

O/0982/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003680551
IN THE NAME OF CORN PRODUCTS DEVELOPMENT, INC.
TO REGISTER THE FOLLOWING MARK:**

CATALYST

IN CLASS 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 429679
BY STEVENAGE BIOSCIENCE CATALYST**

Background and pleadings

1. These proceedings concern the opposition to an application to register **CATALYST** as a trade mark in the UK. The application was filed by Corn Products Development, Inc. (“the applicant”) on 11 August 2021, pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU which enabled applications pending at the European Union Intellectual Property Office (“EUIPO”) on IP Completion Day (31 December 2020) to be filed as applications in the UK and retain the EU filing date. The filing date for this application is therefore 22 June 2020.

2. The application was published for opposition purposes on 24 September 2021 and seeks registration for the following services:

Class 42: *Scientific and technological consulting services, research and design, industrial analysis and development for manufacturers of food, beverages, paper, paperboard, linerboard, textiles, foamed products, adhesives, building materials, construction materials, personal care products, cleaning products, packaging materials, pharmaceuticals, infant food, nutritional supplements, nutritional foods and beverages and animal feed; Food and Beverage Research, Cocreation, or Innovation; Food Additive Research, Cocreation, or Innovation; Scientific Research, Cocreation, or Innovation for Industrial Products.*

3. On 23 December 2021, the application was opposed by Stevenage Bioscience Catalyst (“the opponent”) based upon Sections 5(2)(b), 5(3), 5(4)(a) and 3(1)(c) and (d) of the Trade Marks Act 1994 (“the Act”).

4. In support of its ground under Section 5(2)(b) of the Act, the opponent relies upon the following trade mark and the services covered by it, as shown below:



Filing date: 13 September 2010; Registration date: 4 February 2011

Class 35: *Publicity; advice relating to commercial management; administration business; administrative services.*

Class 41: *Education; training; entertainment; sport and cultural activities.*

Class 42: *Scientific and technological services, as well as associated researches and design services; industrial analysis and industrial research services; designs and developing computers and of software.*

Class 44: *Medical services; veterinary services; hygiene and beauty care services provided for people and for animals.*

5. The opponent claims that the marks are similar sharing the same dominant element 'CATALYST' and that the services are identical, giving rise to a likelihood of confusion.

6. In support of its case under Section 5(3) of the Act, the opponent relies upon the same mark and services shown above. The opponent claims that its mark has an extensive reputation in the UK in relation to, inter alia, *scientific research*. The opponent further states that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of its mark.

7. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier mark

had completed its registration procedure more than five years before the application date of the mark in issue, it is subject to proof of use pursuant to Section 6A of the Act.

8. In support of its case under Section 5(4)(a) of the Act, the opponent relies upon the sign '**STEVENAGE BIOSCIENCE CATALYST**' which it claims to have used throughout the UK since 2010 in relation to the same services as those covered by the earlier mark. The opponent states that since 2010 it has built up significant goodwill and reputation in this name, through its collaboration and partnerships with academics, biotech and pharmaceutical organisations, including world-renowned companies such as GSK. The opponent further submits that the applicant chose to apply for the mark 'CATALYST' in connection to research, design and industrial analysis services, because it acknowledged the goodwill and reputation enjoyed by the opponent and sought to misrepresent that it was in some way connected to the opponent.

9. The opponent's claims under Section 3(1)(c) and (d) are as follows:

Section 3(1)(c): "The word CATALYST means: 'a thing that precipitates an event' and the services covered by the Application, namely (inter alia) scientific research, serve as a catalyst for the development of products. The Application therefore describes the services it covers."

Section 3(1)(d): "In a scientific environment the word CATALYST is used frequently because it is also defined as 'a substance that increases the rate of a chemical reaction without itself undergoing any permanent chemical change'. Therefore, the Application is for a sign which has become customary in the current language and established practices of the relevant trade (scientific research)"

10. The applicant filed a defence and counterstatement, denying the claims made and putting the opponent to proof of use of the earlier mark.

11. The opponent is represented by Harrison Clark Rickerbys Solicitors. The applicant is represented by Cam Trade Marks & IP Services. Only the opponent filed evidence. I shall refer to the evidence to the extent that I consider necessary. Neither party

requested a hearing, but the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

The evidence

12. The opponent's evidence consists of a witness statement from Dr Sally Ann Forsyth who is the Chief Executive Officer at the opponent's company. Dr Forsyth's witness statement is dated 16 December 2022 and is accompanied by 9 exhibits (SAF1- SAF9).

EU Law

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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Proof of use

14. The relevant statutory provisions are as follows:

“6A – (1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
 - (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

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

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

[22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

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

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

17. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application at issue, namely **23 June 2015 to 22 June 2020**.

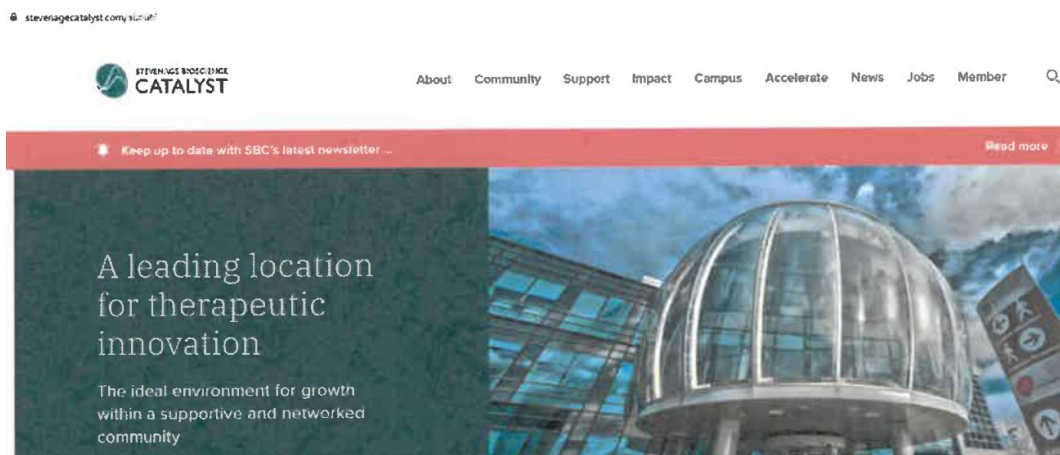
18. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

The evidence of use

19. The most important evidence emerging from Dr Forsyth's witness statement is as follows.

20. The opponent has been using the earlier mark and the sign 'STEVENAGE BIOSCIENCE CATALYST' since 2010. In support of her claim to use, Dr Forsyth produces:

- (a) An undated screenshot of Stevenage Bioscience Catalyst's website (www.stevenagecatalyst.com) displaying the earlier mark, as shown below:¹



- (b) undated photographs of signage at the opponent's facilities displaying the earlier mark, as shown below:²



¹ Exhibit SAF1

² Exhibit SAF2



(c) Examples of undated flyers that the witness says were produced in November 2020 (after the relevant date) and May 2012. The 2020 flyer shows the earlier mark used in relation to an offer for “an entrepreneurial hub for life science”. The flyer advertises “a leading location for companies to develop and commercialise cutting edge therapeutics” and describes the business as follows: “The Campus is home to major organisations including GlaxoSmithKline, the Cell & Gene Therapy Manufacturing Catapult, LifeArc and Cytiva alongside a growing cluster of start-up companies which together have raised £1.6bn in funding. Located within the golden triangle and the academic centres of London, Cambridge and Oxford, SBC is ideally positioned for the translation and scale-up of cutting-edge innovation”. The main services offered under the earlier mark appear to be the provision of laboratory, office and shared space; these seem to be offered in conjunction with supplementary services including business services (networking and events, mentors and consultants, access to finance), amenities (free parking, broad band, meeting rooms, café and catering) and scientific support (shared community lab, flow cytometry facilities, access to Cytiva demo lab).

The 2012 flyer says that the costs of the services cover rental and maintenance charges. It refers to the users of the services as ‘SBC tenants’ as shown below:

Tenant Offering

The rental and maintenance charge covers:

- Shared technical facilities
- A communal area with access to chemistry services and equipment
- Access to electronic journals
- Access to meeting rooms and conferencing facilities
- Access to communal areas, such as a gym and restaurant/cafe



SBC is at the Centre of UK Life Sciences

Stevenage Bioscience Catalyst

Gunnels Wood Road
Stevenage
Herts, SG1 2FX

Email: info@stevenagecatalyst.com
Tel: 01438 906906





Tenant Offering

Access to world class resources including superb high specification laboratories, funding and a vibrant community for biotech growth and development



Stevenage Bioscience Catalyst is part of a growing life sciences cluster in the South East of England. It offers tenants large and small a unique and attractive environment in which to grow and develop their businesses.

www.stevenagecatalyst.com

SBC Investment Funding

SBC intends to develop its own early-stage investment fund. It is also collaborating with Kurma Life Sciences Partners to stimulate investment in bioscience companies.

SR One will allocate up to £10m to invest in selected companies located at SBC.

Access to Laboratory Equipment at SBC

SBC has access to a range chemistry and biology equipment.

A list of equipment, which includes over 2,000 items, is available on request.

Therapeutic Area Expertise at GSK Stevenage

SBC tenants have easy access to key GSK researchers, to share ideas and knowledge in the pre-competitive space.

Drug Discovery and Development Consultancy

Tenants are able to tap into GSK's R&D expertise through Scinovo, which offers scientific consulting and advisory services.

Wellcome Trust and Technology Strategy Board

The Wellcome Trust has committed funding towards

Dr Forsyth states that these flyers were distributed to companies interested in leasing space from the opponent.

(d) A list of companies that, Dr Forsyth says, “*currently lease space from [the opponent]*”.³ Around forty companies are listed all of which are said to have a focus on the research and development of products and technologies that are relevant to the therapeutics industry, including pharmaceuticals. According to Dr Forsyth, Stevenage Bioscience Catalyst provides 75,700 sq.ft./7,032 sq.m. of laboratory and office space and facilities.

(e) A copy of a letter dated 4 October 2019, from the Department for Business, Energy and Industrial Strategy to Dr Forsyth. The letter confirms that Dr Forsyth’s application to name the opponent a “*Life Sciences Opportunity Zone*” had been successful. Dr Forsyth further explains that the opponent’s appointment means that it will benefit from engagement with government ministers and officials from the Department for International Trade and the Office for Life Sciences, a fact which appears to be corroborated by the following text in the letter:

“My officials will be in touch in due course to set up a roundtable for all six new Life Sciences Opportunity Zones. One aspect which I would like to discuss with all of you is how to build connectivity and experience between the different zones. We are also keen that Opportunity Zones are promoted in the most effective way, particularly on the international stage. My officials look forward to working with you and their counterparts in the Department for International Trade to consider the best way to do this”.

(f) Two press releases, from March 2021 and December 2021, respectively. Dr Forsyth says that the press release from December 2021 was circulated to stakeholders but was then picked up by <https://www.ukspa.org.uk/>, <https://uk.finance.yahoo.com/> and on LinkedIn, although it is not said when this occurred; the press released is headed “*Report demonstrates Stevenage*

³ Exhibit SAF4

Bioscience Catalyst's key role in delivering the economic benefit from leading edge UK life sciences” and states:

“An independent report has been released today by Stevenage Bioscience Catalyst (SBC) that demonstrates its key role in delivering economic benefit from life sciences research and innovation in the UK. SBC was formed in 2012 through a collaboration between the Department for Business, Energy and Industrial Strategy (BEIS), GlaxoSmithKline, Wellcome and Innovate UK. Located on the GSK Campus in Stevenage, it is home to the Cell and Gene Therapy Catapult Manufacturing Centre, LifeArc, Cytiva and around 40 thriving start-ups. Entitled 'Stevenage Bioscience Catalyst's key role in delivering economic benefit from life sciences', the report finds that SBC has supported not only early innovation but also scale-up businesses across the life sciences value chain, delivering an outstanding contribution to the UK economy.

*"High-tech, high-skilled jobs in the life sciences sector are vital to both the UK becoming an Innovation Nation growing clusters of opportunity for all, like Stevenage - as well as the UK playing a crucial role in solving some of the world's biggest challenges. The excellent work being done at the Stevenage Bioscience Catalyst is a perfect example of the kind of public/private partnership cluster we need to see across the whole of the UK. I hope it will inspire other clusters in other parts of the country to similar growth and productivity in the years ahead as we develop our high skill Innovation Nation economy of the future." - **George Freeman, Science, Research and Innovation Minister.***

"From a standing start in 2012, we have built a thriving cluster of life sciences companies focussed on developing and commercialising cutting-edge therapeutics. Today's report shows that occupiers value the support we give them, that our companies are making a very significant contribution to the UK economy and that that they are attracting exceptional levels of investment to advance therapeutic research and

development. This forms the core of our outstanding cluster and ultimately will result in new medicines to improve the quality of people's lives." --- **Dr Sally Ann Forsyth OBE, CEO of SBC.**

[...]

A supportive environment is wrapped around this that provides access to specialist scientific equipment, business support and finance with mentoring from leaders in the field with the relevant scientific and commercialisation experience.

The report found that occupier companies are attracted by the reputation and image of SBC, as well as its central location, access to facilities and expertise. Proximity to similar companies is seen as essential including interaction with others within the commercialisation supply chain. Bioscience companies at SBC say the support they receive there has enabled them to speed up product development time by an average of nine months."

Dr Tony Wood, SVP, Medicinal Science & Technology, GSK said: "Stevenage is a leading destination for medical and scientific innovation in the UK and the Stevenage Bioscience Catalyst (SBC) is a core component of that, supporting UK life science SMEs as they scale up. As announced earlier in the year, we are excited to further build on this and work alongside SBC to enable the development of one of Europe's largest life science campuses based in Stevenage, with the goal to create thousands of jobs and unlock up to £400 million of new private investment.

[...]

Mark Bretton, Chair, Hertfordshire LEP and Chair, LEP Network, said: "Our investment in Stevenage Bioscience Catalyst and the Cell and Gene Therapy Catapult has consolidated Stevenage's position as a globally recognised hub for cell and gene therapy, attracting international companies with the potential to create thousands of high-level jobs" (emphasis added).

Dr Forsyth says that the press release from March 2021 was posted on the opponent's website and was picked up by <https://www.prnewswire.com/> (although it is not said when this occurred). It states as follows:

“Stevenage BioScience Catalyst and Kurma Life Sciences Partners Announce Collaboration to Stimulate Investment in Bioscience Companies

Stevenage, UK, and Paris, France, March 21 2012 - Stevenage Bioscience Catalyst (SBC), the UK's first open innovation bioscience campus, and Kurma Life Sciences Partners (Kurma), which has pioneered a new approach for financing innovation, are pleased to announce that they have signed a memorandum of understanding to enable them to work together on establishing and funding new life sciences companies. It is anticipated that funding will also be available for small proof-of-concept projects” (emphasis added).

[...]

21. Noticeably, the press release describes the opponent's business as follows:

“Stevenage Bioscience Catalyst is a joint venture between the Department of Business, Innovation & Skills, GlaxoSmithKline, the Wellcome Trust, the East of England Development Agency and the Technology Strategy Board. The £38m development is an independent bioscience facility.”

And

“About Stevenage Bioscience Catalyst

Stevenage Bioscience Catalyst is the UK's first open innovation bioscience campus, pioneering a unique culture to drive early-stage drug discovery and development. It is backed by £38m of funding from its founding partners -- GlaxoSmithKline, the Wellcome Trust, the Department for Business, Innovation and Skills, the Technology Strategy Board and the East of England Development Agency. Buildings in Phase 1 of the development consist of an

Incubator, an Accelerator and a Hub, covering 60,000 sq ft of laboratory, office and networking space. The independent facility is expected to house a range of companies, from virtual and start-up firms to those which are more established. Located on the GlaxoSmithKline Stevenage site, Stevenage Bioscience Catalyst is in the unique position of operating in proximity to the expertise and resources of a major pharmaceutical company, close to both London and Cambridge. For more information, please go to www.stevenagecatalyst.com" (emphasis added).

22. Dr Forsyth argues that the contested application covers services that are offered by the companies based at the opponent's Stevenage Bioscience Catalyst campus, for example, she says, Autolus (this is one of the companies listed at SAF4 as currently leasing space from the opponent) develops pharmaceutical products and healthcare products. She also provides a screenshot from the applicant's website (<https://www.ingredion.com>) and argues that the applicant seemingly has no operation in the UK, with its website being US-facing.

23. As regards the turnover, Dr Forsyth makes the following statement before introducing the turnover figures (emphasis added):

*"Although turnover is typically an indicator of the goodwill and reputation a business has, **with my company the goodwill and reputation it has is more clearly evidenced in the support and facilities it provides to the companies that lease space from it, its contribution to the UK economy (as mentioned above) and its contribution to scientific research.** However, for visibility, below is my company's turnover for the last five years:*

2017/2018: £3,082,094

2018/2019: £3,693,460

2019/2020: £4,072,444

2020/2021: £4,259,373

2021/2022: £4,619,759"

Does the evidence establish genuine use in relation to the registered services?

24. The applicant submits that the opponent's evidence does not support genuine use of the mark in the relevant classes requiring proof of use and argues that the turnover figures relate to rental income but not direct income from the provision of the registered services.

25. That seems to me to be a fair comment, in the light of the evidence. In particular, it seems to me significant to bear in mind the description of the opponent's business given by the exhibits attached to Dr Forsyth's witness statements which refer to **"tenant offering"** and **"rental and maintenance charges"**. The opponent is essentially a company renting out office and laboratory space to life science businesses. However, the opponent's rental and leasing of offices services fall within the category of real estate services (in class 36) for which the earlier mark is not protected. *"Access to meeting rooms and conferencing facilities"* could be either covered by rental and leasing of offices - as it seems to be the case here according to the 2012 flyer which refers to rental and maintenance charges covering access to meetings rooms and conferencing facilities - or would be rental of meeting rooms (in class 43) and/or providing facilities and equipment for video conferencing (in class 38). In any event, this service does not appear to fall within any of the terms for which the earlier mark has protection.

26. The flyer from 2012 indicates that the opponent's tenants have access to a range of chemistry services and equipment, and high specification laboratories, and mentions that a list of equipment, which includes over 2,000 items, is available on request. However, leasing chemistry and biological laboratory space (or even rental of laboratory apparatus and instruments) is not the same as providing chemistry and laboratory services. This is because chemistry and laboratory services are performed by professionals in order to provide test results needed for clinicians to assess health and diagnose diseases, or as part of scientific research aimed at discovering new drugs and developing new pharmaceutical products. In this case, although the 2012 flyer refers to the opponent offering *"chemistry services"*, it does not seem that the term *"chemistry services"* is used to denote services offered by the opponent to its tenants (or indeed to the general public). On the contrary, the evidence indicates that

the opponent leases laboratory spaces and equipment to bioscience companies and that these companies (who are the opponent's tenants) use the laboratory space and equipment to carry out scientific research, testing and analysis as part of their own business connected with the development of products and technologies that are relevant to the therapeutics industry. It follows that the opponent's argument that the earlier mark has been used in relation to *scientific research* confuses the business run by the opponent's clients (i.e. its tenants) with its own landlord business. I am therefore unable to detect any evidence demonstrating that the opponent has used the earlier mark in relation to *scientific research* services or, indeed, in relation to any of the registered services in class 42, which I remind myself, cover *scientific and technological services, as well as associated researches and design services; industrial analysis and industrial research services; designs and developing computers and of software.*

27. Similarly, to the limited extent that there is some suggestion in the exhibits that the opponent's tenants might have had access to scientific consultancy services (which would fall within the registered term *scientific and technological services* in class 42) or educational and mentoring services (which would fall within the registered term *education* in class 41) whilst leasing laboratory and office space at the Stevenage Bioscience Catalyst site, it appears that these services, if provided, were supplied by GlaxoSmithKline ("GSK"), one of the companies located on Stevenage Bioscience Catalyst campus, or by other tenants. I refer in this connection to the 2012 flyer which states (emphasis added):

*"Therapeutic area expertise at **GSK Stevenage** - SBC tenants have easy access to key **GSK researchers**, to share ideas and knowledge in the pre-competitive space" and "Drug discovery and development consultancy- Tenants able to tap into **GSK's and R&D's expertise** through Scinovo, which offer **scientific consultancy and advisory services"***

28. The press releases also refer to the opponent's tenants having access to mentoring from leaders in the field with the relevant scientific and commercialisation experience, stating as follows (emphasis added):

*“Located on the **GlaxoSmithKline Stevenage site**, Stevenage Bioscience Catalyst is in the unique position of operating **in proximity to the expertise and resources of a major pharmaceutical company**, close to both London and Cambridge”*

29. In this connection, I also note (a) that the press releases refer to “**GSK Campus in Stevenage**” and to Stevenage Bioscience Catalyst being a joint venture between the Department of Business, Innovation & Skills, **GlaxoSmithKline**, the Wellcome Trust, the East of England Development Agency and the Technology Strategy Board; and (b) that the earlier mark was originally registered in name of **Glaxo Group Limited**, and was recorded as assigned to the opponent on 10 December 2019.

30. However, there is no mention in Dr Forsyth’s witness statement of the mark being originally registered in the name of Glaxo Group Limited, and there is no explanation of the relationship between Glaxo Group Limited (i.e. the opponent’s predecessor in title) and GlaxoSmithKline (i.e. one of the founding partners of the Stevenage Bioscience Catalyst campus and a major pharmaceutical company). Furthermore, Dr Forsyth did not say that, prior to the assignment, the opponent used the earlier mark with Glaxo Group Limited’s consent.

31. In those circumstances, I can only assume that when the earlier mark was originally filed in September 2010, Glaxo Group Limited and GlaxoSmithKline were part of the same group of companies sharing the same distinctive name Glaxo. Assuming that I am right in my present assumption, that would explain why the 2012 flyer refers to the opponent’s Stevenage Bioscience Catalyst campus as “**GSK Campus in Stevenage**” and why the press release refers to Stevenage Bioscience Catalyst being located at the GlaxoSmithKline’s Stevenage site. This, in turn, would also explain why Glaxo Group Limited applied to register the earlier mark for, *inter alia*, *scientific and technological services, as well as associated researches and design services* (in class 42) and *education; training services* (in class 41). It was because the Stevenage Bioscience Catalyst campus (in relation to which the earlier mark was going to be used) was co-founded by GlaxoSmithKline and located on its site with a view to attracting companies focussed on developing and commercialising cutting-edge therapeutics by offering these companies the opportunity of operating in

proximity to the expertise and resources of GlaxoSmithKline. This leads me to the next point. Whilst GlaxoSmithKline might have provided some scientific consultancy and mentoring services to the companies leasing space in the Stevenage Bioscience Catalyst campus between 23 June 2015 and 10 December 2019 (i.e. between the start of the relevant period and when the mark was assigned to the opponent) and whilst the provision of such services could arguably be said to be use of the earlier mark by a parent company with the registered proprietor's consent (assuming that I am right in my assumption that Glaxo Group Limited and GlaxoSmithKline were part of the same group of companies) it still does not resolve the opponent's case. This is because (1) it would not be right to find genuine use based on a series of assumptions I had to make in the absence of any explanation from the opponent; (2) turnover figures are not broken down in any way and appear to refer only to income generated by rental and maintenance charges (3) even if a proportion of the rental and maintenance charges reflected the advantage derived by the tenants being able to access GlaxoSmithKline's expertise during part of the relevant period (i.e. the period prior to the assignment taking place because during that period it could be argued that the owner of the mark or its parent company provided scientific consultancy and mentoring services to their tenants under the earlier mark), the lack of any details relating to **when, how and to whom** the scientific consultancy and mentoring services were provided means that it is impossible to establish whether the use of the earlier mark in relation to these services was genuine use within the meaning of the case law.

32. At this point, it is perhaps just briefly worth reminding myself that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of **the origin of the goods or services for which it is registered** in order to create or preserve an outlet **for those goods or services**; and when assessing whether use of a trade mark is genuine, regard must be given to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark in the course of trade is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market **for the goods or services protected by the mark**, the nature of those goods or services, the characteristics of the market and the scale.

33. Whilst I do not dispute that the earlier mark has been used, it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use. This is all the more so if the use shown relates to goods and services others than those for which the mark is registered. In this case, the absence of any reliable evidence about the use of the mark in relation to the registered services cannot be overcome. For these reasons, and after a careful consideration of all of the evidence, I conclude that there is no sufficient evidence to conclude that the earlier mark has been genuinely used by the opponent (or its predecessor in title) during the relevant period in relation to the services for which it is registered in classes 35, 41, 42 and 44 and upon which the opponent relies.

34. As the opponent has failed to establish genuine use of its earlier mark within the relevant period, the opposition based under Sections 5(2)(b) and 5(3) fails at the first hurdle and is dismissed accordingly.

Section 5(4)(a)

35. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

[...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

36. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

The relevant date

37. The opponent must show that it had goodwill in a business at the relevant date of 22 June 2020 (the date of the application)⁴ and that the sign relied upon, ‘STEVENAGE BIOSCIENCE CATALYST’, is associated with, or distinctive of, that business.

Goodwill

38. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL):

⁴ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

39. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered or passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

40. The opponent's claim under Section 5(4)(a) is as follows:

“The Opponent has used the name STEVENAGE BIOSCIENCE CATALYST since 2010. Since this date the Opponent has built up significant goodwill and reputation in this name, through its collaboration and partnerships with academics, biotech and pharma organisations, including world-renowned companies such as GSK.

It is submitted that the Applicant chose to apply for a trade mark for CATALYST, and to use this name, in connection to research, design and industrial analysis services, because the Applicant acknowledged the goodwill and reputation enjoyed by the Opponent and sought to misrepresent that it was in some way connected to the Opponent”

41. There are several issues arising in relation to the opponent's claim for passing off.

42. First, there is nothing to support the claim that the opponent has used the mark 'STEVENAGE BIOSCIENCE CATALYST' since 2010. This is a significant issue here because, although the evidence is a little ambiguous, it suggests that there was use on the part of GlaxoSmithKline dating back to 2012, but there is no evidence that there was any assignment of the goodwill generated by GlaxoSmithKline to the opponent.

43. Perhaps it is appropriate that I should pause here to say that Dr Forsyth's evidence contains some inconsistencies and deficiencies in this respect because: (i) Dr Forsyth says that the opponent has been using the earlier mark and the sign 'STEVENAGE

BIOSCIENCE CATALYST' since 2010, however, the press releases indicate that the 'STEVENAGE BIOSCIENCE CATALYST' campus was formed in 2012 so it is not clear to me what is the business in relation to which the opponent's company used the mark between 2010 and 2012; (ii) Dr Forsyth ambiguously refers to the opponent working in collaboration and partnership with GlaxoSmithKline without explaining what the relationship between the two companies is; (iii) Dr Forsyth does not appear to distinguish between use of the earlier mark and use of the unregistered sign 'STEVENAGE BIOSCIENCE CATALYST' and makes no mention of the fact that until December 2019 the earlier mark was owned by a different company.

44. As it might be recalled, the evidence shows that the 'STEVENAGE BIOSCIENCE CATALYST' campus was built on the GlaxoSmithKline Stevenage site, that GlaxoSmithKline was one of the founding partners of the campus, and that the campus was identified as GlaxoSmithKline's campus in Stevenage, all of which suggest that GlaxoSmithKline (or its parent company Glaxo Group Limited, if it is, in fact, its parent company) was the owner of the assets associated in the minds of the customers with the business itself, such as premises, registered trademarks or other intellectual property rights. Goodwill arises by virtue of the operation of a business and is, initially at least, vested in the person or company who owns and operates the business. In this case, the evidence is silent on the relationship between the opponent and GlaxoSmithKline, but it is reasonably clear that when the campus was formed in 2012 it was operated by GlaxoSmithKline (or Glaxo Group Limited), which means that the goodwill arising from it was owned by GlaxoSmithKline (or Glaxo Group Limited). Hence, in the absence of evidence that the goodwill was assigned to the opponent, it cannot be relied upon to sustain the opponent's claim for passing off.

45. As regards the opponent's activities which might have given rise to goodwill owned by the opponent, the evidence is unclear as to when the opponent started carrying on the business under the name 'STEVENAGE BIOSCIENCE CATALYST'. Further, it seems to me that all the opponent did was to provide real estate services in connection to the site; this might have involved some business supporting activities such as maintenance, security, and administration activities, and finance and personnel activities - and in this connection, I note, the applicant's submission that records from Companies House show that the opponent's main business activity is described as

“other business support service activities not elsewhere classified”. However, any business support services the opponent might have provided to its tenants were ancillary activities essential to the undertaking of its landlord business, i.e. leasing laboratories and office space and maintaining research and development equipment used by the tenants. Whilst there are some references in the evidence to the opponent engaging with some government departments after October 2019 with a view to promoting the ‘STEVENAGE BIOSCIENCE CATALYST’ site there are no further details about these activities.

46. Consequently, even if the opponent used the sign ‘STEVENAGE BIOSCIENCE CATALYST’ before the relevant date, the only conclusion that can be drawn from the evidence is that the use was in relation to a business leasing laboratory and office space. There is no evidence of the opponent using the sign in relation to a business providing the services relied upon under Section 5(4)(a), which are identical to those covered by the earlier mark.

47. Secondly, the difficulty with the opponent’s claim to goodwill is that, as the opponent itself seems to recognise, any goodwill and reputation in the sign ‘STEVENAGE BIOSCIENCE CATALYST’ derives from the fact that the site is home to biotech and pharmaceutical organisations, including GlaxoSmithKline. Even accepting that the ‘STEVENAGE BIOSCIENCE CATALYST’ campus is well-known for the quality of the scientific research carried out by its tenants on the site, the additional value this scientific research brings to the campus is not by reason of the services provided by the opponent but by reason of the tenants’ reputation and activities. Hence, whilst the reputation and activities of the opponent’s tenants might add value to the opponent’s landlord business, I am not persuaded that the opponent is the owner of the goodwill developed by its tenants in relation to activities amounting to scientific research (which the opponent does not provide).

48. For all of those reasons, I am not convinced that the opponent has established goodwill in the sign ‘STEVENAGE BIOSCIENCE CATALYST’ in relation to the services relied upon. The opposition based under Sections 5(4)(a) fails at the first hurdle and is dismissed accordingly.

Section 3(1)(c) and (d)

49. The relevant parts of Section 3(1) of the Act are as follows:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) [...]

(b) [...]

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”.

50. The case law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign

could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods

or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

51. The only evidence filed by the opponent in support of its objection under Section 3(1)(c) is a screenshot from www.collinsdictionary.com which shows that “CATALYST” is defined as a *“thing that causes a change or event to happen”*. The opponent argues that the services covered by the application are related to scientific research and that since scientific research is a catalyst for the development of products, the services covered by the application are descriptive, and the application should be refused.

52. Whilst the dictionary definition provided by the opponent demonstrates that ‘CATALYST’ means a *“thing that causes a change or event to happen”* and that the word is used in chemistry to indicate *“a substance that causes a chemical reaction to take place more quickly”*, I do not consider that ‘CATALYST’ describes a characteristic of the services for which the mark seeks protection which, I remind myself, are *Scientific and technological consulting services, research and design, industrial analysis and development for manufacturers of food, beverages, paper, paperboard, linerboard, textiles, foamed products, adhesives, building materials, construction materials, personal care products, cleaning products, packaging materials, pharmaceuticals, infant food, nutritional supplements, nutritional foods and beverages and animal feed; Food and Beverage Research, Cocreation, or Innovation; Food Additive Research, Cocreation, or Innovation; Scientific Research, Cocreation, or Innovation for Industrial Products.*

53. The dictionary definition produced in evidence also shows use of the word ‘CATALYST’ in the context of a phrase that has nothing to do with the services at issue, namely *“He said he saw the bank’s role as a catalyst to encourage foreign direct investment”*. This reinforces my impression that the versatile nature of the word ‘CATALYST’ (and the concept it conveys) makes it susceptible to metaphorical use in the context of any type of event which involves a person or a thing to causes a change or an event to happen. It is stretching the use of the word ‘CATALYST’ a long way to use it metaphorically to describe scientific consulting, design and research services aimed at the development of products. Whilst the mark might invite consumers to

make some associations, there is no sufficiently direct and specific connection between the mark and the services at issue. To put it simply, the word 'CATALYST' will not be perceived by the relevant public as describing a characteristic of the services with sufficient directness for it to be considered descriptive of those services.

54. As regards, the dictionary definition of 'CATALYST' as a chemical substance "*that causes a chemical reaction to take place more quickly*", the opponent has not pleaded that the mark will be descriptive for this reason and so I do not have to consider it. Nevertheless, for the sake of completeness, I will just add that even if the opponent had pleaded that word 'CATALYST' might describe a particular group of chemical substances that might be used in scientific research (a) there is no evidence to support such a claim and the dictionary definition is not sufficient to establish that the word 'CATALYST' is used to describe a chemical component or a particular group of chemical substances (b) even if I was prepared to accept that the word 'CATALYST' describes a particular group of chemical substances, it would describe some of the goods used in scientific research but would not be descriptive of scientific research services (or indeed of any other services for which the applicant's mark seeks protection).

55. I therefore reject the opponent's objection under Section 3(1)(c).

56. I now turn to the grounds under Section 3(1)(d).

57. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of Section 3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR

II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

58. The opponent claims that that (a) "CATALYST" is a sign that has become customary in the current language of those that operate in scientific fields and (b) "CATALYST" is a generic term for something that causes a reaction, change or event to happen.

59. In support of this claim Dr Forsyth relies on the dictionary definition of "CATALYST" as "*a substance that causes a chemical reaction to take place more quickly*" and on a screenshot from <https://www.gov.uk/government/collections/govtech-catalyst->

information, which refers to the GovTech Catalyst fund, offered by the UK Government, to organisations to solve public sector problems using innovative digital technology.

60. There is no evidence to support the allegations that the word 'CATALYST' is used by other traders to designate the services at issue. The only example provided by the opponent shows use of 'CATALYST' as part of the name of a public fund; this, if anything, would be trade mark use and does not show that the term is used in trade to designate the services at issue.

61. The ground under Section 3(1)(d) is also dismissed.

CONCLUSIONS

62. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

63. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,300 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement:	£400
Considering the opponent's evidence:	£500
Submissions in lieu:	£400
Total	£1,300

64. I therefore order Stevenage Bioscience Catalyst to pay Corn Products Development, Inc. the sum of £1,300. This sum is to be paid within twenty-one days

of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 20th day of October 2023

**Teresa Perks
For the Registrar**