

BL O-701-19

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERNATIONAL REGISTRATION DESIGNATING THE
UNITED KINGDOM NO. 1396954 BY GENESIS GENETICS CO., LTD
TO REGISTER:**

GENESIS GENETICS

AS A TRADE MARK IN CLASS 44

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 414287 BY
INVITRO GENETICS, LLC**

BACKGROUND & PLEADINGS

1. On 22 December 2017, Genesis Genetics Co., Ltd (“the applicant”), designated the UK seeking protection of the trade mark **GENESIS GENETICS** for services in class 44. The designation was published for opposition purposes on 3 August 2018. The amended specification is shown in paragraph 53 below.

2. On 5 November 2018, the application was opposed in full by Invitro Genetics, LLC (“the opponent”). The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the services shown in paragraph 53 below in the following European Union Trade Mark (“EUTM”) registration:

No. 5014279 for the words **GENESIS GENETICS** which was applied for on 11 April 2006 (claiming an international convention priority date of 14 October 2005 from an earlier filing in the UK) and which was entered in the register on 28 March 2007.

In its notice of opposition, the opponent states in relation to its objection based upon section 5(1) of the Act:

“The trade marks in issue are self-evidently identical.

It is submitted that the opposed services and the services of the applicant relied upon are identical. The applicant's "genetic testing for medical purposes" having the same nature and purpose as the opponent's "medical laboratory services" for example, being laboratory and scientific investigatory and testing services provided for medical purposes. These services are provided to the same or similar consumers and can be both complementary or in competition with each other given their broad nature...”

3. In the event the competing services are not considered to be identical, the opponent argues that they are “highly similar”, adding that the application should be refused under section 5(2)(a) of the Act.

4. The applicant filed a counterstatement in which it admits the competing trade marks are identical. In relation to the competing services, it states:

“It is denied that the services of the opposed application are similar to the services of the earlier registration. "Genetic testing for medical purposes" of the opposed application relates to medical treatment and diagnosis, including medical analysis services comprising genetic or chromosome analysis. By contrast "medical laboratory services" covered by the earlier registration, relate to scientific research services. The Applicant believes that the respective services will be provided into different markets and directed to different consumers...”

5. In these proceedings, the opponent is represented by Gill Jennings & Every LLP (“GJE”) and the applicant by Mathisen Macara LLP. Although only the opponent filed evidence, the applicant filed written submissions during the evidence rounds. While neither party requested a hearing, both filed written submissions in lieu of attendance. I have reviewed all of these submissions and will, to the extent I consider it necessary, refer to them later in this decision.

DECISION

6. The opposition is based upon sections 5(1) and 5(2)(a) of the Act which read as follows:

“5(1) - A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

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

(b)...

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

7. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the above provisions. Given the interplay between the dates on which the opponent’s trade mark was entered in the register and the publication date of the designation, the earlier trade mark relied upon is subject to the proof of use provisions. In its notice of opposition the opponent states that it has used its earlier trade mark in relation to all the services shown in paragraph 53 and, in its counterstatement, the applicant asks the opponent to make good that claim.

The opponent’s evidence

9. This consists of a witness statement from Alice Anderson, an Associate at GJE. Ms Anderson states:

“...I am duly authorised to make this witness statement by [the opponent] and I do so from the information and materials provided to me by [the opponent], or my own knowledge and research.”

10. Ms Anderson explains that “she has been advised” that the opponent has used the trade mark upon which it is relying within the EU in relation to “medical laboratory services; reproductive genetic testing.” However, in paragraph 24 of its submissions, the opponent accepts that as its opposition is only based upon “medical laboratory services”, it is only those services upon which it is entitled to rely; I agree.

11. Ms Anderson explains that she “has been advised” that:

“2.... Invitro Genetics, LLC is a subsidiary of The Cooper Companies, Inc...”

And:

“3...Invitro Genetics Ltd...is also a subsidiary of The Cooper Companies, Inc...”

And:

“4. Invitro Genetics, LLC and Invitro Genetics Ltd are therefore part of the same family company group.”

12. Exhibit 1 consists of an extract from the website of Companies House indicating that Invitro Genetics Limited was incorporated on 3 December 2015. I note that in its submissions, the applicant “accepts that [the opponent] and Invitro Genetics Ltd are both subsidiaries of The Cooper Companies, Inc.”

13. Exhibit AA3, consists of an extract dated 4 April 2016 obtained from The Cooper Companies website entitled: “The Cooper Companies Women’s Health Care Unit Acquires Genesis Genetics.” Ms Anderson states:

“5... I have been advised that Invitro Genetics Ltd was formed out of the acquisition to operate the Genesis Genetics business in the UK and Europe (Genesis Genetics London and Genesis Genetics Europe being trading names for the laboratories based in London and Nottingham respectively) and Invitro Genetics, LLC was formed to operate the business in the USA. However, I am advised that EUTM registration no. 5014279 is held by Invitro Genetics LLC for business reasons.”

14. Exhibit AA4 consists of an article from www.prnewswire.co.uk (described as “a distributor of press releases”) dated 30 June 2014, which contains the following:

“Genesis Genetics, a global leader in reproductive genomics has opened a new state-of-the-art clinical and research laboratory in London U.K. Its team of scientists and physicians will focus on the company’s core technical expertise – analysing the genetics of microbiological samples – as well as develop ways to adapt its discoveries into practical applications for the health and well-being of patients....”It is essential that we are shoulder-to-shoulder with top-flight British scientists who are within walking distance of the leading hospitals and clinics of the city” said Hughes...”...”believes the new location is key for partnering with the many hospitals that London has to offer “With the nature of our diagnostic work, there is value in being close to the clinics that need our services”...Genesis Genetics has had an active clinical presence in Nottingham, England for... midlands and the north...In addition to single-gene PGD, Genesis Genetics provides comprehensive chromosome screening, using advanced technologies to test IVF embryos and non-invasive prenatal testing (NIPT) of maternal blood during pregnancy...”

15. Exhibit AA5 consists of a United Kingdom Accreditation Service (“UKAS”) Application Form dated 18 April 2016 by “InVitro Genetics Limited trading as Genesis Genetics” for its laboratories in Nottingham and London. The extract from Wikipedia provided in the exhibit describes UKAS as:

“...the sole national accreditation body recognised by the British Government to assess the competence of organisations that provide certification, testing, inspection and calibration services...”

16. In relation to the question: “What is the main business activity of your company?”, inter alia, the opponent entered:

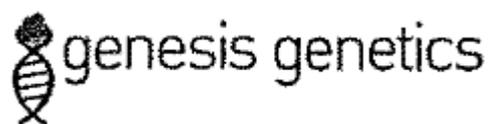
“Genesis Genetics UK offers preimplantation genetic testing on biopsied samples from IVF generated embryos for couples...”

And:

“...also offers non-invasive prenatal testing (NIPT) from maternal plasma to identify trisomy 13 or trisomy 18 or trisomy 21 or sex chromosome aneuploidies in free fetal DNA.”

17. Exhibit AA5 also contains two Accreditation Schedules issued by UKAS to “Invitro Genetics Ltd, trading as Genesis Genetics Ltd” dated 30 January 2017 and 5 November 2017, respectively. Both Accreditations refer to the Nottingham and London laboratories. The 30 January 2017 Accreditation refers to both “Preimplantation Genetic Diagnosis” and “Preimplantation Genetic Screening” at both locations. While the 5 November 2017 Accreditation also refers to both activities at both locations, it also includes “Non-invasive Prenatal testing” at the London laboratory.

18. Exhibit AA6 contains a blank “Biopsy Submission Form” with an issue date of 5 February 2016 and a blank “Physician Test Order Form” with an issue date of 23 June 2017, respectively. Both Forms relate to the laboratories in Nottingham and London i.e. Genesis Genetics Europe and Genesis Genetics London. At the top left-hand side of both Forms there appears the following:



19. The Biopsy Submission Form and Physician Test Order Form includes options for “PGD for an inherited genetic disorder(s)”, “PGD for chromosome translocation” and “PGS (Preimplantation Genetic Screening for chromosome aneuploidy).”

20. Ms Anderson describes exhibit AA7 as consisting of:

“9...a copy of the slides for a presentation which I am advised details the services provided under the mark GENESIS GENETICS presented by Tony Gordon at the Illumina (a company which analyses genetic variation) UGM on 15 November 2017 and a copy of a scientific report - "Tripolar mitosis and partitioning of the genome arrests human preimplantation development *in vitro*" - written by (amongst others) Tony Gordon of "Genesis Genetics" of the London Bioscience and Innovation Centre, London on 29 August 2017.”

21. I note that the slide presentation provided entitled “Microdeletions and All Chromosomes NIPT” was presented by Mr Gordon on the date mentioned at the “Illumina UGM 15th Nov 2017”. The presentation, which also contains references to “Illumina”, contains references to “Genesis Genetics”. However, it is not clear to me who Illumina/Illumina are or where the presentation was made. The scientific report from, it appears, www.nature.com, is as Ms Anderson describes.

22. That concludes my summary of the evidence filed to the extent I consider it necessary.

Proof of use

23. As the earlier mark had been registered for more than five years on the date on which the contested designation was published, Section 6A of the Act applies, which states:

“6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements
which do not alter the distinctive character of the mark in the form in
which it was registered, and

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

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

24. In reaching a conclusion, I must apply the same factors I would as if I were determining an application for revocation based upon non-use. As the proceedings commenced prior to 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use is the five year period ending with the date the designation was published i.e. 4 August 2013 to 3 August 2018 and not, as the opponent states in its submissions, 22 December 2012 to 21 December 2017.

25. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114...the CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal*

Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:
(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

26. As the earlier trade mark being relied upon is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant, in which the Court noted:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining

genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

27. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge

to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

28. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark

opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

29. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

Has genuine use has been accepted by the applicant?

30. In its submissions, the opponent states:

“6. In their submissions, the Applicant admits that the proof of use provided by the Opponent is sufficient for the opposition to proceed for the services upon which the opposition is based...”

31. The opponent provides three quotations by the applicant exemplifying why it considers this to be the case. These are as follows:

“a. “the press release [in Exhibit AA4] seems to confirm that Genesis Genetics provided laboratory and research services to medical researchers and hospital clinics”...

b. "in Exhibit AA5, Invitro Genetics Ltd are applying for accreditation for services which appear to be medical laboratory services. It is noted that both of the managers listed on the application form appear to have a background in medical research"...

c. "the Applicant notes that this exhibit [AA7] appears to highlight that the activities of Genesis Genetics is in the field of medical research and medical laboratory services..."

32. While I think the opponent's submission has merit, I shall nonetheless conduct my own assessment reminding myself that the relevant period is: 4 August 2013 to 3 August 2018.

Use with consent?

33. The opponent's evidence comes from Ms Anderson of GJE based, for the most part, on information provided to her by the opponent; the applicant has taken no issue in this regard. In its evidence, the opponent explains that it and Invitro Genetics Limited are subsidiaries of The Cooper Companies, Inc. and that Invitro Genetics Limited (incorporated on 3 December 2015) was formed to operate the Genesis Genetics business in the UK and Europe while the opponent was formed to operate the business in the USA. The trade mark being relied upon is, states the opponent, being held in its name for "business reasons." In its evidence, the opponent states:

"[The opponent] and Invitro Genetics Ltd are therefore part of the same family company group..."

34. In its submissions, it goes on to refer to use being made by the opponent "or an associated entity with the opponent's consent...". I infer the latter to be a reference to Invitro Genetics Limited. As I noted earlier, in its submissions filed during the evidence rounds, the applicant accepted that the opponent and Invitro Genetics Limited are both subsidiaries of The Cooper Companies, Inc. As nothing in either set of written submissions provided by the applicant suggests that it considers any use made by Invitro Genetics Limited of the GENESIS GENETICS trade mark is not use

upon which the opponent is entitled to rely, that is the basis on which I intend to proceed.

Overview of the opponent's evidence

35. The article from June 2014 explains that the opponent's predecessors in title, Genesis Genetics, had opened a new clinical and research laboratory in London and it describes the company's core technical expertise as "analysing the genetics of microbiological samples, as well as developing ways to adapt its discoveries into practical applications for the health and well-being of patients." The article goes on to explain that Genesis Genetics has had an active clinical presence in Nottingham; it does not, however, state from when. The article further states that in addition to single-gene PGD, Genesis Genetics will provide comprehensive chromosome screening, using advanced technologies to test IVF embryos and non-invasive prenatal testing (NIPT) of maternal blood during pregnancy.

36. Having announced in April 2016 that the Genesis Genetics business had been acquired by the group of companies of which the opponent is a part, on 18 April 2016, a request for Accreditation was submitted to UKAS by Invitro Genetics Limited, trading as Genesis Genetics and, on 30 January and 5 November 2017, respectively, Accreditation Schedules were issued to "Invitro Genetics Ltd", trading as Genesis Genetics Ltd for the Nottingham and London laboratories. The Schedules are in relation to "Preimplantation Genetic Diagnosis", "Preimplantation Genetic Screening" and "Non-invasive Prenatal testing".

37. The opponent has also provided a blank "Biopsy Submission Form" with an issue date of 5 February 2016 and a blank "Physician Test Order Form" with an issue date of 23 June 2017, respectively; both Forms refer to the laboratories in Nottingham and London. The words Genesis Genetics appear on the Forms in the formats shown in paragraph 18 above and relate to the services itemised in paragraph 19 above. Finally, the scientific report provided as exhibit AA7 which was published on 29 August 2017 contains a reference to Genesis Genetics at its address in London.

38. In considering the opponent's evidence I remind myself of the comments of Mr Daniel Alexander Q.C. as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/236/13 i.e:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

39. The comments of Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, are also relevant i.e.

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a

tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Considerations

40. Keeping the above guidance in mind, the evidence shows that by June of 2014 (when the opponent’s predecessors in title opened a new laboratory in London under the name Genesis Genetics), a business had been operating under that name in Nottingham. Although no evidence is provided of how long that business had been in operation, it is clearly also a clinical and research laboratory.

41. The evidence also shows that as early as February 2016, the words “genesis genetics” appeared on the blank Forms mentioned above. Although the words are accompanied by a device, that use is acceptable for the reasons explained by the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12. In April of 2016, the words Genesis Genetics also appeared on the UKAS Application Form and in the subsequent Schedules of Accreditation.

42. The opponent has, however, provided no evidence of any undertakings to whom its services may have been supplied within the relevant period, nor has it provided even estimates of any sales achieved under or amounts spent promoting its GENESIS GENETICS trade mark.

43. As the case law makes clear, genuine use must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns.

44. As is so often the case in proceedings before this tribunal, the opponent's evidence leaves a lot to be desired. However, when the opponent's evidence is considered as a totality, I think it would be unrealistic for me to conclude that within the relevant period the opponent's predecessor in title and then the opponent (via Invitro Genetics Limited) had not been conducting a trade in the UK under its GENESIS GENETICS trade mark. That, I think, accords with the applicant's view of the matter as reflected in its submissions referred to in paragraph 31 above.

45. However, even if that is regarded as being a too generous view of the opponent's evidence and a too liberal interpretation of the applicant's submissions, the opening of the London laboratory under the name Genesis Genetics in June 2014 and the application to UKAS in April 2016 for Accreditation for "Preimplantation Genetic Diagnosis", "Preimplantation Genetic Screening" and "Non-invasive Prenatal testing" services (all of which would be encompassed by the term "medical laboratory services") in the name of, inter alia, Genesis Genetics and the subsequent approvals issued by UKAS in January and November 2017 which also refer to Genesis Genetics are, in my view, sufficient to constitute preparations which were under way to supply services of the type mentioned.

46. I also remind myself that the trade mark being relied upon is an EUTM and other than the reference to Genesis Genetics Europe, there is no evidence to indicate that any services which have been or may be provided have/will be provided outside of the UK. However, for the reasons explained in paragraph 28, that is not a factor which weighs against the opponent.

What constitutes a fair specification?

47. Having concluded that the opponent has made genuine use of its GENESIS GENETICS trade mark, I must now decide what constitutes a fair specification. In this regard, I am guided by the following cases. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

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

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

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

49. Having applied the above guidance to the totality of the evidence provided, I am satisfied that "medical laboratory services" represents a fair specification. Once again, that appears to accord with the applicant's view of the matter as reflected in its submissions referred to earlier.

Conclusion on proof of use

50. In summary, I am satisfied that within the relevant period the opponent has either (i) made genuine of the trade mark upon which it relies in relation to the services upon which it relies, or (ii) the services upon which it relies were about to be marketed and preparations to secure customers for those services were under way. I will conduct the comparison with those conclusions in mind.

Relevant case law in relation to likelihood of confusion – sections 5(1)/5(2)(a)

51. 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 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) 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;
- (d) 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;
- (e) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(f) 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;

(g) 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 trade marks

52. In its counterstatement, the applicant admits the competing trade marks are identical.

Comparison of services

53. The competing services are as follows:

The opponent's services	The applicant's services
Class 42 – Medical laboratory services.	Class 44 - Genetic testing for medical diagnosis and treatment purpose.

54. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“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”.

55. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

57. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

58. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

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

60. In its submissions, the opponent states:

“28. It is acknowledged that the respective services fall in different classes but this does not, in itself, mean that services cannot be deemed identical. It is an accepted principle that classification is for administration purposes only (EUTM Regulation Art.33(7)) and is not determinative of the identity/similarity of services. Although it could be argued that class 44 is more akin to medical

services while class 42 is more akin to scientific and laboratory services, in this case, the Opponent's "laboratory services" in class 44 (sic) are specified as being "medical" i.e. laboratory services working to solve medical issues in patients. There is therefore clear identity on a normal reading of the specifications with the Applicant's medical diagnosis and treatment services as falling in class 42 given that they are both involved with solving medical problems and advancing knowledge in this area.

29. In fact, it is submitted that the Applicant's services are a subset of the Opponent's broader services. It is necessary for "genetic testing for medical diagnosis and treatment purposes" to be conducted within a laboratory and further, a medical laboratory given that the specific application of the Applicant's "genetic testing" is for medical diagnosis and treatment (of medical conditions).

30. It is submitted that the nature and purpose of the services are identical, being services conducted to improve an individual's health by way of collecting data which can be analysed and used for diagnosis, prognosis and treatment of patients.

31. The services have the same channels of trade and are provided by the same entities to the same consumers (either by virtue of business to consumers via individual patients or business to business by providing laboratory and testing services to larger medical companies)."

61. As I mentioned earlier, in its various submissions, the applicant appears to accept that the opponent had made genuine use of its earlier trade mark in relation to the services being relied upon. That, together with its acceptance that the competing trade marks are identical, led it to conclude that:

"3. The present opposition turns on whether or not the services upon which the opposition is based are sufficiently similar to the services covered by the application..."

62. I agree. In those circumstances, it is unsurprising that its submissions filed in lieu of a hearing focused on this issue. The applicant began by drawing my attention to the comments of Carr J. in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), in which he considered when it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge made the following provisional judgment.

(i) the class number should only be taken into account where the meaning of the disputed term is not sufficiently clear and precise;

(ii) where the term is sufficiently clear and precise on its face, the fact that the description covers goods/services that may also be (or should have been) registered in other classes is irrelevant to the scope of protection afforded to the term, or to questions of use of the mark in relation to those goods/services;

(iii) Where the term is not sufficiently clear and precise, the class number may be relied on to construe the proper scope of the registration, i.e. to narrow the possible meanings of the registered description to only goods/services falling in the registered class(es).

63. The applicant states:

“6...In the present case, both "Genetic testing for medical diagnosis and treatment" and "Medical laboratory services" relate to the field of medicine. However, the field of medicine is extensive and reference to the class number will aid interpretation of the scope of the services covered by the Application and the Earlier Registration and also the likely consumer and market for those services.”

64. The World Intellectual Property Organisation (“WIPO”) publishes the “International Classification of Goods and Services”, the most recent edition of which, the 11th, was issued in 2016. I note that publication includes, inter alia, the following in relation to the classes at issue in these proceedings.

Class 42

“...includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer programmers, etc.

This Class includes, in particular:

scientific research services for medical purposes.

This Class does not include, in particular:

medical treatment services (Cl. 44).”

65. In its submissions, the applicant states:

“10. "Medical laboratory services" of the Earlier Registration covers laboratory services for medical purposes, in particular for scientific medical research... The "Medical laboratory services" of the Earlier Registration will be provided either to other scientists and medical researchers or to medical staff in treatment facilities.”

66. In relation to class 44, the WIPO publication reads:

“...includes mainly medical care, hygienic and beauty care given by persons or establishments to human beings and animals; it also includes services relating to the fields of agriculture, horticulture and forestry.

This Class includes, in particular:

medical analysis services relating to the treatment of persons (such as x-ray examinations and taking of blood samples);

This Class does not include, in particular:

scientific research services for medical purposes (Cl. 42).”

67. In its submissions, the applicant states:

8. "Genetic testing for medical diagnosis and treatment purpose" covers medical care relating to the treatment of persons. In particular, the services are limited to the use of genetic testing techniques to diagnose medical conditions in a person and thus assist in the medical treatment on the basis of that diagnosis. The "Genetic testing for medical diagnosis and treatment purpose" services covered by the Application will be provided to patients directly by doctors and medical staff.”

68. In its submissions, the applicant concludes:

“11. Whilst the "Medical laboratory services" of the Earlier Registration and the "Genetic testing for medical diagnosis and treatment purpose" services covered by the Application all relates to the field of medicine, they are not identical. "Medical laboratory services" are for laboratory services for medical research or scientific analysis purposes, whereas "Genetic testing for medical diagnosis and treatment purpose" are for medical testing (in particular genetic testing) used for diagnosis and treatment of illness in persons.

12. "Medical laboratory services" of the Earlier Registration and the "Genetic testing for medical diagnosis and treatment purpose" are provided to different consumers through different channels. The consumer of the Applicants "Genetic testing for medical diagnosis and treatment purpose" services would likely have no knowledge of, involvement in or access to the "medical

laboratory services" provided by the Opponent. The services are not similar..."

69. As the opponent's evidence shows, it provides medical laboratory services to, for example, hospitals and clinics, specialising in "analysing the genetics of microbiological samples." The evidence also shows that it conducts tests requested of it by such organisations on, for example, blood and biopsies provided to it. Although not provided in evidence, it is reasonable to infer that once complete, the results of any tests requested will be returned to the organisation concerned. Such services are properly classified in class 42.

70. Although no evidence has been provided by the applicant, its specification in class 44 is to be construed as medical care services relating to genetic testing for the purposes of diagnosis and treatment. Such services are most likely to be provided by a medical professional who may, for example, discuss various options with a patient, take a blood sample and/or biopsy and, upon receipt of the results of such tests, interpret them and discuss treatment options with the patient.

71. Proceeding on that basis, the competing services are not identical. That being the case, the opposition based upon section 5(1) of the Act fails and is dismissed accordingly.

72. The intended purpose of both parties' services is, ultimately, to provide a patient with the necessary medical information to make an informed opinion on possible courses of treatment. The evidence shows that at present the average consumer of the opponent's services are medical professionals in hospitals and clinics, whereas the average consumer of the applicant's services is most likely to be a member of the general public. Insofar as the opponent's services may be required to provide information which will inform the advice provided by the applicant in the provision of its services, there is, in my view, a clear and obvious link between the services at issue.

73. In addition, while at present it appears the opponent only provides its services to medical professionals, I see no reason why its services may not also be provided

directly to a member of the general public. For example, a member of the public may choose to either use the applicant's services or, send a sample of, for example, his/her blood directly to the opponent for testing and analysis. That, in my view, results in a competitive relationship between the services at issue leading to them being similar to at least a low degree. Although that is the basis on which I intend to proceed, I shall return to this point when I consider the likelihood of confusion.

The average consumer and the nature of the purchasing act

74. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

75. The average consumer of the opponent's services is, it appears, at present most likely to be medical professionals in hospitals and clinics, whereas the average consumer of the applicant's services is most likely to be a member of the general public. However, as I mentioned above, I see no reason why the average consumer for both parties' services may not be a member of the general public. Regardless, given the specialist nature of the services at issue and their likely impact on the well-being of the individual concerned or the medical professional's patient to whom it owes a duty of care, I would expect both sets of average consumers to pay a high degree of attention to their selection.

Likelihood of confusion

76. 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 services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

77. 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 services down to the responsible undertakings being the same or related. Earlier in this decision I concluded that:

- within the relevant period, the opponent has made genuine use of its earlier trade mark in relation to the services upon which it relies i.e. medical laboratory services;
- the competing services are similar to at least a low degree;
- the average consumer will pay a high degree of attention when selecting the services at issue.

78. The competing trade marks are identical. Consequently, neither the high degree of attention likely to be paid by the average consumer during the selection process nor the distinctiveness or otherwise of the earlier trade mark are material factors in assessing the likelihood of confusion. Rather, as the applicant correctly pointed out in its submissions, once proof of use is established, the outcome of these proceedings turns on the similarity or otherwise in the competing services. In this regard, I concluded I would proceed on the basis of at least a low degree of similarity in the respective services. In reaching a conclusion, I must also keep in mind the

interdependency principle i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

79. Although I concluded earlier that there is a clear and obvious link between the competing services, in my view, the opponent's best prospect of success lies in what I regard as the competitive relationship that exists between the services at issue. Even if I am wrong, and that competitive relationship results in the respective services being correctly regarded as being similar to only a very low degree, the fact that the competing trade marks are identical is still, bearing in mind the interdependency principle, sufficient to result in a likelihood of direct confusion. As a consequence, the opposition based upon section 5(2)(a) of the Act succeeds.

Overall conclusion

80. The opposition based upon section 5(2)(a) of the Act succeeds and, subject to any successful appeal, the designation will be refused.

Costs

81. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying the above guidance, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£200
Preparing evidence:	£500
Written submissions:	£300
Official fee:	£100

Total:

£1100

82. I order Genesis Genetics Co., Ltd to pay to Invitro Genetics, LLC the sum of **£1100**. 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 20th day of November 2019

C J BOWEN

For the Registrar