

O/0335/25

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
DESIGNATING THE UK NO. 1474873
IN THE NAME OF BIOGENA GMBH & CO KG:**



IN CLASSES 5, 29 & 30

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418971
BY BIOGEN MA INC.**

Background and pleadings

1. On 31 October 2018, Biogena GmbH & Co KG (“the holder”) registered the international trade mark displayed on the cover page of this decision, under number 1474873 (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 21 September 2018 (Austria). Protection of the IR is sought for the following goods:

Class 5: Pharmaceutical and veterinary preparations; nutraceuticals for use as a dietary supplement; sanitary preparations for medical purposes; dietetic food and substances adapted for medical and veterinary use; dietetic products for a balanced diet; starch for dietetic or pharmaceutical purposes; food for babies; powdered milk for babies; dietary supplements for humans and animals; antioxidants for medical purposes; nutritional supplements and dietetic food supplements for sports and performance enhancement, adapted for medical use; meal replacement powders for sports and performance enhancement for medical use; mineral food supplements, consisting primarily of vitamins, amino acids, minerals and trace elements, adapted for medical purposes; vitamin preparations; preparations for making medicated dietetic beverages; medical plasters; materials for surgical dressings; material for dental fillings and dental impressions; disinfectants; preparations for destroying noxious animals, fungicides; herbicides.

Class 29: Preserved, dried and cooked fruits and vegetables; vegetable extracts and concentrates (purees) for culinary purposes (except essential oils).

Class 30: Dried kitchen herbs; preserved herbs and spices; herbal teas not for medical purposes black teas; tea essences, tea extracts, instant teas, tea mixes.

2. Details of the IR were published for opposition purposes on 4 October 2019. On 3 January 2020, Biogen MA Inc. (“the opponent”) partially opposed the protection of the IR in the UK under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the class 5 goods only. The opponent relies upon the following trade marks and the following goods for which they are registered:

(i) **BIOGEN**

UK registration no. 1154971

Filing date: 1 June 1981

Registration date: 1 June 1981

Goods: Pharmaceutical preparations and substances (class 5)
 (“the ‘971 mark”)

(ii) **BIOGEN**

EU registration no. 14092803

Filing date: 20 May 2015

Registration date: 6 April 2016

Goods: Pharmaceutical preparations; pharmaceutical preparations for the treatment of neurologic disorders and haemophilia (class 5)
 (“the ‘803 mark”)

3. The opponent contends that the IR is similar to its marks. It also argues that the parties’ goods are identical or similar. Based upon these factors, the opponent submits that there is a likelihood of confusion.

4. The holder filed a counterstatement denying the ground of opposition.

5. Both of the opponent’s marks qualify as an ‘earlier mark’ in accordance with section 6 of the Act.¹ As the ‘803 mark had not been registered for five years at the priority date of the IR, it is not subject to the use requirements specified in section 6A of the Act. The ‘971 mark had been registered for more than five years at the priority date of

¹ Although the UK has left the EU and the Transition Period has expired, the ‘803 mark is still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

the IR and is, in principle, subject to the use requirements. However, the holder did not seek to require the opponent to provide proof of use.² As such, the opponent may rely upon both of its marks and all the goods identified without having to show that its marks have been used.

6. Neither party filed evidence, though I note that the opponent filed written submissions during the evidence rounds. A hearing was requested and, after a lengthy stay of the proceedings, held before me, by video conference, on 4 December 2024. The opponent was represented by Theo Barclay of counsel, instructed by Finnegan Europe LLP. The holder is represented by Stevens, Hewlett & Perkins but did not attend.³

Relevance of EU law

7. 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.

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

8. Sections 5(2)(b) and 5A of the Act read as follows:

“5(2) A trade mark shall not be registered if because -

[...]

² Question 7 of the holder's Form TM8.

³ I note that the holder was represented by McDaniel & Co Solicitors until 14 February 2022. It then had no representation until the appointment of Stevens, Hewlett & Perkins on 25 July 2022.

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

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

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

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

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

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

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

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

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

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

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

My approach

10. I note that the two marks relied upon by the opponent in these proceedings are identical. Moreover, neither has been put to proof of use and the specification of the '971 mark is broader than that of the '803 mark. In the event that the opposition fails on the basis of the '971 mark, the '803 mark will not improve the opponent's position. As such, I will determine the opponent's claim on the basis of the '971 mark only, referring to it as "the opponent's mark" from this point onwards.

Comparison of goods

11. In *Canon*, the Court of Justice of the European Union ("CJEU") stated, at paragraph 23 of its judgment, that:

"In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

12. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “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 undertaking.”

14. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

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

15. The holder concedes that its *pharmaceutical [...] preparations* are identical to the opponent’s *pharmaceutical preparations [...]*.

16. The opponent’s *pharmaceutical preparations and substances* is a broad term which would, in my view, cover the holder’s *starch for [...] pharmaceutical purposes*. As such, these goods are to be regarded as identical in accordance with *Meric*.

17. The following goods of the IR can all be broadly described as dietary supplements or dietetic foods/beverages:

Nutraceuticals for use as a dietary supplement; dietetic food and substances adapted for medical [...] use; dietetic products for a balanced diet; starch for dietetic [...] purposes; dietary supplements for humans [...]; antioxidants for medical purposes; nutritional supplements and dietetic food supplements for sports and performance enhancement, adapted for medical use; meal replacement powders for sports and performance enhancement for medical use; mineral food supplements, consisting primarily of vitamins, amino acids, minerals and trace elements, adapted for medical purposes; vitamin preparations; preparations for making medicated dietetic beverages

These goods are typically used to complement a normal diet or because they are considered beneficial for health. They may be used for medical purposes, i.e. if they are recommended by a medical professional, for example. As such, there is an overlap in purpose with the opponent's *pharmaceutical preparations and substances*. Where the holder's goods are in the form of tablets, powders or liquids, there will be an overlap in nature. This overlap does not extend to the dietetic foods as these goods are not typically in this form. Given that the respective goods can be consumed by mouth, there is also an overlap in method of use. The respective goods may reach the market through overlapping trade channels, such as pharmacies, where they may be found on adjacent shelves. There is unlikely to be any meaningful competition between the respective goods, notwithstanding the overlap in purpose. This is because a consumer is unlikely to select a dietary supplement, for instance, to treat a condition requiring medicinal drugs, or a medicinal drug to complement their diet. Moreover, they are not complementary because they are not important or indispensable to the use of one another. In light of all this, I find that there is at least a medium degree of similarity between the respective goods.

18. The holder's [...] *veterinary preparations, dietetic food and substances adapted for [...] veterinary use* and *dietary supplements for [...] animals* and the opponent's *pharmaceutical preparations and substances* overlap in nature as both could take the form of tablets, powders or liquids. There is a broad overlap in purpose in that they are

used to treat health conditions (or are at least considered beneficial for health), though one is for animals and the other is for humans. The method of use is different, since one is administered to animals and the other will be taken by the user. That being said, even though the recipient is different, the user of the goods overlaps because they are both purchased by individuals (either for themselves or their animals). I do not consider that the goods reach the market through shared trade channels; one is likely to be purchased at pet stores or veterinary centres, whereas the other is likely to be purchased from retail outlets or pharmacies. The respective goods are not complementary in the sense outlined in the authorities. Moreover, they are not in competition. Overall, I find that there is a medium degree of similarity between the respective goods.

19. *Sanitary preparations for medical purposes* and *disinfectants* are goods that are used for keeping things clean, including cuts and wounds. They have a different nature and method of use to the opponent's *pharmaceutical preparations and substances*. There may be an overlap in purpose, but only on a general level. The respective goods may reach the market through overlapping trade channels insofar as they are likely to be available from medical suppliers and pharmacies. It is very unlikely that a consumer would purchase the holder's goods instead of the opponent's goods, and vice versa; they are not interchangeable. As such, they are not in competition. Additionally, they are not important or indispensable for the use of one another. On this basis, they are not complementary. In light of the above, I find that there is between a low and medium degree of similarity between the respective goods.

20. The holder's *medical plasters* and *materials for surgical dressings* are first aid products. They clearly have a different nature to the opponent's *pharmaceutical preparations and substances*. The respective goods can be said to have broadly medical purposes, though the ordinary purpose of the holder's goods is to protect an injured part of the body or a wound, not to treat health conditions per se. The opponent's term covers pharmaceuticals which are applied to the body; to that extent, there is a small overlap in method of use. The respective goods both reach the market through retail outlets and pharmacies, wherein they are likely to be located in the same sections. Whilst I acknowledge that it is not always the case, I find that they share overlapping trade channels. Moreover, although the respective goods may be used

together, they are not complementary in the sense outlined in the authorities. There is no competition between them. Balancing all of the above, I find that there is a low degree of similarity between the respective goods.

21. It is my understanding that *fungicides* are chemical substances used to kill fungus. The opponent's *pharmaceutical preparations and substances* covers antifungal medicines. On this basis, there is a broad overlap in nature and purpose. The respective goods do not have the same method of use, since the holder's goods are more likely to be applied to crops and other plants, whereas the opponent's goods will be applied to the human body. The respective goods are not likely to reach the market through shared trade channels; one is likely to be available from agricultural suppliers, garden centres and home improvement stores, whilst the other will be purchased from pharmacies and retail outlets. Although the respective goods are both for killing fungus, they are not in competition; a consumer is not likely to purchase a fungicide to treat a fungal infection, or antifungal medicine to treat their crops. Neither are they complementary in the sense outlined in the authorities. In light of all this, I find that there is a low degree of similarity between the respective goods.

22. Insofar as the opponent's *pharmaceutical preparations and substances* could be in powdered form, there may be an overlap in nature with the holder's *food for babies; powdered milk for babies*. However, this is on a very general level. Whilst the former may be fortified with vitamins and the like, they do not ordinarily contain medicine, nor are they typically used for the same purpose. The respective goods may be sold in large retailers and pharmacies. However, they are unlikely to be found in the same sections of those outlets. Consequently, I do not consider the respective goods to share trade channels. They are not important or indispensable to the use of one another and, as such, are not complementary. Neither are the respective goods in competition as consumers are unlikely to select one over the other. The respective goods may share users, though only on a general level. Taking all of this into account, I find that there is no similarity between the respective goods.

23. It is my understanding that the holder's *material for dental fillings and dental impressions* refer to substances used in dentistry to fill cavities in the teeth or to produce an imprint of the teeth. Although the opponent's *pharmaceutical preparations*

and substances can be manufactured for dental purposes, the nature of the respective goods is different. There is an element of overlap in the intended purpose of the respective goods insofar as they are used to treat health problems. However, this is on a very general level. The method of use is different, since the holder's goods will ordinarily be used during dental work, while the opponent's goods are typically consumed by mouth or applied to the body. The respective goods will not always have the same users or reach the market through shared channels of trade; the holder's goods are likely to be purchased by dental practices from specialist outlets or manufacturers, whereas the opponent's goods can be purchased from pharmacies, retail outlets, or obtained through medical professionals. The relationship between the respective goods is not competitive. Further, although they may sometimes be used together, the respective goods are not important or indispensable to one another. As such, they are not complementary. Overall, I find that there is no similarity between the goods under consideration.

24. *Preparations for destroying noxious animals* describe preparations for killing poisonous animals. They clearly have a different nature, intended purpose and method of use when compared with the opponent's *pharmaceutical preparations and substances*. To my mind, they are likely to reach the market through different trade channels. The opponent's goods are available through general retailers and pharmacies. There is no evidence that the holder's goods are typically sold at these outlets. Given their different purposes, there is no competition between the respective goods. They are not important or indispensable to the use of one another and are, therefore, not complementary. Overall, I find that there is no similarity between the respective goods.

25. Within its written submissions, the opponent concedes that there is no similarity between the holder's *herbicides* and its *pharmaceutical preparations and substances*.⁴ For the avoidance of doubt, for the same reasons as given at paragraph 24 above, I agree. These goods are dissimilar.

⁴ Whilst the opponent did not withdraw the opposition in respect of these goods, it submitted that they are dissimilar. This position was also taken by Mr Barclay at the hearing.

26. Some degree of similarity between goods is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.⁵ My findings above mean that the opposition must fail in respect of the following goods:

Class 5: Food for babies; powdered milk for babies; material for dental fillings and dental impressions; preparations for destroying noxious animals; herbicides.

The average consumer and the nature of the purchasing act

27. As the case law indicates, I must determine who the average consumer is for the parties' goods and the manner in which they are likely to select those goods. The average consumer has been described in the following terms:⁶

"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 [...] 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."

28. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, the GC considered the average consumer of pharmaceutical and medical products in class 5, as well as the level of attention that would be paid in the selection of those products. It stated:

"39. Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika*

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

⁶ *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

(*TOLPOSAN*), T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40. Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41. [...]

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

29. Relevant consumers of the goods at issue in these proceedings include members of the general public and medical professionals. The frequency with which the goods are purchased by the general public is likely to vary; it will factor upon whether the

medical treatment, or dietary supplementation, necessitates repeated usage. For medical professionals, the goods are likely to be purchased relatively frequently for, for example, stocking a pharmacy. I do not consider the purchasing act for any of the goods to be merely casual. Goods which are medical or pharmaceutical in nature would be an important choice for the general public, since the goods will affect their state of health. In respect of these goods, I find that the general public will exhibit a higher than medium level of attention. As for goods which are not strictly medical or pharmaceutical in nature (such as the dietary supplements, plasters, disinfectants and fungicides), the selection process may not be quite as careful, though the general public will still wish to ensure that the product is safe and appropriate for their needs. When purchasing these goods, the general public will demonstrate a medium level of attention. As for medical professionals, the level of attention for medical or pharmaceutical products will be high. Selecting the correct goods will be important as they will thereafter be recommending or prescribing the use of the goods for medical treatment. For goods which are not strictly medical or pharmaceutical in nature, the selection process may not require as much care; however, medical professionals will still consider whether the goods are safe and appropriate. Taking these factors into account, medical professionals will demonstrate a higher than medium level of attention when purchasing these goods.

30. Many of the goods at issue will be purchased by the general public in general retailers, pharmacies, and health stores, or their online equivalents. The goods may be self-selected by consumers from shelves and cabinets, or after viewing information on websites. However, it is likely that some of the goods would need to be prescribed or made available through medical professionals after a verbal consultation. Therefore, the purchasing process is likely to be by a combination of visual and aural means. For medical professionals, the goods are likely to be purchased from suppliers and manufacturers, whereby the selection process would be a combination of visual and aural. Information about the products is likely to be sought primarily from brochures and websites, though medical professionals may also engage in verbal discussions with sales representatives.

Distinctive character of the earlier mark

31. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *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).”

32. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

33. Within its written submissions, the opponent states as follows:

“Biogen was founded in 1978 and has since become one of the most well-known, highly publicised, and respected research and development companies

in the pharmaceutical and biotechnology fields. Biogen leads innovative scientific research [...] Due to this, Biogen owns very substantial trading goodwill and reputation in the mark BIOGEN in the EU and elsewhere in the world for biotechnology, pharmaceuticals and related goods and services.”

34. Although, on this basis, the opponent had previously claimed that the distinctiveness of its mark has been increased, Mr Barclay clarified at the hearing that only the inherent position needs to be considered. I agree. As the opponent’s previous comments were not provided in proper evidential format, I cannot attribute them any weight. Moreover, no evidence of use of the opponent’s mark has been filed.

35. The opponent’s mark is in word-only format and consists of the word ‘BIOGEN’. As there are no other elements in the mark, its distinctiveness lies in the word itself. It is common ground in these proceedings that this word has no meaning in the English language. The opponent’s mark will, therefore, be perceived as an invented word. I find that the opponent’s mark possesses a high level of inherent distinctive character.


Comparison of trade marks

36. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their 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.”

37. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

38. The marks to be compared are as follows:

The opponent's mark	The IR
<p data-bbox="432 853 557 887">BIOGEN</p>	

39. I have submissions from both parties (including those made orally at the hearing) as to the overall impressions of the competing marks and the similarity between them. I do not intend to repeat these here, but I confirm that I have taken them into account in making the following comparison.

40. The opponent's mark is in word-only format and consists of the word 'BIOGEN'. As there are no other elements, the overall impression of the mark lies in the word itself.

41. The IR is figurative and comprises a number of elements. Firstly, the mark contains the word 'BIOGENA' in a standard font. Underneath, presented in a much smaller size, appear the words 'GOOD HEALTH FOR ME'. On the left of the verbal elements appears a device which represents a stylised human-like figure reaching towards a circle. In my view, the device and the word 'BIOGENA' dominate the overall impression of the mark in roughly equal measure. This is due to their relative sizes and positions

within the mark. The words 'GOOD HEALTH FOR ME' are much smaller and less distinctive. They, therefore, play a much lesser role.

42. The marks are visually similar in that the co-dominant element of the IR, 'BIOGENA', only differs from the opponent's mark in the additional letter 'A' at its end. Aside from this additional letter, the competing marks are visually different insofar as the IR contains elements which have no counterparts in the opponent's mark, namely the words 'GOOD HEALTH FOR ME' and the device. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

43. Consumers will make no attempt to articulate the device in the IR. It is arguable whether consumers will pronounce the words 'GOOD HEALTH FOR ME'. This is because the words combine to form an origin neutral tagline which, in my view, consumers do not typically articulate when referring to a mark. However, proceeding on the basis that they will be pronounced, the IR consists of eight syllables, i.e. "BI-O-GEE-NA-GOOD-HEALTH-FOR-ME".⁷ The opponent's mark consists of three syllables, i.e. "BI-O-GEN". The first words are highly similar, differing only in the more elongated "EE" sound in the IR and the "A" sound at its end. The IR also contains four additional syllables. Overall, I find that there is a medium degree of aural similarity between the competing marks.

44. As outlined above, the word 'BIOGEN' in the opponent's mark will be perceived as an invented word. As such, it will not convey any clear meaning to consumers. This also applies to the word 'BIOGENA' in the IR. The additional words 'GOOD HEALTH FOR ME' are likely to be understood as a strongly allusive tagline referring to the purpose of the goods, i.e. promoting good health for the user. The device will be seen as an abstract representation of the human body. The IR conveys meanings which are not replicated by the opponent's mark. To the extent that the competing marks convey any meanings, they are conceptually dissimilar.

⁷ Although the word 'BIOGENA' in the IR could be articulated differently (such as, for example, "BI-O-GEN-A"), I will proceed on the basis of the pronunciation outlined above, not least because it represents the holder's best case.

Likelihood of confusion

45. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 mind.

46. 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.

47. Earlier in this decision, I concluded that:

- The parties' goods are identical or similar to at least a low degree;
- Relevant consumers will include members of the general public and medical professionals;
- The attention exhibited will range between a medium and a higher than medium level for the general public, and between a higher than medium and high level for medical professionals;
- The purchasing process will be a combination of visual and aural means;
- The opponent's mark possesses a high level of inherent distinctive character;

- The overall impression of the opponent's mark lies in the word 'BIOGEN';
- The word 'BIOGENA' and the device dominate the overall impression of the IR in roughly equal measure, whereas the words 'GOOD HEALTH FOR ME' play a much lesser role;
- The competing marks are visually and aurally similar to a medium degree, but conceptually dissimilar overall.

48. I acknowledge that the competing marks share a highly similar element; the word 'BIOGENA', a dominant element of the IR, is nearly identical to the opponent's mark, differing only in the additional letter 'A' at its end. However, the IR contains other additional elements which are not present in the opponent's mark. Although the words 'GOOD HEALTH FOR ME' play a much lesser role in the overall impression of the IR, they are not entirely negligible. Perhaps more importantly, the abstract device is a dominant element of the IR. As such, it is unlikely to be overlooked by consumers. Taking all of the above factors into account, it is my view that these differences are likely to be sufficient for consumers, even when paying no more than a medium level of attention, to distinguish between the marks and avoid mistaking one for the other. Consequently, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical goods.

49. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).⁸

50. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁸

51. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU’s judgment in

⁸ As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

Bimbo, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

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

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

52. I recognise that indirect confusion has its limits and that such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.⁹ It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.¹⁰

53. I have already found that consumers will not mistake or misremember the marks as wholes for one another, given the presence of the additional elements in the IR, namely the words 'GOOD HEALTH FOR ME' and the abstract device. Nevertheless, the word 'BIOGENA' is a dominant element of the IR and plays an independent distinctive role, i.e. it has distinctive significance which is independent of the significance of the whole. It does not combine with the device or the words 'GOOD HEALTH FOR ME' in any way and the IR as a whole is likely to be perceived by consumers as consisting of three separate and seemingly unconnected elements. As outlined above, the words 'BIOGEN' and 'BIOGENA' are nearly identical, differing only in the addition of a letter 'A' in the IR. It is my view that consumers, even paying a high level of attention, may misremember or mistakenly recall these elements for one another. As an invented word, 'BIOGEN' is so strikingly distinctive that consumers, having perceived the words 'BIOGEN' and 'BIOGENA' as identical, are likely to assume that only the opponent would be using it in a trade mark. Further, the differences between the competing marks created by the device and the words 'GOOD HEALTH FOR ME' appear consistent with a sub-brand or brand extension. The presence of the words 'GOOD HEALTH FOR ME' are likely to be perceived as the addition of a strongly allusive tagline which refers to products which promote good health. Whilst the device is a dominant element of the IR, its inclusion is likely to be perceived by consumers as an additional decorative element. In light of all this, I am satisfied that consumers, even paying a high level of attention, are likely to assume a commercial association between the parties due to the nearly identical words 'BIOGEN' and 'BIOGENA'. Accordingly, I find that there is a likelihood of indirect confusion, even in relation to goods which are only similar to a low degree.

⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁰ See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

Conclusion

54. The opposition under section 5(2)(b) of the Act has been partially successful. Subject to a successful appeal against this decision, protection of the IR in the UK will be refused in respect of the following goods:

Class 5: Pharmaceutical and veterinary preparations; nutraceuticals for use as a dietary supplement; sanitary preparations for medical purposes; dietetic food and substances adapted for medical and veterinary use; dietetic products for a balanced diet; starch for dietetic or pharmaceutical purposes; dietary supplements for humans and animals; antioxidants for medical purposes; nutritional supplements and dietetic food supplements for sports and performance enhancement, adapted for medical use; meal replacement powders for sports and performance enhancement for medical use; mineral food supplements, consisting primarily of vitamins, amino acids, minerals and trace elements, adapted for medical purposes; vitamin preparations; preparations for making medicated dietetic beverages; medical plasters; materials for surgical dressings; disinfectants; fungicides.

55. Protection of the IR in the UK will be granted for the following goods, against which the opposition has failed:

Class 5: Food for babies; powdered milk for babies; material for dental fillings and dental impressions; preparations for destroying noxious animals; herbicides.

Costs

56. Both parties have succeeded in part. However, the opponent has enjoyed the greater measure of success. As such, it is entitled to a contribution towards its costs, with an appropriate reduction to reflect the holder's degree of success.

57. At the hearing, Mr Barclay submitted that a costs award ought to be based upon the scale published in Tribunal Practice Notice 1/2023. However, these proceedings commenced before 1 February 2023 and, therefore, the applicable scale is that published in Tribunal Practice Notice 2/2016. Moreover, Mr Barclay claimed £2,600 in costs.¹¹ Considering the guidance in the scale, the nature of the pleaded grounds, the complexity of the issues raised, the hearing being relatively short, and the fact that costs in proceedings before the Registrar are intended to be contributory rather than compensatory, it is my view that this is excessive. In the circumstances, I award the opponent the sum of £1,000, which is calculated as follows:

Preparing a statement and considering the holder's counterstatement: £150

Preparing written submissions: £300

Preparing for and attending a hearing: £450

Official fees:¹² £100

58. I order Biogena GmbH & Co KG to pay Biogen MA Inc. the sum of £1,000. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 7th day of April 2025

James Hopkins
For the Registrar

¹¹ Consisting of "£1,900 hearing costs", "£600 statement costs" and the £100 opposition fee.

¹² Official fees connected with the filing of the Form TM7.