

BL O/0128/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK DESIGNATION WO0000001612512

BY

KURA ONCOLOGY, INC.

TO REGISTER THE FOLLOWING TRADE MARK:

TIPGENVI

AND

OPPOSITION NO. 428279 THERETO

BY

BEIGENE, LTD.

Background and pleadings

1. On 20 July 2021, Kura Oncology, Inc. (the “Holder”) applied to designate the UK for its word only trade mark registration **TIPGENVI**, which has a US priority date of 27 January 2021. The contested designation was published for opposition purposes in the Trade Marks Journal on 24 September 2021. Designation of the mark is sought in respect of the following goods:

Class 5 *Pharmaceutical products for the treatment of cancer.*

2. On 18 November 2021, BeiGene, Ltd. (the “Opponent”) filed a notice of opposition opposing the designation under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of one earlier United Kingdom Trade Mark (UKTM):

UKTM No. 3551296

TIZVENI

Filing date: 3 November 2020

Registration date: 12 March 2021

3. For the purposes of this opposition, the Opponent relied upon all of the goods for which the earlier mark is registered, namely:

Class 5 *Medicines for human purposes; cachets for pharmaceutical purposes; capsules for medicines; pharmaceutical preparations; chemico-pharmaceutical preparations; drugs for medical purposes; chemical preparations for pharmaceutical purposes; biological preparations for medical purposes; chemical preparations for medical purposes; diagnostic biomarker reagents for medical purposes.*

4. Since the filing date of the earlier mark predates that of the contested designation, the Opponent’s mark is considered to be an “earlier mark” in accordance with section

6 of the Act.¹ However, as the earlier mark has not been registered for a period of five years or more before the filing date of the contested application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

5. The opposition is aimed against all of the goods in the contested designation. The Opponent submitted that registration of the contested mark would be contrary to Section 5(2(b) on the basis that it is similar to the earlier mark, and that the contested goods are similar/identical to those of the earlier mark. The Opponent argued that there exists a likelihood of confusion and association between the contested mark and earlier mark, which would create the risk of the relevant public believing the contested goods come from the same or an economically linked undertaking responsible for the goods of the earlier mark.

6. The Opponent submitted that each mark starts with the same letter combination 'TI', and each mark also contains the same subsequent letters 'E', 'N', 'V' and 'I'. The Opponent contended that the only difference between the marks is limited to the change of letters from 'TZ' to 'PG'. The Opponent argued that as a result, the marks are visually similar. The Opponent argued that the marks are also phonetically similar, due to the similar enunciation of each mark's respective three syllables: TIZ-VEH-NI and TIP-GEN-VI. The Opponent submitted that neither mark has a conceptual meaning, and that the earlier mark has inherent distinctive character.

7. The Opponent argued that the earlier mark's goods (specifically *medicine for human purposes*) are broad enough to cover the contested goods, and as a result are self-evidently identical. The Opponent submitted that in the alternative the goods at issue are at least highly similar, due in part to the fact that they are sold or dispensed in the same places, namely pharmacies, and come from the same source, being the pharmaceutical industry.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

8. The Opponent submitted that the relevant public would include members of the general public, as well as business customers with specific professional knowledge and expertise in the medical sector, and also medical professionals and practitioners. The Opponent contended that the attention level of the relevant public for the goods at issue is relatively high, however, the Opponent submitted that account must still be taken for the possibility of imperfect recollection. The Opponent submitted that an important factor to be taken into account when assessing the risk of confusion is that pharmaceuticals can be prescribed via handwritten prescriptions.

9. On 4 April 2022, the Holder filed a counterstatement in which it denied that the marks are either visually or phonetically similar, and also denied that the goods are identical or similar. The Holder submitted that the highly specialized nature of the parties' goods would mean that the consumer is certain to be a doctor or medical professional, and as such would take utmost care when prescribing or administering the goods. Due to the degree of attention and visual and phonetical dissimilarity between the marks, the Holder argued there would be no likelihood of confusion.

10. Neither party submitted evidence. No Hearing was requested.

11. On 19 December 2022, the Holder filed submissions in lieu of a Hearing. The Holder submitted that the identity of the relevant consumer is of particular importance in this opposition, as the contested goods are highly specialist pharmaceutical products for the treatment of cancer. As such, the relevant consumer is the professional clinician or professional procurement specialist acting for the NHS, both of whom would pay attention of the very highest order. The Holder contended that although it is settled case law that the relevant consumer is composed of users likely to use both the goods of the earlier mark and the contested goods (see T-408/09, *Acotel SpA*, paragraph 38), when the goods of one party are contained within the larger list of goods of the other party then the relevant public is defined in relation to the more specific wording (see *ibid*, paragraph 39). As such, the identity of the relevant consumer is determined on the basis of the contested goods, meaning it will not include the general public.

12. The Holder submitted that although the letters 'T', 'I', 'E', 'N' and 'V' are common in both marks, the marks themselves are not of the same length nor are they anagrams

of each other. The Holder submitted that the earlier mark contains the “rare and visually striking letter ‘Z’”, which is used in combination with the letter ‘V’ to create a “vanishingly rare” letter sequence that is present only in the foreign language loanwords *rendezvous* and *barmitzvah*. The Holder submitted that the sequence ‘ZV’ is not contained in the designation. The Holder further submitted that the combination ‘PG’ is equally uncommon and visually striking, and is contained only in the designation.

13. The Holder argued that whilst both marks begin with the letters ‘TI’ and both end with the letter ‘I’ they do not share one syllable in common, with the earlier mark being TIZ-VE-NEE and the contested mark being TIP-GEN-VEE.

14. The Holder argued that although the relevant consumer normally perceives a mark as a whole, and does not proceed to analyse its various details, the fact remains that when perceiving a verbal sign the consumer will break it down into elements that resemble words they know (see T-256/04, *Mundipharma*, paragraph 57). According to the Holder, the relevant consumer would therefore perceive and understand the terms ‘TIP’ and ‘GEN’ in the designation, with ‘GEN’ being shorthand for generation (no definition was provided for ‘TIP’). Likewise, the consumer may recognise and understand the letter string ‘VENI’ in the earlier mark to be either a medical term of/relating to veins, as in *venipuncture* and *venisuture*, or the Latin word for ‘I came’, from the well-known phrase ‘Veni, vidi, vici’.

15. The Holder argued that the element ‘TIP’ in the earlier mark is the dominant and distinctive component on the basis that it is the first syllable, whereas the dominant and distinctive component in the earlier mark is not the first syllable, but is rather the combination ‘ZV’.

16. Both parties are professionally represented. The Holder is represented by CSY London, and the Opponent is represented by Ashfords LLP.

Decision

17. Although the UK has left the EU, section 6(3)(a) of the European Union (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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b)

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

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

(a) ...

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

19. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

20. The respective goods are:

Earlier mark	Contested designation
<i>Class 5: Medicines for human purposes; cachets for pharmaceutical purposes; capsules for medicines; pharmaceutical preparations; chemico-pharmaceutical preparations; drugs for medical purposes; chemical preparations for pharmaceutical purposes; biological preparations for medical purposes; chemical preparations for medical purposes; diagnostic biomarker reagents for medical purposes.</i>	<i>Class 5: Pharmaceutical products for the treatment of cancer.</i>

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

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

22. 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.

23. It has also been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

24. The earlier mark is registered for a number of general categories that would include an array medicines, drugs and pharmaceutical preparations. The contested goods *Pharmaceutical products for the treatment of cancer* are undoubtedly included within a number of the more general categories of the earlier mark, perhaps most specifically the *Medicines for human purposes; pharmaceutical preparations; and drugs for medical purposes*. Therefore, in accordance with the *Meric* principle, the contested goods are considered to be identical to the goods of the earlier mark.

Comparison of the marks

25. 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 CJEU 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.”

26. It would be wrong, therefore, to dissect the trade marks artificially, 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.

27. The respective trade marks are shown below:

Earlier mark	Contested designation
TIZVENI	TIPGENVI

28. The earlier mark is presented in a standard typeface. It consists of the term ‘TIZVENI’, which is not an English-language word. Whilst the Holder has provided submissions as to the meaning of certain components, neither party has provided submissions as to any potential meaning of the term as a whole, and it is therefore assumed to be a seemingly invented term. The overall impression of the seemingly invented term is where any distinctiveness must lie.

29. The contested mark is presented in a standard typeface. It consists of the term 'TIPGENVI', which is not an English-language word. Whilst the Holder has provided submissions as to the meaning of certain components, neither party has provided submissions as to any potential meaning of the term as a whole, and it is therefore assumed to be a seemingly invented term. The overall impression of the seemingly invented term is where any distinctiveness must lie.

Visual similarity

30. Visually, the marks are similar insofar as they coincide in the first and second, fifth and sixth, and respective last letters. In total, the number of identical letters in each mark is five. This is the extent of the visual similarity. The marks differ visually as to their respective third and fourth letters, whilst the contested mark also has an additional letter (seventh) before the last letter 'I', which has no counterpart in the earlier mark. Overall, I consider the marks to be visually similar to a medium degree.

Aural similarity

31. The earlier mark consists of the three syllables TIZ-VEN-EE, whilst the contested mark consists of the three syllables TIP-JEN-VEE. The respective first syllable of each mark has an identical opening sound (TI). However, the closing of each first syllable is quite different (Z and P respectively). The respective second syllables have a different opening vocal (V and J respectively), however, they end identically (EN). The transition between the end of the respective first syllable and beginning of the respective second syllable is notably quite different: IZ to VE, and IP to JE. The third syllable of the contested mark has an opening vocal that is not replicated in the earlier mark (V). However, the ending of each respective third syllable (and likewise the ending of each respective term) is identical. Overall, I consider the marks to be aurally similar to a degree between low and medium.

Conceptual similarity

32. The Holder contended that the component 'VENI' in the earlier mark would be perceived by the relevant consumer as a medical term that relates to veins, and referred to the words *venipuncture* and *venisuture* to support this. Neither a dictionary

nor medical journal was provided to evidence this submission. It is possible that a professional in the field of medicine and pharmaceuticals will be aware of the suffix as meaning vein, however, I do not find it likely that the general public would be aware of such a meaning. I also consider it unlikely that either the general public or the medical/pharmaceutical professional would be aware of the meaning of 'VENI', from the cited Latin phrase 'Veni, vidi, vici'. Whilst I believe that a number of each type of consumer would be aware of the phrase 'I came, I saw, I conquered', I consider it less likely that they would be aware of the Latin origin, although I do not entirely dismiss the possibility.

33. The Holder also contended that the contested mark contains two components with recognisable meanings: 'TIP' and 'GEN'. Whilst no meaning was provided for 'the component TIP', it may be perceived as the verb to overturn or tilt, or a place for depositing rubbish. The meaning of 'GEN' was provided as a shorthand version of generation. I do not totally discount the possibility that the components would be perceived as having such meanings, and I also recognise the finding in the judgment as referred to by the Holder whereby a consumer may break a verbal mark into elements which resemble words known to them. However, I consider it unlikely that either the professional or member of the general public would do so in relation to the marks at issue, as it would require them to artificially dissect the contested mark into words which have no immediately obvious relationship to the goods at issue (it is noted that the Holder did not make submissions as to the relationship between the apparent concepts of the components and the goods at issue).

34. Due to the fact that neither the earlier mark nor the contested mark have any obvious conceptual meaning as a whole, there can be no conceptual comparison.

Average consumer and the purchasing act

35. 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.² In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited,*

² *Lloyd Schuhfabrik Meyer, Case C-342/97*

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.”

36. The contested goods are *Pharmaceutical products for the treatment of cancer*, whilst the goods of the earlier mark are more broad and cover goods that would logically fall under the category of medical, pharmaceutical, and drugs. The Holder argued that the relevant consumer should be identified based on the category of goods of the contested mark only, in which case the consumer should be considered to be the professional clinician or professional procurement specialist acting for the NHS, and not the general public. I disagree. As acknowledged by the Holder, the identity of the average consumer must be constructed based on an assessment of all of the goods at issue. This includes both the contested goods and the goods of the earlier mark. The reason that consideration must be paid to the consumer of the entire scope of goods is because it is the likelihood of confusion in the mind of the same consumer encountering the two different marks on goods that have been found to be identical or similar which must be considered.

37. The goods at issue include very specific and specialised goods, such as *Pharmaceutical products for the treatment of cancer*, but also include the more general category of *medicines for human purposes*, which could be as un-specialist and everyday as cough syrup or paracetamol, or any number of remedies that can be bought without prescription or over-the-counter. Therefore, the type of consumer will vary greatly. I do agree with the Holder’s submission that the level of attention will be high (although not “of the very highest order”, as in my view the consumer is not limited to the professional clinician or procurement specialist acting for the NHS). In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the GC (as it then

was) considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 ...

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and

consumers belonging to the general public with a higher than average degree of attentiveness.”.

38. In relation to either type of good at issue, for which the consumer can vary from a professional prescribing a specific treatment for cancer to a consumer buying pain relief ointment in the pharmaceutical section of a supermarket, the level of attention will be higher than it would in relation to everyday consumer items. Indeed, as identified in *Olimp Laboratories*, even a patient (i.e., average end consumer/general public) is “*less likely to confuse different versions of such goods*” when the medicinal goods are either prescribed by a medical professional or when they are sold without prescription, i.e., when they are bought over-the-counter.

39. The purchase process of the goods at issue is likely to be dominated by the visual aspect. When the consumer is the medical professional it is essential that they pay a high degree of attention to the product they are prescribing, and so will closely scrutinise the mark presented. Similarly, when the consumer is the patient (end consumer/general public) buying the goods themselves, they too are more likely to pay attention and closely read the marks presented (see *Olimp Laboratories* paragraph 40). I am aware that prescriptions and pharmaceutical preparations are also often requested orally in a pharmacy, and so I do not discount the possibility that there may be an aural element to the purchasing process.

Distinctive character of the earlier trade mark

40. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has the Opponent filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

41. 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).”

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

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

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

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

43. The earlier mark has no obvious meaning in the English language, and therefore it has no apparent link to the goods at issue. Neither party has provided submissions as to any supposed link to the goods either. As a seemingly invented word, the earlier mark 'TIZVENI' can be said to be inherently distinctive to a high degree. The distinctiveness lies in the mark as a whole, which does not have an identical counterpart in the contested mark. This will affect the likelihood of confusion.

Likelihood of Confusion

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

45. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The factors include the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

46. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

“50 ...Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

47. Considering the nature of the goods at issue, I am of the opinion that the purchasing process will most likely be dominated by the visual aspect of the respective marks. With this in mind, it is worth noting that I have found the marks to be visually similar to a medium degree. However, I am also of the opinion that the aural aspect of the marks at issue cannot be discounted in the purchasing process, in which case it is also worth noting that I have found the marks to be aurally similar to a degree that is between low and medium.

48. As part of the global assessment, it is necessary to keep in mind the nature of the average consumer and their degree of attention. Whilst I have disagreed with the Holder's submission that the identification of the consumer should be limited to the professional, I have nevertheless agreed with the Holder that the level of attention of

the respective consumer will be high. I attribute this heightened sense of attention not only to the professional consumer but also to the consumer who could purchase some of the goods without prescription in a supermarket, for example.

49. My opinion as to the relevant consumer reflects the reality identified by the GC in the judgment *Mundipharma AG v OHIM*, Case T-256/04. In this judgment, the GC accepted that there were two groups of relevant consumers for a pharmaceutical product, being both professional users and the general public. In that instance, the marks were considered to be only weakly distinctive to professional users which subsequently ruled out a likelihood of confusion on their part. However, the descriptive qualities of the marks at issue were not apparent to the general public, for whom the marks were found to be highly similar, leading to a likelihood of confusion. The court expressed its reasoning as follows:

“70. It has been established above, first, that the goods in question were identical and, second, that the opposing marks were somewhat similar for the professional public and highly similar for the end consumers.

71. As to the distinctive character of the earlier mark, the Court observes that it will be understood as being descriptive by both types of relevant public, although to varying degrees. As mentioned above in the discussion of the conceptual similarity, the professional public will perceive both components as being descriptive of the purpose of the active ingredient of the product in question, whereas the end consumers will not ascribe any particular conceptual meaning to the component ‘cort’, but will be able to understand the reference made by the component ‘respi’.

72. Accordingly, the earlier mark may be regarded as having a weak distinctive character for the relevant public, particularly health care professionals. In that regard, the applicant’s submissions on the frequent use of ‘allusive signs’ in the sector of therapeutic preparations cannot be accepted, first, because they have not been developed any further and, second, because the applicant has not explained the relevance of that fact to the specific case of the earlier mark.

73. Moreover, although, because of the interdependence of the relevant factors for the assessment of the likelihood of confusion and the fact that the more distinctive the mark on which the opposition is based the greater will be the likelihood of confusion (*Lloyd Schuhfabrik Meyer*, paragraph 20), the weak distinctive character of the earlier mark precludes any likelihood of confusion for the professional public, that fact is not sufficient in respect of the end consumers, for whom the opposing marks are highly similar.

74. Accordingly, the Court finds that there is a likelihood of confusion between the mark applied for and the earlier mark in the minds of German end consumers. The single plea must therefore be upheld and the contested decision consequently annulled, without its being necessary to consider the relevance for purposes of the present case of the decision of the Deutsches Patent- und Markenamt relied on by the applicant”.

50. Considering that the types of goods at issue in the above judgment were identical (in part) to the goods at issue in these proceedings, the reference to the judgment is appropriate. It is also a judgment that was referred to by the Holder, and is therefore worth considering. In the judgment, the similarity of the marks at issue led to a finding of a likelihood of confusion for the general public. However, I do not feel obliged to find the same conclusion, nor do I consider the aspects of the marks in the judgment to be on all fours with the marks in the current proceedings. The judgment above considered the marks ‘RESPICUR’ and ‘RESPICORT’, with the Court finding that each mark would be considered to be descriptive to varying degrees by each type of consumer. This is not the case in relation to the marks at issue in these proceedings, as I have not found either the earlier mark ‘TIZVENI’ nor the contested mark ‘TIPGENVI’ to be descriptive in the eyes of either type of consumer. Whilst I acknowledge the Holder’s submissions that certain components may have certain meanings (i.e., a possible reference to vein/Latin for ‘I came’ in the earlier mark, and shorthand for generation in the contested mark), these components are not necessarily descriptive in relation to the goods at issue (nor have they been argued to be), and even if they were they are only disguised fragments of a larger word which as a whole is not descriptive. An additional difference between the marks at issue in these proceedings and the marks in the cited judgment is that the earlier mark RESPICORT was considered to have

weak distinctive character, which is in stark contrast to the highly distinctive earlier mark in the current proceedings.

51. The high degree of attention that each type of consumer would pay to the goods at issue does not equate to a finding of a likelihood of confusion. In fact, by paying a higher degree of attention to the marks any difference between them is more likely to be noticed. In *Claude Ruiz-Picasso*, C-261/04 P, the CJEU found:

40 ““Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between the marks relating to such goods at the crucial moment when the choice between those goods and marks is made”.

52. Having conducted a global comparison of the marks it is my opinion that the marks at issue will not be directly confused. Rather, I believe that the visual and aural differences between the marks are more likely to be acknowledged by the attentive consumer. Whilst the principle of interdependency identifies that a greater degree of similarity between the respective goods may offset a lesser degree of similarity between the respective trade marks, I consider the differences between the marks to be too great to be offset by the identity of the goods.

53. Having found there to be no likelihood of direct confusion, I shall now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.³ Further, there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.⁴

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

³ In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCH Civ 2017, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (as he then was, sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.

⁴ *Ibid*, Arnold LJ’s words at paragraph 13.

“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).”

55. Whilst I acknowledged the Holder’s submission that the marks share certain combinations of letters, such as ‘TI’ and ‘EN’, I would not go so far as to consider them to be an element that the marks have in common, and which no-one else but the brand owner would be assumed to be using. In addition, I do not consider the later mark to

have merely added a non-distinctive element to the earlier mark in the same way as the addition of 'LITE' or 'EXPRESS' would be perceived. Rather, the differences between the marks are specific and deliberate, and distinctive combinations of letters. Further, those differences in the later mark, such as the letter combination 'ZV', are not entirely logical or consistent with a brand extension.

56. Although I do not consider the combinations of letters to lead to a likelihood of confusion in general, the fact that the marks begin with the same combination must nevertheless be addressed. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

57. The marks at issue in the GC judgment were ‘MUNDICOLOR’ vs ‘MUNDICOR’. The GC made it clear that the strong visual similarity was due in part to the marks sharing the “same root”. I do not consider the coincidence of the letters ‘TI’ in the marks in these proceedings to constitute a shared ‘root’ to the same degree that ‘MUNDI’ was in the respective marks in the *El Corte Inglés* judgment. This is not only because ‘MUNDI’ is longer, and therefore has a more significant visual and aural impact, but also because it had concept which the combination ‘TI’ does not. In addition, I do not consider the letters ‘TI’ to be on a comparable level with ‘MUNDI’ as a prefix, which the GC considered ‘MUNDI’ to be.

58. Further, whilst the marks share the combination ‘TI’ and ‘EN’, this in and of itself should not lead to a finding of indirect confusion. In this regard I refer to *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which Mr James Mellor Q.C. (as he then was), stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark, as this would be mere association rather than indirect confusion. Whilst the marks share the combinations ‘TI’ and ‘EN’, I again make clear that I do not consider such combinations to constitute elements. In any case, and if they were to be considered elements, this would not be enough to find indirect confusion.

59. I note that the marks end with the same letter ‘I’. The coincidence of the identical final letter does not lead to a likelihood of confusion either, as although the GC considered the possibility of a likelihood of confusion based on the ending of the marks at issue in *Bristol Global Co Ltd v EUIPO*, T-194/14, in that case the common element was the word ‘STONE’, which self-evidently has a greater visual, aural and conceptual impact than the single letter ‘I’.

60. Having found there to be no direct confusion there would need to have been a “proper basis” for finding there to be a likelihood of indirect confusion.⁵ Having maintained the correct principles of law firmly in mind, I am of the opinion that upon seeing the contested mark the attentive consumer would not carry out the mental process whereby they either consciously or unconsciously assume it to be a logical

⁵ *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCH Civ 2017, paragraph 13,

extension of the earlier mark based purely on the coincidence of certain shared letters, which have no concept, and which have differing impacts on the overall impression of each mark. This is especially so due to the high level of attention paid by the average consumer, who is acutely more aware of the differences between marks that are closely scrutinised.

Conclusion

61. The opposition fails under Section 5(2)(b). Subject to an appeal, the contested application will proceed to registration.

Costs

62. As the opposition has failed, the Holder has been successful and is entitled to a contribution to its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Holder the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering a notice of opposition

and filing a counterstatement	£300
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Preparing submissions in lieu of a Hearing	£400
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Total	£700
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63. I therefore order BeiGene, Ltd. to pay Kura Oncology, Inc. the sum of £700. 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 6th day of February 2023

Dafydd Collins

For the Registrar