O/0337/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO UK3625460
BY ABIOGEN PHARMA S.P.A.TO REGISTER:

ABIOGEN
PHARMA

FOR SERVICES IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 426691
BY BIOGEN MA INC.

BACKGROUND AND PLEADINGS

1. Abiogena Pharma S.p.A. (the applicant) applied to register the trade mark on the cover page of this decision in the UK on 13 April 2021. The application was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, and, as such, it retains the filing date of the EU trade mark from which it derives, namely 25 March 2019.

2. It was accepted and published in the Trade Marks Journal on 11 June 2021 in respect of the following goods:

> 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).

3. On 7 September 2021, Biogen MA Inc. (the opponent) opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is directed against all goods in the application. The opponent relies upon the following marks:

BIOGEN

901345495
Filing date: 13 October 1999; date of entry in register 8 June 2006.
Seniority: Application date 1 June 1981 from the UK; trade mark no 1154971.
Relying on the following goods:

Class 5: Pharmaceutical products made through the use of biotechnology from biological organisms, namely interferons, interleukins, hepatitis antigens and growth hormones.

BIOGEN

914092803
Filing date: 20 May 2015; date of entry in register 6 April 2016.
Relying on all its goods and services, namely:

Class 5: Pharmaceutical preparations; Pharmaceutical preparations for the treatment of neurologic disorders and hemophilia.
Class 42: Development of pharmaceutical preparations and medicines.

913426382
Filing date 3 November 2014; date of entry in register 26 March 2015.
Priority date 24 October 2014 from the USA, claimed from trade mark no 8643348.
Relying on the following goods and services:

Class 5:Pharmaceutical preparations for the treatment of neurologic disorders and hemophilia.
Class 42: Development of pharmaceutical preparations and medicines.

913680731
Filing date 26 January 2015; date of entry in register 12 May 2015.
Priority date 24 October 2014 from the USA, claimed from trade mark no 86433489.
Relying on the following goods and services:

Class 5: Pharmaceutical preparations for the treatment of neurologic disorders and hemophilia.
Class 42: Development of pharmaceutical preparations and medicines.

913680831
Filing date 26 January 2015; date of entry in register 13 May 2015.
Priority date 24 October 2014 from the USA, claimed from trade mark 86433441.
Relying on the following goods and services:

Class 5: Pharmaceutical preparations for the treatment of neurologic disorders and hemophilia.
Class 42: Development of pharmaceutical preparations and medicines.

4. The opponent argues that the respective goods and services are identical or similar and that the marks are similar. The opponent submits that due to these factors there is a likelihood of confusion between the marks, which includes a likelihood of association.

5. The applicant filed a defence and counterstatement denying the claims. It also put the opponent to proof of use of all of its marks – a point to which I return below.

6. The opponent filed evidence in chief during the evidence rounds and the applicant filed submissions.

7. A hearing took place before me on 4 June 2024, via video conference. The opponent was represented by Mr Theo Barclay of 4 New Square Chambers, instructed by Finnegan Europe LLP. The applicant is represented by Mr Jamie Muir Wood of Hogarth Chambers, instructed by Boult Wade Tennant. Both representatives filed skeleton arguments in advance of the hearing.

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 filed evidence in chief in the form of the witness statements of Ms Kylie Bromley and Ms Fionnuala Richardson, dated 21 June 2023 and 22 June 2023, respectively. Ms Bromley is the General Manager and Managing Director of Biogen Idec Limited. Ms Bromley's witness statement is accompanied by 10 exhibits. Ms Richardson is a Chartered Trade Mark Attorney at the opponent's representative. Ms Richardson's witness statement is accompanied by 31 exhibits, being FR1-FR31. I have carefully read all papers, evidence and submissions filed and will refer to them where I deem it necessary to do so.

PROOF OF USE AND MY APPROACH

10. Given their filing dates, the opponent's marks qualify as earlier trade marks under section 6(1) of the Act. Although the Form TM8 requested proof of use in respect of all of the earlier trade marks relied on, it is only the first listed above (the Biogen word mark No. 901345495) that had been registered for more than 5 years at the filing date of the EU trade mark on which the contested application is based. It is therefore only that registration that is subject to the use provisions set out in section 6A of the Act. However, at the hearing both counsel agreed that the second Biogen word mark (914092803) is registered for goods that entirely encompass those registered under the 901345495 mark, and that since the 914092803 mark is not subject to the use requirement, it is unnecessary to consider the question of proof of use of the 901345495 mark. I will conduct my assessment based on the second Biogen word mark (914092803) and will return to the other marks relied upon at a later point, if necessary.

DECISION

Section 5(2)

11. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

> "5(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 of association with the earlier trade mark".

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

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

b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater degree of similarity between the marks and vice versa;

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

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

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

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 THE GOODS AND SERVICES

The applicant's goods	The opponent's goods and services (under the second Biogen word mark (914092803)
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).	Class 5: Pharmaceutical preparations; Pharmaceutical preparations for the treatment of neurologic disorders and hemophilia. Class 42: Development of pharmaceutical preparations and medicines.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (GC) stated:

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

14. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

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

15. Case law has described "complementary", as meaning that *"… 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 the responsibility for those goods lies with the same undertaking."*[1]

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 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;

1 Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06

(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.

Pharmaceuticals […]

17. The parties agree that the applicant's goods are identical to *"Pharmaceutical preparations"* in the opponent's specification. Therefore, I find the goods to be identical, despite being worded differently.

[…] Medical and veterinary preparations

18. At the hearing, Mr Barclay submitted that a *pharmaceutical preparation is a type of medical preparation that encompasses both human or veterinary use* and that the applied-for *Medical and veterinary preparations* are therefore identical to *"pharmaceutical preparations".* In the alternative, he submitted that the applicant's goods are similar to everything else for which the opponent's mark is registered. Mr Muir Wood agreed that the applicant's goods are *"arguably a subset of the other, so that on Meric principles there must be identity for those or at least a high degree of similarity."* On the basis of the submissions of the parties, I find the goods to be identical or, if I am mistaken highly similar.

Sanitary preparations for medical purposes

19. Mr Barclay submitted that the applicant's goods are identical or very similar to the opponent's specification. Mr Muir Wood disagreed, arguing that sanitary products are for hygiene purposes not medical treatments, and so they are unlikely to be identical; he argued that these goods are unlikely to be made by the same undertaking or come from the same origin and whilst the goods may be used in the medical or hospital environment, it does not mean that they are identical.

20. I consider that sanitary preparations for medical purposes include goods used to keep things clean and sterile, such as iodine-based wipes for cuts and wounds or alcohol-based skin wipes prior to administering an injection. The applied-for *Sanitary preparations for medical purposes* differ in nature and method of use from *"pharmaceutical preparations"* in the opponent's specification. I consider that the goods may reach the market through the same trade channels, as they may be sold via the same medical suppliers and pharmacies. Users of the respective goods will both include medical practitioners. It is not obvious to me that *sanitary preparations for medical purposes* compete with *Pharmaceutical preparations* or that those goods are complementary in the case law sense. Consequently, I consider the goods to have a low to medium degree of similarity. I also consider that the above comparison applies to *"disinfectants"* in the applicant's specification.

Dietetic food and substances adapted for medical or veterinary use, Dietary supplements for humans and animals, Vitamin supplements and food supplements

21. The applicant submitted that the above goods are "plainly different from *pharmaceuticals, medical and veterinary preparations."* Since these quoted goods are specified in the applicant's own application, the reference is presumably an inadvertent confusion between the parties' specifications, and I take the comment as intended to refer to *"pharmaceutical preparations"* in the opponent's specification. The applicant's representative went on to say that *"They might be found in the same shop as my learned friend suggests but they are unlikely to be found in the same part of the shop. They are likely to be in a completely different aisle, bought for different purposes and it is very unlikely and there is no evidence before you to suggest that they would be made by the same person or have the same origin."* The opponent, on the other hand, submitted that these goods were identical and that the goods are complementary to its class 42 services.

22. I will conduct the comparison between the applicant's goods and *"pharmaceutical preparations",* which I consider offers the better comparison between the goods. I understand "dietetic" to relate to the science of nutrition and the regulation of diet for health or medical reasons. For the avoidance of doubt, I take the adjective "*Dietetic" to relate both to food and to substances – rather than adapted for medical or veterinary use.*

23. The applicant's goods may all be broadly considered to be dietary supplements or dietetic food or substances for human or animal use. I disagree with the opponent that these applied-for goods are identical to *"pharmaceutical preparations"*, but I do consider that there

is similarity between the goods. These goods are used to complement a standard diet because they are considered beneficial for health. If they are recommended by a medical practitioner, they may be used for medical purposes. Therefore, I consider that there is an overlap in purpose between the goods. I also consider that there will be an overlap in nature between supplements and the opponent's goods, as both goods exist in the form of tablets, powders and liquids. However, this does not extend to dietetic foods, which are typically not in this form. Given the oral consumption of the goods at issue, they will overlap in method of use. I have no clear evidence on where the respective goods may be located in relevant retail outlets. Even though dietetic foods may be found in a different part of a supermarket from pharmaceutical goods (aspirin, cough medicines etc), it seems to me that vitamins, minerals and other supplements may be found alongside pharmaceutical goods in a supermarket. The respective goods will also be sold in a pharmacy/chemist's shop, so trade channels overlap in that specialist outlet. I do not find the goods to be in competition with one another, nor are they complementary. Taking the above into account, I find the goods to be similar to at least a medium degree.

Food for babies

24. The submissions made by the parties for "*Food for babies"* are the same as in relation to the goods above. The opponent's "*pharmaceutical preparations*" may be in powdered form; therefore, there may be an overlap in nature with the applicant's goods, but only on a very general level. I do not consider that there will be an overlap in purpose, since food is for universal daily sustenance, whereas pharmaceutical preparations are intended to address a particular, typically medical, need; although *Food for babies* will often be fortified with vitamins they will not ordinarily contain medication. The goods are likely to be sold in separate sections in supermarkets, and though both goods may be sold in pharmacies, I do not consider this modest overlap in trade channel to be a great point of similarity. I do not find the goods to be in competition, nor are they complementary. There is no notable overlap in users. Taking all the above into account, I would have been inclined to find dissimilarity between the goods. However, given the applicant's admission that the goods must at least possess a degree of similarity, I find the goods to be similar to a very low degree.

Plasters, materials for dressings

25. At the hearing, the opponent's representative submitted that the applicant's goods are closely similar to the opponent's "pharmaceutical preparations" and "Pharmaceutical

preparations for the treatment of neurologic disorders and hemophilia." As pharmaceutical preparations is a broader term, I will focus my comparison on that term, though I acknowledge that one of the consequences of hemophilia entails prolonged bleeding, such that a connection with *Plasters, materials for dressings* perhaps becomes more apparent. The opponent's representative submitted that the goods are both used to treat instances of injury and damage to the body, so overlap in purpose and are complementary. Further, it was submitted and that the goods share consumers and trade channels (as they are both commonly sold in retail stores and their online equivalents). Mr Barclay therefore submitted that there is a *"close degree of similarity"* between the goods.

26. Mr Muir Wood argued that these goods are separate from *"pharmaceutical preparations"* as they "*are liable to come from a separate origin. One would not expect plasters to be provided by the same as pharmaceutical preparations".* He conceded that there is *"at least some similarity there because they are for health purposes,"* but not to the high level that is submitted by the opponent's representative.

27. I consider that the applicant's goods are first aid products and that they have a different nature from the opponent's goods. Whilst I agree with the applicant that there is a shared purpose, I find that shared purpose to be broad, as the ordinary purpose of the applicant's goods is to protect an injured part of the body or a wound rather than to treat health conditions per se. I also find that there is a slight overlap in the method of use, as the opponent's term is sufficiently broad to include pharmaceuticals that will be applied to the body. Plasters, materials for dressings and pharmaceutical preparations share trade channels in that they are both sold in chemist's shops, and painkillers and plasters will be adjacent on supermarket shelves. When I enquired about how the opponent found the goods to be complementary, the opponent's representative responded that the goods are complementary *"because they are often used alongside pharmaceutical preparations including painkillers and drugs."* Whilst they may be used together, this is not complementarity in the sense outlined by the case law; I find no complementarity between the goods. In addition, there is no competition between the goods. Taking all of the above into account, I find there to be a low degree of similarity.

Material for stopping teeth

28. The opponent submitted that these goods, when compared to its "pharmaceutical preparations", whilst not identical, are similar. The applicant defined its goods as *"dental*

sealants designed to protect the teeth from enamel damage and decay.[2]*"* Relying on the definition, the opponent submitted that the applicant's goods are similar to the opponent's because pharmaceutical preparations are also used to treat dental conditions, including medicines which control plaque and prevent dental decay. In addition, they coincide in consumers and sales channels. On that basis, the opponent submits there is a degree of similarity. The applicant submitted that these goods are different from "pharmaceutical preparations", on the basis that they come from a separate origin. The applicant admits that there must be some similarity, but not to the same level of similarity that the opponent submits.

29. Whilst I agree that the opponent's goods can be made for dental purposes, I consider that the nature of the goods is different. I find that there is a loose overlap in intended purpose to the extent that both be used to treat health problems. The applicant's goods will be applied to teeth during dental work, whereas the opponent's goods will be ingested or injected or applied to the body; therefore, the method of use of the goods will differ. Further, I do not consider that they obviously share the same users and trade channels, as the applicant's goods will likely be purchased by dental practices via specialist suppliers and manufacturers and the opponent's goods will be purchased via pharmacies or medical professionals (not dentists). The goods are not in competition and they are not complementary. As the applicant has admitted some similarity between the goods, I consider the similarity to be to a very low degree.

Dental wax

30. The applicant's submissions in relation to material for stopping teeth were echoed in relation to the above goods. Similarly, the opponent echoed its submissions above on the same term in relation to the above goods. The findings that I have made above apply here; as the applicant has admitted that there is some similarity, I find the goods to be similar to a very low degree.

Medical devices (substances)

31. The opponent submitted that these goods are identical or *"at least as closely similar as possible"* to pharmaceutical preparations, on the basis that they share the same intended purpose, producers, distribution channels and end users. The applicant's representative

[2] Counterstatement of the Applicant

agreed that these goods have at least some degree of similarity because they are for health purposes but argued that the goods would differ in origin and provider.

32. The opponent submits that the applicant's goods consist of substances "(such as nasal sprays, cough syrups, and dermal cream), and which are used to treat medical conditions." This definition was not disputed by the applicant and aligns with my understanding of the term.

33. Given that the applicant's goods are specifically 'medical' devices and, as mentioned above, include goods such as nasal sprays; I consider that the opponent's broad goods *"pharmaceutical preparations"* can include the applicant's goods – such as pharmaceutical decongestants – and therefore are identical according to the principle in Meric. If I am mistaken about this, I agree with the opponent that the intended purpose of the goods may be shared, to improve the medical condition of patients. They will also coincide in relevant public. The goods will likely share the same distribution channels and producers. The goods may also overlap in the method of use. Depending on the specific purpose of the goods, they may also be in competition with one another. Taking the above into account, I consider the goods to at least be similar to a medium degree.

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

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

35. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

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

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

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

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

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

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

36. In *Olimp Laboratories sp. z o.o. v EUIPO,*[3] 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 (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

[3] Case T-817/19

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."

37. The average consumer of the goods at issue will include the general public and medical professionals. The frequency with which the goods are purchased by the general public is likely to vary; it will depend on whether the goods relied upon (be they dietary supplements or a medical treatment) are required to be used repeatedly.

38. 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), 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.

39. As for medical professionals, I do not consider the purchasing act for any of the goods to be merely casual; 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.

40. 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.

COMPARISON OF THE MARKS

41. 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."

42. 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.

43. The marks to be compared are as follows:

The applicant's mark	The opponent's mark
	BIOGEN

44. The opponent's mark is a word only mark that consists of 'BIOGEN'. The opponent submitted that the dominant and distinctive element of its mark is the word 'BIOGEN'. I agree. There are no other elements to the mark, and the overall impression lies in the mark itself.

45. The applicant's mark is a figurative mark that consists of the word 'ABIOGEN' which appears in an unremarkable font, with a dot that lies in the middle of the letter 'O'. In a smaller text, under the letters 'IOG' is the word 'PHARMA', which also appears in an unremarkable font. To the left and right of 'PHARMA' the letters 'AB' and 'EN' are underlined. Above the word 'ABIOGEN' is a four-piece pie chart with the top right-hand segment being larger in size. The mark is presented in greyscale.

46. The opponent submitted that the applicant's mark is dominated by the word 'ABIOGEN' with 'PHARMA' playing a lesser role because of its descriptive nature in relation to the goods at issue. In relation to the 'pie-chart element' the opponent submitted that it is of significantly lower distinctiveness; being perceived as a logo or embellishment that the average consumer would give little weight to as an independent indicator of origin.

47. Whilst I recognise that the device is large and positioned at the top of the mark, it is my view that as the eye is naturally drawn to the element of the mark that can be read,[4] the word 'ABIOGEN' plays a greater role in the mark, with the device playing a lesser role. It is arguable that 'Pharma' is not directly descriptive of *all* of the applied-for goods, but it clearly indicates the pharmaceutical nature of the provider and, at best, is of very low distinctive

[4] *MigrosGenossenschafts-Bund v EUIPO*, T-68/17,

character, and will anyway play a lesser role in the overall impression of the mark due to its sizing and position; this will also be the case in relation to the dot present in the letter 'O'.

48. Visually, the applicant admitted that the marks share a verbal element that is similar to its mark. However, it is argued that the 'A' will not go unnoticed (as it is at the beginning of the mark) and the additional elements, being the word 'PHARMA' and the device, will be points of difference and the marks are visually similar to a low degree. In contrast, the opponent submits that the marks are visually similar to a high degree. There is no dispute between the parties on the aspects of similarity/dissimilarity between the marks, and they echo my own view. The contention lies in the resultant level of similarity. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the marks.

49. Aurally, the opponent submitted that the dominant part of the applicant's mark will be pronounced as A-BI-O-GEN, and the opponent's mark will be pronounced as 'BI-O-GEN'. Whilst that might be how that single element of the applicant's mark will be pronounced, I must compare the aural similarity of the marks as a whole, not just a single element of the mark. As mentioned above, the marks cannot be dissected.

50. The consumers will not articulate the device that appears in the applicant's mark. Despite the descriptive nature of the 'PHARMA' element in relation to some of the goods at issue, I am of the view that the average consumer may well the 'PHARMA' element of the mark because they will not view it as a neutral tagline, but as part of the mark. The applicant's mark would therefore be pronounced as A-BI-OH-GEN FARMA; the opponent's mark will be pronounced as BI-OH-GEN. Of the five syllables in the applicant's mark, the opponent's mark will share three. Bearing in mind my assessment of the overall impression of the marks, I find that there is a medium degree of aural similarity between the marks.

51. Conceptually, the opponent submitted that neither 'ABIOGEN' nor 'BIOGEN' has a 'generally understood' meaning in the English language; they do not convey a concept. In contrast, the applicant submitted that 'BIOGEN' means *"a hypothetical living unit of which cells are built up."* In relation to the term 'ABIOGEN', the applicant submitted that the term gains meaning from the term 'Abiogenesis', which it states means *"the origin of life from the non-living matter', i.e. the creation of life from something other than cells."* The applicant submits that these marks are conceptually polar opposites from one another.

52. Whilst submissions on the dictionary definitions were provided by the applicant, I have nothing to suggest how well known the dictionary meanings may be amongst the average

consumers for the goods at issue. It is not enough that a word appears defined in dictionary, since it does not necessarily mean that its meaning would be known by a significant proportion of average consumers.[5] The average consumer of the goods at issue encompasses the general public and medical professionals. The medical profession is specialised, and if it were the case that such a technical term was known to those who operate in that section of the average consumer group, it is reasonable to expect evidence of such to be before me. Without such, I am not willing to find that the meaning of the term would be known to any proportion of average consumers. In any event, the definitions will not be known to the UK general public at large, a point that the applicant accepted at the hearing. I will therefore proceed on the basis that 'BIOGEN' and 'ABIOGEN' will be perceived as invented words.

53. It was submitted by the applicant that "BIO" would be associated with "biological" and that when GEN when merged together "GEN" may fall among words will put the mark into the class of such as 'antigen', allergen' and 'carcinogen', such that the average consumer would "think that it is allusive of something to do with the medical sphere, BIO in particular pointing to biological products." While I accept that the word "BIOGEN" has a medical or biological ring to it, I do not accept that it has any clear, immediately graspable concept, any more than does "ABIOGEN".

54. As for the applicant's mark, I note the addition of the word 'Pharma' and the device. The pie-chart device conveys no clear concept. The word 'Pharma' will be seen as a commonly used abbreviation for 'pharmaceuticals', which will be given its ordinary dictionary meaning and will be seen as descriptive of some of the goods at issue or allusive of the nature of the undertaking behind the mark.

55. In comparing the marks, 'BIOGEN' and 'ABIOGEN' are not capable of contributing to the conceptual comparison, as they have no obvious meaning. These elements are therefore conceptually neutral. The presence of the device in the applicant's mark (or the underlining of the letters) will do anything in the way of the conceptual comparison. I appreciate that the concept of 'Pharma' is absent from the opponent's mark, but I am of the view that it designates the field of activity and will, therefore, not be perceived as a point of sufficient conceptual difference to take away from the conceptual neutrality of the marks (especially given the

[5] I say this whilst bearing in mind the comments of Ms Anna Carboni who, sitting as the Appointed Person in *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08, stated that while it was easily established that Cherokee Nation is a Native American tribe (and something that could be established from an encyclopaedia or internet reference sites), she did not consider it right to find that average consumers of clothing in the UK would be aware of this.

pharmaceutical nature of the opponent's goods). Taking all of the above into account, I find these marks to be conceptually neutral.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

56. 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 C108/97 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. 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.

58. At the hearing, Mr Barclay submitted that the opponent's marks (including its word only mark) have at least an average degree of inherent distinctive character. He argued that they are not descriptive of the goods for which they are used and have acquired distinctiveness through their use, such that the distinctiveness has been enhanced from an average to a high

degree. In contrast, the applicant's representative submitted that the opponent's mark had a low degree of inherent distinctive character.

59. I will consider the inherent distinctiveness of the opponent's word-only mark, on which this decision has proceeded, before considering whether its distinctive character has been enhanced through use. That mark consists only of the word 'BIOGEN' and the distinctiveness lies in the word itself. The applicant accepted that the average consumer is unlikely to be familiar with the definition of 'BIOGEN' mentioned above but argues that it has an *"allusive character to pharmaceuticals because the word "bio" is a well-known starting element for the words".* Mr Muir Wood clarified that it was not inviting me to break down the mark artificially but stating that *"the average consumer seeing BIO merged with the word GEN will put it into that class of word like "antigen", "allergen", "carcinogen" and think that it is allusive of something to do with the medical sphere, BIO in particular pointing to biological products."* Mr Muir Wood argued it has a low degree of inherent distinctive character because of that allusive nature.

60. As I have found above, the word "BIOGEN" will not be known by a significant proportion of average consumers and the opponent's mark will, therefore, be perceived as an invented word. While its composition may involve components allusive of aspects of the pharmaceutical field, I still regard the opponent's mark as possessing at least a medium level of inherent distinctive character.

61. The opponent submits that its mark has been put to significant use in trade, so I move on to consider whether the opponent's evidence establishes enhanced distinctive character of the opponent's mark through use, I note the following:

- Sales of BIOGEN branded products in the UK in the following sums: £362,768,856 (2019); £387,864,329 (2018); £334,595,329 (2017); £200,910,019 (2016); £124,973,137 (2015); and £61,308,641 (2014).[6]
- Promotional materials budgets in relation to BIOGEN products in the UK in the following sums: £537,691 (2019); £746,089 (2018); £357,312 (2017); £202,917 (2016); £661,863 (2015); and £1,170,254 (2014).[7]
- Digital marketing figures in relation to BIOGEN products in the UK of £50,291 (2019), £26,945 (2018), £34,083 (2017), £32,266 (2016), £100,409 (2015) and £328,060

[6] Witness statement of Kylie Bromley, paragraph 8
[7] Witness statement of Kylie Bromley, paragraph 12

(2014). General advertising costs have been provided but they are incomplete. Figures have also been provided in relation to congress and industry events.

- Invoices demonstrating sales in the relevant period for pharmaceutical goods used to treat multiple sclerosis, arthritis, psoriasis and spinal muscular atrophy.

62. I have no evidence or submissions from either party to assist me on the matter of the size of the UK market for the goods concerned. However, even without a stated market share held by the marks, it is clear that a substantial amount of money has been spent promoting the mark in the UK, from 2014 to 2019. The UK sales figures and the invoices demonstrate the long-standing nature of use from 2014 to 2019. The invoices that have been provided have removed the location of the customers, so I have been unable to determine the geographic scope of sales throughout the UK, but they do demonstrate sales in the relevant period for pharmaceutical goods that are used to treat multiple sclerosis, arthritis, psoriasis and spinal muscular atrophy. On the balance of all the evidence, especially taking into account the hundreds of millions of pounds of annual sales, alongside the invoices and the substantial advertising figures, I consider that the distinctive character of the mark has been enhanced through use to a high degree for pharmaceutical goods. Subsequently, the mark enjoys a high degree of distinctive character overall.

LIKELIHOOD OF CONFUSION

63. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa.

64. Earlier in my decision, I found the marks to be visually and aurally similar to a medium degree. I also found the mark to be conceptually neutral. I have found the distinctive character

of the opponent's mark to have a high degree of distinctive character based on its use for pharmaceutical goods. I have found that the average consumer group to comprise primarily of members of the general public and medical professionals. I found the degree of attention to vary from medium to high and that the purchasing process will be a combination of visual and oral considerations. I have found the goods to vary in similarity, between those that are identical to those that are similar to a very low degree.

65. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but assumes that the later mark also identifies the goods of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

66. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that, notwithstanding the medium or higher degree of attention paid, the average consumer is likely to mistakenly recall or misremember the parties' mark for one another. I make this finding on the basis that the dominance of 'BIOGEN' and 'ABIOGEN' in the parties' mark is such that the average consumer is unlikely to remember which mark had the device and the word 'Pharma' and which mark did not. Despite its location at the beginning of the mark, the 'A' on 'ABIOGEN' is likely to be misremembered. This is all the more likely since that small letter may be mis-recalled as simply the indefinite article – so it would be hard to distinguish in memory between an oral recommendation of, say, "Abiogen Pharma vitamin supplements" and "a Biogen pharmaceutical product."

67. I have found the distinctive and dominant elements of the marks to be conceptually neutral. There is a conceptual difference between the marks, in that the applied-for mark contains the word "Pharma", but this conceptual difference does not offset the high level of visual and aural similarity of the parties' distinctive and dominant elements. The point of conceptual difference comes in a descriptive element whose effect is anyway neutralised by the pharmaceutical nature of the opponent's goods.

68. Consequently, I consider that there is a likelihood of direct confusion between the marks at issue. Further, I consider that this finding applies even where the marks are viewed on goods that I have found to be similar only to a very low degree. While I appreciate that a lower degree of similarity between the goods can offset a great similarity between the marks, I find that that is not the case here, because the similar distinctive dominant elements of the marks are, in my view, sufficient to offset the lesser degree of similarity between the goods.

69. If I am wrong to reach a finding of direct confusion, I will proceed to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc,* Case 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)."

70. As mentioned previously, I consider that the 'A' in 'ABIOGENA' will be misremembered by the average consumer. In the present case, given the common use of the dominant

elements, I am satisfied that the average consumer would be indirectly confused when confronted by the marks at issue. I say this because the addition of the device and the descriptive abbreviation 'Pharma' are such that average consumers would consider them lesser distinctive elements that they would expect to find in sub-brands or brand extensions. For example, the addition of the word 'Pharma' will be seen as a reference to a sub-brand or brand extension of the 'BIOGEN' undertaking that has expanded into dealing with pharmaceuticals. Additionally, the slight stylisation elements, if noticed, are such that they would be viewed as indicative of alternative marks used by the same or economically linked undertakings. For example, the opponent's word-only mark may be viewed by the consumer as being the mark used in the context of promotional text, whereas the applicant's figurative mark may be viewed as being that used in the context of company signage, packaging and/or promotional materials. Consequently. I consider that there is a likelihood of indirect confusion. As above, I consider that this finding applies in situations where the marks are viewed on goods that are similar to a very low degree.

FINAL REMARKS

71. As I have found that there is a likelihood of confusion between the application and the '803 mark, there is no additional benefit for me to consider the remainder of the earlier marks relied upon in the opposition, whose goods in any event are more specific and offer a lower degree of similarity than the general specification of "pharmaceutical preparations" on which my consideration of the opposition has been based.

COSTS

72. The opponent has been successful and is, therefore, entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I have calculated as follows:

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's submissions in the evidence rounds	£500
Preparing for and attending a hearing	£900
Official fee (Form TM7)	£100
Total	**£1800**

73. I therefore order ABIOGEN PHARMA S.P.A. to pay BIOGEN MA INC. the sum of £1800. This sum is to 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 22nd day of April 2026

Akira Klass

For the Registrar