

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2012600**  
**of 9 August 2018**

**Opponent:** **BioSystems, S.A.**  
Costa Brava, 30  
08030 Barcelona  
Spain

**Representative:** **Chiever B.V.**  
Barbara Strozilaan 201  
1083 HN Amsterdam  
Netherlands

**Invoked right:** **EU trademark 4424818**



*against*

**Defendant:** **HurraH S.à r.l.**  
Rue d'Olm 61  
8281 Kehlen  
Luxembourg

**Representative:** **Office Freylinger S.A.**  
route d'Arlon 234  
8010 Strassen  
Luxembourg

**Contested trademark:** **Benelux application 1341446**


ABRACA BIOSYSTEMS

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 21 October 2016 the defendant filed an application for a trademark in the Benelux for the wordmark ABRACA BIOSYSTEMS for goods and services in classes 1, 5, 9, 11, 35 and 42. This application was processed under number 1341446 and was published on 27 October 2016.

2. On 16 December 2016 the opponent filed an opposition against the registration of the application. The

opposition is based on EU trademark 4424818 for the combined word/figurative mark  filed 3 June 2005 and registered on 12 June 2006 for goods in classes 1, 5 and 10.

3. According to the register the opponent is the actual holder of the trademark invoked.

4. The opposition is directed against part of the goods in classes 1, 5 and 9 of the contested application and is based on all goods of the trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

6. The language of the proceedings is English.

### B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 19 December 2016. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 27 October 2017.

## II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

### A. Opponent's arguments

9. The opponent first explains that, as a promotor of the health of people, Biosystems S.A. researches, develops, produces and markets instruments, reagents and reliable analytical systems for laboratories around the world.

10. With regard to the visual comparison of the signs, the opponent argues that the element BioSystems in the trademark invoked is the most eye-catching element, because of its position, larger font size and the descriptive character of the caption 'REAGENTS & INSTRUMENTS'. The opponent states that the word BioSystems and BIOSYSTEMS are visually almost identical. According to the opponent, the first word of the contested sign ABRACA does not change the fact that both signs are globally similar.

11. The opponent also states that, because of the presence of the identical word 'biosystems' and the fact that the differences between the marks do not provide sufficient distinctiveness between the marks, the overall impression is that the signs are aurally similar.

12. Due to the fact that both signs contain the word 'biosystems', the opponent argues that, when compared globally, the signs are conceptually similar.

13. The opponent states that the contested goods are partly identical and partly highly similar to the goods of the trademark invoked.

14. The opponent concludes that, despite an increased level of attention for some of the goods concerned, there exists a risk of confusion. For this reason, the opponent requests that the Office grants the opposition.

15. At the request of the defendant, the opponent filed proof of use.

#### **B. Defendant's arguments**

16. The defendant points out that the opponent has not explicitly stated that the trademark invoked is distinctive by virtue of intensive use or reputation. According to the defendant all three word elements of the trademark invoked are descriptive. The words 'Reagents & Instruments' refer to substances and tools required for a chemical reaction. Furthermore, the word 'Biosystem' could be defined as "*a living organism or a system of living organisms that can directly or indirectly interact with others*" or "*any system of mutually interacting biological organisms*". Therefore the defendant argues that the only distinctive elements of the trademark invoked are the figurative elements.

17. With regard to the contested sign, the defendant states that the only dominant and distinctive element is the word ABRACA, which has no meaning with regard to the goods concerned and is positioned at the beginning of the sign.

18. According to the defendant, the comparison of the signs should be made between the distinctive elements, which are the figurative elements of the trademark invoked and the word element ABRACA of the contested sign. In the light of the foregoing, the defendant states that there is no visual similarity.

19. The defendant further argues that, with regard to the aural comparison, the trademark invoked only contains a description of what is marketed under the sign. The contested sign on the other hand, begins with a distinctive and aurally very strong element which will be remembered by the consumer. According to the defendant, with regard to the contested sign, the consumer will probably forget the following descriptive element 'Biosystems'. For this reason, the defendant is of the opinion that the phonetic overall impression is not similar.

20. With regard to the conceptual comparison of the signs, the defendant states that, contrary to the trademark invoked, the contested sign contains a fanciful and magical word, which is ABRACA. For this reason, the signs are not conceptually similar.

21. With respect to the proof of use the defendant states that the documents submitted by the opponent are insufficient to prove use for the relevant goods in the relevant territory, the European Union. According to the defendant, the documents only show the trademark invoked mentioned as a company name. However, it has not been proven that the goods concerned depict the trademark invoked. Furthermore, the defendant states that the catalogues do not contain any indication of the place, extent and manner of use of the earlier trademark. Moreover, some of the documents show a sign which does not correspond with the trademark invoked.

22. The defendant states that the opponent has not proven that the trademark invoked has been genuinely used and for this reason the comparison between the goods, as well as the signs, has become irrelevant. In addition, the signs are not similar and for this reason, the defendant concludes that there is no likelihood of confusion. In the light of the foregoing, the defendant requests that the Office rejects the opposition.

### **III. DECISION**

#### **A.1 Likelihood of confusion**


23. In accordance with article 2.14, 1 BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b) BCIP.

24. Article 2.3 (a) and (b) BCIP stipulates that *"In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark."*

25. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

**Comparison of the signs and the goods**

26. The signs and goods to be compared are the following:

Opposition based on:	Opposition directed against:
	<p>ABRACA BIOSYSTEMS</p>
<p>Class 1 Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry; chemical reagents (other than for medical or veterinary purposes); chemical substances for analyses in laboratories (not for medical or veterinary purposes); bases (chemical preparations); diagnostic preparations (not for medical or veterinary purposes).</p>	<p>Class 1 Ion-exchange resins; ion-exchange membranes; ion-exchange resin membranes [chemical preparation]; chemical substances for impregnation into membranes; media for use in chromatography [not medical]; particulate material for use in chromatographic processes [other than medical]; transfer membranes for biotechnology and for laboratory use; Diagnostic preparations and chemical diagnostic products for scientific use; Chemical diagnostic reagents for industrial use; Diagnostic reagents for scientific or research use; Diagnostic reagents for in vitro use in biochemistry, clinical chemistry and microbiology; diagnostic testing materials, other than for medical or veterinary use; Diagnostic reagents, other than for medical laboratory use; absorption agents.</p>
<p>Class 5 Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; chemical reagents for medical or veterinary purposes; chemical preparations for medical or veterinary purposes; reagents for clinical analyses.</p>	<p>Class 5 Medical diagnostic test strips; Diagnostic preparations for medical or veterinary purposes; Diagnostic biomarker reagents for medical purposes; Medical, veterinary and clinical diagnostic reagents; Diagnostic agents for pharmaceutical use; Diagnostic preparations for veterinary or medical purposes; Diagnostic agents, diagnostic substances, diagnostic reagents and chemical diagnostic chemical reagents for medical use; Reagents for use in diagnostic tests, for medical or veterinary purposes.)</p>
	<p>CI 9 Scientific apparatus and instruments, in particular separation apparatus and instruments for laboratory use, laboratory filters, filters and filter modules for scientific laboratory use and for laboratory experiments; scientific membranes for filtration; membrane filters with adsorption</p>

properties, such as membrane absorbers, adsorption membranes, ion exchange membranes, affinity membranes, ligand membranes and activated membranes in the form of hollow fiber membranes, tube membranes, sheet membranes and flat membranes as strips or cut- to-size for use in apparatus, filters and filter modules for scientific or laboratory use; membranes, membrane filters and filter matting being part of microtiter plates, of filter systems, or being stand-alone media for chromatographic analysis and substance separation, for concentration or for the ultra-purification of fluids; apparatus for processing solutions in the pharmaceutical, medical and laboratory sectors; apparatus for removing pollutants from fluids; filters and filter modules for the filtration and concentration of biological solutions, and for the analysis of macromolecules and biomolecules, namely carbohydrates, peptides, proteins and nucleic acids; filtering units and ultra-filtration membranes for laboratory apparatus; Diagnostic apparatus, not for medical purposes; Testing apparatus for diagnostic purposes, other than for medical use; filtering membranes for scientific use; apparatus for automatic chromatography, chromatographs and chromatography instruments for scientific or laboratory use; liquid chromatography injectors and liquid chromatography columns for scientific use; automatic ion-exchange chromatography instruments for laboratory use; chromatography membranes/media in any of the following formats, rolls, flat sheets, cut discs, syringe columns, spin columns, pipette tips, multi-well plates, cassettes, pleated capsules and cartridges, spiral wound elements, tangential flow, radial flow or dead-end flow housings, all for use in performing chromatographic separations; separation columns for scientific use, in particular separation and filtration devices employing polymeric materials for use in protein purification and in other biological and industrial separations, in large-scale bioprocessing, in small-scale bio-analytics, in blood processing, and in food and beverage processing.

Class 10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials; analysis devices, diagnostic apparatus for medical purposes; testing apparatus for medical purposes.	
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27. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) “there exists a likelihood of confusion on the part of the public” shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, *Sabel*, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

28. Global assessment of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, *Sabel* and *Lloyd*, already cited).

29. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, *Limonchello*, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, *Matratzen*, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and *El Charcutero Artesano*, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

30. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case *Lloyd*, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. In the present case, the goods concerned are specialist goods directed mainly at professionals with specific knowledge and expertise in the scientific and medical fields, including chemistry and diagnostics. Taking into account the fact that these goods are, for the most part, intended for laboratory use and may be quite complex and advanced, the public's degree of attention is considered higher than average.

31. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (*Canon*, *Sabel* and *Lloyd*, already cited).

32. The trademark invoked is a combined word/figurative mark that consists of the word element ‘BioSystems’, depicted in large white letters which are placed in a red rectangle. Below, the sign contains the caption ‘REAGENTS & INSTRUMENTS’, depicted in white letters which are placed in a black rectangle. The contested sign is a purely verbal mark, consisting of two words: ABRACA BIOSYSTEMS.

33. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd*, already cited), the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (EGC, *Respicur*, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; *Aturion*, T-146/06, 13 February 2008, ECLI:EU:T:2008:33;

Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). Due to the use of the capital letter S in the trademark invoked, the Office finds that it is likely that the public will split the word Biosystems into two different parts: Bio and Systems. The word 'Bio' is a common abbreviation of 'biological'<sup>1</sup>, which is an adjective indicating a relation to biology or living organisms.<sup>2</sup> A system is a set of things working together as parts of a mechanism or an interconnecting network.<sup>3</sup>

34. Generally, the public will not consider a descriptive element forming part of a mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003, ECLI:EU:T:2003:184). This is the case for the word elements 'BioSystems' and 'REAGENTS & INSTRUMENTS'. The term 'BioSystems' is descriptive because the goods concerned could be part of a device, system or method involving biological substances. The words 'reagents & instruments' literally describe the goods concerned.

35. Even though, by analogy to the case law of the European Court of Justice in the case F1-LIVE (C-196/11 P, 24 May 2012, ECLI:EU:C:2012:314), it cannot be concluded that an EU trademark that serves as the basis for an opposition is considered as being devoid of distinctive character, the Office considers that the trademark invoked only has a very low distinctive character given the descriptive nature of the word elements in relation to the scientific and medical products concerned.

#### *Conclusion*

36. The similarities between the trademark invoked and the contested sign only lie within a descriptive element. The Office also takes into account that the signs contain clear visual differences such as the use of colours and figurative elements and that the first part of the contested sign 'ABRACA' is a distinctive, imagined term, which is not present in the invoked trademark. These differences are sufficient to neutralize the points of similarity. For this reason, the overall impression of the signs is different. Therefore, in the light of the foregoing, including the higher level of attention of the specialist public for the goods concerned, the Office considers that there will be no likelihood of confusion even if the goods are deemed identical. For this reason, a comparison of the goods is not necessary.

#### **C. Conclusion**

37. Based on the foregoing the Office is of the opinion that there is no likelihood of confusion.

#### **IV. DECISION**

38. The opposition with number 2012600 is rejected.

39. Benelux application with number 1341446 will be registered for all goods for which it has been applied.

40. The opponent shall pay the defendant 1,030 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

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<sup>1</sup> <https://en.oxforddictionaries.com/definition/bio>

<sup>2</sup> <https://en.oxforddictionaries.com/definition/biological>

<sup>3</sup> <https://en.oxforddictionaries.com/definition/system>



The Hague, 9 August 2018

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