

BL O/0406/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001588240

DESIGNATING THE UK

BY MERZ PHARMA GMBH & CO. KGAA:



IN CLASSES 1, 5 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 429790

BY EXTRACT TECHNOLOGY LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark 1588240 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Merz Pharma GmbH & Co. KGaA. The IR is registered with effect from 27 February 2021.

2. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The mark also claims priority from 21 September 2020.

3. The request to protect the IR was published 1 October 2021. On 31 December 2021, Extract Technology Limited (“the opponent”) partially opposed the protection of the IR in the UK. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against class 42 of the application.

4. The opponent relies upon the following trade marks:

EXTRACT TECHNOLOGY

UK registration no. UK00002254988

Filing date 5 December 2000; Registration date 28 July 2001.

(“The First Earlier Mark”)



UK registration no. UK00913056866

Filing date 4 July 2014; Registration date 6 January 2015.

(“The Second Earlier Mark”)

5. As shown above, the opposition is based upon the opponent's First Earlier UK mark and its Second Earlier comparable UK trade mark (EU).¹

6. The opponent relies upon some of its goods and services for which its earlier marks are registered, as underlined in the Annex to this decision.

7. The opponent claims that there is a likelihood of confusion because the goods and services are either identical or similar, and the marks are aurally and conceptually identical.

8. The holder filed a counterstatement denying the claims made and putting the opponent to proof of use.

9. Both parties filed evidence in chief, and the opponent filed evidence in reply. A hearing took place before me on 14 March 2023. The opponent was represented by Mr Alan Fiddes of Murgitroyd & Company. The holder was represented by Mr Nick Zweck of Counsel, instructed by Keltie LLP.

10. 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 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.

EVIDENCE

11. The opponent's evidence consists of the first witness statement of Mr Alan Wainwright dated 23 June 2022. Mr Wainwright is the Managing Director of the opponent, a position which he has held since 30 June 2021. Mr Wainwright's statement was accompanied by 11 exhibits (AW1-AW11).

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

12. The holder's evidence consists of the witness statement of Mr Alistair Gay dated 23 August 2022. Mr Gay is a Chartered Trade Mark Attorney at Keltie LLP, the representatives for the holder. Mr Gay's statement was accompanied by 2 exhibits (ARG1-ARG2).

13. The opponent's evidence further consists of the second witness statement of Mr Alan Wainwright dated 14 November 2022. Mr Wainwright's statement was accompanied by 3 exhibits (AW12-AW14).

Proof of use evidence

14. The predecessor of the opponent was founded under the name Extract Technology Limited ("the original company") in 1981 which was formed to design, manufacture and supply downflow booths to the pharmaceutical manufacturing industry. In April 2000, the original company was acquired by Carlisle Companies Inc, and following a corporate re-organisation, the opponent was formed in 2006. The assets of the original company (including the First Earlier Mark and its goodwill) was transferred to the opponent. I note that **exhibit AW2** includes article printouts to support the above information.

15. Mr Wainwright states that a downflow booth "is primarily used in the pharmaceutical industry to provide a safe working area for operators to protect them from hazardous, sensitising or toxic substances during the handling of powders and solvents. These typically include sampling and dispensing of materials and, depending upon the application, two main configurations are used: 1) re-circulatory booths are used for powder operations; and 2) once-through booths are recommended where solvent or fume vapours are present". The opponent and the original company has been designing and selling downflow booths under the First Earlier Mark since around 1984. Mr Wainwright's witness statement contains the following photograph of a downflow booth demonstration unit which was exhibited at C.O.S.H.H. Environment and Safety Exhibition in London in 1990:



16. In or around 1996, the original company entered the containment isolators market, and the opponent has since used the EXTRACT TECHNOLOGY mark in relation to containment isolators globally. Mr Wainwright highlights that “a containment isolator is designed to not only provide a physical barrier between the operator and the product but also to provide a controlled environment, negatively pressurised with an atmospheric condition or a reduced oxygen content using an inert gas”.

17. In or around 2008, the opponent entered the aseptic isolators market and has since used the EXTRACT TECHNOLOGY mark in relation to these. Mr Wainwright highlights that “aseptic isolators are routinely found within the pharmaceutical industry and are widely used for a number of applications including sterility testing, compounding, sterile injectables, pharmacy dispensing, liquid filling, aseptic transfer, medical device manufacture and assembly, packaging and the integration of key monitoring, processing and decontamination systems”.

18. **Exhibit AW3** contains copies of brochures relating to the sale of their standard products, containment solutions and aseptic solutions. Mr Wainwright confirms in his witness statement that the brochures have been in use before the filing date. I note the following from this exhibit:

Standard Solutions Brochure:

- This includes the opponent's unidirectional flow standard aseptic isolator, a standard containment isolator, a flexipharm, a turbulent flow standard aseptic isolator and a mobile automated glove tester.
- The Steripharm turb is "designed to offer increased protection and quality assurance of process integrity by utilising single pass turbulent flow".
- The Steripharm UDAF is ideal for sterile testing, and utilises recirculated unidirectional airflow achieving a grade A environment.
- The Flexipharm and Isopharm are both apart of their "standard containment solutions".
- The glove tester is capable of testing 1 to 6 glove ports at one time.
- EXTRACT TECHNOLOGY also offers custom containment and aseptic systems as well as mobile cleanroom solutions including; downflow booths, custom containment isolators, sampling facilities, mobile cleanrooms, custom aseptic isolators and pack off and process.
- The opponent has a UK office in Huddersfield and a US office in New Lisbon.

Containment Solutions Brochure:

- This includes the opponent's downflow booth, containment isolator, sampling facility, and pack off and process.
- "Complete containment solutions based around an innovative range of Downflow Containment Booths bring different features and benefits to your application".
- These provide a clean, contained environment for safe handling of powders in dispensing, weighing, sampling or subdivision operations.
- The Downflow booth provides a physical barrier between the active product and the operator, and thereby immediately improving the attainable containment levels.
- The Downflow booth has boosted "energy savings of up to 70% compared to that of conventional systems".

- “Extract Technology has prided itself on being at the forefront of Booth design for the last 30 years”.
- The Downflow booth provides “a suitable cGMP environment for operators to perform either sampling or dispensing tasks in a safe and comfortable atmosphere. Extract Technology facilities are high class state of the art pieces of equipment. Complete with material and personnel airlocks and a downflow booth, the facility operates with a positive pressure to aid in achieving a clean cGMP environment”.
- The downflow booths are made to order, but they are usually designed around the standard downflow booth sizes.
- Extract Technology Rigid Containment Isolators have been designed for handling potent compounds and their designs for sampling, dispensing and sub-division, mixing, milling and vessel charging as well as containing integrated process devices such as filter dryer units, tablet press enclosures, blenders mills and pack off systems. It provides a controlled environment, negatively pressurised with an atmospheric condition or reduced oxygen content using an inert gas.

Aseptic Solutions Brochure:

- This includes the opponent’s filling line isolator, sterility test isolator, C-RABS and O-RABS, and cell therapy isolator.
- Custom sterility test isolators are designed to allow operators to perform sterility testing in an aseptic environment providing assurance of process integrity. They also provide a controlled means of loading and removing the processed product and waste materials from the isolator enclosure.
- The opponent offers custom designed isolators to suit the individual customer requirements including half suits, 6 glove ports, multiple chamber construction and custom sizes.
- CLOSED RABS is a positive pressure system with onboard fan/filtration units to supply HEPA Filtered air over a critical process which then passes through exhaust filters before being recirculated.

19. I also note that the above brochures use the both the opponent's First and Second Earlier marks throughout, including at the top of the brochures, as follows:



20. In his witness statement, Mr Wainwright states that the opponent provides an “excellent level of aftersales service and support”. The opponent provides spare and replacement product parts, maintenance and repair services, installation and relocation services, training, air sampling, filter integrity testing, revalidation services and preparation and bespoke product documentation. An undated brochure on the opponent's aftersales is exhibited at **AW4**. I note the following from this exhibit:

- “Extract Technology have been working with the world's leading pharmaceutical and chemical companies for over 35 years” providing expertise and recourses to help continue to provide a safe working environment.
- The opponent stocks an extensive range of spare parts including replacement filters, cooling coils and control valves, safe change filter bags and rings, gloves, ceiling and bleed PLF screens, gaskets, glove/sleeve combinations, replacement glazing panels, beta transfers and magnehelic gauges.
- The opponent's Planned Preventative Maintenance package provides a scheduled visit to undertake tests and inspect the equipment, along with necessary minor repairs and adjustments.
- The opponent's “other services” includes a training and re-training programme for the safe use of its equipment, Operator Exposure Monitoring using either real time aerosol monitoring or personal sampling, filter integrity testing, revalidation IQ/OQ and documentation.

21. Mr Wainwright states that the vast majority of its products are designed and manufactured in the UK. They are then shipped to customers throughout the EMEA region, South East Asia and Australasia. The opponent's customers are global

pharmaceutical, chemical and bio-technology companies. **Exhibit AW5** contains a printout from the opponent's website listing some of its customers, including Boots, Cancer Research UK, GSK, Johnson & Johnson, the NHS, Procter & Gamble (P&G), Pfizer and Unilever.

22. The opponent provides the following sales figures from 2015 to 2021:

Year	Turnover
2015	£8,193,770
2016	£8,938,941
2017	£10,141,584
2018	£9,948,022
2019	£10,067,536
2020	£9,381,519
2021	£10,924,977

23. The opponent has also provided the following breakdown of the above figures by category:

Product / Service	Approximate % of turnover
Standard products	20%
Containment solutions	45%
Aseptic solutions	20%
Aftersales services	15%

24. Mr Wainwright states that its total sales value of products and services provided between the 1 January 2000 and 31 December 2021 under the earlier marks amounts to approximately £195 million, but this includes the records of both the opponent and the original company. To support these figures, the opponent has provided a selection of invoices dated between 2015 to 2021 exhibited at **AW6**. I note the following:

Date	Goods and quantity	Total
07/07/15	Bus Node Digital input module	€3,664.00

	4" butterfly valve Freight charge	
20/07/15	Replacement of front glass panel on isolator Installation and leaking testing Refitting of glove ports Replacement glass panel and component parts for isolator Supply only of front panel Panel (3 glove) Window seals to be replaced With PTFE fluoroseal joint sealant	€8,208.00
17/08/15	Teva- Holland 2 x 9361 isolator Standard service visit	€3,620.00
17/08/15	NVI Bilthoven 1 x 9226/BSI III Aseptic containment isolator Repairs to festo pneumatic valve terminal Calibrate x3 exhaust value volume pressure transmitters Test all velocities/volumes/velocity Transmitter ranges Service visit	€2,364.00
25/09/15	Filter F8 Filter H13 Temperature transmitter Delta P two port screwed valve	€3,320.25
18/01/16	Filter F8 Freight charge	£2,193.60
18/01/16	Equipment to be serviced 1 x 1593 Downflow booth 1 x 2534 Downflow booth 1 x 1676 Downflow booth 1 x 1892 Downflow booth 1 x 1368 Downflow booth 1 x 1715 Downflow booth 1 x 1257 Downflow booth 1 x SP980 Downflow booth 1 x 4094 Downflow booth Small envair vertical laminar flow cabinet dop test (new unit) Service visit (Jan 2016)	£3,618.00
10/08/16	Equipment to be serviced in the labs 2 x Monmouth fume hoods Service visit	£828.00
28/10/16	100% contract extra- replace fixed technical panel on both downflow booths; nitrogen flow regulators with indicator for feeder seal flow; manufacture of liner cartridge in stainless steel for isolator; modification to pressure vessel vent pipes and re validate pressure rating.	£16,405.00

08/11/16	100% contract extra- modification to Gericke feeders	£4,806.00
02/02/17	Equipment to be serviced as part of bi-annual proposal 1 x 1593 Downflow booth 1 x 2534 Downflow booth 1 x 1676 Downflow booth 1 x 1892 Downflow booth 1 x 1368 Downflow booth 1 x 1715 Downflow booth 1 x 1257 Downflow booth 1 x SP980 Downflow booth 1 x 4094 Downflow booth Small envair vertical laminar flow cabinet dop test (new unit) Service visit (Jan 17)	£3,618.00
25/04/17	Sensor temperature/humidity Pressure switch HUBA Pressure transmitter HUBA Panel filter H14 Teflon filter Freight charge	€1,794.00
27/07/17	Filter cartridge HEPA Filter H14 for push-push	€1,074.00
04/08/17	Inflatable seal x 2 Freight charge	€2,025.00
31/08/17	LEV system for lab exhaust system	£4,258.80
14/02/18	Main filter H14 Exhaust filter H14 Pre filter H14 Freight charge	£832.80
18/07/18	100% contract extra – travel time, flight & car	£1,235.00
27/06/18	Design and manufacture 1 set GP	€1,380.00
12/07/18	Inflatable seal x 2 Freight charge	€1,528.00
31/08/18	Equipment to be serviced as part of bi-annual proposal 1 x 1593 Downflow booth 1 x 2534 Downflow booth 1 x 1676 Downflow booth 1 x 1892 Downflow booth 1 x 1368 Downflow booth 1 x 1715 Downflow booth 1 x 1257 Downflow booth 1 x SP980 Downflow booth 1 x 4094 Downflow booth Small envair vertical laminar flow cabinet dop test (new unit) Service visit (July 2018)	£3,618.00
10/01/19	100% contract extra - travel time, flight and car hire	£2,870.00
14/01/19	Fan	€1,645.00

	Freight charge	
14/01/19	Inv Pflex Inflatable seal airlock window Seal main chamber window Centrifugal fan Cartridge fuses (pack of 10) Freight charge	€5,210.00
08/02/19	Rubber 'o' ring half-cell tab (10)	€340.00
28/06/19	Equipment to be serviced in the labs 2 x Monmouth fume hoods 2 x 1800 scanlaf mars biological cabinets 1 x 900 scanlaf mars biological cabinets Service visit Dop testing for the biological cabinets KI testing for the biological cabinets Replacement front window Freight charge	£3,261.60
21/08/19	Fan Freight charge	£1,274.40
13/03/20	Dedicated visit 1 x envair desktop filtration unit Dismantle, bag up and removal of contaminated filters from site	£1,890.00
20/11/20	10% on completion and receipt of all documentation	£6,196.00
17/07/20	Equipment to be serviced as part of bi-annual proposal 1 x 1593 Downflow booth 1 x 2534 Downflow booth 1 x 1676 Downflow booth 1 x 1892 Downflow booth 1 x 1368 Downflow booth 1 x 1715 Downflow booth 1 x 1257 Downflow booth 1 x SP980 Downflow booth 1 x 4094 Downflow booth Small envair vertical laminar flow cabinet dop test (new unit) Service visit (July 2020)	£3,618.00
16/12/20	Upgrade cooling coil system (40% payment)	€11,335.60
29/06/21	10% on delivery to site	£45,775.68
25/06/21	Dedicated visit Fumecupboards To replace limit and proximity switches Commission both fume cupboards upon completion	£8,280.00
24/06/21	Southco fastener Freight charge	£114.00
25/06/21	Dedicated visit conducted on Monday 21 st and returning Tuesday 22 nd June 2021 1 x ISO	£662.40
28/06/2021	Chaysol fan	\$1,713.00

	Packing and export documentation	
29/06/21	Seal to suit DWG Freight charge	€1,060.00

25. I note that the invoices fluctuate between being in euros or pound sterling. I also note that the customer details have been redacted from the invoices. I am therefore unable to determine the location of the customers for the invoices. Furthermore, the opponent hasn't provided me with any explanation as to whether the invoices which are in pound sterling are specifically just for the UK.

26. I also note that the top of the opponent's invoices uses its marks as follows:



27. **Exhibit AW7** contains undated photographs of the opponent's products bearing its marks, including the following:



28. **Exhibit AW8** contains undated photographs of business papers and packaging materials mainly bearing the opponent's Second Earlier Mark, including their aftermarket shipping stickers, inventory labels, parcel tape, QCD labels, safe change labels and shipping labels.

29. The opponent registered the domain name <https://extract-technology.com> on 24 February 1997, and has been using it since 1998. **Exhibit AW9** contains printouts and screenshots of its website. I note the following from this exhibit:

- 3 screenshots dated 21 May 2013, 2 August 2014 and 19 September 2015 listing the categories of containment strategy, containment systems, aseptic systems, facilities, and after market. I note that the opponent's banner uses the opponent's following marks:



- 3 screenshots dated 1 October 2016, 15 November 2018 and 25 November 2020 listing the categories containment solutions, aseptic solutions, standard solutions, mobile clean rooms and customer support. I note that the opponent's banner uses the opponent's following mark:



- 1 screenshot dated 15 November 2019. Under “advanced containment solutions” it says that “Extract Technology provides a comprehensive range of containment solutions that operate under negative pressure HEPA filtered air to protect the operator from exposure to potent materials”.

30. **Exhibit AW10** contains printouts from the opponent's Twitter and LinkedIn pages. I note the following:

- The “Extract Technology” Twitter page has 1,403 followers. The profile picture is the opponent's Second Earlier Mark. The bio states that they are “worldwide

suppliers of containment & aseptic systems, for the pharmaceutical, biotech & chemical markets”. The latest tweet is dated 21 December 2021.

- The “Extract Technology Ltd” LinkedIn page contains the following in its overview; “Extract Technology has over 70 years of engineering heritage in aseptic and containment systems for pharmaceutical, biopharmaceutical, nuclear containment, and radiopharmaceutical applications. Manufacturing sites are located in New Lisbon, WI, USA, and Huddersfield, UK. Extract Technology is known for invocation in aseptic and containment isolators and downflow booth technology for a broad range of pharmaceutical applications. Extract Technology specialises in isolators and downflow booths with process integrations including for use in pharmaceutical manufacturing, cell and gene therapy processing, sterility testing and liquid and powder filling, and research and development. Equipment solutions from Extract Technology also include modular cleanrooms, cell therapy processing isolators, LAF Carts, RABS, and lab benches”.

31. In his witness statement, Mr Wainwright states that the opponent promotes its goods and services by attending internationally recognised conferences, exhibitions and trade shows because these “events are crucial within the industry” that the opponent operates in. The opponent has regularly attended events such as the PPMA trade show in the UK, Pharmatech, Cell Therapy Manufacturing and Gene Therapy Congress, ISPE Annual Meeting and Expo, ISPE Product Shows, Phacilitate, Making Pharmaceuticals, Pharma Congress and BioProcess International. I note that printouts from the opponent’s website which include details of their attendance to conferences, exhibitions and trade shows are contained within **exhibit AW11**. I note the following:

- An article dated 9 October 2015 which states that the opponent “just last week” exhibited at PPMA trade show in Birmingham NEC. The PPMA is the UK’s trade association for suppliers of processing and packaging machinery to different industries and represents over 400 members and associate companies. “It was a great three days spent on educating visitors, making new contacts and processing new enquiries which makes this show THE event to be in our industries”. A picture on the site shows the opponent’s booth which clearly

displays its Second Earlier Mark. The article goes on to list other conferences that they planned to attend that year such as:

- 24th to 27th November they were going to be exhibiting at Pharmatech in Moscow, which is the largest international exhibition in Russia and the CIS area.
 - On 26th November a team from Sales, Marketing, and Aftermarket departments were to attend the 2015 ISPE UK Annual Affiliate Conference.
 - Between 1st and 3rd December their Standard Products Development Manager was to be co-exhibiting at P-MEC in India and is a “must attend” event in the international pharmaceutical industry events within South Asia.
- The exhibit also includes another 14 articles from the opponent’s website which are dated between April 2019 and 7 March 2022, announcing the opponent’s planned attendance to a variety of conferences based in Amsterdam, the USA, Coventry (UK) and Germany.

32. I note that Mr Gay’s **exhibit ARG2**, contains internet searches conducted on 15 August 2022, showing the websites of companies operating in the field of containment technology and downflow booth technology. It is noted that the opponent’s website was not contained within this exhibit. Therefore in response to this, Mr Wainwright filed his second witness statement, and the following exhibits.

33. **Exhibit AW12** contains a letter, dated 18 October 2022, from Tim Coles who is the Technical Director of Pharminox Isolation Limited, which is a small company which specialises in the technology of pharmaceutical isolators. I note that Mr Cole has held this position since 2004, but has also been involved in the technology of pharmaceutical isolators since 1983, and therefore has a “detailed knowledge of the supplies of aseptic and containment systems used in this industry”. I note that Mr Cole states the following in his letter:

“I have been aware of Extract Technology Limited for more than 10 years as manufacturer of aseptic and containment systems for the pharmaceutical, biotechnology, cell therapy and radiopharmaceutical industries.

I consider EXTRACT TECHNOLOGY to be a trademark of Extract Technology. It is exclusively associated with the products of this company including aseptic and containment systems, isolators, downflow booths and containment gloveboxes. I am not aware of any other businesses using EXTRACT TECHNOLOGY as a trademark or business name.”

34. **Exhibit AW13** contains a letter, dated 19 October 2022, from Martyn Ryder, the founder of the opponent. It states that he has “founded, worked with and been fully aware of Extract Technology Limited for more than 41 years, both as a company and as a major manufacturer of aseptic and containment systems for the pharmaceutical biotechnology, cell therapy, radiopharmaceutical and nuclear containment industries”.

35. **Exhibit AW14** contains a letter, dated 23 October 2022, from Jon Youles who is the Managing Director of Ytron-Quadro (UK) Limited, which is a supplier of process equipment to the pharmaceutical, cosmetic and food industry. Mr Youles has been involved in the Pharmaceutical manufacturing industry since 1997, and therefore has a “detailed knowledge of the suppliers of aseptic and containment systems in this industry”. He states that he has been “aware of Extract Technology for more than 15 years as a manufacturer of aseptic and containment systems for the pharmaceutical biotechnology, cell therapy, radiopharmaceutical and nuclear containment industries”.

Proof of use case law

36. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark ... or international trade mark (UK) ... which has a date of application for registration earlier than that of the trade

mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]

37. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
 - (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

38. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

39. The opponent’s marks qualify as earlier marks in accordance with section 6(1)(a) and 6(1)(ab) as their filing dates are earlier dates than the priority date of the holder’s mark. The opponent’s marks completed their registration process more than five years before the relevant date (the priority date of the mark in issue); therefore they are subject to proof of use pursuant to section 6A of the Act.

4-. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its First and Second Earlier Marks in relation to the goods and services for which they are registered. The relevant period for this purpose is the five years ending on the priority date of the holder’s mark, i.e. 22 September 2015 to 21 September 2020.

41. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have highlighted above. Section 100 of the Act is also relevant, which reads:

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

42. 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 Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence

that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

Form of the mark/how the marks are used

43. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

44. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

45. As far as form of the mark is concerned, I am satisfied that the First and Second Earlier Marks have been used as registered, as highlighted by the evidence above.

Conclusions from the evidence on genuine use

46. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²

47. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

48. As the First Earlier Mark is a UKTM, I must consider the UK as the market in which the opponent is required to show genuine use.

49. As the Second Earlier Mark is a comparable mark, and as the relevant period in which to prove use ended on 21 September 2020 i.e. before the IP Completion Day (31 December 2022), the relevant territory is the EU, which included the UK at that time.

50. Clearly, there are some issues with the opponent’s evidence as highlighted by Mr Zweck at the hearing. I note that some of the evidence is undated, including its brochure exhibited at **AW4**. The invoice evidence provided within **exhibit AW6** contains invoices after the relevant date, and some invoices which fall within the relevant period do not refer to identifiable products (for example ETL TYPE INFLATABLE SEAL and H14 MAIN FILTER). I note that the client information has been removed and therefore I am unable to identify geographically where the invoices pertain to, however, the invoices vary in currency between pound sterling and euros.

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

The product images and shipping labels are also undated, and the exhibition and conference evidence at **exhibit AW11** only refers to an intention to exhibit on future dates, some of which also fall after the relevant period.

51. However, I have been provided with significant sales figures for the relevant period, from 2015 to 2020, which amount to £56,671,372. I note that 45% of this figure pertains to the opponent's containment solutions, including its downflow booths, 20% pertains to its aseptic solutions goods and 15% relates to its aftersales services, which includes its replacement, maintenance, repair, and installation services. These figures are supported by its brochure evidence in **AW3** and **AW4**, a small sample of invoices in **AW6** in relation to its downflow booths, fume hoods, biological cabinets and service visits, and its website screenshots contained within **exhibit AW9**.

52. As highlighted above, the opponent has provided evidence in the form of significant turnover figures during the relevant period, which, in combination with the other exhibits, creates a picture which is sufficient to establish genuine use of the registrations, by the opponent, during the relevant period.

Fair Specification

53. I must now consider whether, or the extent to which, the evidence shows use of the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of

protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

55. The goods and services for which the First Earlier Mark is registered and upon which the opponent relies is a selection of class 6 and 19 laboratory equipment goods and class 37 science services.

56. The goods and services for which the Second Earlier Mark is registered and upon which the opponent relies is a selection of class 6, 9 and 19 laboratory equipment goods and class 37 science services.

57. However, as set out above, it is clear from the opponent’s evidence, including all of the brochure and invoice evidence, as well as the breakdown of the revenue figures, that use of the earlier marks has been limited to its containment solutions, including its downflow booths, its aseptic solutions goods, and the installation and repair of these goods. I therefore consider that the term “isolators” is a broader term which needs to be narrowed down to reflect the opponent’s “aseptic isolators” only (which I consider to be an appropriate sub-category).

58. Consequently, I consider a fair specification for both the First and Second Earlier Marks to be:

Class 6 Contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; aseptic isolators; containment booths; downflow containment booths.

Class 19 Contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; aseptic isolators; containment booths; downflow containment booths.

Class 37 Installing, commissioning, validating, and repairing the following: contained environments for manipulation and handling of

pharmaceutical, chemical and hazardous materials; aseptic isolators; containment booths; downflow containment booths.

Section 5(2)(b)

59. Section 5(2)(b) reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

60. In making this decision, I bear in mind the following principles 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 and services

61. The competing goods are as follows:

Opponent's goods and services	Applicant's services
<p><u>Class 6</u> Contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; aseptic isolators; containment booths; downflow containment booths.</p> <p><u>Class 19</u> Contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; aseptic isolators; containment booths; downflow containment booths.</p> <p><u>Class 37</u> Installing, commissioning, validating, and repairing the following: contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; aseptic isolators; containment booths; downflow containment booths.</p>	<p><u>Class 42</u> Scientific and technological services; development and testing of chemical manufacturing processes.</p>

62. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (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

64. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

65. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

66. I bear in mind the following applicable principles of interpretation from *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms):

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

67. Geoffrey Hobbs QC, sitting as an Appointed Person in the case of *Raleigh International Trade Mark* [2001] RPC 11 stated:

“20. If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22”

68. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

Scientific and technological services

69. The holder’s above services cover a broad range of scientific and technological-related activities, including theoretical and practical aspects of complex fields such as engineering, chemistry, technology etc. I therefore consider that these services are also concerned with research and experimental development, generation, dissemination and application of scientific and technical knowledge. Consequently, I

do not consider that the holder's services overlaps with the opponent's class 37 instillation, commissioning, validating and repair services. I consider that the holder's class 42 services would be provided by specialist engineers in the field of science and technology, and most likely provided to third parties when creating a new product. The opponent's class 37 services would be provided by an undertaking which specialises in the production of contained environments (including containment booths and aseptic isolators), and would be provided to third parties who had previously purchased these goods. I therefore do not consider that the services overlap in nature, method of use, purpose or trade channels. I also do not consider that the services are in competition nor are they complementary. I consider that there may be an overlap in user (scientific institutes, research institutes and laboratories etc.) however, this is not enough on its own to establish similarity. Taking the above into account, I consider that the services are dissimilar.

70. I also do not consider that the opponent's class 6 and 19 goods overlap with the holder's class 42 services. The goods and services clearly do not overlap in nature, method of use and purpose. I also do not consider that there would be an overlap in trade channels as the opponent's goods would be provided by specialists in the field of contained environments (including containment booths and aseptic isolators), which are used to create a controlled environment for the user.

71. I note that at the hearing Mr Fiddes clarified that "we do not have identity of goods and services here" but they have a "close relationship" because the goods are used in the provision of the service. I agree that the provider of the holder's services, which would be specialist engineers in the field of science and technology, may use the opponent's products to conduct its research. On the basis that the opponent's goods may be used to facilitate the holder's services, it could be argued that they are complementary. However, I note that as highlighted by the case law above, complementarity is a two part test. Firstly, are the goods important or indispensable to one another? I do not consider that this part of the test is completely satisfied because the holder's "scientific and technological services" are so broad, and therefore could encompass so many different types of services, that the opponent's goods will not be important or indispensable to all of them. I also consider that the second part of the test, whether the average consumer would believe that the goods and services

originate from the same undertaking, will not be satisfied. I do not consider that the average consumer, who will be those that work within the field of science and technology, would consider that specialist goods such as contained environments, would also provide services concerned with generation, dissemination and application of scientific and technical knowledge. The connection that the goods and services are “laboratory based” is too tenuous to establish a link between them. Therefore, taking all of the above into account, I consider that the opponent’s goods and the holder’s services are dissimilar.

Development and testing of chemical manufacturing processes

72. In the absence of any evidence to assist me, I do not consider the holder’s above services to be self-evidently similar to the opponent’s instillation, commissioning, validating and repair services of goods which are used to create a controlled environment. I do not consider that there would be an overlap in trade channels, method of use or purpose as the holder’s services would most likely be provided by specialists, in the field of chemical manufacturing processes, to third parties including scientific institutes and laboratories. As highlighted above, the opponent’s services would be provided by an undertaking which specialises in the production of contained environments, and would be provided to third parties who had previously purchased their goods. I also do not consider that the services would be in competition nor complementary. Although there may be an overlap in user this is not enough on its own to establish similarity. Consequently, I consider that the services are dissimilar.

73. I also do not consider that the opponent’s goods in class 6 and 19 overlap with the holder’s class 37 services. The goods and services clearly do not overlap in nature, method of use and purpose. They also do not overlap in trade channels as the opponent’s goods would be provided by specialists in the field of contained environments. I note that I haven’t been provided with any evidence or submissions from either party as to what the process of chemical manufacturing would involve. Therefore I do not consider that the provider of the holder’s services would use the opponent’s goods to facilitate its services. Consequently, the goods and services are neither complementary, nor in competition. Taking all of the above into account, I consider that the opponent’s goods are dissimilar to the holder’s services.

74. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that (my emphasis):

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

75. As established in the case law above, under section 5(2)(b), for there to be a likelihood of confusion between the marks, there has to be a finding of similarity between the goods or services. Since I have determined that they are not similar, the opposition fails here.

CONCLUSION

76. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

77. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of **£1,400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filing evidence	£500
Preparation for and attendance at hearing	£700

Total

£1,400

78. I therefore order Extract Technology Limited to pay Merz Pharma GmbH & Co. KGaA the sum of £1,400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 2nd day of May 2023

L FAYTER

For the Registrar

ANNEX

The First Earlier Mark

Class 6

Buildings and building structures, prefabricated buildings, containment buildings, all being in modular form; laboratories; contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; glove boxes; isolators; barrier isolators; pallet staging areas; containment booths; downflow containment booths; laminar flow containment booths; solvent control booths; glove bag containment facilities; containment drums; all of the aforesaid goods in class 6 and parts, fittings and furniture for all of the aforesaid goods in class 6.

Class 19

Buildings and building structures, prefabricated buildings, containment buildings, all being in modular form; laboratories; contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; glove boxes; isolators; barrier isolators; pallet staging areas; containment booths; downflow containment booths; laminar flow containment booths; solvent control booths; reactor containment booths made of glass; glove bag containment facilities; containment drums; all of the aforesaid goods in class 19 and parts, fittings and furniture for all of the aforesaid goods in class 19.

Class 22

Containment bags and sealing heads therefor.

Class 37

Installing, commissioning, validating, and repairing the following: buildings and building structures, prefabricated buildings, containment buildings, all being in modular form; laboratories; contained environments for manipulation and handling of pharmaceutical, chemical and hazardous materials; glove boxes; isolators; barrier isolators; pallet staging areas; containment booths; downflow containment booths; laminar flow containment booths; solvent control booths; reactor containment booths made of glass; containment bags and sealing heads therefor; glove bag containment facilities; containment drums.

The Second Earlier Mark

Class 6

Transportable buildings of metal; buildings and building structures, prefabricated buildings, containment buildings, including those being in modular form; prefabricated buildings being laboratories; laboratories; contained environments for the manipulation and handling of pharmaceutical, chemical and hazardous materials; containment booths; downflow containment booths; laminar flow containment booths; solvent control booths; glove bag containment facilities; containment drums; parts, fittings, fixtures, components and furniture for any or all of the aforesaid goods in this Class.

Class 7

Pallet staging areas, namely, conveyors.

Class 9

Scientific apparatus and instruments; glove boxes; isolators; barrier isolators; furniture especially made for laboratories; parts, fittings, fixtures, components and furniture for any or all of the aforesaid goods in this Class.

Class 19

Non-metallic transportable buildings; buildings and building structures, prefabricated buildings, containment buildings, including those being in modular form; prefabricated buildings being laboratories; laboratories; contained environments for the manipulation and handling of pharmaceutical, chemical and hazardous materials; containment booths; downflow containment booths; laminar flow containment booths; solvent control booths; reactor containment booths made of glass; glove bag containment facilities; containment drums; parts, fittings, fixtures, components and furniture for any or all of the aforesaid goods in this Class.

Class 22

Containment bags and sealing heads therefor; parts and fittings for any or all of the aforesaid goods in this Class.

Class 37

Building construction services; installing, commissioning, validating, and repairing services in relation to the following: buildings and building structures, prefabricated buildings, containment buildings, laboratories, contained environments for the manipulation and handling of pharmaceutical, chemical and hazardous materials, glove boxes, isolators, barrier isolators, pallet staging areas, containment booths, downflow containment booths, laminar flow containment booths, solvent control booths, reactor containment booths made of glass, containment bags and sealing heads therefor, glove bag containment facilities, and containment drums; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.