

**O/1187/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003445369**

**BY NAVENIO LIMITED**

**TO REGISTER THE TRADE MARK:**

**Navenio**

**IN CLASSES 9, 35, 36, 39 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 419659**

**BY ROCHE DIAGNOSTICS GMBH**

## BACKGROUND AND PLEADINGS

1. On 19 November 2019, Navenio Limited (“the applicant”) applied to register “Navenio” as a trade mark in the United Kingdom. Registration is sought for the following goods and services<sup>1</sup>:

*Class 9: Electric measuring devices; Precision measuring apparatus; Measuring apparatus; Measuring apparatus and instruments; Navigation apparatus and instruments; Navigational instruments; Audio/visual and photographic devices; Photographic apparatus; Photographic apparatus and instruments; Photographic instruments; Audio-visual apparatus; Audio-visual instruments; Optical apparatus; Optical apparatus and instruments; Measuring apparatus; Measuring apparatus and instruments; Signalling apparatus; Signalling apparatus and instruments; Signalling instruments; Detecting apparatus and instruments; Apparatus and instruments for transmitting data; Apparatus and instruments for transmitting images; Apparatus and instruments for transmitting sound; Recording apparatus; Apparatus and instruments for recording of data; Apparatus and instruments for recording of images; Apparatus and instruments for recording sound; Computers; Computer peripheral devices; Data collection apparatus; none of the aforesaid for use in relation to diagnostic, clinical, pharmaceutical or medical research.*

*Class 35: Business management; Business administration; Organisation, operation and supervision of loyalty and incentive schemes; Advertising services provided via the internet; Data processing; Business information (Provision of -); Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Data collection services; Business analysis.*

*Class 36: Asset management; Asset management services; Issuing of tokens of value; Issuing of tokens of value in relation to customer loyalty schemes; Issuing of tokens of value in relation to incentive schemes.*

*Class 39: Tracking, managing and optimising the movement of staff and assets.*

---

<sup>1</sup> By way of filing a Form TM21B alongside its written submissions on 21 April 2022, the applicant struck various terms from its specification and introduced a limitation. In an email of 11 May 2022, the opponent confirmed that the opposition was nonetheless maintained.

*Class 42: Development of measuring and testing methods; Technical measuring and testing; Electronic data storage; Hardware design; Design and development of computer hardware; Computer programming; Installation, maintenance and repair of computer software; Computer consultancy services; Software as a service; none of the aforesaid relating to diagnostic, clinical, pharmaceutical or medical research.*

2. The trade mark application was published for opposition purposes on 29 November 2019. On 2 March 2020, the application was opposed, in part, by Roche Diagnostics GmbH (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The scope of the opposition extends to the goods and services in classes 9 and 42 only. For the purpose of the opposition, the opponent relies upon the following trade mark and the goods and services laid out below<sup>2</sup>:

International registration (“IR”) 1313134:

## **AVENIO**

Date of protection of the IR in the UK: 15 August 2019

Priority date: 20 January 2016 (Germany)

*Class 9: Scientific instruments and apparatus; laboratory devices for use in research, science and industry; laboratory instruments, namely, devices for analysis of nucleic acids and for DNA sequencing; nucleic acid sequencers; imaging devices and analyzers; apparatus for preparation, amplification, mixing, hybridization, incubation, and washing of scientific samples; sample loaders and bar code readers for automated laboratory apparatus; genotyping and gene expression microarrays, associated mapping files and associated kits for analyzing nucleic acids for scientific, pharmaceutical and medical research purposes; all the aforesaid goods are not intended for use in the field of health and longterm care, in particular for the planning and documentation of treatment services and nursing care.*

---

<sup>2</sup> I note that the opponent originally intended to rely upon a wider range of goods and services pertinent to classes 9 and 42. However, its specification was reduced as a result of EU opposition proceedings before the General Court which were finalised some time after the present opposition was filed.

*Class 42: Providing DNA screening for scientific research purposes; design and development of laboratory instruments for use in science and clinical research; consultancy, information and advisory services in the field of analysis of biomolecules.*

3. The opponent submits that the similarities between the parties' respective trade marks and the identity and/or similarity between the parties' goods and services gives rise to a likelihood of confusion, which includes a likelihood of association.

4. In its counterstatement, the applicant denies that the respective goods and services are similar or identical and that there exists a likelihood of confusion.

5. The applicant is represented by Reddie & Grose LLP and the opponent by Gill Jennings & Every LLP. The opponent filed evidence during the course of the proceedings whilst the applicant filed written submissions. Neither party requested a hearing but both elected to file written submissions in lieu. I do not propose to summarise the parties' evidence or submissions during my decision but instead will refer to them where it appears necessary. This decision is taken following a careful perusal of the papers.

## **DECISION**

### **Relevance of EU law**

6. 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.

### **Section 5(2)(b)**

7. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

8. Section 5A of the Act reads 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.”

9. The opponent’s mark clearly qualifies as an earlier trade mark pursuant to section 6 of the Act. Given that it had not been registered for five years or more before the filing date of the opposed application, it is consequently not subject to the proof of use provisions laid out in section 6A of the Act.

### **Section 5(2)(b) – case law**

10. 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 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**

11. The competing goods and services are laid out at paragraphs 1 and 2 to this decision.

12. In addition to cases of *literal* identity, the General Court set out a further provision as to when goods (though it equally applies to services) can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>3</sup>. It stated:

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

13. 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;

---

<sup>3</sup> Case T-133/05

(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. For the purpose of a comparison it is permissible to group goods or services together, as appropriate.<sup>4</sup>

15. I keep in mind throughout my assessment that the applicant's terms are subject to the limitation *none of the aforesaid relating to/for use in relation to diagnostic, clinical, pharmaceutical or medical research*. I also note the opponent's class 9 limitation; *all the aforesaid goods are not intended for use in the field of health and longterm care, in particular for the planning and documentation of treatment services and nursing care*.

### Class 9

16. The opponent has a fairly broad term in its specification; *scientific apparatus and instruments*. This term, to my mind, is likely to encompass the following terms from the applicant's specification:

*Electric measuring devices; Precision measuring apparatus; Measuring apparatus; Measuring apparatus and instruments; Navigation apparatus and instruments; Navigational instruments; Measuring apparatus; Measuring apparatus and instruments; Signalling apparatus; Signalling apparatus and instruments; Signalling instruments; Detecting apparatus and instruments.*

---

<sup>4</sup> *Separode Trade Mark* BL O-399-10 (AP)

17. The above terms may not stipulate that they are intended to be used in such a way but, given their nature, it seems reasonable to find that they could be used for a scientific purpose or in a scientific context and can therefore be rendered identical to the opponent's goods on the basis of *Meric*. If that is too general a finding, in the alternative I find the respective goods are at least similar to a fairly high degree. The goods could coincide in use, are likely to share users and trade channels, and could share an element of physical similarity, though admittedly this will be variable according to the specific requirements of each instrument. In some circumstances the goods may occupy competitive roles and there may be an element of complementary in the sense that it would not seem unreasonable for the consumer to expect each to originate from a shared or related undertaking.

*Audio/visual and photographic devices; Photographic apparatus; Photographic apparatus and instruments; Photographic instruments; Audio-visual apparatus; Audio-visual instruments; Optical apparatus; Optical apparatus and instruments; Apparatus and instruments for recording of images; Recording apparatus; Apparatus and instruments for transmitting images.*

18. I intend to proceed, at least initially, on the basis that the aforementioned goods which are 'audio/visual' refer to goods which have both audio *and* visual capabilities<sup>5</sup>. The opponent relies upon *imaging devices and analyzers*. In my view, *imaging devices* is a fairly wide term which may naturally encapsulate goods such as *photographic devices; photographic apparatus; photographic instruments; optical apparatus; optical instruments; apparatus and instruments for recording of images and apparatus and instruments for transmitting images*. Such goods would, consequently, be deemed identical. Alternatively, if that considered too broad an approach, I find *all* of the terms cited above are highly similar to the opponent's *imaging devices* on the basis that there is some coincidence in their respective use, they are likely to share users and trade channels, there may be some opportunity for similarity in physical nature, to some extent, and there could be a competitive relationship. It also seems likely that the goods could be considered complementary; there may be cases whereby the goods share an indispensable element

---

<sup>5</sup> See, for example. BL O/0974/24. Mr Phillip Johnson found, at paragraph 24: "I accept that there is a reasonable argument that "audio-visual devices and equipment" means equipment for both sound and vision and not just sound or vision. But even if a device or equipment which produces only sound or produces only vision is not identical to "audio-visual devices" it is highly similar."

and I could foresee the consumer expecting the respective goods to be offered by a single origin.

*Apparatus and instruments for transmitting sound; Apparatus and instruments for recording sound.*

19. In contrast to the opponent's *imaging devices*, the above goods concern sound specifically. There is consequently a difference in the goods' use, though I suspect there is some overlap in the respective users. Given the relationship between sound and vision I also find it likely that there will be some coincidence in the goods' respective trade channels, though the physical nature is likely to be distinct and the goods are unlikely to be competitive on account of their different use. The goods may not be complementary to the extent that they are indispensable but there may be an expectation on the part of the consumer that both audio and visual devices or apparatus are offered by the same undertaking. I find at least a medium degree of similarity.

20. In the event that I am found to be wrong, at paragraph 18, to have proceeded on the basis that audio/visual devices refer to devices which provide both audio and visual functionality, my findings in the previous paragraph apply to those goods which are concerned solely with an audio function. (i.e. audio/visual devices; audio-visual apparatus and audio-visual instruments). In other words, if the audiovisual goods should be separated into those with an audio function and those with a visual function, I find a high degree of similarity in regard to the visual goods (as per my reasoning at paragraph 18) and at least a medium degree in regard to the audio goods (as per my reasoning at paragraph 19).

*Apparatus and instruments for transmitting data; Apparatus and instruments for recording of data; Data collection apparatus*

21. I consider the above goods against the opponent's *scientific apparatus and instruments* which, as I've mentioned, I find to be a fairly broad term. If it would be too vague a finding for the above goods to be encompassed by such a term, I find at least a medium degree of similarity. Scientific apparatus and instruments could include devices which are intended to gather or record various pieces of data or scientific information and, consequently, it is possible that the goods will be used for the same, or a similar, purpose. In some

circumstances, it seems likely that the goods will be selected or utilized by the same consumer and reach the market via the same channels of trade. In the circumstances I've outlined, I find it likely that there may be an element of similarity in the goods' physical nature, though not exclusively. The goods could occupy competitive positions and there may, in certain scenarios, be an element of complementarity whereby the respective goods are used in conjunction with one another (as part of a scientific experiment, for example) and are considered important for one another to the extent that the consumer would conclude that they originate from a shared origin<sup>6</sup>.

*Computers; Computer peripheral devices*

22. In its submissions in lieu, the opponent includes the above goods, amongst others, at paragraph 32 headed "Detecting apparatus and instruments". The opponent writes:

"The Applicant's specification includes various terms for measuring and navigation apparatus and instruments...

Such goods are likely to be contained within or considered similar to the Opponent's following goods, because they include goods with the same physical nature, intended purpose and relevant user in detecting, signalling and recording the results of scientific instruments and apparatus:

Imaging devices and analyzers; scientific instruments and apparatus; laboratory devices for use in research, science and industry;

The Applicant's goods should also be considered similar to the Opponent's following goods because they have the same physical nature, intended purpose, uses, users, trade channels and are complementary, or are in competition with each because they include photographic apparatus and instruments, which can be used to record and analyse the base sequence of the fluorescently tagged nucleic bases, arranged in length order, as follows:

---

<sup>6</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Laboratory instruments, namely, devices for analysis of nucleic acids and for DNA sequencing; nucleic acid sequencers”

23. I accept that the applicant’s goods (computers, in particular) can be utilized for a wide range of things such that it could provoke some degree of overlap in purpose when considered against the opponent’s goods, though this is a fairly broad finding. Similarly, whilst there may be some coincidence in the goods’ respective users, this is in fairly broad terms only. To my knowledge, the physical nature of the goods is likely to be distinct and I see little, or at least limited, opportunity for the goods to share the same trade channels. Whilst I’ve found that, in some circumstances, there may be an opportunity for the goods’ purpose to be the same, or similar, I do not find the goods are strictly competitive. I also am not aware that the goods share an indispensable relationship or are important to one another to the extent that the consumer would naturally expect them to originate from a shared undertaking. Notwithstanding the opportunities for similarity I have identified, applying due weight, I do not find sufficient coincidence in the relevant factors sufficient to support a finding of similarity.

#### Class 42

*Development of measuring and testing methods; Technical measuring and testing; none of the aforesaid relating to diagnostic, clinical, pharmaceutical or medical research.*

24. The opponent relies upon *scientific instruments and apparatus and laboratory devices for use in research, science and industry*. Of course there is a distinction from the outset, in their nature at least, insofar as one is a good and the other a service but it seems likely that the respective goods and services may be used for a similar purpose, or at least to reach the same outcome. There may be some crossover in the users; users of scientific apparatus, for example, may also engage in measuring and testing services to assess the results generated by such apparatus. The trade channels may not routinely be the same and the goods and services are not competitive. Given what I’ve found in regard to the goods and services being used alongside one another, or as part of the same process, I could foresee the consumer concluding that the respective origins may be shared though, in the absence of any context, I do not find them necessarily

indispensable for one another. I find the goods' similarity to be between a low and medium degree.

*Electronic data storage; Hardware design; Design and development of computer hardware; Computer programming; Installation, maintenance and repair of computer software; Computer consultancy services; Software as a service*

25. I have considered both parties' submissions with regard to the above but, on review of the relevant factors for assessment, I can see no material similarity between the services applied for in class 42 and the goods and services relied upon by the opponent.

26. As some degree of similarity between the parties' terms is necessary to engage a likelihood of confusion,<sup>7</sup> the opposition fails at this juncture in respect of all goods and services for which I have found no similarity, namely:

Class 9: *Computers; Computer peripheral devices; none of the aforesaid for use in relation to diagnostic, clinical, pharmaceutical or medical research.*

Class 42: *Electronic data storage; Hardware design; Design and development of computer hardware; Computer programming; Installation, maintenance and repair of computer software; Computer consultancy services; Software as a service; none of the aforesaid relating to diagnostic, clinical, pharmaceutical or medical research.*

### **The average consumer and the nature of the purchasing act**

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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:

---

<sup>7</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“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.”

15. The average consumer of the goods and services at issue is likely to predominantly comprise professional or academic bodies, though I accept that some will also be selected by members of the general public. The goods and services are likely to be selected from the pages of a catalogue or professional document, or an online resource. The marks’ visual impression is, consequently, likely to carry the greatest weight, though I do not discount the relevance of the marks’ aural impact, particularly as recommendations may be made by colleagues or peers, for example. The cost associated with the goods and services is unlikely to be insignificant, though I accept these will vary. Nevertheless, the average consumer is likely to be alive to considerations such as quality and compatibility throughout the purchasing process. Weighing all factors, I find the average consumer is likely to apply between a medium and fairly high degree of attention to its selection.

### **Comparison of trade marks**

16. 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated, at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>8</sup>, that:

---

<sup>8</sup> Case C-591/12P

“... 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.”

17. 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.

18. For ease, the parties' trade marks are displayed in the table below:

<b>Opponent's trade mark</b>	<b>Applicant's trade mark</b>
<b>AVENIO</b>	<b>Navenio</b>

19. The opponent's mark comprises a single word of six letters. In the absence of any additional components, the mark's overall impression resides solely, therefore, in the word itself.

21. The applicant's mark comprises a single word of seven letters. The mark's overall impression resides only in the word itself.

22. Visually, the marks coincide in the six letter sequence A-V-E-N-I-O / a-v-e-n-i-o. In the opponent's mark, those are the only letters which are present. In the applicant's mark, those letters are preceded by the letter 'N'. Given that the registration of a word mark allows for its presentation in a number of typefaces and casing combinations, little

hangs on the marks' variation in this respect. Whilst I keep in mind that the beginning of the marks are different, and that the beginnings of marks generally have a greater impact on the average consumer, I find the marks' visual similarity to be fairly high.

23. Aurally, the opponent's mark will likely be articulated in four syllables, roughly AH-VEN-EE-OH. The applicant's will also likely be articulated in four syllables, roughly NAH-VEN-EE-OH. Though I note the percussive difference at the beginnings of the respective marks, I find there is a high degree of aural similarity.

29. Beginning with the opponent's AVENIO mark, to my mind it will be viewed as an invented word absent of any retrievable concept. I reach much the same conclusion in respect of the applicant's mark; Navenio will simply be seen as an invented word which fails to convey any specific meaning. I therefore find the conceptual position is neutral.

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

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>9</sup> 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-2779, 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

---

<sup>9</sup> Case C-342/97

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).”

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

32. In the absence of evidence showing the use made of the earlier mark, I have only the inherent position to consider. I have already found that AVENIO is likely to be viewed as an invented word which does not evoke any particular concept. On the basis that the consumer is unlikely to take anything meaningful from the mark, I do not consider it possible for the mark to occupy a descriptive nor allusive role when considered in respect of the goods and services relied on by the opponent. Weighing all considerations, I find the opponent’s mark inherently distinctive to a fairly high degree.

### **Likelihood of confusion**

33. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

34. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

35. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*<sup>10</sup>, 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).

---

<sup>10</sup> Case BL O/375/10

(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. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

37. I will begin by considering a likelihood of direct confusion. In my view, this is the only 'type' of confusion I need consider. I see no material reason as to why the average consumer, upon acknowledging that the marks are different, would nonetheless attribute their similarities to a shared or related origin. The consumer will either directly confuse the marks, or not confuse them at all. Throughout the course of my decision, I have found the marks visually similar to a fairly high degree, aurally similar to a high degree and, conceptually, I have found the position is neutral. I have found that the average consumer is likely to apply between a medium and fairly high degree of attention to its purchase and that the marks' visual impression is likely to play the greatest role in the selection process, though I do not discount the significance of the aural position. I have also found the earlier mark to enjoy a fairly high degree of inherent distinctiveness. Whilst I keep in mind that the beginnings of marks generally have the greatest impact on the average consumer<sup>11</sup> and that the beginnings of the respective marks are, in the present proceedings, different, the marks are but one letter apart and they share an identical six-letter sequence (a-v-e-n-i-o). On balance, in my view, the earlier mark's level of distinctiveness and the degree of similarity between the parties' marks are sufficient to counteract the marks' different beginnings. The consumer (attempting a repeat purchase, for example) may not recall the sequence of letters precisely, particularly as the sequence offers nothing conceptually tangible to recall,

---

<sup>11</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

however, in my view, the consumer will at least recognise that the sequence is *sufficiently familiar* to erroneously conclude that the respective marks are the same. In other words, the consumer will directly confuse the marks. I make that finding in respect of all goods which I have found to be similar, and find it to apply even in circumstances whereby the degree of attention applied is of a fairly high degree.

## **Conclusion**

**38. The opposition succeeds, in part. Subject to any successful appeal against this decision, the application will be refused in respect of:**

*Class 9: Electric measuring devices; Precision measuring apparatus; Measuring apparatus; Measuring apparatus and instruments; Navigation apparatus and instruments; Navigational instruments; Audio/visual and photographic devices; Photographic apparatus; Photographic apparatus and instruments; Photographic instruments; Audio-visual apparatus; Audio-visual instruments; Optical apparatus; Optical apparatus and instruments; Measuring apparatus; Measuring apparatus and instruments; Signalling apparatus; Signalling apparatus and instruments; Signalling instruments; Detecting apparatus and instruments; Apparatus and instruments for transmitting data; Apparatus and instruments for transmitting images; Apparatus and instruments for transmitting sound; Recording apparatus; Apparatus and instruments for recording of data; Apparatus and instruments for recording of images; Apparatus and instruments for recording sound; Data collection apparatus; none of the aforesaid for use in relation to diagnostic, clinical, pharmaceutical or medical research.*

*Class 42: Development of measuring and testing methods; Technical measuring and testing; none of the aforesaid relating to diagnostic, clinical, pharmaceutical or medical research.*

**39. Subject to any successful appeal against this decision, the application will be registered for<sup>12</sup>:**

---

<sup>12</sup> I have included here the goods and services which were unopposed

*Class 9: Computers; Computer peripheral devices; none of the aforesaid for use in relation to diagnostic, clinical, pharmaceutical or medical research.*

*Class 35: Business management; Business administration; Organisation, operation and supervision of loyalty and incentive schemes; Advertising services provided via the internet; Data processing; Business information (Provision of -); Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Data collection services; Business analysis.*

*Class 36: Asset management; Asset management services; Issuing of tokens of value; Issuing of tokens of value in relation to customer loyalty schemes; Issuing of tokens of value in relation to incentive schemes.*

*Class 39: Tracking, managing and optimising the movement of staff and assets.*

*Class 42: Electronic data storage; Hardware design; Design and development of computer hardware; Computer programming; Installation, maintenance and repair of computer software; Computer consultancy services; Software as a service; none of the aforesaid relating to diagnostic, clinical, pharmaceutical or medical research.*

## **Costs**

40. Both parties have achieved a measure of success, with the greater part going to the opponent. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In accordance with that TPN, I award the costs to the opponent as follows:

Preparing a Notice of Opposition and considering the applicant’s counterstatement:	£250
Preparing evidence and written submissions in lieu of a hearing:	£400 <sup>13</sup>

---

<sup>13</sup> I have reduced the cost award pertaining to the preparation of the opponent’s evidence as it was of no assistance to my decision.

Official fees: £100

**Total: £750**

**41. I hereby order Navenio Limited to pay Roche Diagnostics GmbH the sum of £750. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 17<sup>th</sup> day of December 2024**

**Laura Stephens  
For the Registrar**