

O-1089-22

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NO. 1584722 IN THE NAME OF GENTIBIO INC.**

FOR THE TRADE MARK:

GENTIBIO

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 426816
BY ISTITUTO GENTILI S.R.L.**

Background & Pleadings

1. On 8 February 2021, GentiBio Inc. (“the applicant”) applied to protect International Registration (“IR”) no. 1594722 in the United Kingdom for the trade mark **GENTIBIO** in respect of *pharmaceutical preparations for use in the treatment of autoimmune diseases and disorders, autoinflammatory diseases and disorders, alloimmune diseases and disorders and allergic diseases and disorders* in class 5. The application was accepted and published in the Trade Marks Journal for opposition purposes on 11 June 2021.

2. On 13 September 2021, Istituto Gentili S.r.l. (“the opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks and the following goods for which each is registered, as laid out, respectively, below:

United Kingdom Trade Mark (“UKTM”) 917895580

GENTILI

Filing date: 7 May 2018

Registration date: 31 July 2019

Class 5: *Pharmaceuticals*

IR 1452787



Date of protection of the IR in the UK: 25 July 2019

Priority date: 18 July 2018

Class 5: *Pharmaceuticals and medical preparations; pharmaceuticals*

UKTM 918304791

GENTIPAIN

Filing date: 9 September 2020

Registration date: 25 December 2020

Class 5: Drugs for medical purposes; medicines for human purposes; chemical preparations for pharmaceutical purposes; chemical preparations for medical purposes; pharmaceutical preparations; chemico-pharmaceutical preparations; pharmaceuticals

UKTM 918303653¹

GENTINIB

Filing date: 7 September 2020

Registration date: 25 December 2020

Class 5: Pharmaceuticals; Medicines for human purposes; drugs for medical purposes; chemical preparations for pharmaceutical purposes; chemical preparations for medical purposes; pharmaceutical preparations; biological preparations for medical purposes; chemico-pharmaceutical preparations

3. In respect of each of the earlier marks relied upon, the opponent contends that there exists a likelihood of confusion on account of the marks' similarity and the identity between the respective goods. It relies upon the "well-established" rule of thumb that

¹ On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark ("EUTM"). As a result of the opponent's EUTM numbers 17895580, 18304791 and 18304791 being registered before the end of the transition period, a comparable UKTM (the earlier mark) was created for each. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods or services.

coincidences at the beginnings of marks carry a greater weight than differences at their ends, giving rise to a high level of visual and phonetic similarity.

4. The applicant admits that the opponent's *pharmaceuticals* and *pharmaceutical preparations* are identical to the applied for goods but submits that any such identity in the respective specifications is irrelevant as the marks are nonetheless not confusingly similar, concluding that the opposition under section 5(2)(b) should therefore be rejected.

5. The applicant is represented by Withers & Rogers LLP and the opponent by Dehns. Neither party filed evidence during the evidential rounds and neither requested a hearing, though both elected instead to file submissions in lieu. Whilst I do not propose to summarise those submissions here, I will keep them in mind throughout.

6. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why my decision will continue to make reference to the trade mark case law of EU courts.

Decision

7. Section 5(2)(b) of the Act 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.”

8. Under the provisions outlined in section 6 of the Act, each of the opponent's trade marks clearly qualify as an “earlier mark”. In accordance with section 6A of the Act, as

none had completed its registration procedure more than five years prior to the filing date of the applicant's mark, none are subject to the proof of use requirements. Consequently, the opponent can rely upon all earlier marks and the goods it has identified without providing evidence of use.

Section 5(2)(b) - Case law

9. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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.

The principles:

(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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) set out a provision as to when goods can be considered identical. It stated:

“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”.

11. The applicant’s goods, as it concedes, are encompassed by the opponent’s *pharmaceuticals* and/or *pharmaceutical preparations*. Given that each of the earlier marks is registered for at least one of those terms, I will proceed on the basis that the parties’ respective goods are identical.

The average consumer and the nature of the purchasing act

12. 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 in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

13. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, 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.”

14. As the case law indicates, the average consumer of the goods at issue here is likely to comprise both medical professionals and members of the general public. Where applicable, members of the general public will elect to self-select the goods

from the shelves of a traditional retail outlet such as a pharmacy, or they will be specified in a prescription provided by a medical professional. The consumer could also seek the advice of a pharmacist, for example, or request a specific product which is kept 'behind the counter'. The professional consumer is likely to encounter the goods, predominantly at least, in publications such as medical journals or during discussions with peers or colleagues. On that basis, I find that both visual and aural considerations play important roles in consumers' selection of the goods. The goods are not necessarily purchased or selected with any meaningful degree of frequency, though this will depend entirely on the specific needs of the consumer.

15. The goods at hand play an important role in the health or wellbeing of the end consumer. Regardless of whether the goods are selected and prescribed by a professional consumer on behalf of a patient or a member of the general public administering self-care, a consequence of this nature would likely command a reasonable degree of consideration, with the consumer's health typically held in high regard. As the severity of conditions likely to necessitate the use of pharmaceutical preparations can vary widely, the degree of attention paid to the goods' selection will naturally fluctuate. The purchase of an off-the-shelf cold remedy will likely call for a lesser degree of attention than the purchase of pharmaceutical products intended to treat a more serious condition or injury, for example. Still, weighing all considerations, I find the average consumer is likely to apply at least a medium degree of attention, ranging to very high, particularly in the case of a medical professional.


Comparison of trade marks

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...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.”

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

18. The trade marks to be compared are displayed in the table below:

Opponent's marks	Applicant's mark
<p data-bbox="368 1122 639 1155">UKTM 917895580:</p> <p data-bbox="400 1182 608 1227">GENTILI</p> <p data-bbox="416 1323 592 1357">IR 1452787:</p>  <p data-bbox="368 1581 639 1615">UKTM 918304791:</p> <p data-bbox="360 1641 647 1686">GENTIPAIN</p> <p data-bbox="368 1783 639 1816">UKTM 918303653:</p> <p data-bbox="376 1843 632 1888">GENTINIB</p>	<p data-bbox="919 1480 1294 1541">GENTIBIO</p>

19. The opponent's mark ending '580 comprises a single word of seven letters (GENTILI). In the absence of any additional components, the mark's overall impression resides solely in the word itself.

20. The opponent's mark ending '787 comprises a word which is preceded by a figurative element. Its figurative element presents as a light blue circular shape which is broken by a smaller white teardrop shape sitting within, with a tail trailing from its tip penetrating the circumference of the blue circle. The word GENTILI is positioned to its right in a standard, upper case typeface presented in dark blue. Both elements make a contribution to the mark's overall impression, though I find its word element to carry the greater weight.

21. The opponent's mark ending '791 comprises only a nine letter word; GENTIPAIN. The mark's overall impression lies solely in the word it comprises.

22. The opponent's mark ending '653 comprises a single word of eight letters; GENTINIB. Its overall impression resides in the word itself.

23. With it being the only element, the overall impression of the applicant's mark lies solely in a single word of eight letters; GENTIBIO.

The opponent's mark ending '580

24. Visually, the opponent's mark and the applicant's mark comprise seven and eight letters, respectively. The marks coincide in their first five letters; G-E-N-T-I. There is an I within the additional letters of the competing marks, albeit in different positions. Keeping in mind that the beginnings of marks typically have a greater impact on consumers than their endings, I find the marks' visual similarity to be of at least a medium degree.

25. Aurally, the earlier mark is likely to be articulated in three syllables; JEN-TIL-EE. The later mark will likely comprise four syllables; JEN-TIB-EE-OH. The first syllable is

identical and the second and third highly similar, but the fourth syllable in the later mark has no counterpart. I find the aural similarity of at least a medium degree.

26. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.² Conceptually, the opponent submits that all of the respective marks are invented words (and therefore absent of concept). Of the BIO element in the applied for mark, the applicant submits that it nods towards healthy, organic or natural things. I will return to the applicant's claim that, as "the prefix GENTI- is common to registrations on the UKIPO Register", the marks' suffix [BIO] will be more dominant, later in my decision. To my mind, the earlier mark will not convey any concept to the average consumer and will, as the opponent suggests, be viewed as an invented word. I find the same likely to be true of the applicant's mark insofar as it will be seen as an invented word and consequently will not carry any meaning for the average consumer. I do not take the view that the consumer will dissect the mark into a prefix and suffix (i.e. GENTI and BIO). If it did I accept that the word BIO may be viewed as a nod towards the goods' biological makeup but, given the field in which the applicant seeks registration, the consumer will nonetheless likely attribute that little weight and a greater share still would be attributed to GENTI. Again, I do not find this the likely outcome and find it more probable that the consumer will view the word as a whole. On balance, I find neither mark will convey a concept readily accessible to the average consumer. There is, consequently, no conceptual comparison to be considered.

The opponent's mark ending '787

27. Visually, the respective marks coincide in the letters G-E-N-T-I, which represent the beginning of each mark's word element. In the earlier mark, there is a figurative element at the beginning which has no counterpart in the later mark, though I keep in mind what I have said regarding the marks' overall impressions. I find the visual similarity of a medium degree.

² *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

28. I find it unlikely that the average consumer will attempt to articulate the figurative element in the opponent's mark and, consequently, aurally, I find the earlier mark phonetically identical to the opponent's mark ending '580. Applying my earlier reasoning, I find the marks' aural similarity to be of at least a medium degree.

29. Similarly, I find it unlikely that the figurative element in the opponent's mark will make any conceptual contribution. The mark will be viewed as a device paired with an invented word absent of any meaning. As neither mark makes a conceptual impression, there is no comparison to be conducted.

The opponent's mark ending '791

30. The first five letters in the parties' marks are the same, and the marks comprise nine and eight letters, respectively. There is a letter I in the eighth position in the earlier mark and the seventh in the later. I find the marks visually similar to at least a medium degree.

31. Aurally, the earlier mark will likely be articulated in three syllables; JEN-TEE-PAYN. When compared to the applicant's JEN-TIB-EE-OH, there is clearly an identity in the marks' first syllables and in each mark the second syllable begins with a percussive 'T'. I find the aural similarity between a low and medium degree.

32. Conceptually, the earlier mark will be viewed as an invented word with no specific concept, though the consumer may identify the word PAIN within the mark and conclude that the goods are intended to treat pain in its consumers (whilst I acknowledge that in regard to pharmaceutical products, this may not be attributed a great degree of conceptual weight). Still, the preceding part of the word, GENTI, offers no additional qualification and, overall, the respective marks will be viewed as invented words and neither offers a conceptual message which will readily be grasped by the average consumer.

The opponent's mark ending '653

33. The respective marks share an identical string of five letters at the beginning and each comprises eight letters in total, with the seventh letter in each mark an I. Each mark also features a B, albeit in different positions. I find the visual similarity between a medium and high degree.

34. Aurally, the earlier mark will likely comprise three syllables; JEN-TEE-NIB. The marks' respective first syllables are identical and each incorporates an 'EE' and 'IB' sound, though in different positions within the marks. Whilst the opponent's comprises three syllables and the applicant's four, both also incorporate a 'B' and the percussive sound that accompanies it. I find a medium degree of aural similarity.

35. Conceptually, neither mark is likely to convey a clear message to the average consumer as each will be viewed as an invented word absent of any apparent meaning. A conceptual comparison cannot therefore be conducted.

Distinctive character of the earlier trade marks

36. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

38. I must note the applicant’s comments regarding the marks’ common element ‘GENTI’, specifically that “the prefix GENTI- is common to marks on the UKIPO register” and “is non-distinctive”. The applicant does not appear to have presented evidence to show that the string of letters G-E-N-T-I is non-distinctive in the context of trade marks or otherwise and, even so, the existence of such marks on the register would not necessarily have any bearing on whether a likelihood of confusion exists in these proceedings. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not

enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71). “

I therefore dismiss the applicant’s contention that G-E-N-T-I is a non-distinctive prefix.

39. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence showing the use made of the earlier marks, I have only the inherent distinctiveness of the earlier marks to consider. I have already found that the earlier marks will be viewed as invented words and, consequently, I find each to possess a high degree of inherent distinctiveness. The degree may be slightly less in the case of the opponent’s mark ending ‘791 were the average consumer to identify the ‘PAIN’ element as it has somewhat of an allusive relationship with a characteristic of the relied upon goods, but nonetheless the inherent distinctiveness is fairly high.

Likelihood of confusion

40. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive it is, the greater the likelihood of confusion.

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

42. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.””

43. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

44. I will begin by considering a likelihood of direct confusion. I have found the marks’ visual similarity of a medium, or at least medium, degree and their aural similarity between a low and medium degree or a medium (or at least medium) degree and each mark’s word element begins identically with G-E-N-T-I. I keep in mind when approaching my assessment that the average consumer will likely apply between a medium and very high degree of attention to its selection of the respective goods. Still, the selection is not generally made with any meaningful degree of frequency and marks’ beginnings tend to make more of an impact on the consumer. Particularly in the case of the opponent’s earlier marks ending ‘580, ‘787 and ‘653, I can imagine that the average consumer may recall the identical string in the marks’ first five letters G-E-N-T-I and, given that the marks comprise invented words, it may simply misremember the marks’ alternate endings and believe the later mark to be one of the earlier, or vice versa. This may be a less likely outcome in the case of the opponent’s mark ending ‘791 as I have found that the average consumer may readily identify the word PAIN and, on that basis, it may acknowledge that the competing mark does not

incorporate the word PAIN and that they are, therefore, not the same. I should make clear that I find such an outcome more likely in the case of an average consumer applying only a medium degree of attention and, in the case of a professional consumer, or at least a consumer who is applying a high or very high degree of attention, an elevated attention level may be sufficient to allow the consumer to identify that the marks are not the same. In those circumstances, and if I am considered wrong to have found direct confusion where a medium degree of attention is in play, I will go on to consider a likelihood of indirect confusion.

45. As the case law indicates, this type of confusion requires a thought process on the part of the average consumer, in which it recognises that the marks are different but puts their similarities down to the marks being related in some capacity. A finding of indirect consideration should not be considered a consolation prize for those who fail to establish a likelihood of confusion; it requires a proper basis³. In the current proceedings, what the marks have in common is their first five letters, and they are each invented words unlikely to convey any real conceptual message. The interdependency principle sets out that a lesser degree of similarity between the parties' respective trade marks can be offset by a greater degree of similarity between the respective goods or services, and I find that to apply here. Were the consumer to acknowledge that the endings of the marks' word elements are different, I find it equally likely that it will acknowledge that the beginnings of the words are the same. As I've already said, I am not aware that G-E-N-T-I is a common 'prefix' in trade marks generally or in the relevant field. That being so, I find it likely that the average consumer will attribute its presence in the competing marks to more than a coincidence, having weighed the likelihood of two distinct entities electing to use invented words beginning with an identical five letters in respect of identical goods. The variation in names could be attributed to different products intended to treat different ailments or boasting different properties or ingredients, for example, but nonetheless the marks will be thought to originate from at least a related, if not the same, entity.

46. In my earlier assessment, I found it unlikely that the average consumer would dissect the applied for mark into a prefix and suffix, specifically GENTI- and -BIO, and

³ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

instead the overall impression resides in the word as a whole. If I am found to be wrong in that regard, and the average consumer *does* dissect it as such, the opponent's strongest case seems to lie in its GENTIPAIN mark (ending '791) as the consumer would likely dissect the mark in a similar way, given it ends in what will readily be viewed as ordinary dictionary word PAIN. Having identified that the earlier mark uses GENTI to precede PAIN and the later mark uses GENTI to precede BIO, to my mind, that coincidence in the marks' make-up, combining GENTI with a term which is somewhat allusive in the field of pharmaceuticals, would likely be attributed to a relationship between the respective origins, particularly in respect of identical goods. In other words, indirect confusion would occur.

Conclusion

47. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

48. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2016. In accordance with that TPN, I award costs as follows:

Filing a Notice of Opposition (official fee):	£100
Preparing a statement of grounds and considering the counterstatement:	£200
Preparing written submissions in lieu of a hearing:	£200
Total:	£500

49. I order GentiBio Inc. to pay Istituto Gentili S.R.L. the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within

twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of December 2022

**Laura Stephens
For the Registrar**