O-541-22

TRADE MARKS ACT 1994

IN THE MATTER OF

IN THE MATTER OF REGISTRATION NO. 3386309
IN THE NAME OF IMMUNOCORE LIMITED
IN RESPECT OF THE TRADE MARK

ImmTAX

IN CLASS 5

AND

IN THE MATTER OF AN APPLICATION FOR INVALIDATION THERETO
UNDER NO. 503783
BY IMMATICS BIOTECHNOLOGIES GMBH

Background and pleadings

1. The contested registration 3386309, in respect of the mark "ImmTAX", was applied for on 25 March 2019 and registered on 14 June 2019. It stands in the name of Immunocore Limited ("the proprietor"). It is registered in respect of the following goods:

> **Class 5:** *Pharmaceutical preparations; biological preparations for the treatment of cancer; biological preparations for the treatment of viral infections; biological preparations for the treatment of bacterial infections; biological preparations for the treatment of autoimmune diseases; biological preparations for medical use; immunotherapeutic drugs; reagents for medical use; diagnostic preparations; diagnostic reagents for medical use*.

2. On 23 April 2021, Immatics Biotechnologies GmbH ("the applicant") applied to invalidate the registration on the basis of section 47 and section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The applicant relies upon the following two earlier UK marks:

> 810851722
>
> IMMATICS
>
> Filing Date: 27 February 2008
> Registration Date: 20 April 2009
>
> **Class 5:** *Pharmaceutical products, in particular biological and chemical preparations for medical purposes; diagnostic reagents for medical purposes; peptides; proteins; peptides and proteins for medical, diagnostic or therapeutic purposes in particular for cancer therapy; in vitro diagnostic reagents, in vivo diagnostic reagents.*
>
> **Class 42:** *Scientific research in the field of chemistry, biochemistry and biology; services of a biological, biochemical or chemical laboratory;*

performing of biological, biochemical or chemical analysis; cancer diagnostics; services of a biological or biochemical laboratory; biological and biochemical examination services.

Class 44: *Medical services, in particular services of a medical laboratory; medical and clinical examination services; providing medical supply for therapy, in particular supply of peptides or proteins for cancer therapy.*

801291580

Filing Date: 9 November 2015
Registration Date: 12 January 2017

Class 5: *Pharmaceutical products, in particular biological and chemical preparations for medical purposes; diagnostic reagents for medical purposes; synthetic peptides, proteins and cells for pharmaceutical purposes; peptides, proteins and cells for medical, diagnostic or therapeutic purposes, in particular for cancer therapy; in vitro diagnostic reagents, in vivo diagnostic reagents.*

Class 42: *Scientific research in the field of chemistry, biochemistry and biology; services of a biological, biochemical or chemical laboratory; performing of biological, biochemical or chemical analysis; cancer diagnostics for scientific purposes; services of a biological or biochemical laboratory; biological and biochemical examination services.*

Class 44: *Medical services, in particular services of a medical laboratory, medical and clinical examination services, providing medical supply for therapy, in particular supply of peptides, proteins or cells for cancer therapy; cancer diagnostics for medical purposes.*

4. The applicant claims that the respective marks are similar and that the respective goods and services are either identical or similar. It concludes that, because of this, there is a likelihood of confusion.

5. The proprietor filed a counterstatement denying the applicant's claims and putting it to proof of use of its 810851722 mark.

6. The parties both filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

7. A Hearing took place on 11 May 2022, with the applicant represented by Mr Florian Traub for Pinsent Masons LLP and the proprietor by Ms Charlotte Blythe of Counsel, instructed by Kilburn & Strode LLP.

Evidence

8. The applicant's evidence takes the form of a witness statement by Dr Rainer Kramer (Exhibits RK01 – RK07), Managing Director/CBO of the applicant. Dr Kramer provides evidence regarding the history and nature of the business of the applicant and also a collection of pictures, invoices, shipment history, press references and social media relating to its earlier marks.

9. The proprietor's evidence is in the form of a witness statement by Mr Benjamin Scarfield (and exhibits KA-1 – KA-18), chartered trade mark attorney at Kilburn Strode LLP, the proprietor's representative in these proceedings. He provides information from the public domain relating to the activities of the applicant and related companies and its clinical trials relating to a product bearing the contested mark.

10. The applicant's evidence-in-reply consists of the second witness statement of Dr Kramer (and exhibits RK08 – RK33) addressing the issue of genuine use of the applicant's mark in the relevant period.

Statutory provision

11. Sections 5(2)(b) is relevant in invalidation proceedings because of the following provisions set out in section 47 of the Act:

> "47. (1) …
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
> >
> > unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

EU Case Law

12. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Proof of Use

13. The proprietor has put earlier mark 810851722 IMMATICS to proof of use because it completed its registration procedure more than five years before the date of the

application for the declaration. Consequently, I begin by considering the claim to genuine use of this mark.

14. The relevant provisions are set out in section 47 of the Act:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
> >
> > unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> (2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –
>
> > (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
> >
> > (b) the registration procedure for the earlier trade mark was not completed before that date, or
> >
> > (c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

> (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
>
> (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
>
> (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bundervsvereinigung 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 Merken 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].”

16. In line with section 47(2B)(a), the relevant five-year periods where use must be shown is (1) 24 April 2016 to 23 April 2021 and (2) 26 March 2014 to 25 March 2019.

17. The earlier marks relied upon by the applicant are comparable marks and the reliance upon such marks as earlier marks is governed by the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. For the purposes of this decision, the following extract from Tribunal Practice Notice 2/2020 set out the relevant proof of use requirement for the applicant's mark:

> "4. Where, …, comparable marks are relied on in …invalidation proceedings, there will be circumstances when the use provisions apply, ... In such circumstances, it may still be possible to rely on evidence of use in the EU, as set out below:
>
> - where all or part of the relevant five-year period for genuine use under sections 6A, 46(1)(a) or (b), or 47 falls before IP Completion Day [*31 December 2020*], evidence of use of the corresponding EUTM in the EU in that part of the relevant period before IP Completion day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU.
> - ..."

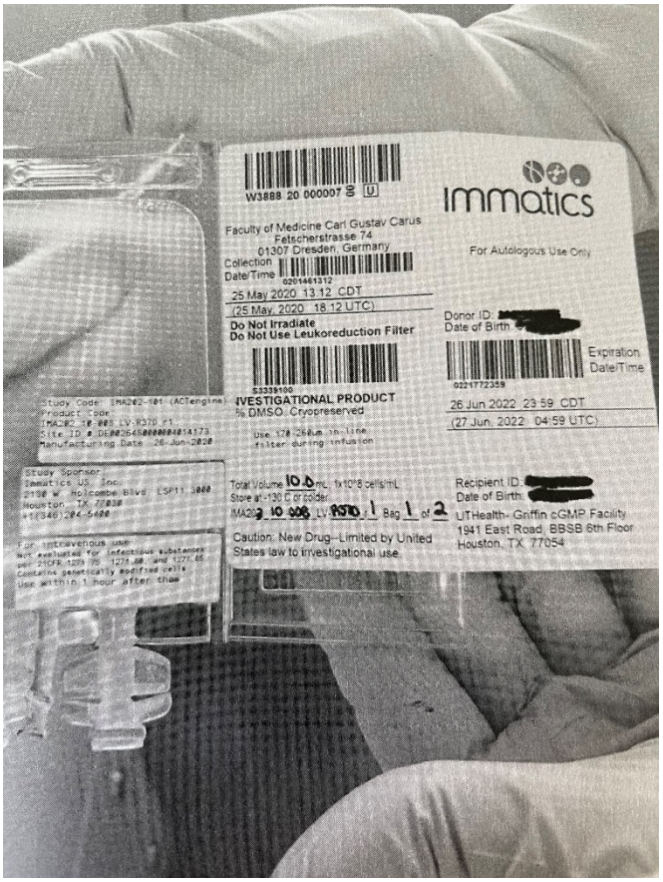
18. Both overlapping periods, in which use must be shown cover, at least partially, a period (up to 21 December 2020) where use in the EU can be taken into account.

19. The following of the applicant's evidence is relevant to the question of whether it has genuinely used its mark and, if so, to what extent:

- IMMATICS is the house mark of the applicant;[1]
- The applicant is a clinical-stage biopharmaceutical company active in the discovery and development of immunotherapies for the treatment of cancer and is developing Adoptive Cell Therapies;[2]

[1] Dr Kramer's witness statement, para 7
[2] ditto

- The applicant offers both personalised therapies and “off-the-shelf” treatments;[3]
- In addition to these pharmaceutical products and medical services, the applicant also provides research services with major pharmaceutical corporations;[4]
- Five photographs of what are labelled as an “Investigational Product” are provided with adhesive labels applied that show the applicant’s figurative mark. Three have a printed “collection date” in May or June 2020, two have a date in June 2021.[5] The latter are outside both relevant periods. Typical of these photographs is:



- By way of examples of customers “throughout EU countries”[6], eleven invoices from 2017 – 2018 are provided[7]. Six relate to five customers in Germany,

[3] Ditto, paras 9 and 10
[4] Ditto, para 11
[5] Exhibit RK01
[6] Dr Kramer’s witness statement, para 13
[7] At Exhibit RK02, pages 1 - 19

three relate to two customers in Switzerland (i.e. outside the EU), one to a customer in the Netherlands and one in Denmark. Two relate to “Research services” and others relate to “rental and auxiliary costs”, “IP pass-through costs” or “PBMC-kits pass-through costs”. One is to a German address and dated in February 2017, the second is to an address in Denmark and dated in November 2018. They all suffer from the deficiency that the figures are totally redacted and therefore, reducing their relevance. In the same exhibit is a list (in German) of orders with values attached to them amounting to nearly €60,000. There is no information providing context of these orders;

- Four further invoices to “Immatics US Inc”. It is not clear what relationship there is between the applicant and this third party and, having similar names, it is unclear whether they are related. If they are, such sales will be considered to be internal. Further, they are not to an EU consumer and, once again, the figures have been redacted;[8]
- Invoice reports for Q4 2015 and Q4 2018[9]. All figures are redacted reducing their relevance. The redacted figures are attributed to headings such as “personnel”, “consumables”, “externals” and “logistics”;
- Fifteen documents all in German are provided and relating to the shipping history of the applicant’s products are dated between August 2016 and December 2017[10]. Two relate to delivery to a German customer, two in Spain, one in Belgium, one in the UK, one in Italy, one in the Netherlands. Others are to the USA and Israel and some appear to be internal i.e. to the applicant but at a different address. A number appear to relate to “CLINICAL TRIAL SUPPL” that Mr Traub submitted this supports use in respect of clinical trials;
- Further documents relating to shipping are also provided[11] including photographs of packaging bearing the applicants IMMATICS figurative mark and the description “… synthetic peptide for in vitro research purposes only. Not for use in humans.” Three are to customers in the EU but one of these is dated “20.05.21” being after both of the relevant periods. A fourth relates to a customer in the US and does not illustrate customers in the EU;

[8] Ditto, pages 41 - 44
[9] Ditto, pages 20 - 40
[10] Exhibit RK03
[11] Exhibit RK04

- A number of press articles are also provided and these include:[12]
    - An article in www.biospace.com, dated 3 February 2021, discussing how the applicant's products could play an important role in cancer treatments;
    - A number of German language articles mentioning the applicant;
    - An article appearing on the website commercial.cancerresearchuk.org, dated 23 April 2014 (early in the first of the two relevant periods), discussing the promising results of a trial run by the applicant in its attempt to develop a cancer vaccine;
    - An article dated 17 February 2010 (before the relevant periods) that appeared in www.fiercebiotech.com and announces that the applicant was entering a collaboration with Cancer Research UK to develop a cancer vaccine. A "Phase 1 trial" was to be carried out at leading research centres in the UK. Several other online articles also announce the collaboration;
    - What appears to be a press release, dated 23 April 2014, announces promising results from this Phase 1 trial and that the applicant was to continue work on the development of the vaccine;
    - A number of documents related to the applicant's attendance at the 2016 and 2017 Bio-Europe events in Cologne and Barcelona, respectively;[13]
    - A number of extracts from the applicant's various social media channels are provided[14] that include YouTube videos in German and English, Twitter and de.linkein.com. These show use of the applicant's IMMATICS mark (and its figurative mark).

20. The proprietor's evidence introduces extracts from the applicant's 2020 Annual Report[15] and from its website (relating to three proposed clinical trials).[16] Links in the web extracts to clinicaltrials.gov have been expanded and exhibited.[17] These

[12] Exhibit RK05
[13] Exhibit RK06
[14] Exhibit RK07
[15] Exhibit BS1 to Mr Scarfield's witness statement
[16] Exhibit BS2
[17] Exhibit BS3

illustrate that the applicant's clinical trials are being conducted in partnership with a number of US cancer centres or universities and that the clinicaltrials.gov is a US website. In response, the applicant filed additional evidence, the most relevant of which I refer to below:

- It is accepted that the applicant has not obtained approval in relation to products for commercial sale, but it maintains that it has used its mark in relation to goods and services;[18]
- A collaboration agreement with GSK in the UK generated revenue of nearly €3.7 million in 2020 and an agreement with Genmab in Denmark denerated income of over €11 million in both 2019 and 2020;[19]
- In such collaboration agreements, the applicant provides investigational pharmaceutical products and research and medical services in return it receives research funding and royalty payments in future sales;[20]
- The applicant also receives income through government grants[21] and this is recorded under "other income" in its "2020 Annual Report" with €303,000 identified in 2020 and €385,000 in 2019. One of these projects, to develop a novel cancer vaccine approach, is identified as being funded by the "EU government" and with the applicant's role being "the vice-coordinator".[22] An extract from www.hepavac.eu/consortium/partner-5-imm-vice-coordinator/ provides a "brief description" of the applicant:

  "[The applicant] *is a leading clinical-stage biopharmaceutical company working on the rational discovery and development of peptide-based cancer immunotherapeutics*. [The applicant's] *lead product …is currently developed in a pivotal phase 3 study after completing a successful phase 2 trial* …[The applicant's] *pipeline also includes* [a vaccine] *which has recently completed a phase ½ study … and* [another vaccine] *currently tested in multiple phase 1 studies* … [The applicant] *is a spin-off company from the University of*

[18] Dr Kramer's second witness statement, para 16
[19] Ditto, para 18
[20] Ditto
[21] Ditto, para 20 and Exhibit RK09
[22] Ditto, para 21

Teubingen … and currently employs 80 employees at office in Tuebingen and Munich, Germany."[23]

- Information is provided regarding collaborative agreements within the EU in a consolidated financial statement from the applicant's 2020 Annual Report[24] identifies the following revenue generation:

Revenue	2020	2019
Genmeb (in Denmark)	€11,204,000	€11,191,000
GSK (in the UK)	€3,695,000	-

21. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

[23] Exhibit RK11
[24] Ditto, para 18 and Exhibit RK09

> “28. ..... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

Use in respect of Class 5 goods

22. At the hearing Mr Traub submitted that although the applicant’s own proprietary products are not yet available to the general public due to the pending clinical trials, it has been advertising its goods and services through attendances at conferences and social media. In *Healey Sports Cars Switzerland Limited v Jensen Cars Limited* [2014] EWHC 24 (Pat), Mr Henry Carr Q.C. sitting as a Deputy Judge of the High Court stated that:

> “26. I agree with the Hearing Officer that the question of whether goods are “about to be marketed” is to be decided in the context of the economic sector concerned, and that some goods will take longer to develop than others. I also agree that the press release and website, which were published a few days before expiry of the five year period and enabled no more than initial interest in a future development to be registered, did not show that the goods were about to be marketed.”

23. Ms Blythe submitted that there has been no use shown in respect of such goods. This submission was based on (a) that it was common ground that the applicant has not yet brought any pharmaceutical product to market and (b) any use shown falls short in respect of quantum in the relevant periods. Mr Traub claimed that the use in

respect of the clinical trials illustrated that the applicant has used its mark in respect of Class 5 goods. Upon seeking clarification Mr Traub confirmed to me that he was submitting that use was being claimed in respect of the following of its Class 5 goods:

> *Pharmaceutical products,* [namely, vaccines]*…; peptides; proteins; peptides and proteins for medical, diagnostic or therapeutic purposes in particular for cancer therapy; ….*

24. Mr Traub drew my attention to the photographs of what are labelled as "Investigational Products" and the shipment papers showing delivery to an address in the US of a "… synthetic peptide for in vitro research purposes only. Not for use in humans." There are five photographs but, based on the dates visible on the labels only three are within the relevant periods. Being labelled as for "in vitro" use and not for use in humans suggests that this product cannot be considered as a pharmaceutical product but, rather, it a product earlier in the development stage. Therefore, despite Dr Kramer's statement that the applicant provides offers both personalised therapies and "off-the-shelf" treatments, it is shown in the evidence and conceded by Mr Kraub at the hearing that the applicant has not brought any goods to market. Therefore, it cannot offer personalised therapies nor off-the-shelf treatments. At best it is providing experimental goods for testing and assessing within research programmes.

25. There are other exhibits referring to "investigational drugs", but it is clear from the above paragraph that these may be only for in vitro use and not for use in humans. There is also a press article dated 3 February 2021 that appeared on www.biospace.com website where the applicant's Chief Medical Officer, is recorded as saying that he "believes his company's engineered T-cell receptors may play an important role in providing treatment options for cancer patients."[25] However, this appears to be a comment on future developments rather than a comment regarding the use, at that time, of a pharmaceutical product. This are some references in the evidence to more advanced phases being reached (Phase 3 is referred to, see

[25] Exhibit RK05, page 1

footnote 23) however, the evidence, when taken as a whole, is very thin in respect of supporting the claim to genuine use of Class 5 goods. There are various references in the evidence to a vaccine but this is always in the context of the development of a vaccine.

26. Taking all of the above into account, I conclude that genuine use has not been shown in respect of any of the Class 5 goods relied upon.

Use in respect of Class 42 services

27. In *Alpex Pharma v EUIPO,* Case T-355/15, the General Court held that conducting research in order to develop new drugs was not a 'service' within the meaning of the word in trade mark law. However, in the current case there is evidence that the applicant has worked with third parties funded by grants to undertake research in order to develop a product not to be used by the applicant. The applicant is described as a "clinical-stage biopharmaceutical company working on the … discovery and development of peptide-based cancer immunotherapeutics" This describes a business that undertakes the type of services listed in both earlier mark's Class 42 services. Revenue in excess of €11 million is disclosed in respect of work in Denmark with a third party called Genmeb and in excess of €3.5 million with GSK in the UK. There are also two invoices in the overlapping period of both relevant periods in respect of "Research services". There is some use shown in respect of the earlier word mark but most of the use is in respect of the earlier figurative mark. I consider this to be an acceptable variant use[26] of the word mark because the word "immatics" appears in an unremarkable script and is presented separately to the device elements. When taking all of this together, I find that use has been shown in respect of all the services covered by the Class 42 specifications of the earlier marks.

[26] See the comments of Phillip Johnson, siting as the Appointed Person in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paras 13 - 15

Use in respect of Class 44 services

28. It is clear from the evidence discussed in respect of Class 42 that the applicant is primarily a company involved in research and development of cancer treatments. The word "medical" means "relating to the science or practice of medicine".[27] The applicant's services can be described as being in the field of science of medicine. On a more specific level, the evidence illustrates that they provide peptides/proteins as part of the research into cancer therapies. I conclude that the applicant has demonstrated genuine use of its marks in respect of the Class 44 services listed in its earlier marks.

Proper reasons for non-use

29. At the hearing Mr Traub also sought to rely upon a fall-back submission that the applicant had proper reasons for non-use. As Ms Blythe pointed out, this was not a pleaded defence and, in fact, the applicant had ticked the Form TM8 to indicate that it had used its mark in respect of all the goods and services listed in the registration and, further, had left blank the box to indicate that it had proper reasons for non-use. In the circumstances, to change its defence at the hearing is unacceptable and unfair to the proprietor who had no time to address the new pleading by way of counter evidence. The applicant is not entitled to rely upon such a defence now and the attempt to do so is refused.

Summary of findings regarding genuine use

30. The applicant has not demonstrated genuine use in respect of Class 5 goods, but it may rely upon its services in Class 42 and Class 44 of earlier mark 810851722, namely:

> **Class 42:** *Scientific research in the field of chemistry, biochemistry and biology; services of a biological, biochemical or chemical laboratory; performing of biological, biochemical or chemical analysis; cancer diagnostics;*

[27] MEDICAL | Meaning & Definition for UK English | Lexico.com

services of a biological or biochemical laboratory; biological and biochemical examination services.

Class 44: *Medical services, in particular services of a medical laboratory; medical and clinical examination services; providing medical supply for therapy, in particular supply of peptides or proteins for cancer therapy.*

Section 5(2)(b)

31. This reads as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

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

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

Comparison of goods

33. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

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

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

34. In the judgment of the Court of Justice of the European Union in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97 (“*Canon*”), 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”.

35. 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.

36. 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".

37. Ms Blythe conceded that the respective Class 5 goods are identical. In respect of earlier mark 810851722, the applicant is not entitled to rely upon the Class 5 specification because of my finding regarding genuine use. In respect of that earlier mark, the applicant can only rely upon its services in Class 42 and Class 44.

38. In respect of the similarity with the applicant's Class 42 services, Mr Traub accepted that these services are different in nature to the proprietor's goods but claimed that they share a common purpose, and it is industry practice that parties collaborate. He further submitted that pharmaceutical providers are also commonly involved in research and development. Ms Blythe submitted that they are different in nature and purpose and there is no evidence that providers of pharmaceutical goods are also involved in research and development of the same.

39. As I am comparing goods with services, it is obvious that their nature and purpose is different and, in that respect, I agree with Ms Blythe. Further, their methods of use are also, self-evidently different. However, even absent evidence, the average consumer upon encountering the provider of, for example, scientific research and/or cancer diagnostics and then encounters a pharmaceutical product under the same or similar name may believe that the provider of the respective goods/services in the same or related undertakings. This leads to a finding of complementarity. Taking all of this into account, I find that the respective goods and services share some similarity, but I would put it at no more than a low level.

40. In respect of the similarity to the applicant's Class 44 services, Mr Traub submitted that the respective goods and services are complementary and that they are similar to a medium degree. Ms Blythe submitted that they are different in nature and purpose. The considerations here are very similar to those discussed in respect of the similarity to the Class 42 services and I find that these also share a low level of similarity to the proprietor's goods.

Comparison of marks

41. It is clear from *Sabel BV v Puma AG,* Case C-251/95 (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."

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of 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.

43. The respective marks are shown below:

Applicant's earlier marks	Proprietor's mark
IMMATICS 	ImmTAX

44. The applicant's first mark consists of the single word "IMMATICS" and the distinctive character of the mark is formed from this single element. The applicant's figurative mark includes the same word presented in an unremarkable lowercase typeface and three circular devices positioned above the last five letters of the word. By virtue of its size within the mark, the word element is the dominant and distinctive part of it. The devices are also distinctive and must be taken into account. No explanation has been provided regarding the significance of these devices, but it appears likely to me that they are pictorial representations that have some significance to the applicant's core activity of research into a vaccination for cancer. As Ms Blythe submitted, the proprietor's mark consists of two conjoined elements "Imm" and "TAX". I reject Mr Traub's submission that the order of capitalisation/lower case is irrelevant because it is a word mark that can be presented in any combination of these. I consider this to be the incorrect approach. The mark's distinctive character is characterised by the two elements "Imm" and "TAX" and the particular combination of upper and lower case letters and the letters "TAX" stand apart from the "Imm" element because of their capitalisation. This has the effect of creating a mark that does not present as a single word but, rather, the two separate but conjoined elements "Imm" and "TAX". The distinctive character of the mark is

created by this combination of the two elements that have roughly equal dominance in the mark. This is different to the applicant's word mark,

45. Visually, the applicant's word mark and the proprietor's mark share some similarity because they both begin with the same three letters "Imm". Both marks also contain the letter "A". They differ in all other respects. The applicant's mark "IMMATICS" presents as a single eight letter word and the proprietor's mark presents as the three letters "Imm" and the three letter word "TAX" conjoined. Taking all of this into account, I conclude that they share a low to medium level of visual similarity.

46. Aurally, Mr Traub submitted that the applicant's mark consists of the three syllables "IM-MA-TICS" and the proprietor's mark consists of the two syllables "IM-TACS". He also claimed that the first syllables are identical, the last syllables are very similar and that the second syllable in the proprietor's mark "is almost lost" in the mark. Ms Blythe pointed out that the respective marks consist of a different number of syllables and suggested the comparison should be between "IMM-AT-ICS" and "IMM-TACKS". It is my view that there is little between these two approaches other than the former down plays the role of the second syllable of the applicant's mark. I accept that either pronunciation is possible but the level of similarity is not greatly impacted either way. There are clear differences and similarities that result in a medium level of aural similarity.

47. Regarding conceptual similarity, Ms Blythe directed me to a decision of the EUIPO's opposition division[28] where the earlier mark was the same as the applicant's figurative mark in the current proceedings and where it was held that the component "IMMUN" in the word element "Immunix" present in the challenged figurative was likely to be perceived as indicating "immune" or "Immunity". Of course, in the current case, neither of the marks contain the component "Immun" but rather, the even more truncated "IMM". In respect of, for example, the area of cancer research, these letters may still allude to "immune" or "immunity", but I recognise that the parties' specifications also include some broad terms that include goods/services

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that may be outside of this field (or any other field where immunity may have some relevance). In these fields the letters “IMM” present in both marks will be perceived as having no meaning. The proprietor’s mark also contains the word/letters “TAX”. There is nothing before me to suggest that (a) the letters “T”, “A” and “X” have any meaning in the fields covered by the lists of goods and services, nor (b) that the word “TAX” has any meaning in these fields. Therefore, it appears to have no meaning beyond the obvious reference to the compulsory contribution citizens are required to pay to state revenue. In summary, the applicant’s marks will be perceived as being/including an invented word but may, nevertheless, weakly allude to “immunity” in certain fields. The proprietor’s mark will be perceived as the invented combination of “Imm” and “TAX”. Again, insofar as the mark is used in respect of a field where immunity is relevant/topical, the “Imm” component may be perceived an weakly allusive reference to “immunitry”. The word “TAX” imparts, if anything, the meaning of the compulsory financial contribution to the state. In cases where “IMM” will be perceived as alluding to “immunity” there is a low level of conceptual similarity between the marks. In other cases there is no similarity.

48. Turning to the similarity between the applicant’s figurative mark and the proprietors mark, the aural and conceptual considerations are identical to the above with the figurative elements not contributing to the aural characteristics of the applicant’s mark nor obviously adding anything to the conceptual analysis as it is not clear what, if anything, they are indicating. Aural similarity is medium and conceptual similarity is low (where “IMM” is perceived as alluding to “immunity”) or absent where it is not.

49. Visually, the three figurative elements of the applicant’s mark add a further point of dissimilarity but because of the dominance of the word element the impact upon visual similarity is only slight and I conclude that there is still a low to medium level of visual similarity.

Average consumer and the purchasing act

50. 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.

51. 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."

52. It is common ground that there are two relevant consumers, namely medical professionals and members of the general public. Mr Traub submitted that the level of care and attention paid by medical professionals will be high and that with the general public the level of care and attention will be slightly lower. Ms Blythe submitted that the general public will pay as much attention as the medical professional and relied upon two cases to support this[29].

53. The respective goods and services are all medical goods and services that may be purchased by ordinary members of the public seeking treatment for a specific condition or by medical professionals. It is likely that both average consumers will pay a higher level of attention when purchasing such goods because of the need to ensure that the goods and services are both safe and appropriate to treat the given condition. Once again, I don't believe there is much distance between the parties' views and I conclude that there is a higher than average level of care and attention in respect of both categories of average consumer.

[29] *Tolposan*, T-331/09 at [26] and *Zydus*, T-288/08 at [36]

Distinctive character of the earlier trade mark

54. 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 *WindsurfingChiemsee* 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)."

55. It is common ground that the applicant's marks are endowed with an average (or normal) level of inherent distinctive character.

56. Mr Traub submitted that this distinctive character has been enhanced because of the applicant's success in the market stating that UK specialist consumers would be aware of its EU activities.

57. Ms Blythe submitted that the applicant was not able to rely upon a claim of enhanced distinctive character because it was not pleaded. I accept the general

point that pleadings should be as full as possible so as to set out the scope of the dispute, however, the absence of any specific reference in the pleadings to enhanced distinctiveness is not fatal to the applicant's case. This is because the assessment of distinctiveness is one of the fundamental factors that needs to be assessed in every case and, as is clear from the case-law, this can come from either the inherent nature of the mark, its use, or indeed a combination of both. Therefore, if evidence has been filed, it is incumbent upon me to factor that evidence into the assessment to decide upon the overall distinctiveness of the earlier mark. It would be perverse to do otherwise, as it would require a pretence as to the true level of distinctiveness on the part of the average consumer, based on a technicality.

58. Ms Blythe went on to submit that if she was wrong then the evidence still falls a long way short of demonstrating enhanced distinctive character and that it was plain from the evidence that UK consumers had not been exposed to the mark to any great degree. The evidence identifies a small number of UK-focussed activities. Firstly, there is the collaboration with Cancer Research UK that was launched in 2010 and appeared to conclude in 2014 and there is also the collaboration with GSK. Ms Blythe submitted that this falls short of illustrating an enhanced distinctive character and, further, only illustrates that any UK activity would only be known by a specialist public and then, only in respect of cancer research (in Class 42).

59. Taking all of this into account, I conclude that the scale of use shown in the UK is insufficient to result in any material increase in distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

60. 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.

61. 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 who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

62. I have found that:

- The Class 5 goods in earlier figurative mark are identical to the proprietor's Class 5 goods but the applicant cannot rely upon its Class 5 goods in respect of its earlier word mark;
- The respective services share a low level of similarity;
- The distinctive character of the proprietor's mark resides in the combination of the two terms "Imm" and "TAX" that have roughly equal dominance in the mark;
- The distinctive character of the applicant's marks resides overwhelmingly in the word "IMMATICS";

- The respective marks share a low to medium level of visual similarity, a medium level of aural similarity and a level of conceptual similarity of low or none depending on how the marks are perceived;
- The average consumer is both medical professionals and members of the general public who both pay a higher than average level of care and attention is involved in the purchasing process that is primarily visual in nature. However, I do not ignore that aural considerations may play a part in some instances;
- The inherent distinctive character of the earlier marks are average and they have not been enhanced through use.

63. I will, firstly, consider the issue of likelihood of confusion between the proprietor's mark and the applicant's word mark. Taking all of the above into account, I find that the mere coincidence of the letters "IMM" appearing at the beginning of the respective marks is not sufficient to create a likelihood of confusion even when keeping in mind that the respective Class 5 goods are identical. The common occurrence of the letters "IMM" at the start of both marks, keeping in mind that in respect of many of the parties' goods and services these letters are likely to be seen as an allusive reference to "immunity", is likely to be perceived by the average consumer as no more than coincidence. The differences in the remaining parts of the marks are sufficient to create marks that are sufficiently different that there will be no likelihood of confusion. The same applies to the situation where the "IMM" is perceived as having no allusive message. I find that there is no likelihood of direct confusion where one mark would be confused for the other.

64. The applicant has argued that "ImmTAX" can also be presented as "Immtax" or "IMMTAX". I do not agree. The mark presents as the two distinct conjoined elements "Imm" and "TAX" and to vary the case in which it is presented would have the effect of creating a single invented word rather than two distinct elements. The mark "ImmTAX" does not confer rights in presentations that change its distinctive character or where it presents as one word rather than two distinct elements. It could be argued that presentations of the proprietor's mark in this way would create greater similarity. In light of my comments, such a comparison is not correct.

However, even if I am wrong and the proprietors mark could be presented as “Immtax” or “IMMTAX”, the respective marks remain sufficiently different that there remains no likelihood of confusion.

65. In the absence of a likelihood of direct confusion, I will also consider the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

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

66. I recognise that a finding of indirect confusion should not be made merely because the two marks share a common element.[30] This is the case here. Whilst the respective marks both begin IMM, this is not so strikingly distinctive that the average consumer would assume that no one else other than the brand owner would be using it in a trade mark. On the contrary, the average consumer may well perceive the allusive reference to "immunity" when used in the context of the relevant goods. Therefore, the issue before me is not an example of the type of situation referred to in (a), above. Clearly situation (b) does not apply to the current situation and neither if the difference between the respective marks such that one mark merely differs by an element that would be perceived as a logical and consistent brand extension of the other mark. I do not understand the three categories referred to in *L.A. Sugar* to be exhaustive, but there is no other circumstance obvious to me where indirect confusion would occur when considering the respective marks in these proceedings.

67. I conclude that there is no likelihood of indirect confusion.

68. At the hearing, Ms Blythe drew my attention to a decision of the EUIPO[31] and submitted that I should find the same way. The applicant in the current proceedings brought an opposition against a figurative mark "Immunix" where the earlier mark relied upon was the figurative mark relied upon in the current proceedings. I am not bound by a decision of the EUIPO and further, the case is not on "all-fours" with the current case because the contested mark in those proceedings is different to the contested mark in the current proceedings. Nevertheless, my findings in the current case appear to be consistent with the findings of the EUIPO in that case. I need not comment further.

[30] See the decision of Mr James Mellor Q.C. sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
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69. It follows from the above findings that the application for invalidation, insofar as it was based upon the applicant's word mark, would have failed. It follows that, insofar as the invalidation relied upon the applicant's figurative mark, the application would also fail.

70. Further, even if I am wrong regarding my findings on genuine use and the applicant could have been entitled to rely upon all its goods as well as the services listed in its 810851722 IMMATICS mark, this would not have changed the final outcome. Similarly, even if the applicant could have relied upon proper reasons for non-use it would not have changed the final outcome.

Summary

71. The application for invalidation fails in its entirety.

COSTS

72. The proprietor has been successful and it is entitled to a contribution towards its costs. At the hearing Ms Blythe requested costs on scale with the exception of the costs associated with the applicant's "late and excessive" evidence-in-reply that involved a case management conference ("cmc") to deal with its challenge to the Registry's preliminary view to refuse the applicant's request for further time to provide this evidence and it also discussed the excessive amount of this evidence. Whilst the extension of time was allowed it was only after additional reasons were provided at the cmc. Further, the applicant was required to reduce the volume of this evidence. Ms Blythe argued that the proprietor had to prepare arguments why the extra time was not justified. I agree that the proprietor is entitled to additional costs for the cmc but disagree that actual costs are appropriate. The applicant was partially successful in challenging the preliminary view to refuse the extension of time and an issue of confidentiality that was only identified on the day and did not require additional preparation. Consequently, I consider contributory costs of £250 to be appropriate. This approach acknowledges that if the applicant had provided fuller reasons at the time of making the extension of time request, that issue may not have

required a cmc to resolve but that, nevertheless, the applicant was partially successful.

73. In the circumstances, I award the proprietor the sum of £2,550 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering TM26I and preparing and filing the counterstatement:	£500
Considering evidence and preparing own evidence	£1,100
Preparing for and attending the hearing	£700
Preparation for, and attendance at cmc	£250
Total:	**£2,550**

74. I therefore order Immatics Biotechnolgies GmbH to pay Immunocore Limited the sum of £2,550. 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 22nd day of June 2022

Mark Bryant
For the Registrar