

O/0289/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 3223514

IN THE NAME OF NEWCROSS HEALTHCARE SOLUTIONS LIMITED

FOR THE FOLLOWING TRADE MARK:



IN CLASSES 35, 39, 41, 44

AND

AN APPLICATION FOR REVOCATION THEREOF

ON GROUNDS OF NON-USE

UNDER NO. 506279

BY UNICAREDEVON LIMITED

Background and pleadings

1. Newcross Healthcare Solutions Limited (“**the Proprietor**”) is the registered proprietor of trade mark number UK00003223514 for the (figurative) mark shown on the front page of this decision (“**the Contested Mark**”). It was applied for on 06 April 2017 before the UK IPO and was registered on 14 July 2017 for the following services:

Class 35 Employment agency services; Providing information in the field of time management; Data processing services in the field of payroll; Payroll advisory services; Payroll preparation; Negotiation of contracts with health care payors.

Class 39 Escorting of patients during transportation; Transportation of patients by car; Transportation of patients by minibus; Transportation of patients by ambulance.

Class 41 Training; Arranging professional workshop and training courses; Educational information; Personal development training; Provision of training courses in personal development; Educational assessment services; Provision of skill assessment courses.

Class 44 Medical care services; Nursing care services; Outpatient and inpatient care services; Respite care services in the nature of home nursing aid; Provision of health care services in domestic homes.

2. On 11 July 2023, Unicaredevon Limited (“**the Applicant**”) sought revocation of the Contested Mark on the grounds of non-use under section 46(1)(a) of the Trade Marks Act 1994 (“**the Act**”).¹ The Applicant claims non-use in the five-year period following the date on which protection was granted, namely, 15 July 2017 to 14 July 2022 (“**the relevant period**”). The Applicant requests an effective date of revocation of **15 July 2022**.

¹ The statement of grounds was originally filed on 11 July 2023, it was further amended and finally accepted on the re-filing of 13 July 2023.

3. The Proprietor filed a counterstatement defending its registration for all the services for which the Contested Mark is registered, claiming that it has been genuinely used, in the United Kingdom, during the relevant period.²

4. The Proprietor is represented by Wilson Gunn. The Applicant is represented by Stephens Scown LLP.

Evidence and submissions

5. The Proprietor filed written submissions and evidence in chief.³ The latter consists of a witness statement from Damien O'Brien, the Company Secretary of Newcross Healthcare Solutions Limited, signed and dated 14 December 2023, and Exhibits DO1 – DO11. The Applicant filed evidence in the form of a witness statement from John Wesley Powell, director of Unicaredevon Limited, signed and dated 12 February 2024, and Exhibits UD1 – UD7. The Proprietor filed evidence in reply, signed and dated 29 April 2024, consisting of a witness statement from Andrew Marsden, chartered trade mark attorney of Wilson Gunn LLP, and Exhibits AM1 – AM2. All of the witnesses are duly authorised to provide evidence on behalf of their respective parties.

6. Neither party requested a hearing, but the Proprietor filed submissions in lieu of a hearing.⁴ The submissions will not be summarised here but will be referred to as and where appropriate during this decision. A summary of the Proprietor's evidence is provided below. This decision is taken following a careful perusal of the papers.

7. Mr O'Brien's witness statement indicates Newcross Healthcare Solutions Limited has been operating in the UK since 1996. The company provides healthcare staff for different facilities (e.g., care homes, hospitals, schools, GP surgeries, and prisons) and private homes. The company also provides specific training for its healthcare staff.

8. Mr O'Brien provides examples of the Contested Mark's colour variations which the Proprietor has used over the years. The first features 'Newcross' in blue and 'HEALTHCARE' in yellow with the bisected cross coloured with the same yellow and blue combination and contained in a blue circle ("***the First Variation***"). The second variation features both words 'Newcross' and 'HEALTHCARE' in the same dark blue

² TM8(N) form dated 12 September 2023.

³ Dated 14 December 2023.

⁴ Submissions in lieu dated 21 June 2024.

hue, the sections of the cross reproduce the same colour combination (i.e., red and dark blue) arranged as in the First Variation and the circle around the cross is removed. Mr O'Brien reports this second colour variation was adopted in 2021 ("***the Last Variation***").

9. **Exhibit DO1** features prints from the Proprietor's website ('newcrosshealthcare.com') from the Wayback Machine Archive. The relevant material the Exhibit contains is the following:

- i. 1 printout dated 2017 (month not visible in the evidence) where "Newcross Healthcare" appears in plain text. The page lists a series of the Proprietor's services:
 - Care at home services for individuals (i.e., coming home from hospital, domestic tasks, end of life care, going on holiday, mental health care, rapid response);
 - Complex care services (including "funding care");
 - Complex care nursing;
 - Offer of health care assistance jobs (HCA);
 - Home carer jobs.

The printout also shows a list of 'featured jobs' the Proprietor offers, consisting of positions for 'care assistant' and 'registered nurse' roles.

- ii. 1 printout dated 2018 (month not visible in the evidence) listing some of the services provided (i.e., provision of care in establishments such as nursing homes, hospitals, schools and hospices, and provision of care by trained staff for one-to-one support in private homes). The printout also indicates that the Proprietor's clients will receive 'a dedicated 24/7 hotline, VAT-free billing, and a wide range of world-class training options'.
- iii. 1 print dated July 2019 referring to the Proprietor's home care services. The page refers to 'Newcross' in plain text.
- iv. 1 screenshot of the website, dated 2020 (month not visible in the evidence), providing examples of some of the Proprietor's services: care at home, agency carers and nurses (i.e., provision of staff for care homes, hospitals, clinics, and prisons). Under the section 'healthcare jobs with Newcross' the evidence shows

the Proprietor offers to its employees instant pay, flexible hours, free training opportunities, and private medical and mental health support). The page contains the word-only version of the Proprietor's full name ('Newcross Healthcare').

- v. 3 screenshots of the Proprietor's website, dated 2018, describing some of the Proprietor's services (i.e., personal care services). The page features 'Newcross' and 'Newcross Healthcare' in plain text.
- vi. 3 screenshots of the Proprietor's website, dated January/February 2018, featuring the 'Latest Stories' articles. The Contested Mark appears at the top of the first page with its stylisation as registered but all in white and the page is in greyscale.
- vii. 1 screenshot of the Proprietor's Twitter account featuring the Contested Mark along with a user's review. The same twitter page and comment are provided identically for the year 2018 and 2019.
- viii. 5 screenshots of the Proprietor's website, dated 2022, describing some of the services the Proprietor offers (i.e., care services provided by nurses and carers and managing people's clinical needs). Page 23 of this exhibit features advertisements for 'nurse' and 'care assistant' jobs. Page 22 reports that 'at Newcross Healthcare we see ourselves as the sector's learning partner for life, providing immersive and interactive training via our mobile app and website that's not only modern, rigorous and comprehensive – but free at the point of access'. The evidence does not specify the type of training the Proprietor provides. Each page shows the Contested Mark in the Last Variation.
- ix. 15 screenshots of the Proprietor's website featuring the website home page, for the years 2018 and 2019, containing the mark in the First Variation followed by pages describing some of the proprietor's services (i.e., provision of staff; clinical expertise and administrative support to deliver home care services). The website pages reproduce various times the words 'Newcross' and 'Newcross Healthcare' in plain text. An equal number of prints showing the same website's pages is also reproduced for the year 2020.
- x. 1 printout of the Proprietor's website describing the 'Surge Pay' service dated 2020. The evidence reports that the 'Surge Pay' scheme rewards employees, with a 30% uplift in pay, who accept to work last-minute notice shifts for the weekend. The page features 'Newcross Healthcare' in its word-only format.

- xi. 1 printout of the Proprietor's website, dated 2020, describing the 'New employee recognition scheme' (i.e., performance-based financial rewards) and the introduction of the 'National Critical Care nursing team', respectively dated October and September 2020. The Contested Mark is reproduced (in white on, respectively, a colourful and dark background) for both articles.
- xii. 6 prints of the Proprietor's website, dated 2021, show the same evidence of what is described at point viii above.
- xiii. 1 printout from the Proprietor's website, dated 2021, featuring feedback from employees. The Last Variation of the mark is clearly visible.

10. For the sake of completeness, the Proprietor provided prints from the Wayback Machine archive showing charts regarding the 'MIME-types count' for the website for the period between 2004 and 2023.⁵ This evidence reports that the website 'www.newcrosshealthcare.com' has been saved 201 times between October 2004 and October 2023 and gives details concerning the 'captures', 'URLs' and 'new URLs' for this website. It appears to me the Proprietor provided this evidence to show the website's user traffic over the relevant period. However, in the absence of further clarification from the Proprietor I am unable to derive clearer information or data the Proprietor may have intended to submit with this evidence.

11. **Exhibit DO2** features additional extracts from the Proprietor's website indicating the type of services offered. The Contested Mark is featured on some of the pages. All the prints are undated (they only show the date of December 2023 which is likely when this evidence has been sourced and falls outside the relevant period). Although this piece of evidence must be disregarded because it falls neither within the relevant period nor in the period covered by section 46(3) of the Act, the evidence shows a consistent use of the Contested Mark on the Proprietor's website throughout various years of operation.

12. In **Exhibit DO3** Mr O'Brien provides copies of the accounts of the Proprietor, the annual turnover, and profit figures for the periods 2017/2018 and 2022/2023. The financial details are the following:

Year end	Profit	Turnover

⁵ Exhibit DO1, pages 55 and 56.

2017	£16,844,577	£105,737,570
2018	£13,575,560	£116,171,670
2019	£18,257,603	£128,298,731
2020	£17,873,294	£134,665,017
2021	£9,752,415	£105,156,061
2022	£20,356,614	£159,024,768

13. **Exhibit DO4** features printouts from the Proprietor's social media accounts of Twitter, Facebook, and YouTube. Whilst the Contested Mark is present in most of the pages, I note this evidence is either undated or dated outside the relevant period. I note that some of the YouTube videos indicate that they have been viewed respectively 6, 5, 4, 3, and 2 years ago. As the evidence is dated December 2023, I can assume that most of this evidence refers to the relevant period. The YouTube videos do not provide clear information on the type of services the Proprietor offers. The Proprietor's Twitter page (now X) contains a reference to the top-level domain (TLD) 'newcrosshealthcare.com' and indicates that the 'Newcross Healthcare' account joined this platform in July 2009. The social media page shows one post (video) concerning the importance of health and social care as a career. The Facebook pages show the 'Newcross Healthcare' account was created in January 2011 and has 29,000 followers. The evidence features the Proprietor's 'about' section reporting that Newcross Healthcare aims 'to offer hospital-level treatment at home and other settings'.

14. **Exhibits DO5 – Exhibit DO9** feature copies of brochures, marketing and advertising material. The material is broken down per year between 2017 and 2021. The Contested Mark is featured throughout the material (often at the front and back pages of the brochures). Most of the evidence shows the Contested Mark in the First Variation, however, there are also instances where the mark is represented all in white, in the Last Variation, and in a white-and-red combination. All the material is dated either with copyright notices of the respective years, or with direct references to the year of the issue (e.g., brochures titled 'News for healthcare professionals').

Furthermore, the winter issue of 'News for healthcare professionals' for 2017 shows the locations of new branches the Proprietor opened throughout the UK (e.g., Kirkcaldy, Hamilton, Preston, Leeds, Sheffield, Oxford).⁶ Similarly, the summer edition of 'News for healthcare professionals' for the year 2018 shows additional new branches opened by the Proprietor across the UK (e.g., Aberdeen, Hull, Shrewsbury, Gloucester, Exeter).⁷

15. From all the marketing material it clearly emerges the Proprietor offers customer-tailored individual caring services provided by a wide range of healthcare professionals and nursing staff. The Proprietor not only offers the services directly to private individuals, but also collaborates with Clinical Commissioning Groups (CCGs) to provide the services to patients who are eligible for NHS Continuing Healthcare funding with CCG-agreed care at home packages. Part of the Proprietor's services also encompass guidance, support, training and personal development for its employees (i.e., caregiving professionals).

16. **Exhibit DO10** contains a generic pro-forma document showing that Newcross Healthcare can offer travel arrangements in the context of care. The document does not feature the Contested Mark and it is undated. The document does not show whether this type of service has been actually provided. The Exhibit also features a list of training courses the Proprietor has provided over the years. The evidence shows the years when the courses were provided. There are courses being provided between the years 2017 and 2020. The evidence does not feature training courses dated 2021 or 2022. The vast majority of courses listed, provided within the relevant period, concern the field of healthcare or personal care (e.g., anaphylactic shock, advanced care practices, brain injury awareness, catatonic seizures, digital bowel stimulation, end of life care, epilepsy awareness & rescue medication, falls prevention, gastrostomy - pump & practical, intermittent catheterisation, ligature training, medication administration, moving and handling theory, nasogastric tube training, palliative care, personality disorder & paranoia, stroke awareness, tracheostomy care with cough assist, ventilation, wound care).

⁶ Exhibit DO5, page 196.

⁷ Exhibit DO6, page 213.

17. The list also includes a few courses of an administrative nature relating to the profession itself (e.g., business development day, head office induction, recruiting and retaining training, right to work training, performance management, train the trainer).

18. **Exhibit DO11** offers examples of marketing spending. The exhibit supplies a selection of sample invoices from 'Reed.co.uk'. Mr O'Brien explains the invoices relate to the job boards / listings of Newcross Healthcare Solutions Limited. The exhibit contains examples of 12 invoices dated from September 2018 to August 2019 for a value of almost £2,000 each for 'Reed.co.uk' to display the Providers' job board and listings on Reed's platform.

19. That completes my summary of the Proprietor's relevant evidence.

Decision

Statutory provisions

20. The relevant provisions of section 46 of the Act are as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

[...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

21. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Relevant Case Law

22. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

23. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... 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 ... 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.”

24. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“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.”

Form of the mark

25. In the evidence the Contested Mark has been mostly used in colour variations of the (black and white) registered mark, along with instances of the logo’s different stylisation (i.e., without the circle around the bisected cross).

26. The test under s. 46(2) of the Act (i.e. whether the form in which the mark has been used differs in elements which do not alter the distinctive character of the mark) was summarised as follows by Phillip Johnson, sitting as the Appointed Person, in *Lactalis McLelland Limited v Arla Foods AMBA*, Case BL O/265/22, (my emphasis):

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative

elements are usually less likely to change the distinctive character than those related to the word elements.”

27. I also note that in *hyphen GmbH v EUIPO*, Case T-146/15, EU:T:2016:469, the General Court (“GC”) held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered⁸

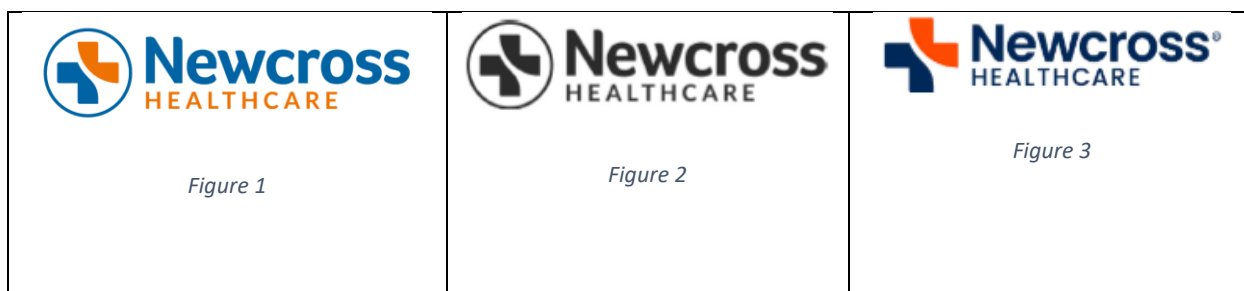


28. For convenience, I reproduce the registered mark below:



29. In his witness statement, Mr O’Brien reported that the Contested Mark was originally used in the blue and yellow colour combination (Figure 1 below) along with the black and white version in which the mark was registered (Figure 2). Mr O’Brien submitted that in 2021 the Contested Mark was rebranded, by changing its colour to the blue and red combination and removing the circle around the cross (Figure 3). This last variation of the mark has been used since 2021. Mr O’Brien submitted that the changes made to the Contested Mark in the last variation (i.e., blue and red variation) do not alter the distinctive parts of the mark and that the roundel is a purely decorative and non-distinctive element.

⁸ See also *Menelaus BV v EUIPO*, Case T-361/13, EU:T:2015:859; *Sony Computer Entertainment Europe v OHIM*, Case T-690/14, EU:T:2015:950; *LTI Diffusion v OHIM*, Case T-83/14, EU:T:2015:974 and *PAL-Bullermann v EUIPO*, Case T-397/15, EU:T:2016:730.



30. I also note that there are few instances where the Proprietor, in its advertising material (i.e., in relation to the 25 years of ‘excellence in care’), has used the mark in a white and red combination as shown below:



Exhibit D09, page 272

31. In Mr Powell’s witness statement, the applicant submits that *“the removal of the roundel [from the bisected-cross logo] alters the distinctive character of the Registered Mark”* and that *“the difference between the font used for the ‘Newcross’ word element in the Amended Newcross Mark [i.e., Figure 3] to the font of the Registered Mark [...] would alter the distinctive character of the latter”*.

32. I find the word element ‘Newcross Healthcare’ to be the main distinctive element in the Contested Mark. Given its position and size, ‘Newcross’ is dominant within the mark and, given the nature of the services, ‘healthcare’ is descriptive of the services and has less distinctive character than ‘Newcross’. The Contested Mark also contains a stylised logo featuring a bisected cross in a circle (or without the circle in the Last Variation). Given the logo’s stylisation, size, and position, I find it contributes, at least in part, to the mark’s overall distinctive character. Therefore, I find the difference in colour between the mark as registered (i.e., black and white) and the figurative variants has minimal impact on its distinctiveness. This is because the relevant consumer will recognise the colourful variants for what they are, namely colour variations of the same elements that compose the Contested Mark (i.e., the words ‘Newcross Healthcare’ and the bisected cross) and the use of two colours is only a minor variation that does not alter the distinctive character of the mark. The evidence shows a few instances where ‘Newcross healthcare’ and ‘Newcross’ are used in plain text without the logo.

According to my assessment of the Contested Mark's distinctive character above, I find that the word-only uses of the mark do not amount to acceptable variants given the role the logo plays in the Contested Mark's overall distinctive character.

33. For the sake of completeness, some of the evidence shows instances where the Contested Mark's logo (i.e., bisected cross inside a circle) is used by itself. I consider the uses of the logo, by itself, not to amount to evidence of genuine use of the Contested Mark because such uses omit the main distinctive element in the Proprietor's mark (i.e., 'Newcross').

Assessment of the sufficiency of use and conclusions

34. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the services at issue in the UK during the relevant five-year period. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the services for which use has been shown;
- the nature of those services and the market(s) for them; and
- the geographical extent of the use shown.

35. Exhibit DO1 shows the mark has been used on the Proprietor's website throughout the relevant period in relation to home care/nursing services and training in the medical and caring field. This evidence shows the Proprietor has used the Contested Mark, within the relevant period, as registered and in acceptable variant forms. I appreciate the evidence is not particularly extensive (especially in relation to the year 2017), however, I find this evidence shows a consistent use of the Contested Mark (as registered and in its variant forms) on the Proprietor's website throughout the relevant period. Furthermore, albeit the website's TLD is '.com', it emerges clearly from various webpages prints in Exhibit DO1 that the Proprietor's website targets the UK territory and consumers as there are direct references to the UK market in these pages.

36. The evidence contained in Exhibit DO2 is undated and I cannot rely on it for the assessment of genuine use as explained above in this decision.

37. The evidence in Exhibit DO3 shows that the Proprietor's profit throughout the whole relevant period, broken down per year, has been an average of approximately £16 million. The annual reports and financial statements show the Proprietor's services are provided in the UK territory; for example, the report for 2020 indicates that *"all the healthcare professionals are recruited to meet the relevant care regulations (Care Quality Commissions in England, Care Inspectorate in Scotland, and Care Social Services Inspectorate in Wales), and that "the key impact of Brexit continues to be on government policy and confidence in the UK macro-economy, rather than on the group's trading operations in the UK".*⁹ The turnover and profit figures provided are not broken down per category of services, however, the annual reports for 2021 and 2022 indicate that *"the Company's focus is to deliver market leading care services throughout the UK [...]"*.¹⁰ Consequently, the above figures likely refer to the UK market and the provision of the Proprietor's services in the UK.

38. The Proprietor did not clarify the position it occupies in the relevant market. Whilst I am not particularly familiar with the market for care services, I believe this is likely to be worth millions, or even billions of pounds; I find that the sales figures, albeit significant, are not exceptionally large. Nonetheless, to determine whether there has been genuine use, I remind myself that the test is not whether the use has been quantitatively significant, but whether there has been real commercial exploitation of the mark intended to create and preserve an outlet for the services which are sold under or in relation to that mark. I also remind myself that the assessment of genuine use is not simply about sales figures, and I must consider them alongside other evidence of use.¹¹

39. I appreciate that some parts of the evidence are undated, imprecise, or irrelevant. However, firstly, the Proprietor has provided numerous examples of use of the Contested Mark on its website, within the relevant period, where the mark is visible. Secondly, I find the advertising material in Exhibits DO5 – Exhibit DO9 to be the central

⁹ Exhibit DO3, page 114.

¹⁰ Exhibit DO3 pages 119 and 124.

¹¹ Case T-467/20 *Industria de Diseño Textil, SA (Inditex) v EUIPO*, EU:T:2021:842.

part of the Proprietor's evidence showing a reasonable exposure of the Contested Mark to the relevant public for the services at hand, throughout the relevant period, and rather wide geographical reach.

40. Taking all of the above into account and bearing in mind that it is important to consider the evidential picture as a whole, not just whether each individual piece of evidence shows use on its own,¹² I consider that the evidence provided, in spite of its shortcomings, on balance, is sufficient to show genuine use of the Contested Mark to maintain or create a share in the market for some of the services as further specified below.

Fair specification

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) 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.”

42. 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 (at [47]):

“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

¹² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

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."

43. From the evidence provided I find the Proprietor offers agency services in the field of healthcare. More specifically, it provides a system where the users (i.e., individual patients and professionals in healthcare institutions) can find and request care and nursing staff for the provision of care or nursing services to individuals at home or in other facilities. The evidence also shows that the Proprietor is involved in the hiring and training of its employees (i.e., carers and nurses). The evidence also shows the Proprietor rewards its employees with a higher fee for those who volunteer to work last-minute shifts on weekends. However, there is no evidence before me indicating that the Proprietor provides either payroll or contract negotiation services either to its

employees or to third parties: paying one's own staff does not constitute the provision of a payroll service. Therefore, I find the Proprietor's fair specification for class 35 services to be: "Employment agency services in the field of healthcare".

44. With regard to the services in class 39, I note that in Exhibit DO1 (page 6) under the heading "Home Care" the service "coming home from hospital" is listed and I appreciate this could be interpreted as meaning that the carers are tasked with accompanying individuals to their home from the hospital. However, whilst I appreciate that the transport of patients could fall within one of the carers' tasks, there is no additional evidence before me to show that the Proprietor has a system in place to provide transportation services for patients. Accompanying patients, of itself, simply means that the carer or nurse travels with the patient, not necessarily that the Proprietor provides the transport. The only other evidence of transportation services is a pro forma document. In the absence of any clear evidence that transportation services were offered in the relevant period, and with no evidence to show how much, if any, of the turnover was attributable to transport services, I am not prepared to find that there has been use in relation to transportation services which was warranted in the sector.

45. Turning to the class 41 services, the Proprietor provided a list of training courses made available to its employees (i.e., carers and nurses) to enable them to acquire relevant medical knowledge and progress in their career. The training courses provided are strictly professional and career related (both the medical and management-type training courses). Furthermore, whilst I acknowledge that the Proprietor has a selection process in place to hire skilled and experienced staff, the evidence provided does not show the Proprietor provides education and skill assessment courses either to its employees or third parties. I appreciate the evidence reports that healthcare assistants can complete National Vocational Qualification (NVQ) Levels 2 & 3 that are assessed in the workplace.¹³ However, it is unclear whether the Proprietor directly provides the course for the NVQ qualification and whether it offers education/skill assessment courses to this regard. Therefore, I find the fair specification for class 41 services to be: "Training; Arranging professional workshop and training courses; Educational information; Career development training;

¹³ Exhibit DO5, page 146.

Provision of training courses in career development; all the aforementioned provided in the field of healthcare”.

46. Regarding the services in class 44, the evidence showed the Proprietor provides caring/nursing services directly to individual patients. With regard to the term “*Outpatient and inpatient care services*” whilst I appreciate that the Proprietor provides nursing services and some of its nursing staff works in hospitals, however the Proprietor does not seem to operate care facilities (e.g., hospitals) where it would treat inpatients or outpatients. The Proprietor’s specification also contains the term “*medical care services*”. Medical care is defined as the professional attention of medical practitioners (i.e., qualified persons who work as doctors in a hospital or private practice),¹⁴ while the Proprietor has shown to offer exclusively healthcare services provided by nurses and healthcare assistants. Therefore, I find the Proprietor failed to show it also provides medical care services in their traditional definition.

47. From the considerations above, it follows that I find the Proprietor’s fair specification to be:

Class 35 Employment agency services in the field of healthcare.

Class 41 Training; Arranging professional workshop and training courses; Educational information; Career development training; Provision of training courses in career development; all the aforementioned provided in the field of healthcare.

Class 44 Nursing care services; Respite care services in the nature of home nursing aid; Provision of health care services in domestic homes.

48. In contrast, the Proprietor has failed to show use for the following services:

Class 35 Providing information in the field of time management; Data processing services in the field of payroll; Payroll advisory services; Payroll preparation; Negotiation of contracts with health care payors.

¹⁴ See Collins dictionary definitions of definitions of ‘medical care’ (<https://www.collinsdictionary.com/dictionary/english/medical-care>) and ‘medical practitioner’ (<https://www.collinsdictionary.com/dictionary/english/medical-practitioner>).

Class 39 Escorting of patients during transportation; Transportation of patients by car; Transportation of patients by minibus; Transportation of patients by ambulance.

Class 41 Educational assessment services; Provision of skill assessment courses.

Class 44 Medical care services; Outpatient and inpatient care services.

Outcome

49. The application for revocation under section 46(1)(a) fails for the services in classes 35, 41 and 44 set out at paragraph 47, above, and the Contested Mark remains registered for these services.

50. The application for revocation under section 46(1)(a) fully succeeds for class 39 and partially succeeds for classes 35, 41, and 44. As a result, the Contested Mark is, subject to any successful appeal, hereby revoked for all the services in class 39 and in part, for the services specified at paragraph 48, above, in classes 35, 41, and 44. The effective date of revocation is 15 July 2022.

Costs

51. Whilst the cancellation applicant has been partly successful, the cancellation action has failed for an almost equal number of services. I therefore consider it appropriate for each party to bear its own costs in these proceedings.

Dated this 27th day of March 2025

Andrea Rossi

For the Registrar