O/1147/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003794315
BY APROGEN INC.
TO REGISTER:

APROGEN

AS A TRADE MARK IN CLASS 5

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 437676 BY
ABIOGEN PHARMA S.P.A

BACKGROUND AND PLEADINGS

1. On 31 May 2022, APROGEN INC. ("the applicant") applied to register the trade mark shown on the cover of this decision in the UK for the following goods:

   Class 5: Pharmaceuticals for human purposes; medicines for human purposes; Vaccines; antibodies for medical purposes; anti-cancer preparations; pharmaceutical preparations for the treatment of auto-immune diseases.

2. The applicant's mark is derived from an earlier trade mark registered in the Republic of Korea under number 40-2021-0249940, which has the filing date of 8 December 2021. As such, the applicant's mark has a priority date of 8 December 2021.

3. The applicant's mark was published for opposition purposes on 26 August 2022 and, on 23 November 2022, it was opposed by Abiogen Pharma S.p.A ("the opponent"). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). Under the section 5(2)(b) ground, the opponent relies on the following marks:

   ABIOGEN PHARMA

   UK registration no. 3625460[1]
   Filing date: 13 April 2021
   Priority date: 25 March 2019

[1] The opponent's first mark was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the EU. This means that the UK mark enjoys a priority date that is in line with the filing date of the opponent's earlier EU mark upon which it is based.

Relying on all goods, being the following:

Class 5: Pharmaceuticals, medical and veterinary preparations, sanitary preparations for medical purposes, dietetic food and substances adapted for medical or veterinary use, food for babies, dietary supplements for humans and animals, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, vitamin supplements and food supplements, medical devices (substances).

("the opponent's first mark"); and

ABIOGEN
PHARMA

UK registration no. 908599862[2]
Filing date 18 September 2009; registration date 1 March 2010
Relying on all goods and services, being the following:

Class 1: Chemical products used in industry and science; Chemical substances for preserving foodstuffs.

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; air deodorising preparations; anti-rheumatism bracelets; mediums

[2] The opponent's second mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

(bacteriological culture -); bracelets for medical purposes; contact lens cleaning preparations; dental impression materials; eyepatches for medical purposes; headache pencils; surgical implants comprised of living tissues; semen for artificial insemination; nutritive substances for microorganisms; blood plasma; anti-rheumatism rings; starch for dietetic or pharmaceutical purposes; surgical implants [living tissues].

Class 42: Research in the pharmaceutical and scientific sector.

("the opponent's mark").

4. Under the section 5(2)(b) ground, the opponent claims that the marks at issue are similar and that the goods and services for which application is sought are identical and/or similar to the opponent's goods. As a result, the opponent argues that there exists a likelihood of confusion between the marks.

5. Under the section 5(3) ground, the opponent relies on its second mark only and claims to enjoy a reputation in "pharmaceutical preparations" and "research in the pharmaceutical and scientific sector". As a result, the opponent claims that use, without due cause, of the applicant's mark, would take unfair advantage of, or be detrimental to the distinctive character and/or reputed of the opponent's mark.

6. The applicant filed counterstatements wherein it denied the claims against it. In doing so, the applicant made reference to the fact that the fate of the opponent's first mark is unknown as it is presently subject to its own opposition proceedings under number 426691. While that may be the case, it is presently a validly registered earlier mark that is capable of forming the basis of an opposition. That being said, this is something that I consider necessary to discuss further below. In addition, the applicant requested that the opponent prove use for its second mark.

7. The opponent is represented by Boult Wade Tennant LLP and the applicant is represented by Dolleymores. Only the opponent filed evidence in chief. No hearing was requested and both parties filed written submissions in lieu of the same. On the basis that the applicant's submissions were filed after the deadline, the opponent was granted permission to file further submissions in reply, which it elected to do so. This decision is taken after careful consideration of the papers.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. The opponent's evidence came in the form of the witness statement of Massimo di Martino dated 21 November 2023. Mr di Martino is the founder, President and Managing Director of the opponent. His statement is accompanied by 12 exhibits, being MDM01 to MDM12. It is noted that MDM12 has been granted confidentiality from the general public at large. I also note that Mr di Martino's statement is accompanied by an addendum wherein he has corrected page number references in paragraphs 13 and 20 of his statement. The purpose of Mr di Martino's statement was to prove use of the opponent's second mark and demonstrate that it enjoys a reputation. Further, the evidence also seeks to prove that both marks enjoy an enhanced degree of distinctive character.

10. In addition, the opponent has filed the witness statement of Jessica Viganò dated 20 November 2023. Ms Viganò is an Attorney at Law and the owner of VLF S.R.L. While it is not clear her relationship with the opponent in the body of her statement, it is confirmed in Mr di Martino's statement that she is the opponent's Italian Trade

Mark Attorney. Her statement confirms that she is the person who provided the translations of a number of exhibits within Mr di Martino's evidence (being MDM06 and MDM09). While not a certified translator, she confirms that she is fluent in Italian and is suitably familiar with and proficient in the English language. In addition, her statement is accompanied by five exhibits, being JV01 to JV05, which is aimed at providing evidence in respect of statistics regarding UK visitors to Italy and Italian visitors to the UK. The purpose of Ms Viganò's statement is to provide translations for a number of exhibits contained within Mr di Martino's witness statement.

11. I do not intend to summarise the opponent's evidence (or the parties' submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

12. As set out above, the opponent's first mark is presently subject to ongoing opposition proceedings. As such, it is possible that the opponent's first mark may be refused registration. If this were to happen, the opponent's first mark would no longer be classified as a valid earlier mark meaning that the opponent would not be permitted to rely on it for the sake of these proceedings. Therefore, any success of the present opposition reliant upon that earlier mark would be provisional pending the outcome of the opposition against it. In such circumstances, I would need to issue a supplementary decision upon the issuance of the decision in processing 426691 wherein I would either confirm my provisional decision or declare it as void/set it aside.

13. In light of the above and the fact that the opponent's second mark is not subject to an ongoing opposition, I consider that the appropriate approach in these proceedings is to begin by conducting a proof of use assessment in respect of the opponent's second mark. If genuine use is proven, I will proceed in reliance upon

the opponent's second mark only. I take this approach because (1) any success in respect of the second mark would not be provisional and (2) the opponent's marks are very highly similar in that the word 'ABIOGEN' dominates both marks.[3] Alternatively, if proof of use is not proven, then the opposition can only proceed in respect of the opponent's first mark. As above, any success in respect of this mark will be provisional, a point I will discuss further at the conclusion of my decision, if required.

DECISION

Proof of use

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

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

[3] As such, I do not consider that either mark offers any clear advantage over the other in respect of the section 5(2) opposition.

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

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

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

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

> "100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

17. As the opponent's second mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

> "7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A to the United Kingdom include the European Union".

18. Given its filing date, the opponent's second mark qualifies as an earlier trade mark under the above provisions. The opponent's second mark had completed its registration processes over five years prior to the priority date of the applicant's mark. As set out above, the applicant requested that the opponent provide proof of use in respect of the same. Therefore, the opponent's second mark is subject to the proof of use assessment.

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

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

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

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

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

20. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period prior to the priority date of the applicant’s mark, being 8 December 2021. The relevant period is, therefore, 9 December 2016 to 8 December 2021 (“the relevant period”).

21. As the opponent's second mark is a comparable mark based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.[4] As a result, the relevant territory between 9 December 2016 and 31 December 2020 is the EU (which includes the UK as, at that time, it was a Member State) and between 1 January 2021 and 8 December 2021, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union ("CJEU") noted that:

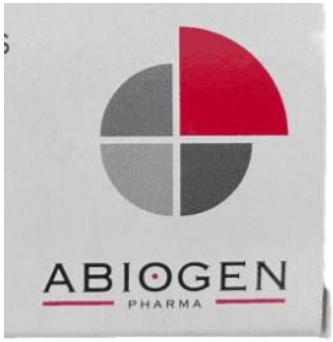
> "It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."
>
> And
>
> "50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

[4] See paragraph 4 of Tribunal Practice Notice 2/2020

22. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[5] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

Form of the mark

23. Briefly, I wish to discuss the form of the mark used in the evidence. While the opponent's second mark is present throughout the evidence, the majority of the opponent's branding is as follows:



24. Plainly, this is the opponent's first mark, albeit presented in colour. While this mark is not relevant here, I consider that it is capable of being considered use that the opponent may rely on in respect of its second mark. I remind myself that the opponent's second mark as registered is as follows:

ABIOGEN
PHARMA

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

25. Firstly, I appreciate that the horizontal lines and the dot in the letter 'O' are presented in red in the mark as used. However, such differences plainly do not alter the distinctive character of the opponent's second mark.[6] Therefore, the way in which the 'ABIOGEN PHARMA' element appears in the mark as used is an acceptable variant of the opponent's first mark. Secondly, I rely on the case of *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12 wherein the CJEU set out that use of a mark encompasses both its independent use and its use as part of another mark. Clearly, the opponent's second mark is used as a part of the mark as used and, therefore, the opponent may rely on the way in which it has used its first mark in its evidence in support of its claim to have genuinely used its second.

Evidence of use

26. The opponent's evidence confirms that it was founded in 1997 and that it manufacturers and markets pharmaceutical preparations, drugs, medical devices, supplements and foods for medical purposes. In addition, the opponent claims to provide research and development services. In respect of the areas in which the opponent focuses, the evidence confirms that this includes bone metabolism, hypovitaminosis (being the prevention and treatment of Vitamin D deficiencies), pain and vicosupplementation (for the management of inflammatory and non-inflammatory/neuropathic pain as well as acute or chronic pain), respiratory, dermatology and diabetology. Information in relation to these areas has been provided in evidence by way of extracts from the opponent's website 'abiogen.it'.[7] These printouts are from within the relevant period and were taken from the internet archive facility, the Wayback Machine. This evidence is very technical in nature as it relates to various medical fields. Therefore, I do not intend to discuss it in full but I do note that it does include a graphic on a printout dated 9 June 2018 that shows the 2017 turnover percentage for the opponent's different therapeutic areas.[8] Of

[6] For guidance on use of marks in differing forms, see paragraphs 13 to 17 of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22
[7] MDM01
[8] Page 25 of MDM01

this, I note that 'bone metabolism' made up 79% of the turnover for that year, with 'pain' taking up 10%, 'respiratory' taking up 4%, 'dermatology' taking up 3% and 'other' making up the last 4%. In addition, I note that there is a printout that shows that the opponent offers licensing in the USA, Switzerland, Spain, Japan, Italy and Sweden.[9]

27. Turning to the various pharmaceutical preparations that it offers; the opponent has provided a printout from its website showing the goods it offers for sale under the mark.[10] The printout providing this information is undated but the narrative evidence confirms that they are substantively the same pages that were accessible on or before 31 December 2020. Under the pharmaceutical page of the opponent's website, it is noted that there is a range of separate brand names shown. For illustrative purposes, these are as follows:

[9] Page 32 of MDM01
[10] MDM02

28. The subsequent pages provided show these different brands and what goods are offered under them. I do not intend to go over each and every one but, for example, note that 'Acetamol' is shown as being a paracetamol, 'Alendros' is shown as being 70mg sodium alendronate and 'KEPLAT' is shown as being a ketroprofen.

29. There is evidence provided that actually shows the packaging of a range of these goods via an information leaflet (which is in Italian) and photographs.[11] It is noted that each package includes the marks shown above but also the opponent's 'ABIOGEN' branding in prominent positions on them. The packaging mostly shows the Italian language but I note that there are some products which have English descriptions on them.

30. In respect of its goods, the opponent has provided printouts taken from the national medicine register of the Italian Medicine Agency (AIFA) which contains details of the pharmaceutical preparations that are authorised for use in Italy.[12] While noted, the printouts were accessed in November 2023 and there is nothing to confirm the authorisation status of such goods during the relevant period.

31. Turnover figures are provided by way of extracts from the opponent's Annual Report and Financial Statement for the fiscal year ending 31 December 2020. The document is provided in Italian but it has been partially translated by Ms Viganò. In respect of the turnover taken from this document, I note that the turnover of the opponent between 2015 and 2020 in the "areas/fields of corporate strategic interest" are as follows:[13]

Year	**Italy (€)**	**Foreign (€)**
2015:	131,734,714	2,772,557

[11] See MDM03 and MDM04, respectively.
[12] MDM05
[13] While it is not confirmed in the report itself that these figures are in euros, I consider it reasonable to conclude that they are on the basis that several times throughout it, there are reference to other figures in euros.

2016:	150,962,914	5,784,070
2017:	166,286,932	7,159,989
2018:	178,996,478	10,989,995
2019:	176,408,703	13,751,080
2020:	160,375,784	18,044,624
Total:	964,765,525	58,502,315

32. It is noted that another table is provided in this report that provide a breakdown of revenue by geographical area. The names of the counties have not been translated. The name of some countries is the same in Italian as it is in English (Canada and Korea) and I can reasonably conclude that 'Israele' is Israel and 'Stato del Vaticano' is the Vatican City. However, I am unable to make out what some other countries are and, therefore, I am not able to determine the breakdown in respect of these countries.[14]

33. Lastly in respect of this report, I note that it sets out that the 'Dibase' product was the opponent's main product during 2020 and one that contributed approximately €100m to the opponent's turnover, accounting for 70% of the overall figures for that year. Based on the evidence regarding the type of product this is, I can confirm that it is a vitamin D tablet which is sold in packaging that bears the 'ABIOGEN' branding.[15]

34. In support of the opponent's sales, I note that it has provided almost 100 pages of invoices.[16] The invoices are said to be representative samples and while I have no intention of discussing the invoices in any great detail, I do note that they show sales of many pharmaceutical preparations in Italy between 19 July 2017 and 29 January 2020. The invoices show different brandings (being those I have discussed above) but are all headed with the 'ABIOGEN' branding.

[14] It is noted that the UK does not appear to be present in this table.
[15] See page 68 of MDM04
[16] MDM08

35. The evidence then turns to discuss the opponent's advertising efforts. In doing so, the opponent confirms that it incurred the following marketing and advertising spend:[17]

Year	Advertising spend (€)
2017	7 million+
2018	9 million+
2019	8 million+
2020	4 million+
2021	6 million+
Total	34 million+

36. Examples of the opponent's advertising efforts are provided by way of advertisements published in Italy between 2013 and 2020.[18] In addition, this same evidence includes a number of press articles. There are approximately 54 pages of articles and advertisements and while some are prior to the relevant period, the majority of them are from within it. The evidence provided here is all in the Italian language and while some translations have been provided, I see no reason to discuss their content here. All I will say is that, clearly, the opponent has demonstrated a significant attempt to promote its brand in Italy during the relevant period.

37. While on the topic of promotion, the opponent's evidence confirms that it attended various international conferences in order to promote its research and goods. These events cover those held in various European countries such as Germany, France, Italy and Spain between 2010 and 2022. I appreciate that some of these events are from outside the relevant period, however, some are from within it.

[17] I note that at MDM07, these same figures are provided and confirmed as relating to the opponent's spend in Italy.
[18] MHM09

Photographs of the opponent's stands/stalls at these events are provided in evidence and I note that they all show the ABIOGEN branding.[19]

38. In respect of its research services, the opponent claims that it supports and funds research in the pharmaceutical, scientific and medical fields. A sample of academic papers that the opponent has funded and supported are provided.[20] While noted, there is nothing to suggest that the opponent actually undertook any research itself or provided the research as a service to others. Instead, the papers provided all expressly confirmed that they were sponsored or funded by the opponent. In my view, such an activity is not capable of pointing to use of the relied upon services in class 42.

39. Lastly, the opponent's evidence discusses a series of datasheets regarding its units sold and market share data. This evidence is covered by a confidentiality order so I will not seek to discuss it in full detail. That being said, the narrative evidence wherein these datasheets (being paragraphs 21 to 23 of Mr di Martino's witness statement) are discussed is not subject to confidentiality. This narrative evidence sets out that the opponent sold over 30.7 million pharmaceutical packs in Italy in 2019 and over 27.8 million packs in Italy in 2020.

Assessment of the evidence

40. Plainly, the opponent's business operation has a significant focus on the Italian market. It does not appear to me that the opponent has filed any evidence that can sufficiently solidly point to any use in the UK whatsoever. Under the present assessment, this is not a particular issue for the opponent because use in the EU is relevant for four of the five years of the relevant period. So while there is no use in the UK (being the relevant territory for 1 January 2021 to 8 December 2021), the use before me in respect of Italy alone is clearly significant. On this point, I remind

[19] MDM10
[20] MDM11

myself that the turnover for various pharmaceutical preparations in Italy stood at almost €1 billion and, further, the opponent incurred an advertising spend in Italy of over €30 million. In addition, the figures in respect of how many pharmaceutical packs the opponent sold in 2019 and 2020 alone are also very significant. Such use in Italy alone is, in my view, sufficient to demonstrate use within the EU as a whole. In saying this, I remind myself of the case of *Leno Merken* (cited above) which confirms that use in a single Member State may be considered as genuine use of an EUTM which cover the whole of the territory of the EU. As a result, I am of the view that the opponent has genuinely used its second mark during the relevant period.

41. The above being said, I do not consider that the use before me covers all of the goods and services upon which the opponent relies. For example, there is no evidence before me in respect of goods such as "dental wax", "materials for dressings" and "headache pencils". Additionally, there is nothing before me that shows use of any form of veterinary preparation. Instead, the focus of the evidence appears to be on a range of pharmaceutical and dietic products for use by humans. This includes products such as paracetamol, vitamin capsules[21] and ketoprofen, amongst others. In my view, the wide range of areas in which the opponent focuses and the range of goods shown in evidence, the opponent's use would be fairly categorised as "pharmaceutical preparations" and "dietetic substances adapted for medical use" by average consumers.

42. Lastly, I note that there is nothing before me in respect of any of the class 1 goods relied upon and, for the reasons I have already set out above, the evidence is insufficient to demonstrate that the opponent actually offers any of the class 42 services relied upon. As a result, I hereby consider that the opposition may only proceed in respect of the following goods, being those that I deem to be a fair reflection of the use shown in evidence:

[21] I note that the DIBASE products (which made up 70% of the opponent's 2020 turnover) are Vitamin D supplements.

Class 5: Pharmaceutical preparations; dietetic substances adapted for medical use.

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

43. Given that I have found that the opponent has genuinely used its second mark, I will proceed in considering this decision in reliance upon this mark only. I do so because if the opposition succeeds in respect of this mark, then any reliance upon the opponent's first mark is not necessary, especially given that it is subject to its own opposition. Alternatively, if the opposition in reliance upon the opponent's second mark fails, then given its similarity with the opponent's first mark, it follows that any reliance on the first mark offers nothing further. All this being said, if I consider it necessary to do so, I will return to discuss the opponent's first mark at the conclusion of my decision. Until then, I will refer to the opponent's second mark as, simply, 'the opponent's mark'.

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

> "(2) A trade mark shall not be registered if because-
>
> (a) […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark."

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

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

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

47. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 5 Pharmaceutical preparations; dietetic substances adapted for medical use.	Class 5 Pharmaceuticals for human purposes; medicines for human purposes; Vaccines; antibodies for medical purposes; anti-cancer preparations; pharmaceutical preparations for the treatment of auto-immune diseases.

48. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

49. I note that in paragraph 6 of its written submissions in lieu, the applicant admitted that there was a high degree of similarity between all of its goods and "pharmaceuticals" in "the Opponent's earlier right". While this is a term in the opponent's first mark's specification (as part of the broader term "pharmaceuticals, medical and veterinary preparations"), the concession can be construed as being equally applicable to the term "pharmaceutical preparations" in the opponent's second mark's specification.

50. While the concession is noted, it is my view that the opponent's term of "pharmaceutical preparations" is sufficiently broad enough to encompass all of the applicant's goods. I say this because *pharmaceuticals* cover any kind of drug used

for medical purposes. Given that the applicant's goods are all types of goods used for medical purposes, they can all be said to be various types of pharmaceutical preparations. Therefore, applying the principle outlined in *Meric*, the goods are identical. Even if this is wrong then I may proceed on the basis of the applicant's concession that the goods are accepted as being similar to a high degree.

The average consumer and the nature of the purchasing act

51. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

52. The opponent submits that there are various different classes of consumers that are relevant here. Firstly, the opponent claims that there are the doctors who will prescribe the pharmaceutical goods, individuals in hospitals who are charged with authorising their use or prescription, pharmacists who are liable to be involved in their provision of selection (depending on whether they need to be prescribed or are available off the shelf or over the counter). The opponent submits that this class of consumer will pay a high degree of attention. Secondly, the opponent submits

that the general public will also be relevant because while some goods may be specialist, some may not. The opponent submits that this class of consumer will pay a lower degree of attention to the class of consumers described above. In short, I agree in that there will be two classes of consumers, being the healthcare professionals and members of the general public. I will return to the submissions in respect of the level of attention paid below.

53. Depending on the ailment that is being treated, the goods will be selected at varying frequencies and at varying costs. For example, paracetamols for the treatment of headaches or other pains will be selected frequently and at a low cost whereas some medications to treat less frequent ailments will be selected a lot less frequently and may come at a higher cost.[22]

54. In respect of the way in which the goods are selected, I consider that they will either be selected by end consumers in supermarkets/pharmacists or will be obtained via a prescription. In the former instance, the goods will be selected visually but may also be selected having a discussion with a pharmacists/doctor, meaning that the aural component will not be discounted. In the latter instance, there will be no selection process per se as the goods will be selected for the end consumer by the healthcare professional. In respect of the selection process of the healthcare professional, the goods will be obtained from the producer of the pharmaceuticals themselves. When determining what goods to prescribe, this will be a result of the professional's own expertise and level of knowledge of active ingredients. In my view, this process will be primarily visual as they will be required to consider the ingredient list of the products as well as any research or consultation papers in respect of the same. In addition, the aural component will also play a role by way of discussions with other healthcare professionals or representatives of the provider itself.

[22] I appreciate that in some instances, the cost will not be borne by the end consumer but, rather, the healthcare service.

55. As for the level of attention paid, I agree with the opponent that healthcare professionals will pay a higher degree of attention on the basis that they will need to rely on their expertise in considering the active ingredients, symptoms of the patient and any risk of adverse reactions. That being said, I wish to clarify that I do not consider that this extends outright to high. As for the general public, I agree that this will be lower and, in my view, this will be at a medium degree. Even where the goods are cheap and frequently selected, consumers will be buying the goods to assist with a medical ailment so will be assessing the medical information on the goods, whether they are suitable for their needs and their dosage requirements.

Distinctive character of the opponent's mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

57. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In the present case, the opponent has pleaded that its mark enjoys an enhanced degree of distinctive character and has filed evidence to that effect. Before considering the evidence, I will first assess the inherent position.

58. The opponent's position is that its mark enjoys between a medium and high degree of inherent distinctive character. This is on the basis that while the word 'PHARMA' points to the goods at issue, 'ABIOGEN' has no particular meaning and is a made-up word that is not particularly short. I agree that the word 'PHARMA' is descriptive of the goods at issue (on the basis that it will immediately be perceived as an abbreviation of 'pharmaceuticals') and, therefore, does not contribute to the distinctiveness of the mark to any significant degree. However, I disagree with the submissions in respect of 'ABIOGEN'. I say this because while 'ABIOGEN' may be perceived as a made up word, consumers, when confronted with verbal signs, will seek to break down its elements which, for them, suggest a concrete meaning or which resemble words known to them.[23] As a result, I consider it likely that a significant proportion of consumers will, when viewing 'ABIOGEN' on pharmaceutical goods, perceive the letters 'BIO' as a reference to 'biology' or 'biological' and the letters 'GEN' to 'genetics'. I appreciate that such a connection is not descriptive as the word still has no obvious meaning, however, I am of the view that it is somewhat allusive to the goods for which the opponent's mark is

[23] See paragraph 62 of *Usinor SA v OHIM*, Case T-189/05

registered. As a result, I consider that the opponent's mark is inherently distinctive to a slightly less than medium degree.

59. In respect of the claim that the opponent's mark enjoys an enhanced degree of distinctive character, I consider that I can deal with this briefly. I say this because as discussed above, the evidence has a significant focus on Italy with only limited references to other countries. Further, there is nothing sufficiently solid pointing to actual use in the UK. On this point, I note that the opponent sought to file evidence regarding the number of people visit Italy from the UK, and vice versa, is provided in evidence.[24] While this evidence is noted and it is appreciated that Italy may be a popular tourist destination for UK consumers, it does nothing to demonstrate any level of knowledge amongst UK consumers of the 'ABIOGEN' brand when visiting Italy. For example, there is nothing to suggest how many of the UK consumer visiting Italy would require pharmaceutical goods when visiting that country and, even if they did, whether it is the 'ABIOGEN' branding that they would come across and retain knowledge of. As a result and given that the assessment of distinctive character is based on the perception of the UK consumer, I consider this issue is fatal to the opponent's claim. As a result, the evidence filed is of no assistance here and the inherent position applies.

Comparison of the marks

60. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

[24] See JV01 to JV04

61. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

63. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
ABIOGEN PHARMA	APROGEN

64. I have detailed submissions in respect of the comparison of the marks from both parties. While I can confirm that I have taken these into account in making my comparison, I will only refer to them where I consider it necessary to do so.

Overall Impression

65. The opponent's mark consists of both word and device elements. The words are 'ABIOGEN' and 'PHARMA', both presented in a black standard typeface. 'PHARMA' is presented below 'ABIOGEN' and in a much smaller typeface. As for the device elements, these come in the form of a dot in the letter 'O' and two horizontal lines either side of the word 'PHARMA'. The opponent submits that while 'PHARMA' will not be overlooked, it will play a lesser role due to its size. I agree that it will play a lesser role, however, this is not solely due to its size but also because it is descriptive of pharmaceutical goods. As for the device elements, the opponent submits that these will be overlooked and are, therefore lowly distinctive. While I agree that they are lowly distinctive, I do not consider that they will be outright overlooked and, instead, find that they play a negligible role. Taking all of this into account, I am of the view that 'ABIOGEN' will play the greater role in the overall impression of the mark, with 'PHARMA' playing a lesser role and the device elements laying a negligible role.

66. As for the applicant's mark, this is a word only mark that consists solely of the word 'APROGEN'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

Visual Comparison

67. Visually, the marks share the letters 'A' at their beginnings and the letter string 'O-G-E-N' at their ends. The marks differ with their second and third letters, being 'P-R' in the applicant's mark and 'B-I' in the opponent's. In addition, the opponent's mark includes the word 'PHARMA' and some device elements. While these play different (and lesser roles) in the overall impression of the opponent's mark, they are still points of visual difference between the marks as they have no counterpart in the applicant's mark. As the applicant's mark is a word only mark, it is capable of being presented in any standard typeface and while it is not legitimate to perform

a comparison between a word mark and a stylised word mark by considering specific ways in which the word might be presented,[25] the point here is that the applicant's mark is not limited to any particular script and therefore the typeface used in the opponent's mark does not provide a point of distinction in itself. Taking all of this into account, I am of the view that the marks are visually similar to a medium degree.

Aural Comparison

45. The opponent submits that the word 'PHARMA' in its own mark will be pronounced. While it may be descriptive, it is not aurally invisible and I, therefore, agree with the opponent's submission.[26] As a result, the opponent's mark will be pronounced in full, being six syllables in length. In my view, it will either be pronounced as 'UH-BYE-OH-JEN-FAR-MAH' or 'ABB-E-OH-JEN-FAR-MAH'. As for the applicant's mark, this consists of three syllables that will be pronounced as 'APP-ROE-JEN'. While the marks begin with the letter 'A', I am of the view that the subsequent letters in each mark inform the pronunciation of that letter to the point that it will be pronounced differently in the marks.[27] Therefore, the only point of aural similarity comes in the third syllable of the applicant's mark, which is identical to the fourth syllable of the opponent's. Further, the marks are of different lengths with the opponent's mark being double the length of the applicant's. Taking all of this into account, I am of the view that the marks are aurally similar to a low degree.

Conceptual Comparison

68. The opponent's position in respect of the conceptual comparison is that the marks are either conceptually identical or, alternatively, are not capable of being

[25] See the decision of the Appointed Person in *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraphs 23 and 34.
[26] See *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein Phillip Harris, as the Appointed Person, stated that descriptiveness of an element does not render it aurally invisible.
[27] On this point, I refer, for example, to the fact that while the first letters in words such as 'ability' and 'apropos' may be the same, they are still capable of being pronounced differently. I consider that this is the case here.

conceptually compared. I disagree on both fronts. As I have set out above, the word ‘ABIOGEN’ will, despite having no known meaning, be understood as a reference to the words ‘biology’ or ‘biological’ and ‘genetics’. As for ‘PHARMA’, this will be understood as an abbreviation of ‘pharmaceuticals’. This is descriptive. All this being said, I do not consider that the mark as a whole conveys any immediately graspable concept to the average consumer. As for the applicant’s mark, I consider that a similar finding will apply here in that the letters ‘GEN’ at the end of the mark may be seen as a reference to the word ‘genetics’. Again, the mark as a whole has no immediately identifiable concept. In my view, the shared reference to ‘genetics’ will be identified in both marks and, while not a strong point of conceptual similarity, I consider that it is sufficient to give rise to a finding that the marks are conceptually similar to a low degree.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their minds.

70. I have found the parties' goods to be identical but I note that, at worst, they are similar to a high degree given the concession of the applicant. I have found the average consumer for the services to be members of the general public at large or healthcare professionals. In terms of the selection process, the goods will, for the most part, be selected after having paid attention to the visual component. That being said, the aural element will still play a role and, in some circumstances, it may be a role that is equal to the visual component. In respect of the level of attention paid, I have found that members of the general public will pay a medium degree of attention and that the healthcare professional will pay a higher degree of attention (though I do not consider that this extends outright to high). In respect of the similarity of the marks at issue, I have found the marks to be visually similar to a medium degree and aurally and conceptually similar to a low degree. Lastly, the opponent's mark is inherently distinctive to between a slightly less than a medium degree.[28]

71. The opponent's submissions in respect of direct confusion were made on the basis that the average consumer is liable to mistake the marks for one another, particularly given that the 'PHARMA' element is so descriptive of the underlying goods that it is liable to be ignored. Insofar as the submissions relate to the 'PHARMA' element, I agree on the basis that its descriptiveness is such that consumers would likely overlook it or misremember it entirely. Having said that, in taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that the consumer will be able to accurately recall or remember the marks for one another. I say this because, regardless of the presence of 'PHARMA', it is the difference in the marks' dominant elements, being 'ABIOGEN' and 'APROGEN', that will lead the consumers to accurately recall the marks for one another. It is appreciated that these elements share the same first letter as well as their last four, however, I do not consider that this automatically

[28] While this level of distinctiveness is not considered to be outright weak, it is on the weaker end of the scale. On this point, I refer to the case of *L'Oréal SA v OHIM*, Case C-235/05 P wherein the CJEU set out that weak distinctive character of an earlier mark does not preclude a likelihood of confusion.

means that the consumer will be confused. Despite the visual similarity between these elements, the impact of the differing letters subsumed within them is such that consumers will not overlook them to the point that they would be directly confused upon being confronted by the marks visually. In addition, the low degree of aural and conceptual similarity are additional factors that will assist the consumer in being able to accurately recall which mark was which. It is, therefore, my conclusion that the average consumer (regardless of whether that is a member of the general public or a healthcare professional) will not be directly confused by the marks at issue, even on identical goods.

72. I turn now to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

73. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. In respect of indirect confusion, the opponent submits that consumers would be likely to believe that the goods offered under the applicant's mark originate from a source related to the earlier right due to the close similarity of the structures of the marks. As such, the opponent claims that there could be an erroneous presumption that the goods of one party are a reformulation or adaptation of those of the other. While these submissions are noted, I do not consider that they are of any

assistance. In respect of the first argument, I will say that closely similar structures in marks is not something that assists an argument of indirect confusion. I appreciate that it may be of assistance where a 'family of marks' argument is in play, however, that is not the case here. Turning to the second argument put forward, I consider that this is one that falls in line with category (c) of *L.A. Sugar* (cited above). While noted, the opponent has provided no logical reason as to why consumers would believe the undertaking responsible for the mark 'ABIOGEN' would reformulate or adapt their mark to 'APROGEN'. Without supportive reasons as to why this is the case, I see no reason why it would be and, as such, I am not willing to find that this alteration is one that is logical or consistent with a brand extension or sub-brand. Further, the distinctiveness of the opponent's mark lies in the word 'ABIOGEN' and not the letters 'A-O-G-E-N'. So even if it were the case that 'ABIOGEN' was highly distinctive,[29] it is not the common element so the present case is not one that, in my view, falls within category (a) of *L.A. Sugar* (cited above). Lastly, I am of the view that category (b) of *L.A. Sugar* is not applicable here as while 'PHARMA' may be a non-distinctive addition, the lack of confusion in respect of the marks' dominant elements is such that consumers would not consider this a logical addition indicative of a sub-brand.

75. I appreciate that the categories set out in *L.A. Sugar* are not exhaustive, however, there is nothing further before me that would suggest the existence of a likelihood of indirect confusion. For me to seek to formulate further arguments in support of indirect confusion would not be appropriate in the circumstances and neither would it be fair to the applicant. As a result, taking all of the above into account and reminding myself of the comments of Mr Mellor Q.C. and LJ Arnold at paragraph 73 above, I find that there exists no likelihood of indirect confusion, even where the marks are viewed on identical goods.

[29] On the basis that my finding above was incorrect and in the event that 'ABIOGEN' is perceived as a completely made up word.

Final remarks in respect of the opponent's first mark

76. Before proceeding to consider the section 5(3) ground, I pause here, briefly, to discuss the opponent's first mark. I do so at this point because that mark is not relied upon under the section 5(3) ground so will not be relevant there.

77. For the sake of completeness, I will say at this point that I see no reason why any assessment based on the opponent's first mark would have resulted in a favourable outcome for the opponent. I say this because the opponent's marks are very similar and while its first mark has an additional figurative element, it is, like its second mark, dominated by the word 'ABIOGEN'. In addition, the opponent's first mark consists of the same terms upon which I based my finding of identity (and is also subject to the applicant's concession as to high similarity). Notwithstanding the fact that the opponent's first mark is likely less similar from a visual standpoint with the applicant's mark, I am of the view that, at best, any assessment of similarity of goods, distinctiveness of the mark and the similarity of marks in respect of the opponent's first mark would have resulted in the same outcomes as those reached for those respective assessments above. As such, I see no reason why the same logic expressed in my likelihood of confusion assessment in respect of the opponent's second mark would not also apply to the opponent's first mark.

78. For the avoidance of doubt, I do not consider that there exists any likelihood of confusion between the opponent's first mark and the applicant's mark.

Section 5(3)

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

> "5(3) A trade mark which –

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

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

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar.[30] Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

82. Given that the opponent's mark is a comparable mark and because the use before me has a significant focus on Italy, I consider it necessary to refer, at this point, to the case of *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, wherein the CJEU held that:

"20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression 'has a reputation in the Community', by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that

[30] Given my findings under the section 5(2)(b) ground, I am satisfied that there is a degree of similarity between them.

condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29 As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community."

Reputation

83. I have assessed the opponent's evidence at paragraphs 26 to 39 above, I do not consider it necessary to repeat this evidence here. However, I will briefly reiterate that for the years 2017 to 2020, the opponent enjoyed a turnover of €964 million in Italy. Further, the opponent incurred an advertising spend of over €28 million over that same period in the same jurisdiction. I have no hesitation to the find that this level of use is, in my view, sufficient to warrant a finding that the opponent, as at

the relevant date, enjoyed a strong reputation in Italy. Italy constitutes a substantial part of the territory of the EU Community and I, therefore, consider that the significant level of use in this country alone is sufficient to conclude that the opponent's level of use in this territory is sufficient to support a finding that the opponent's mark enjoyed a reputation in the EU as a whole. On this point, I remind myself that EU use is relevant to the present assessment up to 31 December 2020, being just 11 months prior to the relevant date. Given the level of use and the proximity of IP Completion Day to the relevant date, I see no reason to find that this does not reflect the position as at the relevant date. Therefore, I consider that the opponent's reliance upon its Italian use is such that the opposition in respect of the present ground may proceed.

Link

84. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

85. The marks are issue are visually similar to a medium degree and aurally and conceptually similar to a low degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

86. I have found above that the goods at issue identical, however failing that, the applicant has conceded that they are similar to a high degree.

The strength of the earlier mark's reputation.

87. I have found that opponent's mark enjoys a strong reputation in the EU.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

88. Inherently, I have found the opponent's mark to be distinctive to a slightly less than medium degree. While the evidence is sufficient to warrant a finding of a reputation, the assessment as to enhanced distinctive character is based on the UK only. Given the lack of any UK specific evidence, I do not consider that the opponent's mark enjoys any degree of enhanced distinctive character.

Whether there is a likelihood of confusion

89. I have found that is no likelihood of either direct or indirect confusion between the marks.

Conclusions on link

90. In considering whether there exists a link or not, I remind myself of the case of *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, BL O/281/14, wherein Mr Iain Purvis QC, sitting as the Appointed Person, stated:

> "40. […] I believe that the ultimate decision under s5(3) was nonetheless correct. In order to succeed under s5(3), the opponent has to show either that the distinctive character or repute of its earlier mark would be damaged by reasonable and fair use of the mark applied for, or that such reasonable and fair use would take unfair advantage of the reputation of its earlier mark. The reasonable and fair use of the mark applied for can only be use in the United Kingdom, since this is the entire territorial scope of the application.

41. If the reputation of the earlier mark does not extend to the United Kingdom, it is difficult to see how (at least in the usual case) it could be damaged by use of a mark in the United Kingdom, or that such use could be said to take unfair advantage of the earlier mark. For one thing, the necessary 'link' between the marks in the mind of the average consumer which must be established in any case which relies on the extended protected (see Adidas-Saloman v Fitnessworld [2004] ETMR 10) would not exist. There is certainly no evidence in the present case which explains how any 'link' could be made in the UK absent of a reputation here."

91. In light of the above, I am of the view that what I have said above regarding the lack of a reputation in the UK is fatal to the existence of a link between the marks. The circumstances in the present case mirror the one cited above in that there is no evidence provided by the opponent which can be said to explain how any link could be made in the UK in light of the fact that the majority of the use before me relates to Italy. On this point, I note that the opponent has attempted to provide evidence to prove how many visitors from the UK visit Italy each year, however, for the same reasons discussed above (when considering enhanced distinctive character), this is of no real assistance in proving that the UK consumer has become aware of the opponent's mark's reputation in Italy. As a result, I fail to see how average consumers in the UK would make the necessary link between the marks as there exists no reputation in the relevant territory for my consideration of a link. Therefore, I hereby find that the opponent's claim under its section 5(3) ground fails at this point.

CONCLUSION

92. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant's mark may proceed to registration for all of the goods applied for.

COSTS

93. As the applicant has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While it is noted that the applicant did not file its own evidence, I consider that it should be awarded costs for the task of considering the opponent's evidence. In the circumstances, I award the opponent the sum of £1,200 as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Considering the opponent's evidence:	£500
Written submissions in lieu:	£400
Total:	**£1,200**

94. I hereby order Abiogen Pharma S.p.A to pay APROGEN, INC. the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of November 2024

A COOPER
For the Registrar