

O-500-20

TRADE MARKS ACT 1994

IN THE MATTER OF  
APPLICATION NO. WO0000001378665  
BY MY DNA LIFE LIMITED  
TO GRANT PROTECTION IN THE UNITED KINGDOM  
FOR THE FOLLOWING INTERNATIONAL TRADE MARK:



IN CLASS 42

AND

OPPOSITION THERETO UNDER NO. 412478  
BY DEWAN FAZLUL HOQUE CHOWDHURY

## BACKGROUND AND PLEADINGS

1. My DNA Life Limited (“the Holder”) is the holder of International Registration no. WO0000001378665 (“the IR”) in respect of the mark detailed on the cover page of this decision. The IR was registered on 13 October 2017 and, with effect from the same date, the Holder seeks to protect the IR in the UK under the terms of the Protocol to the Madrid Agreement. The Holder seeks protection in respect of the following class 42 services:

*DNA testing services; scientific research including scientific research relating to genetics; advisory services relating to scientific research; analytical laboratory services; medical laboratory services; medical research; scientific services; biotechnological research.*

2. The IR was published in the UK for opposition purposes on 23 March 2018. On 15 May 2018 Dewan Fazlul Hoque Chowdhury (“the Opponent”) opposed the designation in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon United Kingdom trade mark (“UKTM”) no. UK00003117087, the pertinent details of which are as follows:

The logo consists of the word "my" in a small, grey, lowercase sans-serif font, positioned to the left of the word "DNA" in a large, bold, black, uppercase sans-serif font.

**Representation:**

**Filing date:** 09 July 2015

**Registration date:** 13 November 2015

**Services (as relied upon):** Class 42: *Medical research; scientific and industrial research; genetic testing for scientific research purposes.*

3. The Opponent’s UKTM qualifies, under section 6 of the Act, as an earlier trade mark for the purpose of these proceedings. Given its registration date, it is not subject to the proof of use provisions contained in section 6A of the Act.

4. The Opponent's case under section 5(2)(b) is that the Holder's mark is similar to its earlier mark and is seeking protection for similar/identical services, resulting in a likelihood of confusion.

5. The Holder filed a counterstatement in which it denies a likelihood of confusion on the basis that the marks at issue are not similar. The Holder does, however, state that the services covered by its IR are identical and similar to those covered by class 42 of the Opponent's mark.

6. The Opponent is represented by Serjeants LLP. The Holder is represented by Boulton Wade Tennant LLP. Neither party filed evidence. Neither party requested a hearing. Only the Opponent filed written submissions, during the evidence rounds. This decision is taken following a careful perusal of the papers.

## **DECISION**

### **Section 5(2)(b)**

7. Section 5(2)(b) of the Act states that:

“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.”

### **Relevant law**

8. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### 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 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 services**

9. The competing services are shown in the table below:

<b>Earlier mark (as relied upon)</b>	<b>Holder's mark</b>
<i>Medical research; scientific and industrial research; genetic testing for scientific research purposes.</i>	<i>DNA testing services; scientific research including scientific research relating to genetics; advisory services relating to scientific research; analytical laboratory services; medical laboratory services; medical research; scientific services; biotechnological research.</i>

10. In its counterstatement, the Holder admits that its services are identical and similar to the class 42 services relied upon by the Opponent. However, as the Holder has not

identified which of the services it considers to be identical and the degree to which any similarity exists, I will undertake a full comparison of the services in issue.

11. The General Court confirmed in *Gérard Meric v OHIM*<sup>1</sup> that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

12. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,<sup>2</sup> the court stated at paragraph 23 of its judgment that:

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

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>3</sup> for assessing similarity were:

(a) the respective uses of the respective goods or services;

(b) the respective users of the respective goods or services;

---

<sup>1</sup> Case T-133/05

<sup>2</sup> Case C-39/97

<sup>3</sup> [1996] R.P.C. 281

(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.

14. In the absence of evidence or submissions from the parties relating to the definitions of the terms in their respective specifications, I rely on my own knowledge of those terms, where necessary.<sup>4</sup>

15. It is self-evident that the parties' "*medical research*" services are identical.

16. I find the Holder's "*DNA testing services*" identical to the Opponent's "*genetic testing for scientific research purposes*" since DNA testing and genetic testing are terms that are used interchangeably.

17. In accordance with *Meric*, I find the Holder's "*scientific research including scientific research relating to genetics*" and "*biotechnological research*" identical to the Opponent's "*scientific and industrial research*".

18. In accordance with *Meric*, I find the Holder's "*scientific services*" identical to the Opponent's specification since scientific services would encompass medical research, scientific and industrial research, and genetic testing.

---

<sup>4</sup> *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842 [56]-[57]

19. Taking note of the factors identified in the *Canon* and *Treat* cases, I find the Holder's "advisory services relating to scientific research" highly similar to the Opponent's "scientific and industrial research" given that one is an advisory service for the other and that the users and the respective trade channels are likely to overlap.

20. The Holder's "analytical laboratory services" and "medical laboratory services" and the Opponent's services often take place in a laboratory setting. In addition, the users of these services are likely to overlap to the extent that they could all be used by professionals in the field, they are likely to be available through the same trade channels, i.e. scientific testing facilities, there will be an overlap in nature and method of use, and there may also be an overlap in purpose. Therefore, I conclude that these services are highly similar.

### **The average consumer and the nature of the purchasing act**

21. It is necessary for me to determine who the average consumer is for the services in question; I must then determine the manner in which the services are likely to be selected by the average consumer in the course of trade.

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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*.<sup>5</sup>

23. 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*,<sup>6</sup> 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

---

<sup>5</sup> Case C-342/97

<sup>6</sup> [2014] EWHC 439 (Ch)



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.”

24. The average consumer of the services at issue will be either the public at large or healthcare professionals. I deal, firstly, with the services used in a medical context. For members of the general public, the purchase will be a fairly infrequent one and, although the services will vary greatly in price, they are unlikely to be inexpensive. For healthcare professionals, their knowledge of the services will be greater, and the purchase will be more frequent. In relation to the services associated with DNA and genetic testing, these have become more commonplace in the consumer market in recent years and will be available at a lower price than that of the other services at issue. Therefore, the same level of attention is not necessarily required for DNA and genetic testing services as it is for those services that concern the health of the final consumer. Taking all of this into account the level of attention will range from average to high. The services at issue are likely to be selected both visually (from websites and advertising material) and aurally (from recommendations and referrals). Bearing this in mind, I find that both visual and aural considerations of the marks are important.

### **Comparison of marks**



25. It is clear from *Sabel* 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

27. The respective marks are shown below:

Earlier mark	Holder’s mark
	

28. The earlier mark consists of the word “DNA” written in block capitals and in black and the word “my” written in lower case and in grey. The word “my” appears in a much smaller font and is superimposed on the letter “D” of the word “DNA”. Due to its smaller size, the visual impact of the word “my” is less significant than that of the word “DNA”. However, the combination “my DNA” will still be perceived as a unit.

29. The Holder’s mark consists of the word “DNA” written in block capitals and in light grey, (i) preceded by the word “my” written in lower case and (ii) followed by a full stop and the word “life” written in lower case, all in grey. Below the textual components are five images of people in varying shades of grey: they appear to represent people of different genders and ages. Considering their size and prominent position in the mark, the textual components “myDNA.life” are dominant in the mark, although the figurative devices still contribute to the overall look and feel of the mark.

### Visual comparison

30. The words of the earlier mark appear, successively, in the same order in the Holder's mark, meaning the entirety of the earlier mark is visible in the Holder's mark. The differences are in: (i) the stylisation and positioning of the words "my DNA"; and (ii) the addition of ".life" and the five images in the Holder's mark. In my view, the marks are visually similar to a medium degree.

### Aural comparison

31. Taking the view that neither the full stop nor the images in the Holder's mark will be articulated, the marks will be pronounced as MY DNA (earlier mark) and MY DNA LIFE (Holder's mark). I find the marks to be aurally similar to a high degree.

### Conceptual comparison

32. The presence, in both marks, of the words "my DNA" creates the same concept: that being the DNA belonging to or associated with the user. Whilst the word "life" in the Holder's mark is fairly low in distinctiveness for the services at issue, it does slightly alter the concept of "my DNA" because it makes the meaning somewhat ambiguous. In my view, the images in the Holder's mark do not create an alternative concept to consider. Overall, I find the marks conceptually highly similar.

### **Distinctive character of the earlier mark**


33. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer*, 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).”

34. The Opponent has not claimed that the earlier mark has an enhanced distinctive character through use and has filed no evidence in this regard. I therefore have only the inherent position to consider.

35. The earlier mark consists of the sign . The Oxford English Dictionary defines DNA as “*deoxyribonucleic acid, a self-replicating material which is present in nearly all living organisms as the main constituent of chromosomes. It is the carrier of genetic information*”. Whilst I acknowledge that the average consumer may not know what DNA stands for, or the full definition of DNA, they are likely to recognise it as being a term associated with genetics. The word “my” is merely the determiner denoting that the thing that follows belongs or is associated with the speaker. Consequently, the verbal element of the mark as a whole, i.e. “my DNA”, will be understood as an expression referring to the consumer’s DNA or genetic information.

36. In relation to the services at issue in class 42, the words “my DNA” are elements with a low degree of distinctive character, particularly in the context of services concerning personalised DNA and genetic testing. The get-up of the mark does not

make a material difference to my finding, so, the distinctiveness of the mark as a whole is low.

### **Likelihood of confusion**

37. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have referred in paragraph 8 of this decision. Such a global assessment is not a mechanical exercise. I must keep in mind the average consumer of the services and the nature of the purchasing process. I remind myself that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind: see *Lloyd Schuhfabrik Meyer*, paragraph 27.

38. There are two types of confusion: direct and indirect. The distinction between the two was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>7</sup>

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

---

<sup>7</sup> BL O/375/10

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

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

39. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>8</sup>

40. Due to the clear visual and aural differences between the marks at issue, I am satisfied that the average consumer will not mistake one mark for the other. The devices and the word “life” in the Holder’s mark are likely to prevent the marks from being misremembered or mistakenly recalled. There is no likelihood of direct confusion.

41. I go on now to consider whether the average consumer, having recognised that the marks are different, would consider the common elements of both marks and determine, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

---

<sup>8</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]



**Preparing written submissions: £200**

**Official fee: £100**

**Total: £500**

46. I therefore order My DNA Life Limited to pay Dewan Fazlul Hoque Chowdhury the sum of £500. This sum should 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 7th day of October 2020**

**Emily Venables**

**For the Registrar**

**The Comptroller-General**