TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION TO PROTECT INTERNATIONAL TRADE MARK REGISTRATION NO. WO0000001617462 IN THE UNITED KINGDOM

SALIOGEN

IN THE NAME OF SALIOGEN THERAPEUTICS, INC.

AND

AN OPPOSITION UNDER NO. 433411

BY BRISTOL LABORATORIES LIMITED

Background and pleadings

1. On 6 August 2021, Saliogen Therapeutics, Inc. ("the applicant") requested the protection in the United Kingdom ("UK") of the international trade mark registration shown on the cover page of this decision ("the applicant's mark"). The applicant's mark claims the benefit of a priority date of 8 February 2021. The applicant's mark was published for opposition purposes on 11 February 2022 for the following goods and services:

Class 1	Reagents, nucleic acids, and nucleotides for scientific and research use in the fields of clinical research, drug development, agriculture and genetics research; reagent kits comprised of reagents and chemical preparations for scientific research purposes; samples of nucleotide sequence variants and modifications for use in the fields of scientific research, clinical research, and scientific diagnostics research.
Class 5	Pharmaceutical preparations for genetic therapies to treat genetically driven disorders in the fields of neurology, gastroenterology, metabolism, immunology, dyslipidaemia, the musculoskeletal system, oncology, and diseases of the retina, liver, heart, lung, bone marrow, brain, muscle, immune system, and kidney; reagents; nucleic acids, and nucleotides for medical and veterinary purposes; all of the foregoing excluding pharmaceuticals for the treatment of xerostomia.
Class 42	Scientific and laboratory research services in the fields of gene, genome and cellular editing, modification, engineering and regulation for use in developing human and veterinary pharmaceutical and biological preparations; custom design and development of engineered cell lines for others for use in scientific research, and drug discovery and development.

2. Bristol Laboratories Limited ("the opponent") filed a notice of opposition on 11 May 2022. The opponent claims that the protection for the trade mark which is

the subject of the application in suit should be refused in the UK under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the goods and services covered by the application.

3. For its claim, the opponent relies upon all the goods covered by the below-mentioned UK trade mark registration:
   Mark: SALIO
   Registration No. 3171298
   Filing date: 24 June 2016
   Registration date: 28 October 2016
   Goods:
   Class 5 Pharmaceuticals, excluding pharmaceuticals for the prevention and treatment of respiratory disease.

4. The opponent claims that its earlier mark is similar to the applicant's mark and its goods are identical or similar to the applicant's goods and services, with the result that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the grounds of opposition.[1]

6. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. The earlier mark had completed its registration process more than 5 years before the priority date of the applicant's mark and is subject to proof of use pursuant to section 6A of the Act. However, the applicant chose not to put the opponent to prove use of the earlier mark.

7. The applicant is represented by Page, White & Farrer Limited and the opponent is represented by WP Thompson. The opponent filed submissions during the evidence rounds. No hearing was requested but the applicant filed submissions in lieu of a hearing. This decision is taken after careful reading of all the papers filed by the parties.

[1] The TM8 and counterstatement which were filed late were admitted into the proceedings on 8 September 2022. Please see the Registry's letter dated 8 September 2022.

8. Although the UK has left the European Union ("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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Section 5(2)(b)

9. Section 5(2)(b) of the Act reads 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."

10. Section 5A of the Act is as follows:

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

Case law

11. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03,

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.

The principles:

(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 the 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

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

13. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

14. In *Gérard Meric v OHIM*, the General Court ("GC") held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.[2]

15. The conflicting goods and services are as follows:

[2] case T-133/05

Applicant's goods and services	Opponent's goods
Class 1 Reagents, nucleic acids, and nucleotides for scientific and research use in the fields of clinical research, drug development, agriculture and genetics research; reagent kits comprised of reagents and chemical preparations for scientific research purposes; samples of nucleotide sequence variants and modifications for use in the fields of scientific research, clinical research, and scientific diagnostics research. Class 5 Pharmaceutical preparations for genetic therapies to treat genetically driven disorders in the fields of neurology, gastroenterology, metabolism, immunology, dyslipidaemia, the musculoskeletal system, oncology, and diseases of the retina, liver, heart, lung, bone marrow, brain, muscle, immune system, and kidney; reagents; nucleic acids, and nucleotides for medical and veterinary purposes; all of the foregoing excluding pharmaceuticals for the treatment of xerostomia.	Class 5 Pharmaceuticals, excluding pharmaceuticals for the prevention and treatment of respiratory disease.

Class 42 Scientific and laboratory research services in the fields of gene, genome and cellular editing, modification, engineering and regulation for use in developing human and veterinary pharmaceutical and biological preparations; custom design and development of engineered cell lines for others for use in scientific research, and drug discovery and development.	

Class 1: Reagents, nucleic acids, and nucleotides for scientific and research use in the fields of clinical research, drug development, agriculture and genetics research; reagent kits comprised of reagents and chemical preparations for scientific research purposes; samples of nucleotide sequence variants and modifications for use in the fields of scientific research, clinical research, and scientific diagnostics research.

16. The opponent submits that the conflicting goods are highly similar as the applicant's goods are used in the development of pharmaceuticals and are commonly carried out by the same companies who manufacture and sell pharmaceuticals.[3] The applicant, on the other hand, denied the similarity between the respective parties' goods. The applicant contends that its goods are ingredients or additives used in the manufacture of pharmaceuticals and have different nature and purpose, and they are not complementary goods.[4] The applicant also contends that although the conflicting goods can be broadly classified as chemical products, their specific purpose is different.[5] I agree with the applicant that the specific purpose of the goods is different. The applicant's

[3] The opponent's written submissions, dated 22 December 2022, paragraph 8.
[4] The applicant's submissions in lieu, paragraphs 10 and 11.
[5] *Ibid*, paragraph 8.

goods are substances and preparations used in research, while the opponent's goods are medicinal drugs intended to treat, manage and prevent a medical condition. The applicant's goods target pharmaceutical companies or government agencies engaged in research and drug development while the users of the opponent's goods are members of the general public and professionals such as doctors and pharmacists. I also do not think that the goods are complementary in the sense described by the case law. The conflicting goods do not follow the same distribution channels. Considering these factors, I find that the applicant's goods are dissimilar to the opponent's goods.

Class 5: Pharmaceutical preparations for genetic therapies to treat genetically driven disorders in the fields of neurology, gastroenterology, metabolism, immunology, dyslipidaemia, the musculoskeletal system, oncology, and diseases of the retina, liver, heart, lung, bone marrow, brain, muscle, immune system, and kidney; all of the foregoing excluding pharmaceuticals for the treatment of xerostomia.

17. The applicant concedes that the above-mentioned goods are identical or similar to the opponent's goods.[6] All of the above-mentioned goods fall within the broad category of "pharmaceuticals, excluding pharmaceuticals for the prevention and treatment of respiratory disease" covered by the opponent's specification. The goods are identical under the *Meric* principle.

Class 5: Reagents; nucleic acids, and nucleotides for medical and veterinary purposes; all of the foregoing excluding pharmaceuticals for the treatment of xerostomia.

18. The applicant submits that its reagents and nucleic acid sequences in Class 5 are therapeutic agents used for the treatment of human diseases.[7] As pharmaceuticals are drugs intended for the treatment of diseases, I am of the

[6] The applicant's submissions in lieu, paragraph 13 and 14.
[7] *Ibid.*, paragraph 15.

view that the applicant's goods mentioned above fall within the broad category of the term pharmaceuticals covered by the opponent's specification. The conflicting goods are identical under the *Meric* principle. If I am wrong on this finding, I am of the view that the conflicting goods are highly similar. As the opponent's goods are also used for treating or preventing diseases, there is a similarity in the purpose between the conflicting goods. The goods are likely to be manufactured by the same company. The users will also overlap. The channels of trade are also likely to coincide. The goods are likely to compete as both are used for therapeutic purposes.

Class 42: Scientific and laboratory research services in the fields of gene, genome and cellular editing, modification, engineering and regulation for use in developing human and veterinary pharmaceutical and biological preparations; custom design and development of engineered cell lines for others for use in scientific research, and drug discovery and development.

19. There is an intrinsic difference between the nature, purpose and method of use of the applicant's services and the opponent's goods, as with any goods and services. Companies that produce pharmaceuticals are also likely to engage in research to develop pharmaceutical preparations or design and develop engineered cell lines. It is likely that the average consumer may believe that the same company is responsible for manufacturing pharmaceuticals and the research, design and development services for drug discovery and development. There is, therefore, a degree of complementarity between the applicant's services and the opponent's goods. Considering these factors, I find that the applicant's services in Class 42 are similar to a low degree to the opponent's goods.

20. In *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU), it was held that some similarity of goods and services is essential to establish a likelihood of confusion. Having concluded that there is no similarity between the applicant's goods in Classes 1 and the opponent's goods, the opposition against the goods in Classes 1 fails.

The average consumer and the nature of the purchasing act

21. I will proceed to determine who the average consumer is for the respective parties' goods and services.

22. 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".

23. In *Mundipharma AG v OHIM*, Case T-256/04, the GC accepted that there were two groups of relevant consumers for a pharmaceutical products, professional users and the general public. In *Bayer AG v EUIPO*, Case T-261/17, the GC held that the average consumer pays a heightened level of attention when selecting pharmaceutical products, including such products available without a prescription[8].

24. I find that the general public pays a high level of attention in selecting the goods as they will take some care in choosing the correct medicine to treat the illness. I also find that where the goods are for professional users, the level of attention is high, as professional users take into account various factors, for example, the correct dosage, potential interaction with other drugs or adverse effects.

[8] See paragraph 33 of the judgment.

Class 42 services will be aimed at professionals with specific knowledge and experience. Their level of attention is high as the services are very specialised. Visual considerations are likely to dominate the selection process of both goods and services. I also think that aural considerations are relevant particularly when goods and services are selected further to word-of-mouth recommendations.

Distinctive character of the earlier mark

25. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).
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> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does 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)."

26. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark. The opponent did not file evidence, so I only have the inherent position to consider. The earlier mark is a word-only mark for SALIO. The mark appears to be an invented word with no meaning. I find that the opponent's mark is inherently distinctive to a high degree.

Comparison of marks

27. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the 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."

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

Opponent's mark	Applicant's mark
SALIO	SALIOGEN

29. The respective parties' marks are word-only marks for SALIO and SALIOGEN. The overall impression and the distinctiveness of the marks lie in those words.

30. In terms of visual similarity, the opponent's mark is wholly contained in the applicant's mark. Both marks begin with the word 'SALIO'. I note here that the identity at the beginning of the marks is likely to have a great impact on the average consumer.[9] The difference is introduced by the word GEN, which is at the end of the applicant's mark. Considering these factors, I find that the marks are visually similar to a reasonably high degree.

31. Aurally, both marks coincide in the pronunciation of the word SALIO, which will be pronounced identically as SA-LIO. The aural difference between the marks is introduced by the word 'GEN', which does not have a counterpart in the opponent's mark. Considering these factors, I find that the marks are aurally similar to a reasonably high degree.

32. Conceptually, both parties agree that none of the marks have a meaning for the relevant public.[10] However, at paragraph 17 of the opponent's submissions, the opponent contends that "the relevant public would perceive the suffix -GEN as merely adding a descriptive connotation to the trade mark SALIO, thus seeing SALIOGEN as a sub brand of SALIO related to genetics." I note here that some of the applicant's goods and services are in respect of genetic research and genetic therapies. In so far as the consumer makes a connection between 'GEN' with genetics, this adds a point of conceptual difference but overall being invented words (and where not relate to genetics), I find that the marks are neutral. Where the average perceives a concept due to the presence of GEN, I find that the marks are dissimilar.

[9] *El Cortes Inglés v OHIM - González Cabello and Iberia Lineas Aéreas de España* (MUNDICOR) [2004] ER
[10] The opponent's submissions, paragraph 14 and the applicant's submissions in lieu, paragraph 28.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

34. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (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 undertaking being the same or related).

35. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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

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

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

36. I have found the respective marks to be visually and aurally similar to a reasonably high degree and conceptually neutral or dissimilar. I also found that the goods will be selected primarily by visual means, with a high degree of attention by the general public and the professionals. The goods are either identical or similar to a high degree. I also concluded that the inherent distinctiveness of the earlier mark is high, and it has not been enhanced through the use.

37. The word Salio is invented, highly distinctive and is wholly contained in the applicant's mark. I am of the view that due to the prominence of this word, the

average consumer is likely to misremember the difference between the marks. I, therefore, find that there is a likelihood of direct confusion between the marks.

38. Where the average consumer recalls the difference, I find that there is a likelihood of indirect confusion. In that assessment, I bear in mind that the distinctiveness of the common element is key[11]. The common element in this case is highly distinctive. Bearing in mind the reasonably high degree of both visual and aural similarity between the marks overall, together with the high degree of inherent distinctive character of the shared component, I consider that the average consumer is likely to think that the identical/similar goods and similar services at issue are from the same or economically linked undertakings. Even where a high degree of attention is paid to the purchase of the goods or the selection of the services, the average consumer is likely to think that the undertakings selling goods or offering services under the trade mark consisting of or containing the mark 'SALIO' are related or that the applicant's mark is a sub-brand of the opponent's mark, particularly in respect of those goods and services related to genetics. I conclude there is a likelihood of indirect confusion in respect of all of the goods and services.

Conclusion

39. The opposition has been partially successful. The protection of the international registration is refused in respect of the goods in Class 5 and services in Class 42, namely:

Class 5	Pharmaceutical preparations for genetic therapies to treat genetically driven disorders in the fields of neurology, gastroenterology, metabolism, immunology, dyslipidaemia, the musculoskeletal system, oncology, and diseases of the retina, liver, heart, lung, bone marrow, brain, muscle, immune system, and kidney; reagents; nucleic acids, and nucleotides for medical and veterinary purposes; all of the

[11] Kurt Geiger v A-List Corporate Limited, BL O/075/13

foregoing excluding pharmaceuticals for the treatment of xerostomia.

Class 42 Scientific and laboratory research services in the fields of gene, genome and cellular editing, modification, engineering and regulation for use in developing human and veterinary pharmaceutical and biological preparations; custom design and development of engineered cell lines for others for use in scientific research, and drug discovery and development.

The protection of the international registration is granted in respect of the goods in Classes 1, namely:

Class 1 Reagents, nucleic acids, and nucleotides for scientific and research use in the fields of clinical research, drug development, agriculture and genetics research; reagent kits comprised of reagents and chemical preparations for scientific research purposes; samples of nucleotide sequence variants and modifications for use in the fields of scientific research, clinical research, and scientific diagnostics research.

Costs

40. As both parties have achieved a measure of success, I order they bear their own costs.

Dated this 13th day of December 2023

Karol Thomas
For the Registrar
The Comptroller-General