O-0716-23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NOS. 918274013 AND 3515118
BOTH IN THE NAME OF BIOGEN MA INC.
IN RESPECT OF THE TRADE MARK

BYOOVIZ

IN CLASS 5

AND

IN THE MATTER OF AN APPLICATIONS FOR INVALIDATION THERETO
UNDER NOS. 504348 AND 504349
BY NOVARTIS AG

Background and pleadings

1. The contested registrations 918274013 and 3515118, are both in respect of the mark BYOOVIZ. The first was applied for on 22 July 2020 (the "relevant date" for these proceedings) and registered 5 November 2020 and the second was applied for on 23 July 2020, claiming priority a priority date of 22 July 2020 (the "relevant date" for these proceedings) and it was registered on 6 November 2020. They stand in the name of Biogen MA Inc. ("the proprietor") and, following partial surrenders, they both currently stand registered in respect of the following same list of goods in Class 5:

> *Pharmaceutical preparations, for supply only on prescription of a registered medical practitioner.*

2. On 15 November 2021, Novartis AG ("the applicant") applied to invalidate the registrations on the basis of section 47, sections 5(2)(b) and section 5(3) of the Trade Marks Act 1994 ("the Act").

3.The applicant relies upon the following earlier mark:

> 801389203
>
> BEOVU
>
> Filing date: 6 November 2017
> Priority date: 27 October 2017 (based on Swiss mark 709080)
> Registration date: 17 July 2018

4. The applicant relies upon all the goods listed in this registration, namely:

> **Class 5:** *Pharmaceutical preparations*

5. The applicant claims that the respective marks are similar, claiming that the respective marks share the three components BE-/BY-, -O-/-OO- and -VU/-VIZ and share three of the five letters, namely, B, O and V that appear in the same sequence

and are the dominant sound in each of the three syllables. It concludes that the respective marks share the same overall pattern, being three syllables, the first syllable being a “B2 sound, the same “O” sound in the middle and an ending “V” sound. It also claims that both marks allude to the term “bio” being a shortened form of “biological”. It states that “[t]he conclusion that the signs are similar is confirmed by applying the Phonetic Orthographic Computer Analysis (POCA) algorithm to the words, an algorithm used by the US Food and Drug Administration website to determine phonetic and orthographic similarity between two drug names. It also asserts that the respective goods are identical. It also points to the fact that its mark is an invented word and that it is promoted extensively in the UK and it, therefore, has a high degree of distinctive character. It concludes that there is a high likelihood of confusion.

6. In respect of the ground based upon section 5(3) the applicant claims a reputation in respect of a treatment to slow the deterioration of eyesight caused by wet age-related macular degeneration (“wAMD”). It claims extensive use throughout the UK since at least February 2020. It states that the applicant’s BEOVU treatment is one of only four treatments currently approved in the UK for treating wAMD. It also states that the proprietor’s BYOOVIZ is one of the other three approved treatments but has yet to be used in the UK.

7. The applicant explains that there was marketing of the product prior to approval in the UK but that such marketing could not use the name BEOVU. Following the granting of marketing approval in February 2020 it marketed the goods under the mark and the goods were made available from April 2020. It asserts that because of its pre-marketing of the product, as soon as the BEOVU product was launched, health care professionals will have been aware of it and would immediately make a connection. It concludes that its BEOVU mark had a well-established reputation.

8. The applicant also asserts that:

(i) Because of the alleged visual, aural and conceptual similarities between the marks, and because of the reputation in the applicant’s mark, it asserts

that use of the contested mark will result in the creation of a link between the respective marks in the minds of the relevant consumer;

(ii) use of the proprietor's mark will take unfair advantage because it will create a false impression that its goods emanate from the same or linked undertaking as the applicant's goods. It points out that companies undertake significant research before launching products in this field and the proprietor would have been aware of the earlier mark. The applicant asserts that the proprietor adopted the BYOOVIZ name to deliberately exploit the applicant's mark's reputation;

(iii) Alternatively, the applicant claims that the proprietor chose its mark to allude to the active ingredient (called brolucizumak) present in the applicant's product but not present in the proprietor's mark. The applicant contends that this and/or the circumstances described under (ii) will result in an unfair advantage being taken of the applicant's mark with the proprietor's mark free-riding on the applicant's investment in its mark;

(iv) Use of the proprietor's mark where the applicant has no control over the quality of the goods would risk detriment to reputation of the applicant's mark. It asserts that the consequences of this are particularly relevant where pharmaceutical products are involved;

(v) Use of the proprietor's mark will encroach on the ability for the applicant's mark to distinguish the applicant's goods from those of other undertakings because the proprietor's mark is so different to two of the competitors in the treatment of wAMD but similar to the applicant's mark and threatens the uniqueness of its mark. Consequently, there will be detriment to the distinctive character of the applicant's mark.

9. The proprietor filed counterstatements denying most of the applicant's claims and, in particular, those relating to the similarity of the marks and the claim that the applicant's mark has a high level of distinctive character. It submits that BEO will be understood as meaning "bio" and that VU will be understood as meaning "view" or "vision". It claims that it is a common naming practice to refer in some way to active ingredients and because of this there co-exists a number of pharmaceutical marks

with similar connotations. This was recognised by the EUIPO in several of its decisions.[1]

10. It admits that the respective goods are identical but asserts that both parties' products are prescription only and administered by health care professionals who will pay a high level of care and attention when purchasing from speciality pharmacies and hospital pharmacies.

11. The two applications for invalidation were consolidated and this decision is in respect of both applications.

12. A hearing was held before me on 28 March 2023 where the proprietor was represented by Lindsay Lane KC instructed by Jones Day. The applicant was represented by Henry Ward of counsel, instructed by Bristows LLP.

Evidence

13. The applicant's evidence-in-chief takes the form of a witness statement by Jeremy Dixon, Marketing Director (Ophthalmology) at the applicant, and partially confidential Exhibits JD1 – JD20. Mr Dixon provides evidence relating to the background of the applicant, the product provided under the BEOVU mark, pronunciation of pharmaceutical marks and treatments for wAMD.

14. The proprietor's evidence-in-chief is in the form of a witness statement (and exhibits BLA-1 – BL10) by Blake Leitch, Head of Marketing and Communications in the Global Biosimilars unit of the proprietor. His evidence addresses the applicant's evidence and provides support for the claim that it is common practice for different pharmaceutical marks to use common elements.

15. The applicant's reply evidence takes the form of a second witness statement of Mr Dixon. This statement is subject to a confidentiality order and is accompanied by Exhibits JD21 – JD24.

[1] See *RETILUT/TETINORM* (B 3 069 424) and *Vita Stic/Vitafit* (R 877/2013-1)

16. The proprietor filed additional evidence. This takes the form of the confidential witness statement of Kathryn Jones-Orr Head of Global Marketing in the applicant's Ophthalmology Biosimilars unit, together with Exhibits KJO1 - KJ06. The purpose of this evidence is to submit documents provided to the proprietor following a disclosure request, to address Mr Leitch's allegations of potential confusion and to respond to a specific point which the proprietor suggested that the applicant should have commented upon.

Statutory provision

17. Sections 5(2)(b) and section 5(3) are both relevant in invalidation proceedings because of the following provisions set out in section 47 of the Act:

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

18. Sections 47(2A) and 47(2G) relate to proof of use and, because the earlier mark in these proceedings has a filing date less than five years prior to the filing date of the contested mark, these do not apply here.

EU Case Law

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

DECISION

Section 5(2)(b)

20. I find it convenient to firstly consider the grounds based upon section 5(2)(b) of the Act. This reads as follows:

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

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

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

Comparison of goods

22. It is common ground between the parties that the respective goods are identical.

Comparison of marks

23. It is clear from *Sabel BV v Puma AG,* Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("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."

24. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

25. The respective marks are shown below:

Applicant's earlier mark	Proprietor's mark
BEOVU	BYOOVIZ

26. The parties' marks both consist of a single, invented word and their distinctive character obviously resides in these words.

27. In respect of the visual consideration of the marks, Mr Ward repeated similar arguments to those in the applicant's statements of grounds and submitted that each

mark comprises two components, the first beginning with B and ending with O and the second starting with V (and ending in U and IZ respectively) and that the marks share three out of the five letters present in the applicant's mark. He concluded that the marks share a medium to high level of visual similarity. It is not obvious to me that the respective marks will be split in this arbitrary way. They both consist of invented words that do not lend themselves to such artificial dissection. When considering the marks as a whole, I observe that the applicant's mark presents as a reasonably short word consisting of five letters whereas the opponent's mark presents as a visually noticeable longer mark consisting, as it does, of seven letters. As Mr Ward observed, three of the five letters of the applicant's mark appear in the same order in the proprietor's mark and this creates some similarity. It follows that four letters present in the proprietor's mark are absent in the applicant's mark. Taking these similarities and differences into account, the respective marks share a relatively low level of visual similarity.

28. Mr Ward also referred to the Phonetic Orthographic Computer Analysis (POCA) algorithm where the respective marks scored what is characterised as a high level of visual similarity. In the applicant's statement of grounds, it explains that POCA is used by the US Food and Drug Administration to determine phonetic and orthographic similarity between two drugs and is recognised by the European Medicines Agency. I note this, but it is not clear how the tool aligns to the perceptions of the UK average consumer and it cannot be substituted for my analysis of similarity between the marks regardless of its perceived usefulness as a tool to assess similarity. Such a tool cannot and should not replace the "average consumer" as defined in case law. I carry out my analysis with the UK average consumer firmly in mind and this approach is not displaced by the conclusion reached by POCA.

29. Mr Dixon states[2] that during his "very frequent" contact with people involved in purchasing pharmaceutical preparations, they tend to pronounce the applicant's mark as BEE-OH-VIEW or BAY-OH-VIEW. I accept that these are the two most likely ways of expressing the mark. Therefore, the respective marks do not share any

[2] At [14] of Mr Dixon's first witness statement ("Dixon1")

identical syllables. Mr Ward submitted out that the first two components share the same starting consonant and that the second syllable of both marks end in the same "O" or "OO" letter(s). This is all correct, but the second syllable of both marks are different, one being a short "OH" sound as in "bow", the other a long "OO" sound as in "booze". Mr Ward also referred to the POCA algorithm where the respective marks scored what is characterised as a moderate level of oral similarity. As I have already noted, it is not clear how the POCA algorithm aligns to the perception of the UK average consumer, nevertheless, I accept that because of both marks consist of three syllables, the first and third syllables begin with the same sound and because the second syllables are similar, that the respective marks share somewhere approaching a medium level of aural similarity.

30. Conceptually, as I have already noted the respective marks present as invented words, however, I keep in mind that invented words may be perceived as having an allusive meaning.[3] Mr Ward submitted that the -VU and -VIZ components of the marks are allusive of view/vision and, consequently, there is a degree of similarity. Further, Mr Dixon also states[4] that the respective BEO and BYOO components will be perceived as being allusive of BIO. I accept Mr Ward's submission that -VU may bring to mind the word "view" and that -VIZ may bring to mind "vision". However, the concepts are less likely to be identified if the marks were used on pharmaceutical preparations not for treatment of the eyes. I do not agree with Mr Dixon. The BEO and BYOO element are visually very different to "bio" and are neither are they aurally identical and I consider that both these factors point away from the UK average consumer perceiving them as being an allusion to the prefix "bio". Rather, these parts of the respective marks present as having no obvious meaning. With these observations in mind, I conclude that there is a very low level of conceptual similarity with the only similarity created by the similar concepts of "view" and "vision" present at the end of each mark when used in respect of pharmaceutical preparations for the treatment of the eyes, but weaker still where this is not the case.

[3] I keep in mind that invented words can be perceived as having allusive meaning. As Mr Ward noted, in *Usinor SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-189/05 at [62]: the consumer will break a verbal sign down into verbal elements which suggest a concrete meaning or resemble known words.
[4] Dixon1 at [11]

Average consumer and the purchasing act

31. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

32. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the General Court ("the GC") 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.".

33. The applicant submits that there are three relevant consumers, namely, members of the public, health care professionals and professionals involved in administrative roles within the healthcare system and who may have responsibility for making purchasing decisions. This submission aligns with the comments of the GC in *Olimp Laboratories* and I agree that these are the relevant consumers.

34. It is common ground that the average consumer will pay a reasonably high level of attention during the purchasing process.

35. The purchasing process is likely to be visual in nature with products being chosen from a catalogue or after seeing sales literature, but I do not ignore that aural considerations may play a part, for example, when a product is recommended by, or discussed with a medical sales representative or where a health professional discusses the product with a patient.

Distinctive character of the earlier trade mark

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. The applicant’s mark consists of the word mark BEOVU. As already discussed, this is an invented word with a weak allusion to the word “view” created by the VU letters at the end of the mark. This does not detract to any great extent from the high level of inherent distinctive character.

38. The applicant also submits that the distinctiveness of its mark is enhanced through use. Having concluded that the applicant’s mark is endowed with a high level of inherent distinctive character, any enhancement to this through use is not likely to improve the applicant’s case to any material affect but, for the sake of completeness, I will comment briefly.

39. I keep in mind that the relevant date in these proceedings is 22 July 2020 and that the applicant must demonstrate that its mark has acquired an enhanced level of distinctive character by that date.

40. The non-exhaustive list of factors to be taken into account as identified in *Lloyd Schuhfabrik Meyer* are discussed below.

Market share held by the mark

41. The applicant's product had not been launched at the relevant date and its market share was zero. BEOVU was approved for use in Scotland on 7 September 2020 and in England and Wales on 16 December 2020.[5] This was after the relevant date.

How intensive, geographically widespread and long-standing use of the mark has been

42. There was no use as at the relevant date.

Amount invested by the undertaking in promoting the mark

43. Mr Dixon states that the applicant "has spent considerable sums marketing and promoting BEOVU".[6] He provides a summary of the applicant's marketing efforts that included:[7]

- A UK spend of over USD$1.7 million in 2018 in respect of medical and promotional spend and sales force costs, rising to USD$ nearly 7.8 million in 2019;
- During this time the applicant did not use the name BEOVU because it is not permitted to market a product until it is authorised, but it is not unusual for the health professionals to become aware of a pharmaceutical product and its name before marketing authorisation is granted;[8]

[5] Dixon1 at [29]
[6] Dixon1 at [30]
[7] Dixon1 at [33], [34]
[8] Dixon1 at [35]

- Marketing authorisation was granted in February 2020 and stock first became available in the UK in April 2020[9] and medical and promotional spend increased to USD$13.3 million in 2020 and USD$16.2 million in 2021. "Significant marketing efforts to build brand recognition" commenced in April 2020 (three months prior to the relevant dates).[10]

44. It is clear from this that there was no promotion of the mark prior to receiving marketing authorisation in February 2020, some five months prior to the relevant date. It follows that there could not have been any legal promotional activity of the mark prior to this date. A breakdown of the medical and promotional spend between February 2020 and the relevant date is provided by Mr Dixon and amounts to a promotional spend of nearly $2 million and a medical spend of nearly $1.9 million.[11] Mr Dixon explains that "medical spend" describes the costs of educating health care professionals about the active ingredient (but NOT the mark).

Proportion of the relevant section of the public which identifies the goods as originating from a particular undertaking

45. Mr Dixon states that it is not unusual for health professionals to become aware of a product prior to marketing authorisation.[12] The applicant claims that by the relevant date most, if not all, health care professionals in the UK specialising in the treatment of eye disease would have been aware of BEOVU. Mr Dixon does state that it is lawful and common practice for companies to educate health care professionals about the active ingredient of a future product in certain circumstances (namely where health care professionals request information or hold budget responsibility, or when the company provides updates on the results of clinical studies). It is these activities that he states the "medical spend" relates.

46. The applicant has provided examples of what the promotional spend relates and includes press releases,[13] emails to healthcare professionals announcing the

[9] Dixon1 at [32]
[10] Dixon1 at [32]
[11] Mr Dixon's second witness statement ("Dixon2") at [6]
[12] Dixon1 at [35]
[13] Dixon1 at [51] and Exhibit JD-10

products authorisation,[14] letters, leaflets,[15] telephone and video calls to the same,[16] an advertisement placed in journals,[17] banner advertisements on websites targeting health care professionals,[18] and meetings with and webinars for health care professionals.[19]

Statements from chambers of commerce and industry or other trade and professional associations

47. No such evidence has been provided.

48. When considering all of the above, many of the factors set out in *Lloyd Schuhfabrik Meyer* have not been met, but I keep in mind that this is not an exhaustive list and that the circumstances in the current case involve a relatively small number of health care professionals as part of the average consumer.

49. Mr Leitch argued that, in his professional experience, the applicant's mark did not have distinctive character at the relevant date.[20] He proffered two reasons:

> (i) no marketing of the trade mark could have taken place before marketing authorisation was granted in February 2020;
> (ii) the proprietor could not have made any significant use until approval to use was achieved in the UK which, in this case, was September 2020 in Scotland and December 2020 in England and Wales.

50. Whilst the wider average consumer is unlikely to have any awareness of the mark at the relevant date, I accept that this is not the case with the specialist eye health professionals who were specifically targeted by the applicant both before and after marketing authorisation and, despite there being no sales before the relevant

[14] Dixon1 at [51]
[15] Dixon1 at [51] and Exhibits JD-11 and JD-12
[16] Dixon1 at [51]
[17] Dixon1 at [51] and Exhibit JD-13 showing an advertisement from March 2020
[18] Dixon1 at [51] and Exhibits JD-14 and JD-15 each showing banner advertisements from May 2020
[19] Dixon1 at [51] and Exhibits JD-16 and JD-17 each referring to a webinar on 22 June 2020 and 29 July 2020, respectively
[20] Leitch1 at [13]

date, I conclude that awareness of the trade mark would have been reasonably high for a significant proportion (i.e. the health care professionals that buy and use the product) of the average consumer by the relevant date, despite the limited time for which the mark had been promoted in the UK by the relevant date. In reaching this conclusion, I recognise that there is only a small number of health care professionals in the field and that the applicant was drawing attention to the fact that they were in the process of bring the product to market some time prior to obtaining marketing authorisation. Further, whilst the parties have slightly different views as to how many other drugs are available to treat wAMD, it is clear that the number is low. Within this context, I accept that it would be relatively easy to educate healthcare professionals (i) of a pending product prior to obtaining marketing authorisation, and (ii) that, after obtaining marketing authorisation and before the product was actually available, its name was to be BEOVU. The evidence illustrates that such education was undertaken.

51. In summary, despite these unusual circumstances, I find that the applicant's mark benefits from an enhanced level of distinctive character in respect of *pharmaceutical preparations for the treatment of wAMD*.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

53. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG,* paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

54. I have found that:

- The respective goods are identical;
- The distinctive character of the parties' marks reside in the single invented words "BYOOVIZ" and "BEOVU" respectively;
- The respective marks share a relatively low level of visual similarity, somewhere approaching a medium level of aural similarity and a very low level of conceptual similarity;
- The average consumer consists of the public, health care professionals and professionals with responsibility for purchasing the goods concerned. There is a reasonably high level of care and attention involved in the purchasing process that is primarily visual in nature. However, I do not ignore that aural considerations may play a part in some instances;
- The inherent distinctive character of the earlier mark is high and is enhanced through use in respect of *pharmaceutical preparations for the treatment of wAMD*.

55. Mr Ward submitted that merely because the average consumer pays a high level of attention, imperfect recollection is still a relevant consideration:[21]

> "Furthermore, the fact that the relevant public will be more aware of the identity of the producer or supplier of the product or service that it wishes to purchase does not mean that that public will examine the mark before it down to the smallest detail, or that it will compare that mark in minute detail to another mark. Even for a public displaying a high level of attention, it remains the case that the average consumer only rarely has the opportunity to compare the different marks directly, but must rely on his or her imperfect recollection of them (see judgment of 22 November 2018, Endoceutics v EUIPO – Merck (FEMIVIA), T-59/18, not published, EU:T:2018:821, paragraph 65 and the case-law cited)."

56. I accept that this is the case.

57. There is confidential evidence relating to what the regulatory bodies said about possible confusion of the respective marks and the parties take opposing views regarding how to interpret this.[22] [redacted].[23] I confirm that I keep this evidence in mind together with the parties' positions but, for the purposes of my considerations, it does not replace the global appreciation test based on trade mark law. Consequently, I need to conduct my own analysis of the likelihood of confusion based on the factors discussed earlier in this decision.

58. The respective goods are identical, and I keep in mind that this a factor increasing the likelihood of confusion. There is a relatively low level of visual similarity and the only conceptual hook in either mark is the similar concepts of

[21] Mr Ward directed me to the finding of the General Court in *Ruximblis/Ruximera*, T-542/20, at [57]
[22] Mr Leitch's witness statement ("Leitch1") at [51] and confidential Exhibit BL9 and Dixon2 at partly confidential [37]
[23] Redacted oral submission contained in confidential part of Mr Ward's skeleton argument at [40]

"vision" and "view". These are both concepts relevant to a product for the treatment of an eye condition. Keeping in mind the relevance of these concepts, the average consumer, if they perceive these concepts at all, are likely to put their occurrence down to coincidence and a desire to allude to vision/view rather than leading to a perception that the goods originate from the same or linked undertaking.

59. I also keep in mind the applicant's arguments, as set out in its statements of grounds, that both marks begin with the letter "B", that both have a letter "O" in the middle of the mark, and both have a letter "V" near the end of the mark. The position of the letter "B" and "V" results in the first syllable of each mark beginning with a "Buh" sound and the third syllable with a "Vuh" sound. However, in all other respects they are aurally different. The high level of distinctive character (both inherent and enhanced) of the earlier mark is also a factor that can increase a likelihood of confusion.

60. Taking account of all of the above and reminding myself that I must consider the marks as a whole, whilst there are similarities between the marks, they are insufficient to lead to a likelihood of confusion. They are counteracted by a number of other characteristics of the marks. Visually, the difference in length of the marks is not likely to go unnoticed, neither will the different "IZ"/"U" endings to the marks. Further, aurally, the respective marks do not share any of the same syllables. Based upon these differences alone, I find that there is no likelihood of confusion. When the reasonably high level of care and attention is also factored in, it is a further factor that points away from confusion. In reaching this finding, I have kept in mind the wide range of average consumers that includes both members of the general public who may encounter the parties' marks during treatment and medical professionals with a good knowledge of the treatments available for given medical issues.

61. In summary, I find that there is no likelihood of confusion and the grounds based upon section 5(2)(b) fail.

Section 5(3)

63. Section 5(3) states:

> (3) A trade mark which –
>
> > (a) is identical with or similar to an earlier trade mark,
> >
> > (b) *Repealed*
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

64. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Addidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

> a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

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

Reputation

65. The requirements under section 5(3), namely, that the earlier mark has a reputation, that there is a link between the respective marks and that use of the applicant's mark leads to an unfair advantage or detriment, are cumulative and the applicant can only succeed under this ground if its first demonstrates that it has the requisite reputation. The applicant claims that its mark's reputation is in respect of a treatment to slow the deterioration of eyesight caused by wAMD. It claims extensive use throughout the UK since at least February 2020 and is one of only four treatments currently approved in the UK for treating wAMD. I have summarised the applicant's evidence at paragraphs 41 to 51 above when considering the issue of enhanced distinctive character and this is also relevant to the question of reputation. For the purposes of this decision, I will proceed on the basis that this evidence demonstrates the requisite reputation.

Link

66. It is necessary for the relevant public, when confronted with the later mark, to make a link with the earlier reputed mark and this includes the bringing to mind the earlier mark. Whether such a link exists must be assessed globally taking account of all relevant factors. These factors include:

Degree of similarity between the respective marks

67. Earlier, I found that the parties' marks share a relatively low level of visual similarity, somewhere approaching a medium level of aural similarity and a very low level of conceptual similarity.

Degree of similarity between the goods/services

68. It is common ground that the respective goods are identical.

The extent of the overlap between the relevant consumers for those goods/services

69. The goods are identical, and it follows that the relevant consumers will be the same.

The strength of the earlier mark's reputation and distinctiveness

70. I have concluded that the applicant's earlier mark has a high level of inherent distinctive character and that this has been enhanced through use. I have assumed that this translates into the requisite reputation.

71. I keep all these findings in mind, together with the fact that to make a link with the earlier reputed mark, the bringing to mind the earlier mark is sufficient. This is a lower threshold than when considering a likelihood of confusion, nevertheless, I consider that the differences between the respective marks are sufficient that the required link will not be made. The visual differences between the marks, highlighted earlier, combined with the absence of conceptual meaning in either, beyond that of "view"/"vision" results in the requisite link not being established. As I noted earlier the concepts of "view" and "vision", being of some allusive/descriptive relevance for an eye treatment, results in the existence of these concepts in the marks being more likely to be put down to coincidence rather than creating any link between the marks. I find that the requisite link between the respective marks is not established. This is the case even where a strong reputation exists.

72. In the absence of the requisite link, the grounds based upon section 5(3) fail in their entirety.

Summary

73. The invalidation applications have failed in respect of both grounds and the proprietor's marks remain validly registered.

COSTS

74. The proprietor has been successful in defending both invalidations and is entitled to a contribution towards its costs in accordance with the scale of costs published in Tribunal Practice Notice 2/2016. In the circumstances I award the proprietor the sum of £2800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the Form TM26(I)s and preparing the counterstatements:	£600
Considering other side's evidence and preparing evidence:	£1400
Preparing for and attending a hearing:	£800
Total:	**£2800**

75. I therefore order Novartis AG to pay Biogen MA the sum of £2800. 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 26th day of July 2023

Mark Bryant
For the Registrar