

**O-0637-23**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3700704  
BY HAN BIOMEDICAL INC. IN RESPECT OF THE TRADE MARK**

The logo features the word "HANBIO" in a small, spaced-out, sans-serif font above the word "BarriGel". "BarriGel" is written in a larger, bold, sans-serif font, with the "i" in "Gel" being lowercase and the "G" being uppercase. The entire logo is set against a light gray background.

**IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 431709 BY  
GALDERMA HOLDING SA**

**AND**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3748113  
BY GALDERMA HOLDING SA IN RESPECT OF THE TRADE MARK**

**BARRIGEL**

**IN CLASSES 5 AND 10**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 433570 BY HAN  
BIOMEDICAL INC.**

## BACKGROUND AND PLEADINGS

1. Han Biomedical Inc. (“Han”) applied to register the following trade mark in the UK:

Trade mark number: 3700704



Filing date: 24 September 2021

Publication date: 10 December 2021

**Class 5:** *Medicines for human purposes; collagen for medical purposes; dressing materials; surgical dressings; medical dressings.*

2. In accordance with Article 59 of the European Union (Withdrawal) Act 2018, a UK mark (identical to an EU mark) that is filed within 9 months of the end of the transition period (31 December 2020) may retain the priority date that applied to the EU trade mark (“EUTM”). This is the case here, where the contested mark is based upon EUTM 011901329 with a priority date of 29 November 2017.

3. Galderma Holding SA (“Holding”) opposes the application (“the first opposition”) in full on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) based upon similarity in respect of the following earlier mark, the relevant details of which are shown below:

911901329 BARRIGEL

Filing date: 14 June 2013

Registration Date: 6 November 2013

Revoked from 7 November 2018

**Class 10:** *Medical device, namely a gel protecting the rectum from radiation during prostate cancer radiation treatment.*

4. The earlier mark had been registered for less than five years before the priority date of the contested mark and is consequently not subject to the use provisions under the Act.<sup>1</sup>

5. Han filed a counterstatement denying the claims and, additionally, asserting that the earlier mark is based upon EUTM 011901329 that was revoked on the basis of non-use from 7 November 2018. It claimed that the earlier mark should have been removed from the UK register in line with the outcome of the EUTM upon which it was based.<sup>2</sup>

6.. At a case management conference (“CMC”) held on 20 March 2023, I considered Han’s position regarding the effect of the revocation of the EUTM upon these proceedings. Case law was presented<sup>3</sup> finding that for an EU trade mark to be a valid earlier mark in opposition proceedings, it must be valid not only at the publication date of the opposed trade mark but also at the date the substantive decision was issued in the opposition proceedings. I found there was no basis in UK law to ignore the revocation date in favour of assessing validity at the date a substantive decision is issued. The relevant date for assessing the Opponent’s claim under section 5(2)(b) in these proceedings is 29 November 2017, being the priority date of the opposed trade mark application. Since the EUTM upon which the earlier mark is based was not revoked until January 2018, the earlier mark was still valid at the relevant date.

7. Han also stated that it stands by its claim to estoppel. I dismissed this claim at the same CMC. The relevant extract from my letter following the CMC stated:

“Party B [Han] had previously indicated that it was pursuing a claim of estoppel against Party A [Holding] on the basis that it was re-running a case identical to that before the EUIPO. Mr Clemson for Party A submitted that no estoppel is created out of opposition proceedings. I agree and I referred Ms Jones to the

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<sup>1</sup> See section 6A of the Act.

<sup>2</sup> The Cancellation Division of the EUIPO issued Cancellation No. 26 361 C (Revocation) on 16 December 2019.

<sup>3</sup> *Beko plc v EUIPO*, Case T-162/18

judgment in *Special Effects Ltd v L'Oreal SA* [2007] EWCA Civ 1 confirming this.”

8. Han also filed an opposition (“the second opposition”) against Holding’s mark number 3748113, the relevant details of which are:

**BARRIGEL**

Filing date: 27 January 2022

Publication date: 18 February 2022

**Class 5:** *Gel injected between prostate and rectum for creating a space between the two for protecting the rectum from radiation during prostate cancer radiation treatment.*

**Class 10:** *Medical device for treating cancer; Radiation therapy devices; Medical devices, namely, gel implants and sheeting for protecting the rectum from radiations during prostate cancer radiation treatment.*

9. The opposition is brought under section 5(2)(b) on the basis that the contested mark is highly similar to its pending trade mark 3700704 (the subject of the first opposition) with both marks containing the distinctive element BARRIGEL and are in respect of complementary goods. It concludes that there is a likelihood of confusion.

10. Holding filed a counterstatement. It makes no admission as to the validity or enforceability of the mark Han relies upon. It also cites the fact that Han’s mark is itself subject to opposition by Holding and its position is that that opposition will succeed in full.

11. These two oppositions were subsequently consolidated.

12. The parties both filed evidence. No hearing was requested but both sides filed written submissions in lieu of attending a hearing and I keep these in mind when

making my decision. Holding was represented in these proceedings by Cleveland Scott York LLP and Han was represented by HGF Limited.

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Evidence**

14. Holding's evidence consists of a witness statement by Andrew James Clemson, Chartered Trade Mark Attorney with Holding's representative in these proceedings, together with Exhibits AJC1 – AJC7. This evidence provides information regarding the nature and purpose of the products in respect of which the parties use their marks.

15. Han's evidence consists of the witness statement of Claire Louise Jones, Chartered Trade Mark Attorney with Han's representative. This is accompanied by Exhibits CLJ01 and CLJ02. This evidence identifies the difference in approach between the UK and EU when applying a relevant date in revocation proceedings and was filed in support of its position that the UK should apply the same practice as the EU (see paragraph 6 and 7, above).

## **DECISION**

### ***THE FIRST OPPOSITION***

16. It is clear from the circumstances that the outcome of first opposition will have a potential impact upon the outcome of the second opposition because it is directed at the earlier mark in the second opposition. Therefore, I will begin by considering the first opposition.

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

18. The following principles are obtained from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 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 goods***

19. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,<sup>4</sup> 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.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“the GC”) stated that:

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<sup>4</sup> [1996] R.P.C. 281

“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 für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

22. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“the 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”.

23. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

24. In addition, in its written submissions, Han submitted that terms should not be allowed such liberal interpretations that they become imprecise, but rather they should be given their natural meaning construed by reference to their context. I agree. The submission is consistent with the guidance set out in *YouView TV* and other cases.<sup>5</sup>

25. Finally, I also keep in mind section 60A of the Act that states:

“(1) For the purpose of this Act goods and services—

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

26. The respective goods to be compared are:

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<sup>5</sup> See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd & Another* [2000] F.S.R. 267 (HC)

Holding's goods	Han's goods
<p><b>Class 10:</b> <i>Medical device, namely a gel protecting the rectum from radiation during prostate cancer radiation treatment.</i></p>	<p><b>Class 5:</b> <i>Medicines for human purposes; collagen for medical purposes; dressing materials; surgical dressings; medical dressings.</i></p>

*Medicines for human purposes*

27. Holding submits that these are clearly complementary to its *medical device* goods and share the same user and concludes that these goods are similar to an above average degree. It explains that Han's goods would include, for example, anaesthesia medications that need to be administered to patients before its medical device can be inserted. It refers to an article from the National Institute for Health and Care Excellence website, nlm.nih.gov, entitled "Barrier agents for adhesion prevention after gynaecological surgery".<sup>6</sup> It describes what procedure is involved in the spacer insertion during radiotherapy for prostate cancer. In this description, it states that the procedure is normally done under general anaesthesia or local or spinal anaesthesia.

28. Han submits that the use of "namely" in the description of Holding's goods limits the scope of its specification to *a gel protecting the rectum from radiation during prostate cancer radiation treatment*. I agree. The word "namely" has an obvious limiting effect upon the term *medical device*. Holding's goods are not medicines but rather a protective gel device. Han's term is very broad and, in its submissions, Holding focuses on the fact that the term can include anaesthesia medications and that such goods can be administered to a patient prior to insertion of Holding's goods. With this submission in mind, it is clear that the respective goods are different in terms of purpose, nature and are not in competition. Holding submits that its gel device and an anaesthesia medication are both used in procedures to implant its gel device and that this creates similarity. I do not agree. Such a claim to complementarity requires the consumer to assume that anaesthesia medication and a device in the form of *gel protecting the rectum from radiation during prostate*

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<sup>6</sup> Provided at Exhibit AJC6

*cancer radiation treatment* originate from the same or linked undertaking. For such specialist goods, I am unable to confirm such a claim in the absence of evidence that it is common for the same trader to provide both products.<sup>7</sup> On an instinctive level, the likelihood that they would appear remote. To find otherwise would result in similarity existing between anaesthesia medication and any other goods used in medical operations such as artificial joints, suture materials or surgical implements. I conclude that, in the absence of evidence to the contrary, the respective goods are not complementary.

29. In summary, the similarity between the respective goods exists only because they are both in the field of medicine. This creates no more than a very low, if any, level of similarity.

#### *Collagen for medical purposes*

30. Holding submits that these goods share the same nature, intended purpose, method of use, trade channels and are in direct competition to its *medical device* goods. This is based on its evidence that collagen can be sold in gel form.<sup>8</sup> There is evidence showing medical collagen being used as a barrier agent to prevent wound adhesion during pelvic surgery.<sup>9</sup> Most significantly, there is also evidence that collagen is used as a barrier agent during radiation treatment for prostate cancer, being the same purpose of Holding's goods.<sup>10</sup> Therefore, Han's *collagen for medical purposes* can have the same purpose as Holding's goods. The main difference is that one is injectable whilst the other is a spacer that is inserted. Consequently, I disagree with Han's submission that the consumer is unlikely to believe that both types of goods can be provided by the same or linked undertaking. On the contrary, I

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<sup>7</sup> *Commercy AG v OHIM*, Case T-316/07 as referred to in Han's submission that where similarity is not self-evident, evidence of similarity may be required

<sup>8</sup> Holding's Exhibit AJC3 consisting of an extract from Han's website hanbiomedical.com where its BarriGel product is described as "adhesion prevention gel". The extract includes a 2016 copyright notice.

<sup>9</sup> At Exhibit AJC5 is an article from "Cochrane Library" entitled "Barrier agents for adhesion after gynaecological surgery"

<sup>10</sup> Exhibit AJC6 being a paper published by the National Institute for Health and Care Excellence (NICE) discussing interventional procedures during radiotherapy for prostate cancer. It states "The aim of injecting a biodegradable substance (examples include polyethylene glycol hydrogel, hyaluronic acid, and human collagen), or inserting and inflating a biodegradable balloon spacer ... to reduce the amount of radiation delivered to rectum ... during prostate radiotherapy."

consider it likely that the average consumer is likely to believe that collagen for use as a barrier agent and a gel device with the same purpose will originate from the same or linked undertaking. I conclude that there is at least a medium level of similarity.

*Dressing materials; surgical dressings; medical dressings.*

31. Holding claims that these are clearly complementary to its *medical device* goods and have the same user. It submits that the insertion of the barrier gel necessarily creates a wound for which dressing would need to be applied. Whilst I accept that both parties' goods may be used in the same procedures, it does not follow that they are similar. They differ in terms of their nature, intended purpose, methods of use and they are not in competition, Further, there is no obvious complementary relationship in the sense that, even in respect of surgical dressing, one is indispensable or important for the use of the other in such a way that customers may think that responsibility for these goods lies with the same or linked undertaking. Finally, there is nothing before me to suggest that this would be so. I find that there is no overlap of trade channels.

32. I conclude that the respective goods are both medical in nature, but in all other aspects that are different, therefore, there is no more than a very low level of similarity.

### ***Comparison of marks***

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

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

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

35. The respective marks are shown below:

Holding's earlier mark	Han's mark
BARRIGEL	 The image shows the word "HANBIO" in a small, spaced-out, sans-serif font above the word "BarriGel". "BarriGel" is written in a larger, bold, sans-serif font, with "Barri" in lowercase and "Gel" in uppercase.

36. Holding's mark consists of a single invented word and, naturally, its distinctive character resides in this word. Han's mark consists of the word "HANBIO" and the two elements "Barri" and "Gel" conjoined. Despite being conjoined, "Barri" and "Gel" retain their own identity within the mark because of the presence of the capital letters "B" and "G". The "BarriGel" elements are presented in a much larger size than the word "HANBIO" and are, therefore, the dominant and distinctive elements but the latter is not negligible and retains its own distinctive character within the mark.

37. Visually, Holding's mark consists of a word that is very highly similar to the two dominant and conjoined elements in Han's mark. Normal and fair use of Holding's mark will include use of it in lowercase with a capital first letter. In this form the only primary difference to the corresponding part of Han's mark is the capitalisation of the letter "G". The word "HANBIO" in Han's mark is absent from Holding's mark and is a

point of difference. I also note the thicker lines that form the “BarriGel” elements of Han’s mark. Taking all of this into account and reminding myself that I must consider the marks as a whole, I find that they share a high level of visual similarity.

38. Aurally, Holding’s mark consists of the three syllables BA-REE-JEL. The word HANBIO in Han’s mark, although appearing in smaller text than the BARRIGEL element, it appears above it and is likely to be the first word when considered aurally. Therefore, Han’s mark consists of the six syllables HAN-BY-OH-BA-REE-JEL. All three syllables present in Holding’s mark are reproduced as the fourth, fifth and sixth syllables of Han’s mark. The marks differ in that the three syllables HAN-BY-OH appear at the start of Han’s mark and are absent from Holding’s mark. Taking these differences and similarities into account, I conclude that the respective marks share a medium level of similarity.

39. Conceptually, the BARRIGEL elements of both marks is likely to be perceived as an invented word with an allusion to “barrier gel”.<sup>11</sup> This allusive meaning is relevant to the core goods of both parties and to possible other goods covered by the Han’s specification. The word HANBIO will also be seen as an invented word that does not create any obvious allusion other than, perhaps, the BIO part being perceived as suggesting “biological” or similar. Taking these observations into account, there is conceptual similarity arising from the allusive invented element BARRIGEL/BarriGel appearing in both marks and I conclude they share at least a medium level of conceptual similarity.

### ***Average consumer and the purchasing act***

40. 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

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<sup>11</sup> I keep in mind that invented words can be perceived as having allusive meaning. In *Usinor SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-189/05 at [62]: the consumer will break a verbal sign down into verbal elements which suggest a concrete meaning or resemble known words.

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

41. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

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

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state

of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 [...]

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

43. The above guidance can relate to all of Han’s goods, and I conclude that the average consumer of its goods consists of both medical professionals together with patients and end users. Holding’s goods are very specialist and not likely to be encountered by patients. The average consumer is likely to be limited to medical professionals only.

44. In respect of the level of care and attention paid by the average consumer during the purchasing process, this is likely to be heightened in respect of most of the parties’ goods. Han’s *dressings materials* and *medical dressings* may include goods that are an exception to this finding and include goods that may be purchased directly by the general public who is likely to pay a slightly lower level of attention.

45. The purchasing process is likely to be visual in nature, but I keep in mind that in certain circumstances, aural considerations may also be relevant, for example, when speaking to a medical sales representative.

***Distinctive character of the earlier trade mark***

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

virtue of the use that has been made of it. There is no evidence of use filed by Holding and therefore, I cannot conclude that its mark benefits from an enhanced distinctive character through use and I consider only its inherent level of distinctive character. I have already noted that Holding's mark is an invented word but that it is one that alludes to a barrier gel, therefore, whilst it is endowed with distinctive character, it is not of the highest level, rather, I would describe it as having no more than a medium level of inherent distinctive character.

### ***Global Assessment – Conclusions on Likelihood of Confusion***

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

49. In the current case, I have found that:

- Han's *medicines for human purposes* shares a very low, if any, level of similarity to Holding's goods;
- Han's *collagen for medical purposes* shares at least a medium level of similarity with Holding's goods;

- Han's *dressings materials; surgical dressings; medical dressings* share no more than a very low level of similarity with Holding's goods;
- Holding's mark consists of the single invented word BARRIGEL and its distinctive character resides in this word;
- The "BarriGel" elements of Han's mark are the dominant and distinctive part but the HANBIO element is not negligible and retains its own distinctive character within the mark;
- The respective marks share a high level of visual similarity, a medium level of aural similarity and at least a medium level of conceptual similarity;
- The average consumer of Han's goods consists of both medical professionals together with patients and end users. The average consumer of Holding's goods is limited to medical professionals. In respect of both parties' goods the purchasing process is visual but aural considerations may play a part. The level of care and attention during the purchasing process is likely to be heightened in respect of most of the parties' goods, but slightly less in respect of some goods covered by Han's *dressings materials* and *medical dressings*;
- Holding's mark is endowed with no more than a medium level of inherent distinctive character. This is not enhanced through use.

50. Holding submits that notional use of its mark would include use as "BarriGel" and also the word presented in the same way as presented in Han's mark. I reject this submission. The capitalisation of the letter "g" impacts upon the distinctive character of the mark changing it from a single invented word to the two words "Barri" and "Gel" conjoined. Consequently, I do not consider such an imagined use to be notional use of the earlier mark. I kept this distinction in the distinctive character of the respective marks in mind when considering the similarity of the respective marks and I also keep it in mind now, when considering the question of likelihood of confusion.

51. I keep all these findings in mind. The high level of visual similarity and the common occurrence of the "BarriGel"/"BARRIGEL" element in both marks points towards a finding of direct confusion in respect of goods that share some similarity. Partially balancing this is the fact that the average consumer will, in most cases, have a heightened level of attention during the purchasing process that will mitigate to some

degree against a likelihood of confusion. However, balancing these factors, I am of the view that a likelihood of confusion does exist in respect of goods that share more than a low level of similarity. Therefore, the first opposition succeeds in respect of Han's *collagen for medical purposes*.

52. The opposition fails in respect of Han's remaining goods, namely, *medicines for human purposes and dressing materials; surgical dressings; medical dressings*. Whilst these goods are all medical in nature, that is the extent of any similarity to Holding's very specialised goods. When this is kept in mind together with the heightened level of care and attention paid during the purchasing process and the allusive nature of "barrigel", I consider that confusion is unlikely and the similarity would be put down to no more than coincidence.

## **THE SECOND OPPOSITION**

### **Comparison of goods**

53. The first opposition was partially successful and, therefore, Han may still rely upon its earlier mark in respect of *medicines for human purposes and dressing materials; surgical dressings; medical dressings*.

54. Therefore, the respective goods to be considered are:

<b>Han's goods</b>	<b>Holding's goods</b>
<p><b>Class 5:</b> <i>Medicines for human purposes;... dressing materials; surgical dressings; medical dressings.</i></p>	<p><b>Class 5:</b> <i>Gel injected between prostate and rectum for creating a space between the two for protecting the rectum from radiation during prostate cancer radiation treatment.</i></p> <p><b>Class 10:</b> <i>Medical device for treating cancer; Radiation therapy devices; Medical devices, namely, gel implants</i></p>

	<i>and sheeting for protecting the rectum from radiations during prostate cancer radiation treatment.</i>
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## **Class 5**

55. Holding's goods are different to that of its 911901329 registration where its goods are a device in Class 10. In the second opposition, its applied-for mark is in respect of an injectable gel in Class 5 albeit with the same purpose as its device in Class 10. Having noted this difference, it is still for use in prostate cancer radiation treatment and used as protection of the rectum during such treatment. Therefore, when comparing these goods with Han's *medicines for human purposes* my considerations are very similar to those at paragraphs 27 - 29, above. It is clear that the respective goods are different in terms of purpose and nature and that they are not in competition. Whilst Holding's gel and Han's medicines could both be administered by injection this is not sufficient reason to find similarity and complementarity. I find that the respective goods share only a very low level of similarity.

56. I also need to consider the similarity of Holding's goods to Han's *dressings materials; surgical dressings; medical dressings*. Again, I keep in mind that here, Holding's goods are injectable gels rather than a gel device, but nevertheless, my findings mirror those expressed in paragraphs 31 and 32 above and I find that the respective goods share a very low, if any, level of similarity.

## **Class 10**

*Medical devices, namely, gel implants and sheeting for protecting the rectum from radiations during prostate cancer radiation treatment.*

57. For the reasons discussed in the first opposition (at paragraphs 27 - 32 above), I find that Han's goods share a very low level of similarity to these goods.

*Medical device for treating cancer; Radiation therapy devices*

58. These terms are broader than previous term, but such devices share little obvious similarity to Han's medicines and dressings. They are self-evidently different in nature and methods of use. Han's medicines may be for the treatment of cancer or used as part of a course of treatment also involving the use of radiation therapy devices. Consequently, they may be used as part of the same multi-faceted treatment regime, but there is nothing before me to suggest that they are complementary in the sense expressed in *Boston Scientific* and in all other aspects they are not similar. I conclude that this creates similarity, but only at a very low level.

**Comparison of marks**

59. The respective marks are:

Han's earlier mark	Holding's mark
 The image shows the text 'HANBIO BarriGel'. 'HANBIO' is in a smaller, spaced-out font above 'BarriGel'. 'BarriGel' is in a larger, bold font with a slight shadow effect.	BARRIGEL

60. The considerations regarding the comparison of mark are identical to those in the first opposition where I concluded:

- Holding's mark consists of a single invented word and its distinctive character resides in this word;
- Han's mark consists of the word "HANBIO" and the two elements "Barri" and "Gel" conjoined. "BarriGel" is the dominant and distinctive part of the mark but the HANBIO element is not negligible and retains its own distinctive character within the mark;
- Visually, the respective marks share a high level of visual similarity;
- Aurally, the respective marks share a medium level of similarity;
- Conceptually, the respective marks share at least a medium level of similarity;

- The average consumer of Han’s goods consists of both medical professionals together with patients and end users. The average consumer of Holding’s goods is limited to medical professionals. In respect of both parties’ goods the purchasing process is visual but aural considerations may play a part. The level of care and attention during the purchasing process is likely to be heightened (in respect of all the relevant goods in issue).

### ***Average consumer and the purchasing act***

61. Once again, my considerations are identical to those set out at paragraphs 39 - 44 when discussing the first opposition. For clarity, my earlier findings in respect to Holding’s Class 10 goods extend to its Class 5 goods also.

### ***Distinctive character of the earlier trade mark***

62. Han has provided no evidence of the scale of use of its mark and, therefore, I only need consider its inherent distinctive character. I have already found that “BarriGel” is the dominant and distinctive part of the mark, but the HANBIO element has its own distinctive character within the mark. “BarriGel” is allusive of barrier gel and not of the highest level of distinctiveness, but HANBIO is an invented word without any obvious meaning. Therefore, when taking the mark as a whole, I conclude that it is endowed with an inherent level of distinctive character of more than a medium level but less than a high.

### ***Global Assessment – Conclusions on Likelihood of Confusion***

63. To summarise, I have found:

- the parties’ goods share only a very low level of similarity;
- Holding’s mark consists of a single invented word and its distinctive character resides in this word;
- Han’s mark consists of the word “HANBIO”, together with the two conjoined elements “Barrie” and “Gel”. “BarriGel” is the dominant and distinctive part of

the mark but the HANBIO element is not negligible and retains its own distinctive character within the mark;

- Visually, the respective marks share a high level of visual similarity;
- Aurally, the respective marks share a medium level of similarity;
- Conceptually, the respective marks share at least a medium level of similarity.
- The average consumer of Han's goods consists of both medical professionals together with patients and end users. The average consumer of Holding's goods is limited to medical professionals. In respect of both parties' goods the purchasing process is visual but aural considerations may play a part. The level of care and attention during the purchasing process is likely to be heightened in respect of most of the parties' goods;
- Han's mark is endowed with more than a medium level of inherent distinctive character but less than high. This is not enhanced through use.

64. My considerations are very similar to those of the first opposition because the marks being considered are the same as in the first opposition, as are the average consumers. I recognise that some of the goods comparisons are slightly different, but taking all the relevant factors into account and, in line with my findings in the first opposition, a very low level of similarity between the respective goods results in my finding that there is no likelihood of confusion.

65. In light of my conclusions, the second opposition fails in its entirety.

## **Summary**

66. The first opposition succeeds in respect of the following goods:

*collagen for medical purposes.*

but fails in respect of the remaining goods, namely:

*medicines for human purposes and dressing materials; surgical dressings; medical dressings.*

67. The second opposition fails in its entirety.

## **COSTS**

68. The parties both achieved a degree of success in the first opposition and the parties should bear their own costs in respect of that part of the consolidated proceedings. Han failed in the second opposition and Holding is entitled to a contribution towards its costs in respect of that case. I keep in mind that the Holding filed evidence and that there was no hearing. In the circumstances I award Holding costs as follows:

Considering statement of case and preparing and filing Form TM8 and counterstatement:	£400
Preparing evidence and considering other side's evidence:	£500
Preparation of submissions:	£400
<b>Total:</b>	<b>£1300</b>

69. I, therefore, order Han Biomedical Inc. to pay Galderma Holding SA the sum of £1300. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5<sup>th</sup> day of July 2023**

**Mark Bryant**  
**For the Registrar**