based on their ordinary and natural meaning, are apt to protect.

82. The MATRIGEL mark is registered for the following goods:

"Chemical reagents; biological cell culture substrates; culture media; cell growing medium; basement membrane extracts; chemicals and chemical preparations for use in the laboratory for "in vitro" testing and the like scientific purposes; all included in Class 1."

"Chemical reagents"

83. I have already set out that the Applicant submitted in its counterstatement that *"the goods covered by the prior marks are identical to those applied for",* adding that *"of*

course a proper more detailed comparison will in due course be made to those goods for which actual use is proven".

84. It is obvious that the applied-for *"chemical test reagents"* are identical to the Opponent's *"chemical preparations for scientific purposes"* under its BIOCOAT mark, and *"chemical reagents"* under its MATRIGEL mark.[53] Since I have already determined that the Opponent cannot rely on its BIOCOAT mark, it is necessary for me to determine whether it can rely on *"chemical reagents"* under its MATRIGEL mark, particularly since that would lead to a finding that the applied-for goods are identical to the Opponent's goods.

85. I note that Mr Hardee stated in his First Witness Statement that *"Corning sells* […] *solubilized basement membrane preparations under the MATRIGEL mark"* – which I have found is in line with the evidence. The Opponent submits that its use in relation to solubilized basement membrane preparations is use in relation to chemical reagents. In its skeleton arguments it submits that its evidence *"clearly"* demonstrates use of the MATRIGEL mark in relation to *"chemical reagents"* and that *"it can rely on the MATRIGEL Class 1 specification as filed* […] *specifically chemical reagents"*.[54]

86. Conversely, the Applicant's position is that the Opponent's evidence of use for MATRIGEL *"is confined solely to highly specific solubilized basement membrane culture medium",*[55] and that even if genuine use is found in relation to such goods it submits they are not 'chemical reagents', and therefore concludes that the Opponent cannot rely on its MATRIGEL mark for 'chemical reagents'.

87. I have recounted below the parties' submissions in relation to the term 'chemical reagents'.

88. The Applicant submits the following:[56]

> "35. […] With respect to the terms "chemicals and chemical preparations for use in the laboratory for "in vitro" testing and the like scientific purposes" and

[53] Identity would be found under the principles outlined in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05.
[54] See the Opponent's Skeleton Arguments, paragraph 26.
[55] Final written submissions of the Applicant, dated 30 May 2024, paragraph 22.
[56] Ibid., paragraphs 35 to 36.

"chemical reagents" we submit that these are different to "solubilized basement membrane culture medium" as they are chemical reactants rather than being growth medium that is biological in nature. A membrane culture medium is not a "chemical" or "chemical preparation".

36. We submit that, in respect of the terms "chemical reagents" and "chemicals and chemical preparations", the prior marks have not been used, but if some use is found to fall within these terms, we submit that these are both very broad terms for which use could not be shown across any more than one small distinct part of the full scope. One cannot artificially support a broad term with very limited use in only one clearly distinct subset thereof. The full scope of broad terms must therefore be disregarded in the MATRIGEL Prior Mark."

89. At the hearing Mr McManus began his submissions as follows (my emphasis for clarity)*: "I will mention from the outset that* ***the first part of the Applicant's Class 1 term is important in the Opponent's view, i.e. the term "chemical test reagents"*** *and I will elaborate on that when it comes to discussing the evidence and the comparison of goods. But for now, I will explain in general, in case you are not aware, that in chemistry a reagent or an analytical reagent is a substance or compound that is added to a system to cause a chemical reaction or test if one occurs."* I asked whether that definition was anywhere to be found in the evidence and Mr McManus replied in the negative, submitting that *"I think it is explained more or less in the Opponent's evidence but that is just a general definition. But no, it is not in the evidence."*

90. In continuing to answer my query, Mr McManus directed me to page 24 of Exhibit RTH10 of the Opponent's evidence in reply, which I note is literature in relation to the Opponent's *"Corning® BioCoat™ Matrigel® Invasion Chambers – Frequently Asked Questions"*, dated 27 May 2022 (this page is included at Annex 1 of this decision for ease of reference). With regard to this evidence he submitted that (again my emphasis for clarity): *"our view is that* [this evidence] ***explains in detail*** *that the mark relates essentially to* ***a chemical reagent, in particular, a cell growing medium****, and I think this is supported throughout Exhibit RTH10. Our view on this is all the exhibits show that the language refers to cells in this regard. You see a lot of terms where it says 'cells behave better with MATRIGEL' et cetera."*

91. With page 24 of Exhibit RTH4 in front of me I asked where it referred to 'chemical reagents' because it wasn't apparent to me and I asked Mr McManus if he could direct me to it. Mr McManus replied to my request by skipping forward to page 83 of Exhibit RTH10 (which I have included at Annex 2 of this decision for ease of reference) and submitted as follows: *"You obviously firstly have the reference to 'cells behaving better with MATRIGEL'. In there it talks about years ago researchers are* ***looking for a way to grow cells and that MATRIGEL provided a solution****,* ***a solubilized membrane preparation****. It refers to 'cell culture', et cetera. This is essentially what is meant by the broader term 'reagent'."*

92. Since the disparity between the parties' positions rests heavily on the term 'chemical reagents', and given that it was still not *"clearly"* apparent to me from the pages of evidence Mr McManus had directed me to, I imposed upon him again for a further clarification and asked where it was *"clearly"* demonstrated in the evidence that the MATRIGEL products are 'chemical reagents'.

93. Mr McManus did not direct me to any further parts of the evidence rather, he submitted that the MATRIGEL goods fall *"within the broader term of what a chemical reagent is, what it does* [i.e.] *causing reactions to do with growing cells and that sort of thing, it falls within that broader term so it is a chemical reagent as such which* [the Opponent] *offer*[s] [under the MATRIGEL mark]". Again I asked where that was to be found in the evidence and Mr McManus replied as follows:

> "What I am saying is that – as I mentioned what a chemical reagent is, it is to do with sort of reaction and a growth of things. That is the broader term for the Opponent's products and obviously it is specified in more detail as basement membranes et cetera and cell types and cell growth et cetera, but it comes as a thinly general term. That is my understanding of chemical reagent.
>
> […]
>
> I would also point out that obviously if you look at the Applicant's specification it does talk about cells as well. So if we look at the [Applicant's specification] it says "chemical test reagent for cell research use", essentially. I think it is clear from the evidence that MATRIGEL relates to cell culture substrates, culture

media and growing cells. On that basis I would argue that there is identity there and it comes within the scope.

[…]

If you look at the MatriCOAT specification, it qualifies that chemical test reagents are for cell research use, for cell microbiological research use. I am saying that if you look at our specification, also the evidence, it is clear that MATRIGEL relates to culture media, cell growing mediums et cetera."

94. One argument that Mr McManus advances is therefore that the applied-for specification aids in the interpretation of the registered specification, which I do not accept. I also note as a general point, that the fact that a specification is registered for certain goods cannot alter the nature of the goods shown in the evidence.

95. At this juncture I find it pertinent to note my criticisms with the submissions and evidence, or lack thereof, from both parties. The crux of the parties' legal arguments in relation to the evidence of use is heavily dependent on their interpretation of what 'chemical reagents' are (which I agree with Mr McManus is an important point, particularly since the applied-for specification solely relates to 'chemical test reagents'), yet neither side has provided me with any conclusive evidence which would assist me in determining whether 'solubilised basement membrane preparations' can, or cannot be, characterised as 'chemical reagents'. It is one parties' word against the other, with the Opponent submitting that 'extracellular matrices' in the form of 'basement membranes' extracted from a mouse tumour are *"chemical reagents",* yet those submissions are not supported by the evidence; and the Applicant asserts that they are not chemical reagents, without providing any evidence whatsoever to support that assertion.

96. Prior to Mr McManus' oral submissions at the hearing, neither party had provided me with a definition of what a 'chemical reagent' is and, as confirmed by Mr McManus, a definition was not contained in the evidence. With no evidence from the parties to assist me in interpreting the term 'chemical reagent', I rely on the ordinary and natural meaning of the words used in the evidence and in doing so, it is open to me to consult

dictionaries as part of my decision making process.[57] In this regard I note that the definition Mr McManus provided for a 'chemical reagent' is in line with the definition contained in the Oxford English Dictionary i.e. 'reagent' in reference to 'chemical reagent' is defined as follows: "*Chemistry.* A substance used in testing for other substances, or for reacting with them in a particular way; (more widely) any substance used in chemical reactions."

97. The word 'chemical' is defined in the Oxford English Dictionary as "*Noun.* A distinct substance or compound, especially one which has been chemically prepared or purified" which certainly aligns with my understanding of the ordinary word 'chemical' which brings to mind products such as bleach.[58] I also note the terms listed below (which are terms used to describe the MATRIGEL products in the evidence) are defined in the Oxford English Dictionary as follows (my emphasis for clarity):

'extracellular'	*Biology*. Situated or taking place outside the walls of a cell. e.g. extracellular fluid.
'matrix'	• A place or medium in which something is originated, produced, or developed; the environment in which a particular activity or process begins; a point of origin and growth. • *Biology.* An amorphous or fibrillar material that surrounds cells; esp. the extracellular substance of connective tissue. Also: the ground substance in which structural elements (e.g. of a shell, cell wall, etc.) are embedded. • *Cell Biology.* The ground substance of a cell or organelle; (now) esp. the substance contained within the inner membrane of a mitochondrion. • *Biochemistry and Pharmacology.* A material that **supports** or immobilizes **a reagent**, esp. in separation procedures; a material used to retain a **drug** for controlled release.
'basement membrane'	*Anatomy.* A layer of fibrillar material and glycoprotein situated between a layer of cells and the underlying connective tissue and having a **supporting** (and sometimes also filtering) function.

[57] See the Appointed Person's decision in *SmartContract Chainlink Limited v Stripe, Inc*, BL O/0294/24 at paragraph [31], wherein the Appointed Person makes reference to a judgement of the General Court in Case T-222/09 *Ineos Healthcare v. OHIM* at paragraph [29] and the case law cited therein.
[58] Bleach being a chemical that is used both industrially and domestically.

98. Taking all the above definitions into consideration, I remain unconvinced that the evidence *"explains in detail"* that the MATRIGEL products are 'chemical' reagents and the dictionary definitions alone support the Applicant's submissions.

99. The evidence consistently describes MATRIGEL as being a product used by researchers to *"grow mouse sarcoma cells"* and that it is (my emphasis for clarity) "*the original, trusted* ***extracellular matrix (ECM)****,* […] *a* ***solubilized basement membrane preparation*** […] ***for*** […] ***cell culture in vitro****".* In relation to the *'Corning® Matrigel® matrix-3D plates'* product, the product literature states that it provides ***"an in vitro assay that allows for <u>growth of cells</u>*** *in 3D* ***<u>for drug discovery applications</u>****."*[59] There is no evidence to suggest that the MATRIGEL products are used as anything other than an extracellular material to support the growth of cells in a laboratory vessel.

100. Some protocols on how to use the MATRIGEL products have also been provided in the evidence which suggest that the product is to be used in conjunction with 'reagents'[60] (as opposed to it being a reagent itself). Conversely, there is one scant piece of evidence originating from one of the Opponent's distributors' catalogues that refers to ECM's such as MATRIGEL as being 'reagents',[61] although that evidence does not refer to MATRIGEL as a 'chemical' reagent per se.

101. Taking all the foregoing into account, it is my understanding that a solubilized basement membrane is a 'biological preparation for use in science',[62] (as opposed to a chemical preparation for use in science[63]) because it is described in the evidence as a 'natural' ECM, having been extracted from a mouse sarcoma i.e. it is biological in nature; MATRIGEL is also identified in the evidence as one of the *'biological'* coatings applied to the BIOCOAT products.

102. Whilst I do not overlook the scant piece of evidence which refers to MATRIGEL as a 'reagent' (in fleeting reference to the applications of a 'cooling rack'), I am not satisfied that this is unequivocal evidence that it is a 'chemical' reagent. Indeed, the

[59] See the Opponent's evidence in chief, Exhibit RTH5, page 28.
[60] See the Opponent's evidence in chief, Exhibit RTH5, pages 34 and 35.
[61] Exhibit RTH12, pages 19 to 22.
[62] Which I note is a term proper to Class 1 of the Nice Classification system.
[63] Which I note is also a term proper to Class 1 of the Nice Classification system.

only plausible potential conclusion I could reach is that that evidence could be referring to a 'biological' reagent, or more aptly, a 'bioreagent' (the term 'bioreagent' is defined by the Collins English Dictionary as *"a **reagent of biological origin**, such as an enzyme"*).

103. Although, based on the dictionary definition of what an extracellular matrix is, it does not appear that they are biological reagents either, because it doesn't appear that matrices trigger reactions, rather a matrix is a substance which provides the supporting environment in which a reaction can occur i.e. it supports and immobilizes a reagent, rather than being the reagent itself.

104. I therefore find that the evidence, which shows use in relation to 'solubilized basement membrane preparations', does not support a finding of genuine use in relation to *"chemical reagents"*. The Opponent therefore cannot rely on the term *"chemical reagents"*. Even if I am wrong in this finding, for reasons that will become apparent, it would not alter the overall outcome of these proceedings and I shall return to this point at the end of my decision.

"chemicals and chemical preparations for use in the laboratory for "in vitro" testing and the like scientific purposes"

105. In light of my assessment in relation to *"chemical reagents"*, I also find that the evidence does not support a finding of genuine use in relation to the above goods, since the use shown relates to 'solubilized basement membrane preparations' which I do not consider to be 'chemicals'.

106. I now turn to consider the remaining goods contained in the Opponent's specification. In assessing evidence of use in relation to these terms, I bear in mind the ordinary and natural meaning of the words contained in the specification and note that the terms listed below are defined in the Oxford English Dictionary as follows (my emphasis for clarity):

'substrates'	*Biology.* The surface or material on which any particular organism occurs or grows. *Chemistry.* The **substance which a** particular agent or **reagent acts on**; especially (Biochemistry) the molecule which a

	particular enzyme acts on, **bringing about a specific transformation**.
'culture medium'	*Biology.* **A nutrient liquid or solid** in or **on which** microorganisms, **cells**, etc., **are cultured**.

107. I have already noted that the Applicant has submitted that *"any use which has been shown relates solely to a very specific product, namely "solubilized basement membrane culture medium".*[64] It continues by submitting the following:[65]

> "35. […] It might be said to support the terms "biological cell culture substrates;" and "basement membrane extracts". With respect to the terms "culture media" and "cell growing medium" these are both much broader in scope than "solubilized basement membrane culture medium" so are not we say support across the breadth of these terms [*sic*]. […]".

"biological cell culture substrates" and *"basement membrane extracts"*

108. In light of my comments above and bearing in mind the evidence before me and relevant dictionary definitions, I consider the use in relation to 'solubilized basement membrane preparations' is sufficient to show genuine use in relation to *"biological cell culture substrates"* and *"basement membrane extracts"*. The Opponent can therefore rely on these terms as registered.

"culture media" and *"cell growing medium"*

109. I consider 'solubilized basement membrane preparations' to be an appropriate sub-category of the much broader terms "culture media" and "cell growing medium", consequently, I conclude that "culture media, namely solubilized basement membrane preparations" and "cell growing medium, namely solubilized basement membrane preparations" to be a fair specification for the use shown.

[64] Final written submissions of the Applicant, dated 30 May 2024, paragraph 35.
[65] Ibid.

110. In conclusion, a fair specification of the use shown is set out below. The Opponent can therefore rely on the following fair specification in these opposition proceedings:

> *"biological cell culture substrates; basement membrane extracts; culture media, namely solubilized basement membrane preparations; cell growing medium, namely solubilized basement membrane preparations."*

THE CLAIM UNDER SECTION 5(2)(b)

Legislation and Case Law

111. Section 5(2)(b) of the Act states:

> "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".

112. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

113. In *Gérard Meric v Office for Harmonisation in the Internal Market,*[66] ("***Meric***"), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

114. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[67]

(1) the physical nature of the goods;
(2) their intended purpose;
(3) their method of use / uses;
(4) who the users of the goods are;
(5) the trade channels through which the goods reach the market;
(6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
(7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
or
(8) whether they are complementary to each other.

115. Complementary means *"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*

[66] Case T- 133/05
[67] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

undertaking".[68] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[69]

116. When interpreting the terms in a specification I bear in mind:

(1) that it is *"necessary to focus on the core of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"where words or 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"*;[70]

(2) where *"the words chosen may be vague or could refer to goods or services in numerous classes* [of the Nice classification system]*, the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services"*;[71]

(3) the following applicable principles of interpretation:

> *"(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*
> *(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*
> *(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*
> *(4) A term which cannot be interpreted is to be disregarded."*[72]

[68] *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82
[69] *Kurt Hesse v OHIM*, Case C-50/15 P
[70] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
[71] *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94
[72] See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

117. The goods to be compared are shown in the table below.

Opponent's fair specification	Applicant's specification
Biological cell culture substrates; basement membrane extracts; culture media, namely solubilized basement membrane preparations; cell growing medium, namely solubilized basement membrane preparations.	Chemical test reagents for cell and microbiological research use, other than for medical and veterinary purposes.

118. Although the purpose and nature of the Applicant's goods is different to that of the Opponent's goods (since the one is a chemical test reagent and the others are cell culture media), taking into account all the Opponent's evidence and the foregoing conclusions I have reached in relation to that evidence, I find that similarity exists between the competing goods. This is on the basis that the goods are complementary to each other, because they are both used in cell research, indeed, the Applicant's test reagents are likely to be the chemicals that are added to, or used in conjunction with, cell culture substrates and basement membranes like MATRIGEL, perhaps to see how the cells suspended in the MATRIGEL grow/react in the presence of such chemical test reagents; or perhaps they are chemical reagents that 'coat' cultureware to be used with an ECM such as MATRIGEL.

119. For example, the Opponent's evidence points to MATRIGEL *"coming into contact with"* cultureware and reagents;[73] and the BIOCOAT evidence supports a finding that cultureware can be 'coated' with synthetic (as opposed to biological) compounds that enhance cell adhesion.[74]

120. Thus I find that the Opponent's goods are indispensable or important for the use of the Applicant's goods in such a way that consumers may think that the responsibility for those goods lies with the same undertaking.

121. I also find that the respective goods would share the same user i.e. cell research scientists, which is in line with the Applicant's submissions, since the Applicant submits that the user of the *"relevant goods is the professional scientist working in cell and*

[73] See the Opponent's evidence in chief, Exhibit RTH5, pages 34 and 35; and my paragraph 40(1)(b).
[74] BIOCOAT product number '356663' (see my paragraph 39).

microbiological research". In addition, the parties' respective goods would likely share the same trade channels, as the manufacturer of cell culture media is likely to also sell the chemical test reagents which complement/ are to be used in conjunction with, those products. For instance, the Opponent's evidence lends support to a finding that various goods for scientific research reach the market through the same trade channels, when taking into account the range of goods the Opponent sells for scientific research.

122. Overall I find that the applied-for goods and the goods contained in the Opponent's fair specification are similar. Whilst it has been held that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown,[75] (since any degree of similarity is essential in order to consider a likelihood of confusion), for the sake of clarity, I consider the goods to be similar to a low to medium degree.

The average consumer and the nature of the purchasing act

123. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. It is therefore necessary to determine who the average consumer of the goods is, and how the consumer is likely to select them.

124. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word 'average' merely denotes that the person is typical,[76] which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.[77]

125. I have already stated that I consider the average consumer of the respective goods would be research scientists and I note that the parties are agreed that the

[75] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, paragraph 49.
[76] *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60
[77] *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

average consumer is a science professional and/or a consumer who operates in a scientific field.[78]

126. However, the parties do not agree on the level of attention the average consumer will pay when selecting the relevant goods. Indeed, the Opponent submits that the parties' goods *"are for use by large corporate organisations in scientific fields, such as microbiology"* and that *"the level of attention* […] *is therefore likely to be medium"*.[79] Whereas the Applicant submits that it is indisputable that the attention will be high for such goods and references two decisions of the General Court, namely *Tolposan*[80] and *Zydus*[81] to support its submission. Whilst I note that in both decisions the Court found that the degree of attention was high, the goods related to Class 5 pharmaceutical products and the average consumers were doctors, pharmacists and the general public.

127. The relevant Class 1 goods are specialist goods for use in a specialist field, namely scientific research including cell research. Even where the average consumer of the goods is a large corporate organisation, it will be the scientists working within that organisation that will be using and ordering the goods they need for their research. I therefore consider the average consumer of the relevant goods will pay a high degree of attention when selecting those goods, taking various factors into account such as cost, ingredients/formulations of the products, and whether the goods meet the specific needs for the research they are conducting.

128. The goods are likely to be selected visually through purchases from websites or after viewing catalogues etc., where an image of the product is displayed. Although I do not discount that the goods may be selected orally if orders are placed over the phone. Therefore, the way the marks look is of primary importance, but the way they sound must also be taken into account.

[78] See the Opponent's submissions dated 18 September 2023, paragraph 28 and the Opponent's skeleton arguments paragraph 50.
[79] See the Opponent's submissions dated 18 September 2023, paragraph 27.
[80] Case T-331/09
[81] Case T-288/08

Comparison of marks

129. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union stated in *Bimbo SA v OHIM*,[82] 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."

130. The marks being compared are shown below:

Earlier mark	Contested mark
MATRIGEL	MatriCOAT

Applicant's submissions

131. Clearly the marks coincide with regard to the sequence of their first five letters 'MATRI' and they differ with regard to the remaining letters 'GEL' and 'COAT' respectively. Before I proceed with a detailed comparison of the marks, and before I assess the distinctive character of the earlier mark, I note the Applicant's submissions.

132. The Applicant has attempted to downplay the identity between the first five letters of the respective marks by submitting that (my emphasis for clarity) *"the **common component*** ['MATRI'] *can be understood as a **reference to a "matrix"***,[83] and that **'MATRI'** ***"is descriptive of the goods in question"***,[84] which *"is further emphasized*

[82] Case C-591/12P, at paragraph 34.
[83] See the Applicant's Form TM8, paragraph 7 of the counterstatement; and the Applicant's submissions dated 27 November 2023, paragraph 20 which repeats this submission.
[84] See the Applicant's Form TM8, paragraph 7 of the counterstatement.

by the Opponent's evidence which clearly shows that the mark MATRIGEL is used alongside the descriptor MATRIX."[85]

133. It goes on to submit that *"the common element MATRI- is not unique to the Opponent"* and that *"moreover, the prefix MATRI is frequently used in marks covering goods in class 1. In this regard, reference is made to the results of a UKIPO search for marks starting with MATRI- filed or registered in the UK in class 1 which produces 34 results."*[86]

134. Aside from the fact that the Applicant gave no indication as to what these Class 1 goods were, the Applicant did not file any evidence of the search to which it refers. Even if it had filed those search results, evidence of that nature would carry no weight since it would not include indications as to how many of such trade marks are effectively used in the market. The mere fact that a number of trade marks relating to Class 1 goods begin with 'MATRI' is not enough to establish that the distinctive character of that element has been weakened.[87]

135. With regard to the remaining elements making up the respective marks, namely 'GEL' and 'COAT', the Applicant submits that these elements would be understood as an indication ***"as to the nature of any product"***,[88] and that *"the word "gel" defines the nature* [of the Opponent's] *product"*[89] (as per the Opponent's evidence I note that the 'MATRIGEL' product forms into a 'gel' when reconstituted).

136. The Applicant makes the following submissions in relation to the 'COAT' element (although these submissions were made in relation to its comparison between the Opponent's 'BIOCOAT' mark and its 'MatriCOAT' mark, they are still relevant to a comparison with the Opponent's 'MATRIGEL' mark), my emphasis:[90]

> "The common component **COAT can be understood as a reference to a "coating"**. **The first element of each of the marks** [i.e. 'BIO' and 'Matri'] would thus be understood to **define the nature of such a coating**/covering and these

[85] See the Applicant's submissions dated 27 November 2023, paragraph 20.
[86] Ibid. paragraphs 20 to 22.
[87] See *Zero Industry Srl v OHIM*, Case T-400/06, paragraph 73.
[88] See the Applicant's Form TM8, paragraph 7 of the counterstatement.
[89] See the Applicant's submissions dated 27 November 2023, paragraph 24.
[90] See the Applicant's Form TM8, paragraph 11 of the counterstatement.

are very different. Thus, the marks may be considered as conceptually different save perhaps for **a common descriptive reference to coatings**."

137. The Applicant also submits that *"the clearly different meanings of "gel" and "coat" would lead to a conceptual divergence in the mind of the relevant consumer as to the **nature** of any product".*[91]

138. Therefore, the Applicant's position is that 'MATRI', being the first element in both marks, is descriptive of the goods in question i.e. it would be understood by the average consumer as a reference to a matrix; that the 'GEL' component in the earlier mark defines the nature of those goods (i.e. the nature of those matrices); that the 'COAT' component in its mark is a *"descriptive reference to coatings"*, which is qualified by the term 'Matri' which in turn *"defines the nature of such a coating",* i.e. a 'matrix.'

139. The Applicant is ultimately submitting that 'MATRI' is descriptive and would not denote trade origin; as a consequence, the differentiating factor between the competing marks is 'GEL' and 'COAT', notwithstanding its assertions that they too are descriptive elements. Since it is a premise of trade mark law that descriptive elements do not denote trade origin, I find the Applicant's submissions to be very perplexing, because in an attempt to steer me towards a conclusion that the common element[92] is negligible, it has asserted that both elements of its mark are descriptive of the goods for which registration is sought.

140. It is also ultimately submitting that its goods are matrices, which is even more perplexing given its contention that the applied-for goods, chemical test reagents, are not similar to the Opponent's basement membrane goods for cell culture (the latter falling squarely into the dictionary definition of the word 'matrix'). Whilst I take into account that 'MATRI' is not the word 'MATRIX', and that there is nothing before me to suggest that it is the apt abbreviation for the word 'MATRIX', I nevertheless agree with the Applicant that it is likely that the average consumer would perceive 'MATRI' as

[91] See the Applicant's Form TM8, paragraph 7 of the counterstatement.
[92] i.e. the 'common element' being 'Matri' when compared to 'MATRIGEL' and 'COAT' when compared to 'BIOCOAT'.

deriving from the word ‘MATRIX’, even when seen in respect of the applied-for goods. Therefore ‘MATRI’ is somewhat allusive.

141. The Applicant’s approach relies heavily on an artificial dissection of the marks which I do not subscribe to. Its approach would also have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance.[93]

142. The correct approach is to view the marks as a whole taking into account any distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks, and that is the approach I intend to take.

Overall impression

143. Both marks are word only marks, therefore the overall impression of both marks rests solely in those words. Despite the marks being made up of a single word, it is likely that the average consumer will perceive that those words are made up of two elements, the first being ‘MATRI’ and the second being the recognisable ordinary words ‘GEL’ and ‘COAT’.

144. Both parties have made submissions about the contested mark with regard to the letters ‘COAT’ being capitalised, in contrast to the ‘Matri’ element, however this has no significance when comparing word-only marks. A word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. As I have already noted, word-only marks are not limited by any features such as typeface or capitalisation appearing on the Register, therefore the following renditions would all be considered to be identical to the contested mark: ‘MATRICOAT’; MATRIcoat; MatriCoat; and so on,[94] as such, the fact that ‘COAT’ is capitalised does not represent a distinguishing feature.

145. Notwithstanding the allusive nature of the ‘MATRI’ element, it is not outright descriptive and it certainly cannot be overlooked as it contributes to the overall impression of both marks, not least because it forms the first five letters of both marks

[93] *L’Oréal SA v OHIM,* paragraph 45.
[94] See for example *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraph 15.

– as a general rule of thumb, the first parts of a mark normally carry a greater significance because the average consumer tends to focus its attention on the beginnings of a mark.[95]

146. However, the other elements making up the marks, 'GEL' and 'COAT, are seemingly descriptive, therefore in an overall impression of the marks, those elements would likely carry less weight than the common element 'MATRI'. That said, even if the average consumer perceives the words 'GEL' and 'COAT' as descriptive, that does not of itself render those elements negligible or invisible,[96] and they nonetheless contribute to the overall impression of the marks and their presence should still be considered when comparing the marks. Whether a consumer attaches any weight to such elements or not does not negate their existence.

Visual comparison

147. 'MATRI' forms the first five letters of the contested mark and that sequence of letters is therefore identical to the first five letters of the earlier mark.

148. The visual differences lie in the remaining letters making up both marks, which are 'GEL' in the earlier mark and 'COAT' in the contested mark.

149. Overall the marks are visually similar to a medium degree owing to the different endings.

Aural comparison

150. 'MATRI' will be pronounced as 'MAH-TREE' or 'MAY-TREE', either way, it will be pronounced identically in both marks. 'GEL' and 'COAT' will be pronounced in the ordinary way (as in 'hair gel' and 'winter coat') which clearly represents a point of aural dissimilarity between the marks.

151. Therefore the earlier mark will be pronounced as 'MAH-TREE-JELL' / 'MAY-TREE-JELL' and the contested mark will be pronounced as 'MAH-TREE-KOHT' / 'MAY-TREE-KOHT'.

[95] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81
[96] *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22.

152. Overall the marks are aurally similar to a medium degree.

Conceptual comparison

153. Given my earlier comments, it is likely that the average consumer of the relevant goods (being a cell research scientist), would perceive 'MatriCOAT' as alluding to the concept of 'matrices' for cell research in the form of 'coatings', and 'MATRIGEL' as alluding to the concept of 'matrices' for cell research in the form of a 'gel'.

154. Since the overriding concept portrayed by the marks is that of 'matrices' (albeit in different forms), I assess the conceptual similarity as medium to high overall.

Distinctive character of the earlier mark

155. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

156. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[97] the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

[97] Case C-342/97.

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)."

157. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be,[98] although it is the distinctive character of a component that is similar between the marks that is particularly relevant,[99] in this case the distinctive character of 'MATRI' is particularly relevant.

158. The Applicant has made submissions to the effect that 'MATRI' is descriptive. Given my earlier comments, whilst it is likely that the average consumer of the Opponent's goods would perceive 'MATRI' as deriving from the word 'MATRIX', it cannot be said to be descriptive nor devoid of distinctive character. Indeed, the Opponent's evidence, to which the Applicant points (where 'MATRIGEL' is used in conjunction with the word 'matrix', often as *'Matrigel Matrix'* and *'Matrigel Basement Membrane Matrix'*), shows that 'MATRIGEL' is being used to denote trade origin, because otherwise it begs the question as to why the Opponent would accompany 'MATRIGEL' with the word 'matrix' if the 'MATRI' element of its mark is being so glaringly used as a descriptor for its goods. It also lends itself to the observation that the Applicant also chose to eliminate the letter 'X' in 'matrix', perhaps as a means to distance it from the seemingly descriptive word 'matrix', especially when used in combination with the word 'COAT' (the latter being, by the Applicant's own admission, descriptive of the nature of the applied-for goods).

159. Nonetheless, as the 'MATRI' component is suggestive or allusive of a characteristic of the goods concerned, I assess the inherent degree of distinctive character as low.

[98] *Sabel v Puma*.
[99] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

160. Notwithstanding the ‘MATRI’ element is weakly distinctive, the other element of the mark, ‘GEL’, is of even weaker distinctive character, and is arguably descriptive since it is clear from the evidence of use that the MATRIGEL products form a gel when reconstituted. Therefore the mark as a whole only has a low degree of inherent distinctive character, since the conjoining of the two components making up the mark does not elevate the distinctiveness of the mark as a whole, beyond low.

161. The distinctive character of a mark can however be enhanced by virtue of the use that has been made of it. In that regard I note that there is no evidence provided that would enable me to determine the Opponent’s market share, despite the MATRIGEL products having been on the market for over thirty years and the evidence stating that it is among the most widely used models for 2D and 3D cell culture.

162. Although it appears from the invoice evidence that the Opponent has UK-based customers, this snapshot does not sufficiently demonstrate how geographically widespread the use of the mark is.

163. The evidence does not provide any details as to advertising expenditure, and whilst the Opponent points to its attendance at a few UK conferences and screenshots of its online instructional videos posted on ‘YouTube’ as evidence of advertising, this evidence is not in a trading context, and is not sufficient (alone) to clearly establish the extent to which the mark has been used commercially in the UK. Indeed, there is nothing in that evidence which shows how the goods were promoted at the conferences and/or via ‘YouTube’. It is also unclear where the viewers of the ‘YouTube’ videos are located and how many views it had by the relevant date; and no information has been provided about the number of attendees at the conferences. In any event, the Opponent’s attendance at a few conferences is not evidence of continued and consistent promotional activities of its MATRIGEL products throughout the relevant period.

164. In conclusion, I do not find the evidence sufficient to establish any enhancement of the distinctiveness of the earlier mark in the UK market for the goods the Opponent may rely on.

Conclusions on the likelihood of confusion

165. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[100] I must also consider the average consumer of the goods, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.[101]

166. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.[102] The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.[103]

167. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods bearing the later mark come from the same undertaking or from an economically linked undertaking.[104] For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.[105]

168. The marks share a first common element, being 'MATRI' and they differ in relation to their endings, 'GEL' and 'COAT', therefore I have found that the marks are visually and aurally similar overall to a medium degree, taking into account the different

[100] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

[101] *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

[102] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

[103] See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

[104] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

[105] *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

endings; and conceptually similar overall to a medium to high degree on the basis that both marks allude to the concept of a 'matrix', albeit in different forms.

169. I have found the goods to be similar to a low to medium degree, on the basis that the respective goods are complementary, would share the same user and would share the same trade channels.

170. Turning now to the distinctiveness of the earlier mark, which I have found to be low overall; and the distinctiveness of the common element 'MATRI', which I have also found to be low. In this regard I note the findings of the CJEU in *L'Oréal SA v OHIM.*[106] In this case the CJEU considered the comparison between an earlier mark for the word 'FLEX' and a later mark for the words 'FLEXI AIR', both for hair-care products. The CJEU held that even where an earlier trade mark is deemed to have a weak distinctive character, that does not preclude a finding of a likelihood of confusion per se. In reaching this conclusion, the court stated (my emphasis for clarity):

> "31. […] the assessment of the similarity of the signs in question must concentrate on the perception of the relevant public, irrespective of the extent of the protection enjoyed by the earlier mark.
>
> 32. […] the extent of the distinctiveness of an element of a complex mark will be a guiding factor in determining whether such distinctiveness will dominate the overall impression conveyed by that mark, irrespective of the assessment of the similarity of the two signs. The fact that such an element is only of weak distinctive character does not automatically mean that it cannot be the dominant element of a complex mark. **If the other elements of the mark are of even weaker distinctive character, the common element will, notwithstanding its weak distinctive character, none the less dominate the global impression conveyed by the mark applied for.**
>
> [...]
>
> 42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of

[106] Case C-235/05 P

the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

[...]

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, **even where the other elements of that complex mark were still less distinctive than the common element** and notwithstanding a likelihood that consumers would believe that **the slight difference between the signs reflected a variation in the nature of the products** or stemmed from marketing considerations and not that that difference denoted goods from different traders."

171. Given that the average consumer would pay a high degree of attention when selecting the goods, and given that the goods are similar to a low to medium degree, I rule out the possibility of a finding that the average consumer would directly confuse the two marks.

172. Whilst I have found that the average consumer of the goods at hand would pay a high degree of attention when selecting them, even a consumer paying the lowest degree of attention would not overlook that the marks share the identical first sequence of letters. Therefore the fact that the average consumer is paying a high degree of attention doesn't alter or skew that identity, if anything, it would render it all the more apparent. What is of particular note is that 'MATRI' forms the first part of both marks, and since the first parts of a mark normally carry a greater significance, this identity is significant.

173. Although I have made a finding that the common element 'MATRI' has an inherently low degree of distinctive character, the average consumer could not merely

disregard that element in favour of a reliance on the terms 'GEL' and 'COAT' to denote trade origin, since those elements are even lower still in distinctive character, particularly because (1) the evidence points to 'GEL' describing the nature of the Opponent's goods; and (2) 'COAT' (even by the Applicant's own admission) is a highly allusive/ descriptive element, indeed the BIOCOAT evidence certainly supports such a finding.[107]

174. Taking all my foregoing conclusions into account, and having regard to the above findings of the CJEU in *L'Oréal,* I find that a likelihood of indirect confusion is inevitable. This is on the basis that the average consumer will undoubtably notice the difference between the competing marks, but will also notice that they have the first element 'MATRI' in common. Notwithstanding the low degree of distinctiveness in the common element, the average consumer is likely to conclude that the contested mark is another brand of the owner of the earlier mark because they share that common element; and that the difference between the marks, namely 'GEL' and 'COAT', reflects a variation in the nature of the products rather than denoting goods from different traders. In this regard, I note even the Applicant submits that 'GEL' and 'COAT' would be seen as an indication of the 'nature' of the products.

175. In reaching this conclusion I also have regard to the Opponent's evidence which demonstrates that a 'matrix' product used in cell research can be used as a 'coating', namely: the evidence in relation to the *'Matrigel matrix-3D plates'* product (being *"pre-coated, ready to use"* cultureware); and the evidence of its BIOCOAT products, including its co-branded *'BioCoat Matrigel Invasion Chambers',* which demonstrates cultureware products can be 'coated' with various biological and synthetic substances, including matrices.

176. As such, upon encountering 'MATRIGEL' and 'MATRICOAT' on complementary goods that share the same trade channels, there is a likelihood that the average consumer (who is the user of both parties' goods), or a significant proportion thereof, is likely to be indirectly confused as to the origin of those goods, thus believing that they derive from the same or economically linked undertakings.

[107] The 'BIOCOAT' evidence shows that 'COAT' is being used to refer to products that are 'biologically coated'.

OUTCOME

177. The opposition under section 5(2)(b) of the Act is successful. Subject to any appeal, contested trade mark application number 3842545 shall be refused registration.

Final Remarks

178. Even if I am wrong in my finding that no genuine use of the BIOCOAT mark has been shown, given that reliance on the MATRIGEL trade mark alone leads to the opposition being successful in its entirety, a reliance on the BIOCOAT mark would not have materially improved the Opponent's position.

179. Even if I had found that the Opponent had shown genuine use of the MATRIGEL mark in relation to *"chemical reagents"*, this would not have materially improved the Opponent's position, as the opposition is in any event successful in its entirety based upon the Opponent's fair specification.

COSTS

180. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £2,700 based on the contributory scale set out in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official fee for filing Form TM7	£100
Preparing a statement of grounds and considering the other side's counterstatement	£400
Preparing evidence and considering the other side's submissions	£1,200
Preparing for and attending a hearing	£1,000
TOTAL	**£2,700**

181. I therefore order ORIENTAL YEAST CO., LTD. to pay Corning Incorporated the sum of **£2,700**. This 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 31st day of October 2024

Daniela Ferrari

For the Registrar

Annex 1

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BioCoat_Matrigel__Invasion_Chambers.pdf

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Corning® BioCoat™ Matrigel® Invasion Chambers

Frequently Asked Questions

CORNING

The Corning BioCoat Matrigel Invasion Chamber is a useful tool to study the invasion of malignant cells. For cells to metastasize, they must be able to secrete proteases that break down the basement membrane as well as migrate. Invasion through a Corning Matrigel matrix-coated cell culture insert has become the gold standard for low throughput quantitative and qualitative measurement of cellular metastatic potential, including investigation of the mechanisms of cell invasion and inhibition of cell invasion[1-10].

Q: How do I prepare Corning BioCoat Matrigel invasion chambers for use?

A: Remove the package from storage at -20°C and allow it to come to room temperature.

Confirm that the inserts are in the notches of the companion plates. Add warm bicarbonate-based media to the interior of the inserts. For exact volumes, see *Corning BioCoat Matrigel Invasion Chamber Guidelines for Use* (enclosed with the product). Allow to rehydrate for two hours in a 5% CO_2 incubator.

NOTE: If you do not want to use all of the inserts in the same experiment, do not allow them to thaw, as repeated freeze-thaws will damage the Matrigel matrix barrier. Open the package under aseptic conditions, and, using sterile forceps, transfer the inserts to a separate companion plate to thaw. Wrap the unused inserts in the original packaging and quickly return them to the -20°C freezer.

Q: Should I add chemoattractant into the upper or lower chambers?

A: The chemoattractant should be placed in the lower, or basolateral, chamber. It slowly diffuses into the upper, or apical, chamber setting up a chemotactic gradient for the cells to follow. See Corning Biocoat Matrigel Invasion Chamber Guidelines for use for detailed instructions.

Air Bubble

Q: Does it matter if I have air bubbles, and how do I prevent them?

A: It is critical that the BioCoat Matrigel invasion chambers are in the notches and there are no air bubbles. Add pre-warmed media containing chemoattractant to the wells of the Falcon® tissue culture companion plate, or add just media to the negative control wells. Use sterile forceps to transfer the chambers into the previously filled wells of the companion plate. To avoid air bubbles, tip the chamber at a slight angle as it is lowered into the liquid and align the notches. If there are air bubbles, carefully tap the side of the plate to dislodge the bubbles.

Q: I don't want cells to be weak during the migration/invasion assay, so can I add serum to the

Annex 2

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