

O/231/21

TRADEMARKS ACT 1994

IN THE MATTER OF THE TRADEMARK APPLICATION 3443256

BY

BICYCLETX LIMITED

TO REGISTER THE FOLLOWING TRADEMARK IN CLASSES 5 & 42

TICA

AND THE OPPOSITION UNDER NO. 419492 THERETO

BY

IMMATICS BIOTECHNOLOGIES GMBH

Background and pleadings

1. BicycleTX Limited (the Applicant) applied to register the trade mark '**TICA**' in the UK on 11 November 2019. It was accepted and published in the Trade Marks Journal on 22 November 2019 in respect of the following goods and services:

Class 5: Pharmaceutical products; pharmaceutical preparations; all being for use in relation to oncology.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; information, consultancy and advisory services relating to the aforesaid.

2. Immatics Biotechnologies GmbH (the Opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of two earlier European Union Trade Marks (EUTMs) as follows:

- a) EUTM 17869204, which was filed on 7 March 2018 and registered on 26 July 2018 in relation to the following mark:

TCER

For the following goods and services:

Class 5: Medical and veterinary preparations and articles, namely medicines and natural remedies, and diagnostic preparations and material.

Class 42: Medical and pharmacological research services.

Class 44: Medical and pharmaceutical services.

- b) EUTM 17869203, which was filed on 7 March 2018 and registered on 3 November 2018 in relation to the following mark:

TiCR

For the following goods and services:

Class 5: Medical and veterinary preparations and articles, namely medicines and natural remedies, and diagnostic preparations and material.

Class 42: Medical and pharmacological research services.

Class 44: Medical and pharmaceutical services.

3. The Opponent argues that the respective goods and services are identical or highly similar and that the marks are highly similar.
4. The Applicant filed a counterstatement denying the claims made.
5. Only the Opponent filed evidence in these proceedings. The evidence comprises a witness statement of Florian Traub with accompanying exhibits FT01 and FT02. The witness statement of Mr Traub establishes that he is a solicitor working for Pinsent Masons LLP, who represent the Opponent in this matter. His witness statement reinvokes the arguments put forward in the Opponent's initial claim. Exhibit FT01 comprises extracts from the register of the European Union Intellectual Property Office (EUIPO) showing the status of the Opponent's earlier marks. Exhibit FT02 comprises print outs from the online version of the Merriam-Webster dictionary confirming there are no definitions for the terms TCER and TiCR. Finally, Mr Traub provides a brief analysis of the likely pronunciation of each term at issue. I will deal with the phonetic assessment of the marks later in this decision.
6. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

7. The Applicant has been represented by Taylor Wessing LLP and the Opponent by Pinsent Masons LLP.
8. Although the UK has left the EU, section 6(3)(a) of the European (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.

DECISION

Section 5(2)(b)

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

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

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

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which states:

“6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

11. In these proceedings, the Opponent is relying upon the trade marks shown in paragraph 2, above, which qualify as earlier trade marks under the above provisions. As the trade marks had not completed the registration process more than 5 years before the filing date of the application in suit, they are not subject to proof of use, as per section 6A of the Act. The Opponent can, as a consequence, rely upon all of the services it has identified.

Similarity of goods and services – Nice Classification

12. Section 60A of the Act provides:

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

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

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

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

13. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

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

16. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

17. The parties' respective specifications are:

Earlier EUTMs	Contested Application
Class 5: Medical and veterinary preparations and articles, namely medicines and natural remedies and diagnostic preparations and material.	Class 5: Pharmaceutical products; pharmaceutical preparations; all being for use in relation to oncology.
Class 42: Medical and pharmacological research services.	Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; information, consultancy and advisory services relating to the aforesaid.
Class 44: Medical and pharmaceutical services.	

18. The Applicant accepts in its submissions that the goods within Class 5 of the contested mark are identical or similar to the class 05 goods of both earlier marks. In order to determine the level of similarity between the class 5 goods I will briefly consider this further.

19. The earlier marks contain "Medical and veterinary preparations and articles, namely medicines" and I find the addition of "namely medicines" to be important here. I suggest that the term 'medicines' encompasses the entirety of the class 5 goods of the contested mark. Applying the *Meric* principle, I consider the goods in class 05 to be identical.

20. The Applicant goes on to state that the majority of its services in Class 42 are dissimilar to the goods and services of the earlier marks save for "research".

21. One of the definitions of 'Medical' is "of or relating to the science of medicine".¹ Pharmacology is the branch of science relating to drugs and medicines.² Therefore, I would consider that the earlier 'medical and pharmacological research services'

¹ <https://www.collinsdictionary.com/dictionary/english/medical>

² <https://www.collinsdictionary.com/dictionary/english/pharmacology>

are wholly encompassed within the 'scientific and technological services and research and design relating thereto' of the Applicant's services. Applying the principle set out in *Meric* these services are identical.

22. In the event that I am found to be wrong in the application of *Meric* in relation to the above services, I will consider them within the context of the principles laid out in *Treat*.

23. I consider that the contested 'scientific and technological services and the research and design relating thereto' would provide innovation for the benefit of companies and the public at large, this would include innovations in relation to medicine, be that new drugs, new procedures or technology used in procedures. The users of such services could be scientists and researchers, including medical professionals, hospitals and health boards. There would be an overlap here of both use and users with those of the Opponent's medical and pharmacological research services.

24. I believe there also to be an overlap in the nature of both 'scientific and technological services and the research and design relating thereto', and 'medical and pharmacological research services', as they both relate to progression, experimentation and investigation in potentially the same areas.

25. The trade channels between the two types of services would also be similar. I believe that the contested services would be used by companies in developing new products or technology, this may include pharmaceutical or medical companies who are developing new medicines or procedural technology which would wholly encompass the trade channels used by the Opponent's class 42 services.

26. I therefore consider that the contested 'scientific and technological services and research and design relating thereto', are either identical under *Meric*, or highly similar, to the Opponent's 'medical and pharmacological research services'.

27. I now move on to consider the contested 'industrial analysis and research services'. Industrial analysis is used to examine the past trends in an industry, the current demand and supply mechanics, and the future outlook of the industry. It also acts as a guide to investors on the viability of investing in a company.

28. I do not believe that these services will share the same use or users as either medical and pharmacological research services or medical and pharmaceutical services. The Applicant's services in this instance appear to be more focused on business and their structures. I also believe these services differ in their nature and trade channels. I therefore conclude that these services are dissimilar.

29. I now turn to the Applicant's Class 42 services: 'information consultancy and advisory services relating to the aforesaid'. As I have already dismissed the "industrial analysis and research services" these services solely relate to the 'scientific and technological services and research and design relating thereto'. I am reminded of the case of *Kurt Hesse v OHIM*, Case C-50/15 P, where the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

30. Given that I have found previously that 'scientific and technological services and the research and design relating thereto' are identical or highly similar to the Opponent's 'medical and pharmacological research services', it follows that the 'information consultancy and advisory services relating to the aforesaid' will be complementary to the Opponent's services and therefore similar to at least a low degree.

31. In conclusion, I have found all of the contested class 05 goods to be identical to the class 05 goods of earlier marks. I have also found the contested 'scientific and technological services and research and design relating thereto' to be either identical under the *Meric* principle, or highly similar to the 'medical and pharmacological research services' of the Opponent, and I have found the 'information, consultancy and advisory services' as they pertain to the contested 'scientific and technological services and research and design relating thereto' to

be complementary and similar to at least a low degree. I have also found the contested class 42 services 'industrial analysis and research services' to be dissimilar to all of the Opponent's goods and services.

32. The Opposition is therefore dismissed insofar as it pertains to the class 42 'industrial analysis and research services' of contested application. My assessment of the matter in hand will therefore continue only in respect of the contested class 5 goods and the class 42 services: 'scientific and technological services and research and design relating thereto; information, consultancy and advisory services related to the aforesaid'.

Average consumer and the purchasing act

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

34. 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."

35. 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.

36. Given the Applicant's goods are 'pharmaceutical products; pharmaceutical preparations; all being in relation to oncology' I find that the average consumer of

these goods will be medical and healthcare professionals. These types of products are generally not available to the public without a prescription and would most likely be given in a hospital or other medical centre. The goods of the Opponent include 'medicines' at large, which are goods that may require a prescription or may be purchased in retail outlets over the counter. The average consumer of these goods may be a professional but may also be the general public. However, taking account of the finding in *Bayer AG*, I find that both sets of consumers would pay a higher than normal degree of attention in the selection and purchase of such goods.

37. The selection of the services at issue is also likely to be made when applying a higher degree of attention. The average consumer of medical and pharmacological research services; medical and pharmaceutical services, or scientific and technological services and research and design relating thereto' may be a professional or a member of the general public, however due to the nature of these specialised services, both sets of consumers can be said to be paying a higher than normal degree of attention in the selection of those services.

38. The selection process is likely to predominantly involve a visual aspect when looking for products in a retail setting or perusing a specialist catalogue or website. There may also be advertisements or presentations of the goods and services that the consumer will be exposed to. I do not however, discount that there may also be an aural component to the purchase through word-of-mouth recommendations or orders which may be placed by telephone.

39. Taking into consideration the nature of the goods and services at issue, I conclude that a higher than normal level of attention would be paid in the purchasing process.

Comparison of marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

41. It would be wrong, therefore, to artificially 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.

42. For the sake of procedural economy, I will focus my comparison initially on EUTM17869203. I will deal with the Opponent's second earlier EUTM later in my decision. The respective trade marks are shown below:

TiCR	TICA
Earlier trade mark	Contested trade mark

43. Both marks comprise one word that is four letters long. Neither word has a dictionary definition. The overall impression of both marks lies within the single word element.

44. The marks share the same first three letters presented in the same order. Whilst the earlier mark is registered in a combination of upper and lower case lettering and the contested mark has been applied for in capital lettering, I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* case BL O/281/14 who found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

45. I therefore acknowledge that the marks may be presented in any font, sizing or combination of upper and lower-case fonts. The first three letters of the marks at issue can therefore be said to be identical. The last letter of these marks creates the only difference between them. The earlier mark ends with the letter ‘R’ whilst the contested mark ends with an ‘A’. However, I find that the letter ‘A’ and the letter ‘R’ can be said to be quite similar in appearance.

46. I acknowledge the caselaw that the Applicant has provided in respect of differences in short marks, however, I am also aware of the findings in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the GC noted a general rule that the beginnings of words tend to have more visual and aural impact than the endings. Given in this instance that the first three letters are essentially identical, and the final letters are quite similar in appearance, I consider the marks to be highly similar visually.

47. Comparing the marks aurally, I accept that some people will verbalise the marks letter by letter as suggested by the Opponent in its submissions. The first three letters are identical aurally and it is only the last letter of each mark that creates a difference in sound. I would suggest however that the sounds made when enunciating a letter ‘A’ or an ‘R’ are not strikingly different. I would therefore consider that where the consumer pronounces these marks letter by letter, they are highly similar aurally.

48. I consider that there is a second possibility for the pronunciation of both marks. I would suggest that both marks may be spoken as words and, in such cases, will be verbalised as TEE/KUH. In this instance, they can be said to be aurally similar to at least a high degree, if not identical.

49. I disagree with the Applicant's submissions that the words would be verbalised as follows:

“a. **TICA**: tuh – ee – kuh – a

b. **TiCR**: tuh – ee - si – ur”

50. I do not find the submission that “in the English language, the letter 'c' is pronounced the same as the letter 'k' if it is before the letter 'a', otherwise it has a soft pronunciation” to be wholly correct. There are multiple examples of words containing 'cr' where the letter 'c' has a hard sound such as: screening, microwave, prescribe etc. I therefore consider that the 'c' will be pronounced as a hard 'c' as per para 45 above. In conclusion, I find the marks to be aurally highly similar when enunciated letter by letter and aurally highly similar, if not identical, when articulated as words.

51. Neither mark has a dictionary definition and, as stated by both parties, neither mark can be said to have a conceptual meaning. Therefore, the marks are conceptually neutral.

Distinctive character of the earlier trade mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which

it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

53. The Opponent has not provided any evidence that the earlier mark has acquired an enhanced degree of distinctive character and no claim was made to that effect. I must therefore assess the mark purely on its inherent distinctive character.

54. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

55. The earlier mark is one word ‘TiCR’ which has been invented. It has no dictionary meaning and is not suggestive of the goods and services registered. I would therefore say that the earlier mark has a high degree of inherent distinctive character.

Likelihood of Confusion.

56. There are two types of confusion that I must consider. Firstly, direct confusion i.e. one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

57. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

58. I have previously found that the contested goods in class 05 are identical to the Opponent’s earlier class 05 goods, I have also found the contested ‘scientific and technological services and research and design relating thereto’ to be either identical under the *Meric* principle, or highly similar to the ‘medical and pharmacological research services’ of the Opponent, and the contested ‘information, consultancy and advisory services related to the aforesaid’ in as far as they pertain to the ‘scientific and technological services and research and design relating thereto’, to be similar to the Opponent’s services to at least a low degree.

59. I have found the marks to be visually similar to a high degree, aurally identical or similar to a high degree, and conceptually neutral. The earlier mark is inherently distinctive to a high degree. Given these levels of similarity, I am satisfied that although I have found that the average consumer, be that a professional or a member of the general public, would be paying a higher than normal degree of attention when selecting the goods and services at issue, the similarities between the marks and the goods and services are sufficiently high so as to counteract that attention level. I therefore find that the average consumer may mistake one of these marks for the other and consequently there is a direct likelihood of confusion between these marks.

60. In making my assessment, I have kept in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

61. The Opponent's remaining earlier mark, namely EUTM17869204, is registered for the same goods and services and therefore my finding regarding the assessment of the goods and services would be the same. The mark TCER, which is the subject of the remaining earlier EUTM, is no closer to the contested application than the EUTM TiCA which has been the subject of my initial comparison and therefore does not provide the Opponent with any stronger case. Therefore, I find no reason to consider EUTM 17869204 any further.

Conclusion

62. The Opposition has succeeded in respect of all of the contested goods in class 5 and the following Class 42 services: 'Scientific and technological services and research and design relating thereto; information, consultancy and advisory services relating to the aforesaid'. Subject to appeal, the application will be refused in respect of those goods and services.

63. The Opposition has failed in respect of the following contested services in class 42: 'Industrial analysis and research services; information consultancy and advisory services relating to the aforesaid'. The application may proceed to registration for those services.

Costs

64. The Opponent has been largely successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale set out in Tribunal Practice Notice (TPN) 2/2016. After due consideration, I believe that an award of costs to the Opponent is appropriate as follows:

Official fee	£100
Preparing the Notice of Opposition and considering the Counter Statement	£300
Preparing Evidence and written submissions And considering the Applicant's written submissions in lieu	£500
Total	£900

65. I therefore order BicycleTX Limited to pay Immatix Biotechnologies GmbH the sum of £900. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 1st day of April 2021

**L Nicholas
For the Registrar**