

O-229-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 3393064 AND 3393069
BY BAUER HOLDINGS LIMITED TO REGISTER THE TRADE MARKS**

TESTOGEN

IN CLASS 5

AND

TESTOGEN

IN CLASSES 5 AND 25

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER
NOS. 417203 AND 417204 BY BESINS HEALTHCARE LUXEMBOURG S.A.R.L.**

Background and pleadings

1) Bauer Holdings Limited (“the applicant”) applied to register two trade marks in the UK on 17 April 2019, the relevant details of these marks are shown below. They were both accepted and published in the Trade Marks Journal on 3 May 2019:

- (i) Application no. 3393064

TESTOGEN

List of goods:

Class 5: *Dietary supplements and dietetic preparations; Dietary supplement drink mixes; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Nutraceutical preparations for humans; Nutraceuticals for use as a dietary supplement; Nutritional supplements; parts and accessories for all the aforesaid goods.*

- (ii) Application no. 3393069

TESTOGEN

List of goods:

Class 5: *Dietary supplements and dietetic preparations; Dietary supplement drink mixes; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Nutraceutical preparations for humans; Nutraceuticals for use as a dietary supplement; Nutritional supplements; parts and accessories for all the aforesaid goods.*

Class 25: ..

2) Besins Healthcare Luxembourg S.A.R.L. (“the opponent”) opposes the applications insofar as they cover Class 5 goods. The oppositions are on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). These two grounds are both brought on the basis of its earlier UK trade mark no. 2041928 in respect of the mark TESTOGEL. The relevant details are:

Filing date: 19 October 1995

Registration date: 11 October 1996

Class 5: *Pharmaceutical preparations and substances; all in gel form.*

3) This is an earlier mark as defined by section 6 of the Act, by virtue of it being registered and having a filing date that predates the filing date of the applications.

4) The opponent asserts that all of the applicant’s contested goods are identical or similar to the opponent’s goods. It also asserts that the applicant’s word mark differs in only a different last letter and that it is visually and aurally highly similar to the opponent’s mark. In respect of the applicant’s word and device mark, the opponent refers to “a small amount of stylisation within the mark” but reaches the same conclusion that the marks are visually and aurally highly similar. It claims that, in respect of both of the applicant’s marks, there exists a likelihood of confusion with its own mark.

5) In respect of the grounds based upon section 5(3) the opponent relies upon a reputation in respect of *testosterone replacement preparations and supplements; testosterone supplements*. It claims that:

- use of the applicant’s marks would take unfair advantage because it would lead the public to believe that there is an economic link to the opponent’s mark and, as a result, the applicant will obtain an enhanced position in the market from being associated with the reputation of the opponent’s mark;
- the reputation of the opponent’s mark is associated with providing an effective testosterone replacement product and use of the applicant’s marks

will lead the public to believe there is an economic link. If the applicant uses them on a less effective product it will lead to detriment to the reputation of the opponent's mark in the form of tarnishment;

- there is detriment to the distinctive character of the opponent's mark because if the applicant's marks are used in respect of treatment in the same field, it will reduce the uniqueness of the opponent's mark in the market place. If the applicant's marks are used in a different field of treatment it will reduce the public's ability to rely on the opponent's mark as indicating a product for testosterone replacement, thereby reducing its distinctiveness.

6) The applicant filed counterstatements denying the claims made and requesting that the opponent provides proof of use of the earlier mark relied upon.

7) The opponent is represented by Dollymores and the applicant by Cloch Solicitors. The opponent filed evidence and submissions in lieu of a hearing. The applicant did not file submissions but did provide comments on costs. I will refer to all of these to the extent required to make my decision. As no hearing was requested this decision is taken following a careful consideration of the papers.

Evidence

8) This takes the form of a witness statement from Xavier Dandoy, director of the opponent. I will refer to this, as appropriate, in my decision.

DECISION

Proof of Use

9) The relevant statutory provision is section 6A of the Act

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

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

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

[EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

11) Section 100 of the Act states that:

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

12) The relevant five-year period for the opponent to demonstrate that it has genuinely used its mark is 18 April 2014 to 17 April 2019. Mr Dandoy provides the following relevant evidence to support the claim to such use:

- turnover in the UK under the TESTOGEL mark has been £7,070,820 in 2016, £6,748,286 in 2017 and £5,285,293 in 2018¹;
- a selection of 9 invoices dated between May 2016 and December 2018 totalling over £4 million of sales of “Testogel 50mg” to the pharmaceutical distribution company Alloga UK Ltd²;
- Packaging designs from 2018 are shown³ relating to the two forms in which TESTOGEL is sold, namely in sachets and a pump bottle. They show two slightly different forms of the mark, firstly “Testogel” and, secondly, “**TESTOGEL**”;
- An information leaflet for consumers is also provided and shows the use of the mark in the forms “Testogel” and “**TESTOGEL**”⁴;
- Extracts from the opponent’s website obtained from the Internet archive Wayback Machine are provided showing use of the “**TESTOGEL**” mark between 10 March 2017 and 16 April 2018⁵;
- Extracts from four third party websites showing the sale of individual packs of the TESTOGEL product in the UK are provided⁶. Three have “.co.uk” high level domain names and one is a “.com” address. All are priced in pounds sterling. None can be definitively dated to within the relevant period.

¹ Mr Dandoy’s witness statement, para 4

² As illustrated in extracts from Alloga UK Ltd’s website at Exhibit XD2

³ At Exhibit XD4

⁴ ditto

⁵ Exhibit XD5

⁶ At Exhibit XD6

13) This evidence illustrates turnover, under the mark, in the region of £19 million over three years of the relevant period and illustrates sales to both a UK pharmaceutical distributor (in the relevant period) and by third party online sellers (at an unspecified date) offering the TESTOGEL product for sale to UK consumers. Taking this evidence into account, even though one exhibit consists of undated Internet extracts, when viewing the evidence as a whole, I have little hesitation in concluding that there has been clear and reasonably significant use of the mark TESTOGEL in the UK during the relevant period. The use has been exclusively in respect of one product, namely, testosterone replacement medication. Such use requires me to consider how to frame a specification to fairly reflect this use.

Fair Specification

14) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

15) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

16) The evidence of use illustrates that the opponent has used its mark in respect of a testosterone hormone replacement medicine. The registration relied upon covers *Pharmaceutical preparations and substances; all in gel form*. Putting the limitation to gel to one side, this specification is extremely broad and clearly is not in line with the above guidance. The opponent makes a broad submission that it is in line with the

guidance but does not provide any reasoning. Having concluded that the specification is too broad, I must consider alternative terms to reflect the use shown. The guidance states that it is permissible to identify a suitable sub-category of goods of which the actual goods sold are part, and that my task is not to describe the goods in the narrowest possible terms unless that is what the average consumer would do. The consumer is likely to understand that such goods are part of the category of goods described as hormone replacement treatment and, consequently, with this in mind, I find the appropriate terms in which to reflect the genuine use shown to be *Hormone replacement preparations and substances*.

17) The opponent's original specification is limited to being "*all in gel form*". By not adopting this same limitation in framing a fair specification will result in allowing the opponent to base its opposition upon a broader scope of goods than those originally covered by the specification, i.e. those not in gel form. There is no provision within the Act that permits amendments that increase the scope of protection of a registration. Accordingly, the same limitation must be applied here to the fair specification arrived upon. Taking this into account, the opponent may rely upon the following list of goods:

Hormone replacement preparations and substances, all in gel form

Section 5(2)(b)

18) 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".

19) Section 5A of the Act is also potentially relevant:

“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.”

Comparison of goods

20) In the judgment of the Court of Justice of the European Union (“the 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”.

21) 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.

22) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it 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 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”

23) 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 General Court 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”.

24) The two contested applications are in respect of the same list of Class 5 goods and therefore, the following lists of goods must be compared:

Opponent's goods	Applicant's goods
<p>Class 5: <i>Hormone replacement preparations and substances, all in gel form</i></p>	<p>Class 5: <i>Dietary supplements and dietetic preparations; Dietary supplement drink mixes; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Nutraceutical preparations for humans; Nutraceuticals for use as a dietary supplement; Nutritional supplements; parts and accessories for all the aforesaid goods.</i></p>

25) The opponent's submissions are based on it having been permitted to rely upon the original list of goods in its specification. The applicant's comments are limited to those made in its counterstatement and I keep these in mind when considering similarity within the context of the criteria identified above.

26) In respect of the applicant's *Dietary supplements and dietetic preparations; Dietary supplement drink mixes; Dietary supplements consisting of vitamins; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Nutraceuticals for use as a dietary supplement; Nutritional supplements*, these are all dietary or nutritional supplements and, on a plain reading of the terms, they are not pharmaceutical products. The opponent submits that where the applicant's goods are considered a non-pharmaceutical supplement, they may be complementary to the opponent's goods. Applying the guidance in *Boston Scientific*, I consider that the applicant's goods may be important for the use of the other and may be used together in circumstances where the applicant's goods are considered to have health benefits that complement hormone treatment. I conclude that there may be a level of complementarity between the respective goods.

27) The applicant's goods are likely to be in the form of goods to be ingested. The opponent's goods are in the form of a gel and ingestible goods may also be in gel

form. Therefore, they share some similarity in nature and method of use. Their intended purpose is to provide nutrients, vitamins or minerals as a supplement to the user's normal diet. Hormone deficiencies are a medical condition rather than a dietary issue. Therefore, I conclude that they are different in intended purpose. There is no evidence before me that dietary supplements have the same or similar effect as hormone replacement therapy, but as an ordinary consumer, I accept that dietary supplements may be marketed as boosting health and, therefore, may be taken or recommended to be taken at the same time as hormone replacement treatments, but they are not likely to be in competition. I recognise that dietary supplements may be prescribed or recommended by medical professionals and, consequently, there may be some overlap of trade channels. Taking all of the above into account, I conclude that the respective goods share a low to medium level of similarity.

28) In respect of the applicant's *Neutraceutical preparations for humans*, the term "neutraceutical" is not explained by the opponent but it appears to be a combination of the words "nutrient" and "pharmaceutical" and suggests a nutrient that has some kind of therapeutic use. This could increase the level of similarity to the opponent's compared to the goods compared above. I find that these goods share a medium level of similarity to the opponent's goods.

29) Finally, in respect of the applicant's *parts and accessories for all the aforesaid goods*, it is not clear what a "part" or an "accessory" to a nutritional supplement might be and the opponent does not explain why it believes such goods are similar to its goods. Without being given any steer from the opponent as to what such goods may be or why they are similar to its own, I conclude that, by virtue of being a part or accessory of nutritional and dietetic preparations and substances, the level of similarity is likely to be the same as identified above.

Comparison of marks

30) 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.”

31) 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.

32) The respective marks are shown below:

Opponent's mark	Contested marks
TESTOGEL	TESTOGEN TESTOGEN

33) As submitted by the applicant in its counterstatement, the opponent's mark consists of a single invented word made up of the two parts TESTO and GEL. These combine to create a distinctive unit that is self-evidently the dominant and distinctive part of the mark. The applicant's word mark, similarly consists of a single invented word, also made up of two parts, namely TESTO and GEN. Again, the word as a whole is the dominant and distinctive element. The applicant's word and device mark consists of the letters TEST in ordinary typeface and GEN in a sloping typeface together with a circular device with a green coloured diamond-shaped centre. This device functions as a replacement for the letter "o" and the mark as a whole presents as the word TESTOGEN. As submitted by the opponent, the device has a secondary

effect. As with the word only mark, it is the word TESTOGEN that is the dominant impression, but I note that the device, whilst not dominant, nevertheless contributes to the distinctive character of the mark.

34) Visually, the opponent's mark and the applicant's word mark are similar in that they both consist of eight letter words where the first seven of these are identical. They differ only in their respective last letters, being "L" and "N" respectively. I find that they share a high level of visual similarity. The level of similarity of the opponent's mark to the applicant's word and device is lower because of the device element present in the applicant's mark and because the sloping typeface of the GEN part of the word creates a slight visual division between this and the rest of the mark that is absent in the opponent's mark. However, it still presents as the word TESTOGEN. Taking all of this into account I conclude that the visual similarity is between medium and high.

35) Aurally, both of the applicant's marks consist of the three syllables TEST-O-JEN. The opponent's mark consists of the three syllables TEST-O-JEL. The marks share the same first two syllables but differ slightly in the third syllable. The respective third syllables begin with the same JEH sound, but they end in ENN and ELL respectively. Taking all of this together, I conclude that both of the applicant's marks share medium-high level of aural similarity to the opponent's mark.

36) The opponent submits that both parties' marks consist of invented words with no meaning in relation to the goods and that they should not be artificially dissected. I agree that they present as invented words but, nevertheless, a dissection of the marks is appropriate to understand if there is a conceptual message communicated by the marks when viewed as a whole⁷. In this respect, the opponent's mark and the applicant's marks all present themselves with the same prefix TESTO. Where the opponent's mark is used in respect of testosterone replacement preparations and substances, whilst there is nothing before me to suggest that TESTO is a known abbreviation for "testosterone", it nonetheless, alludes to such a meaning. The second part of the opponent's mark will be perceived as indicating a "gel", i.e. a thick liquid-like substance. The applicant's marks both have the second part GEN. It is not obvious

⁷ See for example *Usinor SA v OHIM, (GALVALLOY)*, T-189/05, paras 62 - 68

to me what this will indicate to the consumer, if anything. Where the applicant's goods are intended to address issues such as men's vitality, the consumer will be alert to the same allusion as TESTO creates in the opponent's mark. Taking all of this into account, the respective marks may be seen to share some conceptual similarity. The mere fact that the respective marks are invented words does not prevent some conceptual similarity being present. In circumstances where the consumer, upon encountering the applicant's marks, does not make a link to testosterone, the respective marks will be conceptually neutral.

37) The device present in the applicant's second mark does not disturb this conceptual analysis.

Average consumer and the purchasing act

38) 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*.

39) 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.”

40) The average consumer of the opponent's goods will be a medical professional prescribing or recommending the use of hormone replacement products. I agree with

the applicant where, in its counterstatement, it suggests that the opponent's goods, are not likely to be available directly to the consumer to self-select. Despite there being no evidence on the issue, it is likely that hormone replacement treatment products are not available for users to self-select and they are likely to be prescription-only. The applicant's goods are likely to be selected by consumers as part of their choice to supplement their diet. It is possible that such supplements may be recommended by a medical professional. Therefore, the average consumer for these goods may be the public or a medical professional.

41) 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 (see paragraph 33 of the judgment). The position is likely to be similar for dietary and nutritional supplements where care will be taken to identify the appropriate supplement and preferred or recommended quantity of active ingredient.

42) The applicant, in its counterstatement, submitted that the respective goods are not likely to be sold in the same manner or in the same location as the opponent's goods. The applicant's goods are likely to be selected from a shelf at a pharmacy, health shop, or online equivalent and in such circumstances will be visual in nature. Aural considerations may also play a part where the goods are requested over the counter. The opponent's goods are likely to be selected from a print or online catalogue and may be introduced by a sales representative to the medical professional and, therefore, both visual and aural considerations may be important. I agree with the applicant when it submits that the opponent's goods are likely to be available only through controlled channels such as pharmacies, however, I also keep in mind that the average consumer of these goods is also the end user⁸, despite not likely to be involved in the purchasing process (that will be undertaken by medical professionals). However, end users will still be familiar with the mark used in respect of their prescribed medication.

⁸ Case C-412/05P *Alcon Inc v OHIM and Biofarma SA* ("Alcon"), [57] – [63]

Distinctive character of the earlier trade mark

43) 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).”

44) As I have already noted, the opponent’s mark is an invented word that consists of the prefix TESTO and the suffix GEL. When considered in respect of the opponent’s goods, the first part is likely to be perceived as an allusive reference to “testosterone”. The second part describes the physical nature of the goods i.e. in gel form. Therefore, despite it consisting of an invented word, it alludes to the goods for which it is used and its level of distinctive character is not of the highest order. I find that it has a low to medium level of inherent distinctive character.

45) The opponent makes no specific claim to its mark having an enhanced level of distinctive character but it has provided evidence of use in the region of £19 million of sales under the mark over a three-year period. No evidence has been provided to provide context within the market, but the pharmaceutical industry is very large in scale and within that context, whilst these sales appear to be at a reasonable level, in the absence of specific evidence or submissions on the point, I find that if the distinctive character of the opponent's mark has been enhanced through use, it is not to any material extent.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

46) The following principles are obtained 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.

47) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer. It is necessary to consider the earlier

mark to have been used in relation to all the goods/services covered by the registered specification or, if a new specification has been arrived at as a result of a challenge to the use of the earlier mark, that specification⁹.

48) I have found that the respective goods share a low to medium or a medium level of similarity, that there is an enhanced level of care and attention during the purchasing process and that the level of distinctive character of the earlier mark is low to medium. These are findings that, in some circumstances, may contribute to a finding of no likelihood of confusion.

49) In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, [81] the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. However, the courts have also recognised that “where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them”¹⁰. Therefore, another part of my considerations is to consider whether the allusive message present in the opponent’s mark is sufficiently “clear and specific” so that any differences counteract the visual and phonetic similarities between the marks. The applicant submits that the concept of “GEL” acts as a “memorable hook to counteract any visual and aural similarity”. It is my view that there is little in the applicant’s marks to create any conceptual dissonance with the opponent’s mark other than the absence of the concept of “gel”. However, this concept, indicating the physical form of the opponent’s goods and appearing at the end of the mark, does not contribute strongly to the overall distinctive character of the mark. Further, visually it is only the last letters of the respective marks that influence the conceptual perception. I find that this is not sufficient to displace the visual and phonetic similarities. I also dismiss the applicant’s submission that the “GEN” part of the applicant’s mark has a natural military connotation (of the rank of “General”). This is nothing before me to suggest that this would be the perception of the consumer and I consider it very unlikely that this would be so.

⁹ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, [78]

¹⁰ *The Picasso Estate v OHIM*, Case C-361/04 P, [20]

50) The applicant also submits that that the opponent's mark lacks any inherent or enhanced distinctive because it merely describes a "testosterone gel". I have found that mark is allusive rather than descriptive and there is no evidence before me that "TESTO" is an abbreviation for "testosterone". Further, having regard to section 72 of the Act, registration of a mark is prima facie evidence of validity and, therefore, prima facie distinctiveness. Consequently, it is not open to me to make a finding that the opponent's registered mark lacks any distinctive character. The applicant also submits that the difference between goods in gel form are completely different from dietary supplements in, for example, tablet form. The applicant's goods are not limited to being in tablet form and, bearing in mind, ingestible goods may also be in gel form, I dismiss this argument.

51) Keeping all of this in mind when factoring all my findings into the global assessment, I find that the obvious similarities in the marks are such to outweigh the findings that may otherwise point the other way and I conclude that, taking account of imperfect recollection, the consumer is likely to confuse one mark for the other. Therefore, there is a likelihood of confusion in respect of all of the applicant's Class 5 goods listed in both its applications.

52) In making this finding, I have kept in mind that there are two groups of relevant consumers, both medical professionals and the general public. However, my finding applies to both groups.

53) In summary, the grounds based upon section 5(2)(b) succeed in their entirety in both oppositions.

Section 5(3)

54) My findings under section 5(2)(b) are sufficient for the oppositions to succeed in respect of all the goods opposed, but I will comment briefly on the grounds based upon this part of the Act.

55) Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

56) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the

section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation and link

57) The evidence summarised earlier, when considering the issue of genuine use, illustrates that the opponent uses the mark in respect of *testosterone replacement preparations and supplements, all in gel form*. The use over a three-year period ending in 2018 was in the region of £19 million and this is supported by invoices from the same period. Such use is sufficient to demonstrate that the opponent has the requisite reputation for the purposes of section 5(3). Consistent with my earlier comments, it is not permissible to broaden the scope of an application and, therefore, the reputation claimed must relate to a list of goods wholly encompassed within the original specification. Taking account of the opponent's claimed reputation and that the goods must be limited to being in gel form, I find that the reputation of the opponent's mark resides in the following list of goods: *testosterone replacement preparations and supplements; testosterone supplements; all in gel form*.

58) In respect of the requisite link, it is sufficient that when the public is confronted with the applicant's marks, a link is made with the earlier reputed mark, which is the case where the public calls the earlier mark to mind. The "calling to mind" is a lower hurdle than that of likelihood of confusion¹¹. I have found that a likelihood of confusion exists. When this factored in together with the repute shown in the evidence, I find that the requisite link will be made to the opponent's mark.

Unfair advantage and detriment

59) The opponent relies upon three separate claims:

Unfair advantage of the reputation of the opponent's mark

60) The opponent claims the use of the applicant's marks would lead the public to believe that there is an economic link to the opponent's mark and, as a result, the applicant will obtain an enhanced position in the market from being associated with the reputation of the opponent's mark. It is not necessary for there to be evidence

¹¹ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P at [72]

actual injury to the opponent's mark, it is sufficient that I can conclude there is a risk, which is not hypothetical, of unfair advantage¹². I have found that the visual and aural similarity between the respective marks is of a sufficiently high level that the marks are likely to be confused when the applicant's marks are used in respect of its Class 5 goods. It is my view that there will be a transfer of the image of the opponent's marks to the applicant's goods and this will amount to exploitation through riding on the coat-tails of the reputation of the opponent's mark. The opponent is successful in respect of its claim.

Detriment to reputation

61) The reputation of the opponent's mark is associated with providing a testosterone replacement product. The opponent claims that use of the applicant's marks will lead the public to believe there is an economic link and that, if the applicant uses them on a less effective product it will lead to detriment to the reputation of the opponent's mark in the form of tarnishment. Such a claim is difficult to establish, especially in the absence of any evidence to demonstrate that the applicant's marks identify goods associated with a negative reputation¹³. In the absence of such evidence I find that this limb of the case fails.

Detriment to the distinctive character

62) The opponent claims that if the applicant's mark is used in respect of treatment in the same field, it will reduce the uniqueness of the opponent's mark in the market place. If the applicant's mark is used in a different field of treatment it will reduce the public's ability to rely on the opponent's mark as indicating a product for testosterone replacement, thereby reducing its distinctiveness. The change of economic behaviour required by the guidance in *Intel* can be inferred¹⁴. I keep in mind the following guidance of the CJEU in *Environmental Manufacturing LLP v OHIM*, Case C-383/12P:

¹² *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P at [22]

¹³ *Unite The Union v The Unite Group Plc*, Case BL O/219/13 at [46] [47]

¹⁴ *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch), [133]

Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

63) In the current case, keeping in mind the level of similarity between the respective marks and that I have found that the respective goods may overlap in terms of trade channels and that the applicant's goods may be used at the same time as the opponent's goods, I find that use of the applicant's marks in respect of goods intended to support the body's testosterone levels and/or, for example, male vitality, is likely to result in detriment to the opponent's mark.

Due Cause

64) The applicant does not rely upon a claim of due cause.

COSTS

65) The opponent has been successful in both oppositions and would normally be entitled to a contribution towards its costs. Mr Hannay of the applicant's representative submits¹⁵ that the opponent should not be awarded any costs, even if successful, because it refused to enter a cooling-off period. He claims that the proceedings may, therefore, have been unnecessary. I am not persuaded by this. There is no requirement to enter a cooling-off period and a party is entitled to make a business decision to decline to do so. Mr Dandoy states that the opponent filed notices of threatened opposition and only when the Class 5 goods of the applications

¹⁵ Mr Hannay's email of 21 February 2020

were not withdrawn did it file these oppositions¹⁶. In the circumstances I award the opponent a contribution to the costs of the proceedings. The sum is calculated as follows:

Official fees	£400
Preparing statement and considering counterstatement	£400
Preparing own evidence	£500
Written submissions in lieu of a hearing	£400
Total	£1700

66) I therefore order Bauer Holdings Limited to pay Besins Healthcare Luxembourg S.A.R.L. the sum of £1700. 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 9th day of April 2020

**Mark Bryant
For the Registrar**

¹⁶ Mr Dandoy's witness statement, paragraph 2