

O/0096/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001840836 DESIGNATING THE UK
BY LI-COR BIOTECH, LLC

ATLAS

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP600003660
BY AENEAS GMBH & CO.KG

Background and pleadings

1. LI-COR BIOTECH, LLC (the “Holder”) is the holder of the International Registration shown on the cover page of this decision (“the IR”).The IR was registered on 29 January 2025, but claims priority from the 20 November 2024.¹ With effect from 29 January 2025, the Holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 7 March 2025.The Holder seeks protection for the IR in relation to the following goods:

Class 9: Optical imaging instrument for detecting nucleic acids and proteins.

2. On 15 April 2025, Aeneas GmbH & Co.KG (“the Opponent”) opposed the IR under the fast-track opposition scheme. The opposition is brought under section 5(2)(a) of the Trade Marks Act 1994 (“the Act”), and is directed at all of the goods and services in the IR.
3. The Opponent relies upon the following trade mark (“the earlier mark”):

ATLAS

Trade mark no. UK00003648184

Filing date: 27 May 2021

Registration date: 10 December 2021

Priority Date: 18 May 2018 (European Union Intellectual Property Office)

Priority Date: 22 November 2017 (Germany)

Relying upon all the goods and services for which the mark is registered, as set out at paragraph 16 of this decision.²

¹ This is claimed from United States of America trade mark no. 98863272

² This case is filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 18/05/2018

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions contained in section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services within its specification without having to demonstrate proof of use.
5. The Opponent submits that the marks at issue are identical, and that the goods and services in issue are identical or highly similar.
6. The Holder filed a counterstatement in which it acknowledges that the marks at issue are identical, however it denies that the goods and services are identical or highly similar.
7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
8. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
9. A hearing was neither requested nor considered necessary; however, both parties filed written submissions in lieu. This decision is taken following a careful consideration of the papers.
10. The Holder is represented by Burley Law Limited; the Opponent is represented by Forresters IP LLP.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(a)

12. Section 5(2)(a) 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”.

13. The following principles are gleaned from the decisions 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 C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of marks

14. The respective trade marks are shown below:

Earlier Mark	The IR
ATLAS	ATLAS

15. It is a pre-requisite of section 5(2)(a) of the Act that the marks at issue are identical. In the present case, the contested mark and the earlier mark are both word only marks consisting of the single word “ATLAS” and are self-evidently identical. This has been admitted by the Holder in its counterstatement. Accordingly, the first requirement of section 5(2)(a) is formally met.

Comparison of goods and services

16. The competing goods and services are as follows:

Opponent's goods and services	Holder's goods
<u>Class 5:</u> Medical, chemical and biological test kits and test reagents for medical purposes, included in class 5; Antiserums for diagnostic purposes; Chemical reagents for medical diagnostic, medical or veterinary	<u>Class 9:</u> Optical imaging instrument for detecting nucleic acids and proteins.

purposes; Medical or veterinary chemical test reagents; Diagnostic preparations for medical or veterinary purposes; Diagnostic preparations; Diagnostic preparations for medical, pharmaceutical or veterinary purposes; Diagnostic biomarker reagents for medical purposes; Diagnostic testing materials for medical use; Diagnostic reagents for medical use; Diagnostic substances for medical use; Immunoassay reagents for medical or medical diagnostic purposes; In vitro diagnostic preparations for medical use; Indicators for medical diagnosis; Medical diagnostic test strips; Medical diagnostic reagents and assays for testing of body fluids; Medical diagnostic reagents; Preparations of microorganisms for medical or veterinary use; Preparations for detecting genetic predispositions for medical purposes; Preparations for detecting mutation in prion genes for medical purposes; Reagents for use in analysis [for veterinary purposes]; Reagents for analysis purposes (for medical diagnostic, medical or veterinary purposes); Reagents for use in diagnostic tests [for veterinary

<p>purposes]; Clinical diagnostic reagents; Reagents for in-vitro laboratory use [for veterinary purposes]; Reagents for in-vitro laboratory use [for medical purposes]; Reagents for blood grouping [for medical purposes]; Reagents for use with testing apparatus for medical or medical diagnostic purposes; Reagents for use in diagnostic tests or in analyses for medical purposes; Reagents for use with testing apparatus for medical diagnostic or veterinary purposes; Reactants for medical or veterinary diagnosis; Veterinary diagnostic reagents; Clinical medical reagents; Biological reagents for medical, medical diagnostic or veterinary purposes; Chemical reagents for medical, medical diagnostic or veterinary purposes; Chemical reagents for medical or veterinary purposes; Reagents for microbiological analysis, for medical or veterinary purposes; Genetic identity tests, consisting of reagents for medical purposes; Reagents and media for medical and veterinary diagnostic purposes; Reagents for medical use; Reagents for medical or veterinary genetic testing; Chemical preparations for use in dna analysis</p>	
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[medical]; Chemical preparations for medical or medical diagnostic purposes; Blood for medical or medical diagnostic purposes; Biological preparations for medical, medical diagnostic or veterinary purposes; Mixed biological preparations for medical or medical diagnostic purposes; Blood plasma; Blood components; Blood protein fractions; Enzymes for medical, medical diagnostic or veterinary purposes; Enzyme preparations for medical or veterinary purposes; By-products of the processing of cereals for medical or medical diagnostic purposes; Nucleic acid sequences for medical diagnostic, medical or veterinary purposes.

Class 10:

Medical apparatus and instruments; Analysers for medical use; Diagnostic apparatus for medical purposes; Automated testing apparatus for bodily fluids, for medical or medical diagnostic purposes; Diagnostic, examination, and monitoring equipment; Laser pointers for medical use; Laser beam delivery instruments for medical use; Medical instruments; Medical instruments incorporating lasers;

Tools for medical diagnostics; Medical diagnostic apparatus for medical purposes; Medical and veterinary apparatus and instruments; Apparatus for carrying-out diagnostic tests for medical purposes; Apparatus for analysing images [for medical use]; Apparatus for DNA and RNA exams for medical purposes; Apparatus for analysing bacteria in biological samples [for medical use]; Capillary tubes for delivering reagents; Specimen cup holders; Laboratory apparatus for the transmission of liquids, for medical or medical diagnostic purposes; Laboratory apparatus for mixing liquids, for medical or medical diagnostic purposes; Laboratory apparatus for administering liquids, for medical or medical diagnostic purposes; Laboratory apparatus for thinning liquids, for medical or medical diagnostic purposes); Laboratory apparatus for incubating liquids, for medical or medical diagnostic purposes; Medical or immunological testing apparatus; Electronic analyzers for medical purposes; Photometric analyzers for medical use; Automatic analyzers for medical diagnosis; Body composition analyzers for medical purposes;

Analysers for bacterial identification for medical purposes; Physical analyzers for medical use; Blood centrifuging tubules [for medical use]; Blood filters for extracorporeal use; Hypodermic needles; Medication injectors; Injectors for medical or medical diagnostic purposes.

Class 42:

Laboratory services.

Class 44:

Medical assistance; Medical services; Veterinary services; Medical analysis in connection with the treatment of individuals; Pharmaceutical advice; Advisory services relating to medical apparatus and instruments; Providing information relating to the rental of medical machines and apparatus; DNA screening for medical purposes; Medical diagnostic services; Medical testing services relating to the diagnosis and treatment of disease; Medical and health services relating to DNA, genetics and genetic testing; Pharmaceutical advice; Pharmacy advice; Consultancy for medical or medical diagnostic instruments;

<p>Consultancy in relation to immunology or autoimmunology; Consultancy and information relating to medical or medical diagnostic products; Consultancy in relation to medical or medical diagnostic services; Medical analysis services for the diagnosis of cancer; Medical analysis for diagnosing autoimmune diseases; Medical laboratory services for the analysis of blood samples taken from patients; Medical laboratory services for the analysis of samples taken from patients; Medical analysis for the diagnosis and treatment of persons; Medical analysis services for cancer diagnosis and prognosis; Medical analysis for the diagnosis and prognosis of autoimmune diseases; Medical analysis services relating to the treatment of patients; Medical analysis services relating to the treatment of persons; Medical analysis services relating to the treatment of persons provided by a medical laboratory; RNA or DNA analysis for cancer diagnosis and prognosis; RNA and DNA analysis the diagnosis and prognosis of autoimmune diseases.</p>	
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17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 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.

18. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- i. The respective uses of the respective goods or services;
- ii. The respective users of the respective goods or services;
- iii. The physical nature of the goods or acts of service;
- iv. The respective trade channels through which the goods or services reach the market;
- v. 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;
- vi. 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.

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of

similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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.”

20. The Opponent submits in general terms that each class of its goods/services is similar to the goods of the Holder to “varying degrees”. However, the Opponent does not identify the level of similarity between its goods and services, and the Holder’s goods. The opponent also does not identify which of its own goods/services it considers to be the closest comparator, or which of its terms should be compared to the specific term within the Holder’s services. On this point, I refer to the case of *SmartX* (BL O/0911/24) wherein Mr Iain Purvis K.C., sitting as the Appointed Person, addressed the issue of an Opponent’s failure to identify similarity in respect of long specifications. Mr Purvis K.C. said:

“28. [...] it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach [...] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.”

21. Further on in this decision, Mr Purvis K.C. stated:

“31(v). In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent.

If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. But this has of course not happened and to this extent the Opponent has benefited from the Hearing Officer's generosity. However, it would obviously be perverse to say that the Hearing Officer ought therefore to have taken every other unpleaded and unargued point in the Opponent's favour."

22. Whilst the Holder's specification is limited to "Optical imaging instrument for detecting nucleic acids and proteins" in Class 9, the Opponent's specification is of a relatively significant length. The issue is compounded by the fact that the Opponent's specification does not include any terms in Class 9. Therefore, it is not particularly obvious as to what the Opponent's best case is. For the avoidance of doubt, I do not consider that the case law cited above means that I must dismiss any level of similarity between the Opponent's goods and services and the Holder's goods. However, the takeaway from *SmartX* is that it would be unfair for me to go through all of the Opponent's terms in order to assess each and every combination of goods and services. I bear in mind the above when considering the Opponent's submissions regarding the similarity of their goods and services as a whole, or in general terms. Instead, in the circumstances, I consider that a reasonable approach would be for me to identify what I reasonably consider to be the closest terms and carry out the comparison on that basis.³ In doing so, I will remain mindful of the comments of Mr Purvis K.C. above regarding the procedural unfairness.

23. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

"365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification

³ On this point, I also refer to the case of *MontyPay* (BL O/0924/24)

of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

24. I also note that section 60A(1)(a) of the Act provides that goods and services 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, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

CLASS 9

“Optical imaging instrument for detecting nucleic acids and proteins”

25. The Holder submits that optical imaging apparatus are tools and machines for imaging purposes, which in this case, are for detecting nucleic acids and proteins.⁴ The Holder goes on to state that optical instruments are analytical apparatus, used for highly specialist research and scientific purposes.⁵ Notwithstanding the Holder’s submissions, I note that “optical imaging” is defined as the use of light to obtain images from inside the body, tissues, or cells.⁶ I therefore understand the Holder’s above referenced term to be an instrument that uses light to obtain images to detect nucleic acids and proteins within cells. Noting the above, I consider the Opponent’s closest comparator to be “apparatus for analysing images [for medical use]”.

26. I have no evidence before me as to what is meant by the term ‘apparatus for analysing images [for medical use]’. However, adopting the ordinary meaning of

⁴ Holder’s submissions in lieu, paragraph 16.

⁵ Holder’s submissions in lieu paragraphs 16 and 23.

⁶ <https://www.collinsdictionary.com/dictionary/english/optical-imaging>

the words within the term, I understand this to be apparatus which can analyse images for medical purposes.

27. I consider that an “optical imaging instrument for detecting nucleic acids and proteins” could be used for medical science, including to assist with medical diagnosis. Consequently, I consider there to be an overlap in broad nature and end purpose between these compared goods as they are both physical devices which may be used for the purpose of medical science and to assist with medical diagnosis. However, I note that the primary purpose of optical imaging instruments is to be used in laboratory research for analytical detection, while the Opponent’s goods are specifically for medical purposes, likely relating to clinical diagnosis. In reaching this view, I bear in mind that “optical imaging instrument for detecting nucleic acids and proteins” is in class 9, which includes apparatus and instruments for scientific research, while the Opponent’s “apparatus for analysing images [for medical use]” is in class 10, which includes surgical, medical, dental and veterinary apparatus and instruments.

28. I also consider there to be an overlap in users (being health boards or private clinics) and trade channels (being medical retailers). However, without any evidence being provided to the contrary and given the specialist purposes of the goods at issue, I do not consider them to be in competition, nor do I consider them to be complementary as they are neither important nor indispensable from one another.⁷ Overall, I consider the goods to be similar to a medium degree.

Average consumer and the purchasing act

29. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

⁷ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

30. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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:

“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.”

31. In respect of the goods at issue, I find that the average consumer will be either health boards or private health clinics or laboratories. The goods are going to be purchased infrequently, and the cost is likely to be high. The selection process is likely to predominantly involve a visual aspect when looking for goods online, via a catalogue or in a specialist retailer. I do not however, discount that there may also be an aural component to the purchase through word-of-mouth recommendations, or where equipment is demonstrated by a sales representative. The average consumer will consider factors such as reliability, durability, cost and suitability for particular requirements. There are also likely to be regulatory requirements that will need to be considered during the purchasing process. Taking into consideration the nature of the specialist goods at issue and potential high cost, I consider that a high level of attention is likely to be paid by the average consumer during the purchasing process.

Distinctive character of the earlier trade mark

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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).”

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

34. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. However, as the Opponent has not filed any evidence of use of its mark, I only have the inherent position to consider.

35. The Opponent's mark is comprised of the ordinary dictionary word 'Atlas', which is neither descriptive nor allusive of the Opponent's goods/services. Consequently, I find that the earlier mark has a medium degree of inherent distinctive character.

Likelihood of Confusion

36. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

37. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16. Given my finding that the marks in issue are identical, I do not consider there to be any basis for a finding of indirect confusion between these marks. However, I will proceed to consider whether there is a likelihood of direct confusion between the marks in issue.

38. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be identical.
- I have found the Opponent's mark to be inherently distinctive to a medium degree.

- I have identified the average consumer of the goods in issue to be health boards or private health clinics and laboratories who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a high degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be similar to a medium degree.

39. Taking all of the factors listed above into account, I am satisfied that the average consumer would likely mistake one mark for the other, this is because I consider that the general public would become confused upon seeing identical marks used in relation to similar goods used in similar fields (i.e., medical science). Whilst I am conscious that I have only found the goods in issue to be similar to a medium degree, I consider this lesser degree of similarity between these goods will be offset by the identity between the marks. For the avoidance of doubt, I consider this to be the case even with due regard to my finding that a high degree of attention will be paid during the purchasing process.

CONCLUSION

40. The opposition under section 5(2)(a) of the Act has succeeded. Subject to any successful appeal against my decision, the application will be refused in its entirety.

COSTS

41. The Opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the Opponent the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a notice of opposition and considering the other side's statement	£250

Written submissions in lieu of a hearing £350

Total: £700

42. I therefore order LI-COR BIOTECH, LLC to pay Aeneas GmbH & Co. KG the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th of February 2026

**E REES
For the Registrar**