

O/0969/23

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION 3582783

IN THE NAME OF CHECK4CANCER LTD

AND

APPLICATION 504906 BY QUADRATECH DIAGNOSTICS LTD

TO INVALIDATE THE REGISTRATION OF THIS TRADE MARK

AND

TRADE MARKS REGISTRATIONS 2201437 AND 918123549

IN THE NAME OF QUADRATECH DIAGNOSTICS LTD

AND

APPLICATIONS 505171 & 505172 BY CHECK4CANCER LTD

TO INVALIDATE THE REGISTRATION OF THESE TRADE MARKS

AND

APPLICATION 505174 BY CHECK4CANCER LTD

TO REVOKE THE SERIES OF TWO TRADE MARKS REGISTERED

UNDER 2201437 FOR NON USE

BACKGROUND AND PLEADINGS

1. These are four consolidated cancellation proceedings. The first concerns trade mark 3582783 (“the 783 mark”), which looks like this:



2. Check4cancer Ltd (“C4C”) applied to register this trade mark on 21st January 2021 in relation to a range of software, medical testing apparatus, medical and support services in classes 9, 10, 42, 44 and 45, all for use in the field of cancer.¹ The trade mark was registered on 21st May 2021.

3. On 25th May 2022, Quadrtech Diagnostics Ltd (“Quadrtech”) applied to invalidate the 783 mark under section 47(2) of the Trade Marks Act 1994 (“the Act”), which is as follows:

“(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

4. Quadrtech is the proprietor of earlier trade mark 918123549 (“the 549 mark”), which consists of the word and numeral **Check4**. It is registered in class 5 for, inter

¹ A full list of the goods/services is at annex A. The application and resulting registration originally included diagnostic preparations in class 5 too, but the registration of the mark in relation to these goods was voluntarily surrendered after these proceedings began.

alia, *diagnostic preparations for medical and veterinary use and pregnancy testing preparations*. The full list of goods is at annex B.

5. The application to register the 549 mark was made on 10th September 2019 to the Intellectual Property Office of the EU (“EUIPO”). The mark was registered as an EU trade mark on 7th February 2020. When the UK left the EU, the 549 mark was created as a comparable UK trade mark. This means it is treated as though it was applied for and registered as a UK trade mark.

6. According to Quadrtech, C4C’s trade mark is (1) similar to its earlier trade mark, (2) registered for identical or similar goods/services, and (3) there is a likelihood of confusion on the part of the public.

7. Further, Quadrtech claims to have used **Check4** throughout the UK since 1999 in relation to the goods for which the mark has subsequently been registered. According to Quadrtech, (1) it has acquired valuable goodwill under the sign, (2) C4C’s use of trade mark 3582783 would constitute a misrepresentation to the public that it is connected with Quadrtech, and (3) this would damage its goodwill. Therefore, C4C’s use of this mark could be restrained under the law of passing off.

8. Consequently, Quadrtech claims that registration of the 783 mark was contrary to section 5(2) and 5(4)(a) of the Act, which are as follows:

“(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) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

-

“(4) A trademark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) –

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

9. C4C filed a counterstatement denying Quadrotech’s grounds for invalidation. I note, in particular, the following:

- (1) C4C contends that Quadrotech’s earlier 549 mark is invalid because it is descriptive, generic or otherwise non-distinctive;
- (2) In the alternative, C4C denies there is a likelihood of confusion with trade the 783 mark, partly because the common element – Check4 – is descriptive and non-distinctive;
- (3) C4C denies that the goods and services covered by the 783 mark are similar to the goods in class 5 for which the earlier 549 mark is registered;
- (4) If necessary, C4C relies on honest concurrent use of the 783 mark since 2015;
- (5) C4C sought proof that Quadrotech had acquired more than a trivial level of goodwill by the date it adopted the 783 mark in 2015 and that (being descriptive) Check4 was distinctive of that goodwill;
- (6) C4C denied that use of the 783 mark has, or would, deceive the public as alleged, or constitute passing off.

10. In addition to filing a counterstatement to Quadrotech’s application for invalidate the 783 mark, on 22nd July 2022 C4C filed a counter application to invalidate trade

mark Quadratech's 549 mark. There are two bases for C4C's application. The first is section 47(1) of the Act, which is as follows:

“(1) The registration of a trade mark may be declared invalid on the ground that the trademark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trademark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

11. C4C contends that registration of **Check4** was contrary to section 3(1)(b), (c) and (d) of the Act, which are as follows:

“(1) The following shall not be registered—

(a) -

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

12. The factual basis for the C4C's case under section 3(1)(b) and (c) was put like this:

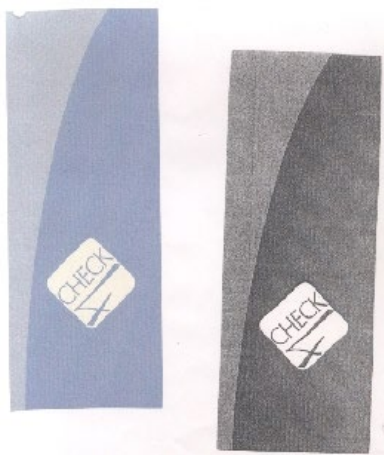
“The words CHECK4, which would be read by the average consumer as “CHECK FOR” describe a process of diagnosis or testing denoting the intended purpose of the class 5 goods for which the Mark is registered.”

13. The factual basis for the C4C’s case under section 3(1)(d) was put like this:

“...the words CHECK FOR or CHECK4 are commonly used in the sale of diagnostic testing kits and devices to describe or reference a process of testing or diagnosis.”

14. The second part of C4C’s application to invalidate the 549 mark is based on section 47(2) of the Act. According to C4C, its own use of the mark CHECK4CANCER since February 2015 in relation to, inter alia, *diagnostic testing materials for medical use, computer software for the detection and diagnosis of cancer, tests for medical purposes and cancer screening services*, means that Quadratech’s use of **Check4** in relation to some of the wider descriptions of goods in class 5 covered by the 549 mark (e.g. *diagnostic preparations for medical use*) would amount to Quadratech passing itself off as being, or being connected to, C4C. Consequently, C4C claims that registration of the 549 mark was, at least in part, contrary to section 5(4)(a) of the Act.

15. In addition to the cross invalidation proceedings brought by the parties in relation to the 783 and 549 marks, C4C filed two further applications to invalidate and/or revoke (for non-use) another two trade marks held by Quadratech. These trade marks are registered as a series under 2201437 (“the 437 mark”). They look like this:



16. The first mark in the series is registered in the colours light blue Pantone 2706 and dark blue Pantone 2716. The second mark is shown in greyscale, i.e. it is registered without colour.

17. The application to register these marks was filed on 29th June 1999 and the marks were registered on 25th February 2000. They are registered in class 5 for *pregnancy testing preparations and substances and diagnostic preparations and substances for medical diagnosis; all being in kit form.*

18. According to C4C, the registration of the trade marks covered by the 437 marks was (as with the 549 mark) contrary to sections 3(1)(b),(c) and (d) of the Act. The reasons advanced are the same as those advanced in relation to the **Check4** word/numeral mark. C4C says these trade marks should also be declared invalid.

19. C4C originally claimed that registration of the 437 marks was also contrary to section 5(4)(a) of the Act. However, at the hearing mentioned below C4C indicated it was no longer pursuing this ground for invalidation. I will say no more about it.

20. Quadratech's application to revoke the trade marks registered under the 437 mark is made under section 46(1)(a) and (b) of the Act, which 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;

(b) that such use has been suspended for an uninterrupted period of five years, 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 (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 trademark 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 trademark 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. C4C claims that the 437 marks were not put to genuine use in the periods 26th February 2000 to 25th February 2005, and 20th January 2016 to 19th January 2021. Accordingly, C4C asks for the trade marks to be revoked for non-use with effect from 26th February 2005 or 20th January 2021.

22. Quadrotech filed counterstatements denying C4C's grounds for invalidating and/or revoking the 437 trade marks. I note that Quadrotech claims that the 437 marks are inherently distinctive due to the distinctiveness of the word/numeral **Check4** “*and the stylised elements of the mark.*”

23. Both sides seek a contribution towards their costs.

THE EVIDENCE

24. Quadrotech's evidence consist of witness statements by Graham Jones (with 10 exhibits) and others I shall call Mr NH (with 1 exhibit), Mr D, Mr RH, Mr DMN and Mr DML.

25. Mr Jones is a director of Quadrotech. The main purpose of his evidence is to show that Quadrotech has used **Check4** as a trade mark since 1999 in relation to lateral flow tests made for it by a company called Veda Lab. These are said to have covered tests for pregnancy, cancer markers, faecal occult blood and prostate specific antigens.

26. Messrs NH, RH, DML and DMN work for undertakings that have bought **Check4** tests off Quadrotech since 2015 or later (2022 in the case of DMN). They mostly say they have procured pregnancy tests, although RH says that his employer (Basingstoke and North Hampshire Hospital) regards Quadrotech as a trusted brand for Rotavirus and Adenovirus antigen detection.

27. RD is the CEO of Vedalab S.A. The purpose of his evidence is to confirm that his company has been providing Quadrotech with diagnostic tests branded as **Check4** since 2000, and that these included tests for pregnancy, rotavirus/adenovirus infections, and (internal) bleeding.

28. C4C's evidence consists of a witness statement (with 10 exhibits) by Gordon Wishart, who is the director and founder of the company. The main purpose of Mr Wishart's evidence is to show that C4C adopted the corporate name Check4Cancer Ltd in February 2015 and first used that sign on its website in July of that year. The company provides cancer diagnostic tests and associated clinical and support services. Mr Wishart also explains how C4C conducts its business and gives evidence that he is unaware of any confusion with Quadrotech.

REPRESENTATION

29. C4C is represented by Sipara Ltd. Quadratech is represented by Tennant IP Ltd. A hearing took place (remotely) on 5th September 2023. Henry Edwards appeared as counsel for C4C. Jamie Muir Wood appeared as counsel for Quadratech.

C4C'S APPLICATION TO INVALIDATE TRADE MARK 918123549 (Check4) ON ABSOLUTE GROUNDS

30. It is convenient to start by considering C4C's application to invalidate the 549 mark. At the hearing, Mr Edwards focussed C4C's attack based on the absolute grounds for registration on section 3(1)(c) of the Act. Therefore, I will start with this.

31. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

32. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc.*² These are the most relevant points:

- (a) The general interest underlying section 3(1)(c) is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.
- (b) With a view to ensuring that that objective of free use is fully met, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes.
- (c) The application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is

² [2012] EWHC 3074 (Ch)

therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question. It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration.

- (d) The situations specifically covered by section 3(1)(c) of the Act are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in section 3(1)(c) of the Act, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.
- (e) The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in section 3(1)(c) of the Act are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. A sign can be refused registration on the basis of section 3(1)(c) only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.
- (f) In addition, a sign is caught by the exclusion from registration in section 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.

C4C's *prima facie* case

33. C4C's case is that:

- (1) 'Check for' is commonly used to describe the purpose of testing;
- (2) These words describe the purpose of the diagnostic and testing preparations for which the 549 mark is registered in class 5;
- (3) The purpose of the goods is a key characteristic;
- (4) The average consumer would understand that that the numeral '4' is used to mean 'for' and would instantly understand the description conveyed by **Check4**.

34. Quadratech's case is that:

- (1) Whilst the **Check4** mark alludes to checking for something, it does not say what, or how the check will work;
- (2) The concatenation of the word 'Check' with the numeral '4' creates an inherently distinctive mark.

35. It is common ground that average consumers of diagnostic and testing preparations in class 5 includes members of the public (e.g. for *pregnancy testing preparations for home use*) and medical/healthcare professionals (e.g. for *in vitro diagnostic preparations for medical use*). Given the importance of medical tests to such consumers, they will pay (at the least) an 'above average' degree of attention when selecting such goods.

36. It is obvious that 'check for' is commonly used to describe the purpose of testing. Checking for something is also the central purpose of any test. These are important points in favour of C4C's case. As to Quadratech's point that the mark is not a true description because it does not tell you what the check is for, I do not accept that this would prevent average consumers regarding the words 'check for' alone as describing the intended purpose of the goods. It is true that the mark does not say what the check is for, but the words say enough to inform consumers that the goods are to be used to check for something. That, by itself, is a descriptive message.

37. Mr Edwards drew my attention to the judgment of the Court of Appeal in *J.W. Spear & Sons Ltd V Zynga, Inc.*³, which, inter alia, addressed the registrability of the word SCRAMBLE on absolute grounds in relation to board games. In my view, the most relevant aspect of this judgment was the court's reliance on the judgment of the EU's General Court in *Agencja Wydawnicza Technopol*.⁴ The General Court was there dealing with an appeal from the EUIPO which had refused to register the numeral 1000 in relation to puzzle books on descriptiveness grounds. The General Court upheld the EUIPO's decision stating that:

“....it should be noted that..... there is from the point of view of the relevant public a direct and specific link between the sign ‘1000’ and some of the characteristics of the goods concerned. The sign ‘1000’ alludes to a quantity and will immediately be perceived by the relevant public, without further thought, as a description of the characteristics of the goods in question, in particular the number of pages and works, amount of data, or the number of puzzles in a collection, or the ranking of items referred to in them. That conclusion cannot be invalidated by the fact that the mark applied for is composed only of figures, since ... the missing information may be readily identified by the relevant public, the association between the figure and those characteristics of the goods in question being immediate.”

38. When I asked him about it, Mr Muir Wood had to accept that the decision of Mr Geoffrey Hobbs QC as the Appointed Person in *Cycling is...*⁵ would make Quadragech's case difficult if it depended purely on the absence of the name of the condition (such as 'cancer') covered by Quadragech's diagnostic preparation tests. He was clearly right to do so. In that case the unsuccessful applicant had applied to register the series of two marks shown below:

³ [2015] EWCA Civ 290

⁴ [2011] E.T.M.R. 34

⁵ [2002] RPC 37

“Cycling IS ...”

**“Cycling
IS ...”**

39. The registrar refused registration on the grounds that the marks were non-distinctive for cycling products and services. Mr Hobbs upheld the refusal finding the signs in question would be perceived by the relevant class of persons as pronouncements identifying cycling as the *raison d'être* for the marketing of the goods and services to which they related. Neither the nature of the pronouncement nor its presentation were sufficiently striking to function as an indication of trade origin.

40. A further difficulty with this aspect of Quadrotech's case can be seen by looking at examples of the mark in use. The following example is taken from an invoice issued by Quadrotech in 2016:⁶

4035 - Check4[®] Haemoglobin strips & samplers

41. Mr Muir Wood accepted this represented normal and fair use of the 549 mark. The absence from the mark itself of an indication as to what the test is for will plainly make little or no difference to average consumers when the mark is used in relation to the name of the product, in this example 'Haemoglobin strips and samplers'.

42. As to the distinctiveness said to arise from the concatenation of the word 'Check' with the numeral '4', I accept C4C's submission that consumers have long been accustomed to the use of numerals as substitutes for words with the same sound. When used in commercial communications, and in a context where the word 'for' would make sense, the numeral 4 will convey the same meaning as that word. Indeed, Quadrotech makes that very point itself in support of its section 5(2) case against C4C's mark in which it argues that Check4 and CHECK4CANCER are conceptually

⁶ See exhibit GJ5

similar. Simply running the word 'Check' and numeral '4' together does nothing to change the collective meaning of **Check4**.

43. Mr Muir Wood drew my attention to *Phones 4U Ltd v Phone4u.co.uk. Internet Ltd*⁷ as an example of a case where this sort of number-for-word substitution was found to provide a sign with distinctive character. However, that was a passing off case. The mark was found to be semi-descriptive. Further, the claimant was able to rely on extensive use of a logo including the Phones 4U element to show that it was distinctive at the relevant date. Jacob. L.J. concluded:

“...the name is not descriptive in the sense that anyone would describe a business or shop selling mobile phones as a “Phones 4u” business or shop. It is that sort of name which tells you what the business is, but is also obviously intended to be an invented name to denote a particular business. True it is that it is not particularly inventive—“4u” was a bit in vogue—the sort of thing others might well want to use. For that reason it would be unlikely to be accepted for registration as a trade mark without some proof of acquired distinctiveness.”

44. I find that average consumers would immediately recognise that **Check4** designates the intended purpose of the diagnostic goods in class 5 for which the 549 mark is registered. Registration of the mark in the UK without evidence of acquired distinctiveness would therefore have been contrary to section 3(1)(c) of the Act. It follows that registration would also have been contrary to section 3(1)(b). In these circumstances it is not necessary to consider whether registration would also have been contrary to section 3(1)(d).

Quadratech’s claim that the 549 mark had acquired a distinctive character through use by the date of the application for invalidation

45. At the hearing, Mr Edwards accepted that Quadratech was entitled to argue the **Check4** mark has acquired distinctive character through use, despite not having pleaded reliance on the proviso to section 47(1) of the Act. He was right to do so. If he

⁷ [2006] EWCA Civ 244

had maintained the position set out in his skeleton – that Quadrotech would have to make an application to amend its pleadings in order for such a case to be considered – I would have allowed an application to amend the pleadings. This is because (1) Quadrotech filed evidence of use of the mark after registration, (2) it was clear from Mr Jones’ evidence, and the accompanying written submissions, that this was part of Quadrotech’s case, (3) it is a pure point of law, and (4) in these circumstances the case based on acquired distinctiveness could be considered without prejudicing C4C. I thank Mr Edwards for saving us all a bit of time.

46. The relevant date for this assessment is 22nd July 2022, which is when C4C filed its application to invalidate the 549 mark.

47. The Court of Justice of the European Union (“CJEU”) provided guidance in *Windsurfing Chiemsee*⁸ about the correct approach to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

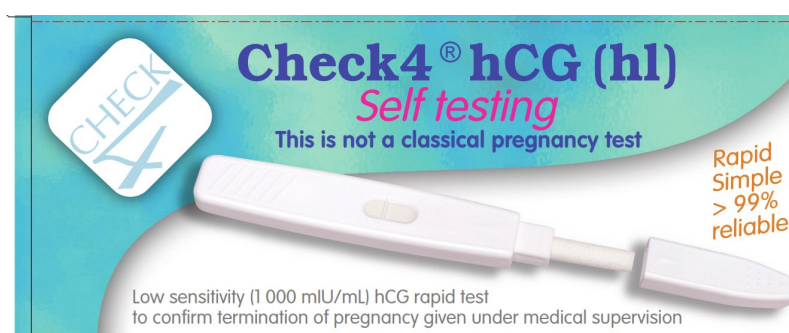
⁸ Joined cases C-108 & C-109/97

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 37).”

48. It is clear from *Oberbank AG & Banco Santander SA v Deutscher Sparkassen- und Giroverband eV*⁹ that the burden of establishing acquired distinctiveness rests on the proprietor of the mark.

49. Mr Jones’ evidence is that Quadrotech first used the mark **Check4** in 1999. The mark was applied to all lateral flow tests manufactured and supplied to it by Veda lab. These included cancer markers, faecal occult blood and prostate specific antigens as well as routine pregnancy tests. Since 2010, the products included a termination of pregnancy test. At the date of Mr Jones’ statement (February 2023), **Check4** branded products accounted for 30% of Quadrotech’s turnover.

50. An example of the mark applied to the goods is shown below:¹⁰



51. The evidence also includes product information sheets bearing the mark from 2018 – 2020.¹¹ I note that one of these (dated May 2019) is for a Check4 Rota and Adeno virus test.

⁹ Joined cases C-217 and 218/13

¹⁰ See exhibit GJ1. Mr Jones says this example dates from 2014.

¹¹ See exhibit GJ2

52. Mr Jones provides sales figures for the period 2016 to 2022. These show sales of around 9,000 **Check4** pregnancy-related tests in 2016, and small numbers of tests for other things; haemoglobin (16), Myoglobin (20), Adeno and/or Rota virus (17), and RSV (4).¹² By 2021, the annual volume of sales of pregnancy-related tests had risen considerably to around 200k. However, sales of some of the other tests (RSV, Rotavirus (alone) and Haemoglobin) ceased in 2017, 2018 and 2020, respectively. Annual sales of the remaining non pregnancy-related tests remained very small (myoglobin - 46, Rota and Adeno virus – 55).

53. Information provided in exhibit GJ4 shows that Quadratech had over 60 customers for one of its **Check4** pregnancy tests in 2021, and around 80 in 2022 (albeit some of these may have been after the relevant date in 2022). The customers were NHS hospitals and trusts, pregnancy services (including the British Pregnancy Advisory Service) and others healthcare providers in the same field. By contrast, there were just seven customers for tests for **Check4** myoglobin in 2021, and two for **Check4** Rota and Adeno virus. Only five of these nine customers are recognisable as healthcare providers based in the UK.

54. Mr Jones also provides estimated sales figures for **Check4** products for the years 2010 to 2022. Sales in 2010 are £125k. Sales for 2014 to 2016 declined to between £12 - £22k. Sales increased again between 2017 (£142k) and 2021 (£523k). Invoices show the seller as Quadratech Diagnostics and the product as Check4 (plus a small, registered symbol) followed by the type of test, e.g. 'Check4 mid-term pregnancy'.

55. Quadratech maintains a website on which it has advertised its Check4 products since 2002.¹³ It does not engage in traditional marketing of its products in magazines or online. Mr Jones says this is not necessary. Rather, sales managers market the products direct to businesses on a face-to-face basis. There is evidence of customers approaching Quadratech asking for **Check4** tests.¹⁴

¹² See exhibit GJ3

¹³ See exhibit GJ9

¹⁴ See exhibit GJ6

56. C4C points to the highly descriptive nature of the mark, and the fact that those who buy the products already know they come from Quadratech, as reasons why the mark had not acquired a distinctive character by the relevant date.

57. Some of the goods covered by the 549 mark, e.g. *pregnancy testing preparations for home use, ovulation test kits* include goods aimed at the general public. There is no evidence that the mark has become distinctive to any significant part of the general public. However, it is not necessary for Quadratech to show that the mark is factually distinctive to **all** the relevant public. It is sufficient to show that it has become distinctive through use to a *significant proportion* of them. Taking into account that:

- (1) Use of the mark has been longstanding;
- (2) The mark has been used on the products as the principal means of distinguishing them from the goods of other traders;
- (3) The pregnancy related products had been widely used in the NHS and healthcare sectors prior to the relevant date;
- (4) Quadratech has provided evidence from Messrs NH, DML and DMN that their organisations regard **Check4** pregnancy tests as distinctive of Quadratech;
- (5) Some of these goods would have been used by members of the general public, albeit under medical supervision;¹⁵

- I find the evidence establishes that, by the relevant date, **Check4** was factually distinctive of Quadratech's pregnancy-related diagnostic products to a substantial proportion of those businesses and organisations in what C4C calls "*the reproductive health space*." I further find that these constitute a *significant proportion* of the relevant public for such products.

58. By contrast, the evidence indicates that the 549 mark had only a small customer base for tests for other things, such as haemoglobin, myoglobin, and rota and adeno virus. Further, the volume of sales of these products was very small even amongst

¹⁵ See the example at paragraph 50 above.

those few customers. I note RH's evidence that Basingstoke and North Hampshire Hospital regards **Check4** as a trusted brand for Rotavirus and Adenovirus antigen detection. However, the evidence from Mr Jones indicates that this hospital was one of only 2 customers for these goods between 2017 - 2019, and again in 2021. There were only 3 customers in 2020 and only 1 (the hospital itself) in 2022. In these circumstances, I do not accept the evidence establishes that **Check4** has acquired a distinctive character through use to a *significant proportion* of the relevant public for any of these products.¹⁶

59. This means that the application to invalidate the 549 mark fails in relation to:

Class 5: Pregnancy testing preparations for home use; Pregnancy testing preparations; Preparations for the diagnosis of pregnancy; Preparations for use in the diagnosis of pregnancy; Ovulation test kits; Preparations for the diagnosis of ovulation; In vitro preparations for predicting ovulation; In vitro preparations for predicting ovulation for home use.

60. The application succeeds in relation to:

In vitro diagnostic preparations for medical use; Diagnostic preparations and materials; Diagnostic preparations for medical purposes; Diagnostic preparations for medical and veterinary use; Diagnostic preparations for medical or veterinary purposes; Diagnostic preparations for veterinary purposes; Diagnostic preparations for veterinary use.

C4C'S APPLICATION TO INVALIDATE THE TRADE MARKS REGISTERED UNDER 2201437 (Check4 devices) ON ABSOLUTE GROUNDS

61. I next turn to C4C's application to invalidate the 437 marks on absolute grounds. The application to invalidate the 437 marks was (as with the 549 mark) filed on 22nd July 2022. The grounds for invalidation are the same as those advanced against the 549 word/numeral trade mark.

¹⁶ Even though I recognise that the relevant public for these goods does not include ordinary members of the public.

62. The marks are registered in relation to:

Class 5: Pregnancy testing preparations and substances and diagnostic preparations and substances for medical diagnosis; all being in kit form.

63. I understand this to cover *pregnancy testing preparations and substances and diagnostic preparations and substances for medical diagnosis*, both in kit form.

64. I have already found that registration of the **Check4** word/numeral mark was contrary to sections 3(1)(b) and (c) of the Act. The relevant date for assessing C4C's case against the 437 marks is earlier than for the 549 mark: 29th June 1999.

65. Mr Edwards drew my attention to the case law surrounding the registration of descriptive signs as part of device or figurative marks as set out in *Starbucks (HK) Ltd v British Sky Broadcasting Group PLC*.¹⁷ The mark at issue in that case is shown below.



66. Arnold J. (as he then was) held that:

“Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art. 7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art. 7(1)(b).”

67. The essential teaching from the case law is that registering a descriptive sign with a ‘fig leaf’ of an accompanying device or get-up will not circumvent the exclusion of

¹⁷ [2012] EWHC 3072 (Ch) at paragraphs 96 to 117

descriptive marks from *prima facie* registration. The more descriptive the sign, the harder it will be to validly register a composite mark including it.

68. However, nothing in the case law prevents the registration of a distinctive mark that includes a descriptive element.

69. The 437 marks consist of rectangular two tone devices¹⁸ with the central element shown below.

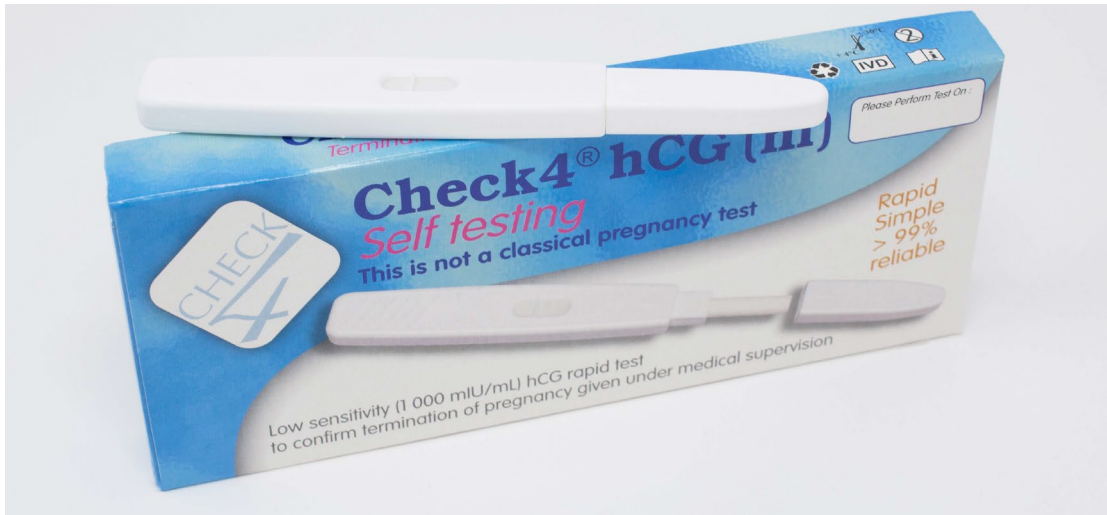


70. There is nothing distinctive about a rectangular 2D shape. It is the sort of shape commonly used in packaging for all kinds of products, including medical diagnostic kits. The two tone get-up is not distinctive because it does not differ substantially from colour schemes commonly applied to packing. Mr Muir Wood submitted that the central element of the marks (shown above) was *prima facie* distinctive. I disagree. The word/numeral CHECK4 is highly descriptive of medical diagnostic and pregnancy testing preparations. Presenting the word CHECK at a 45 degree angle to the numeral 4, and presenting the latter in a slightly stylised and larger font than the word within a diamond shaped outline, does not alter or disguise the clear meaning of CHECK 4, or imbue the mark as a whole with an inherently distinctive character. In my view, registration of the 437 mark was therefore contrary to section 3(1)(c) and/or (b) of the Act.

71. Mr Jones' evidence shows that Quadratch used the diamond shaped element of the 437 marks prior to the date of the application for invalidation.¹⁹ The device mark was used alongside the **Check4** word/numeral mark on the packaging of the goods. This is an example.

¹⁸ See paragraph 15 above

¹⁹ See exhibit GJ2



72. For the same reasons I found that the **Check4** had acquired a distinctive character by 22nd July 2022 for the goods specified in paragraph 59, I reach the same finding in relation to the *pregnancy testing preparations and substances* for which the 437 marks are registered.

73. For the same reasons I found that the **Check4** had not acquired a distinctive character by 22nd July 2022 for the goods specified in paragraph 60, I reach the same finding in relation to the wider description *diagnostic preparations and substances for medical diagnosis* for which the 437 marks are also registered.

C4C'S APPLICATION TO INVALIDATE TRADE MARK 918123549 (Check4) ON RELATIVE GROUNDS

74. C4C claims to have used CHECK4CANCER since February 2015 in relation to, inter alia, *diagnostic testing materials for medical use, computer software for the detection and diagnosis of cancer, tests for medical purposes and cancer screening services*.

75. Mr Edwards' skeleton argument outlined C4C's case as this:

"In short, this challenge reflects the fact that (i) [Quadratech's] Word Mark purports to cover all class 5 diagnostic products across all potential medical and veterinary applications but (ii) by the filing date of [the 549] mark [C4C] had developed a significant goodwill in relation to cancer diagnostic goods and

services and (iii) [Quadrately's] had not developed any goodwill in [C4C's] field by this time, its trade being limited to pregnancy-related products.

[C4C's] position is that it has the earlier unregistered rights in relation to oncology. This entitles it to invalidate [Quadrately's] Word Mark such that it does not cover class 5 products that encompass or relate to cancer diagnosis or anything colourably similar to this."

76. This appears to mean that it is not (or no longer) in dispute that Quadrately started using **Check4** in relation to pregnancy related tests prior to C4C's use of **CHECK4CANCER**. C4C's case appears to be that it alone has established goodwill in relation to oncology tests, and Quadrately's use of **Check4** in relation to those sorts of tests would encroach on C4C's goodwill and constitute passing off. In support of this submission Mr Edwards relied on *Easygroup Ltd v Nuclei Ltd*²⁰ as showing that goodwill attached to the particular goods/services marketed under the mark.

77. In *SWORDERS TM*²¹ I assessed the relevant date for establishing a passing off right in the context of an action based on section 5(4)(a) of the Act. I found that:

"Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made."

78. In *Smart Planet Technologies, Inc. v Rajinda Sharma*,²² Mr Thomas Mitcheson QC, as the Appointed Person, pointed out that *"the start of the behaviour complained about"* is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have

²⁰ [2022] EWHC 901 (Ch) at paragraph 200

²¹ BL O-212-06. This statement was subsequently approved by Mr Daniel Alexander KC as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

²² BL O/304/20

complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when the first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because the claimant had acquired a protectable goodwill under a conflicting mark at that time), he or she will not normally be passing off by continuing to use the mark.

79. Mr Wishart's evidence on behalf of C4C is that the name of the company was changed to Check4Cancer Limited on 27th February 2015. The name was first used on C4C's website on 12th July 2015.

80. Mr Jones' evidence is that Quadragech adopted the **Check4** mark in 1999 and started using it in relation to lateral flow tests provided by Veda Lab. He says these included "*cancer markers, [tests for] faecal occult blood.*" This is consistent with the evidence of RH who says that VedaLab S.A. starting working with Quadragech in 2000 and supplies it with rapid diagnostic tests branded **Check4**. One of these is a test to "*detect injuries/bleeding.*" In support of his narrative evidence Mr Jones' exhibits:

- (1) Historical screenshots from the Quadragech's website dated 2002, 2013 and 2014 showing that '*Check4 Haemoglobin*' tests were available in those years;²³
- (2) A copy of a Declaration of Conformity dated 1st December 2003 explaining that '*Check4 Haemoglobin Sampler – faecal occult blood test collection and extraction accessory*' conform with International quality standards;²⁴
- (3) Version 2 of a Product Information Sheet for '*Check4 Haemoglobin*' dated May 2019 stating that it is for "*the detection of faecal occult blood in colorectal cancer*";²⁵
- (4) An extract from a study entitled '*Diagnostic Accuracy and Cost-Effectiveness of Faecal Occult Blood Tests Used in Screening for Colorectal*

²³ See exhibit GJ9

²⁴ See exhibit GJ10

²⁵ See exhibit GJ2

Cancer: A Systematic Review' conducted by the University of York in 2007, which lists 'Check4 – Haemoglobin' as a relevant product;

- (5) A copy of an email dated April 2017 from a researcher at the Southern England NHS Bowel Cancer Screening Hub saying that she had found details of '*Check4 Haemoglobin*' on Quadrotech's website and asking for product samples and product information literature;²⁶
- (6) An invoice dated 15th November 2016 from Quadrotech to Buckinghamshire Healthcare NHS Trust for 5 '*Check4 Haemoglobin strips and samplers*'.²⁷

81. C4C points out that:

- (1) Quadrotech has not provided sales figures for *Check4 Haemoglobin* prior to 2016 and, therefore, prior to its use of CHECK4CANCER in 2015;
- (2) The sales figures provided by Mr Jones for 2016 – 2020 show small sales of *Check4 Haemoglobin* (between £420 in 2016 and around £4k in 2019) to, at most, 7 customers in total;
- (3) The documentary evidence does not show continuous use of *Check4 Haemoglobin* between 1999 and 2019.

82. I find that Quadrotech's evidence establishes that it was using **Check4** in relation to haemoglobin tests prior to 2015 and that it continued to market that product in small volumes until 2020. The evidence indicates that this test was used to detect signs of bowel cancer. It therefore shows that Quadrotech used **Check4** in relation to diagnostic tests for cancer before C4C started using **CHECK4CANCER**. Consequently, irrespective of whether Quadrotech had actionable goodwill in relation to this kind of diagnostic test in 2015 or September 2019, it was the first-in-time user of the two marks at issue in relation to cancer diagnostic tests. This is fatal to C4C's challenge to the validity of the 549 mark based on section 5(4)(a) of the Act, which fails accordingly.

²⁶ See exhibit GJ6

²⁷ See exhibit GJ5

QUADRATECH'S APPLICATION TO INVALIDATE C4C's TRADE MARK 3582783 ON RELATIVE GROUNDS

The section 5(2) ground for invalidation

Comparison of goods/services

83. It is convenient to start by considering Quadratech's case based on the closest goods (still) covered by the 783 and 549 marks. In my view, these are the goods in classes 10 and 5, respectively. And in practice it is only necessary to consider the closest goods within these classes. These are set out below.

<i>Goods in class 10 covered by 783 mark</i>	<i>Goods in class 5 for which the earlier 549 mark is validly registered</i>
Class 10: Diagnostic tests for medical purposes in the field of cancer; parts and fittings for the aforesaid.	Class 5: Pregnancy testing preparations for home use; Pregnancy testing preparations; Preparations for the diagnosis of pregnancy; Preparations for use in the diagnosis of pregnancy; Ovulation test kits; Preparations for the diagnosis of ovulation; In vitro preparations for predicting ovulation; In vitro preparations for predicting ovulation for home use.

84. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case²⁸ for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

²⁸ [1996] R.P.C. 281

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

85. The goods covered by C4C's mark are testing apparatus, such as test kits, for detecting cancer.

86. The goods covered by the earlier mark are preparations in class 5 used for detecting pregnancy.

87. By the end of the hearing it was common ground that diagnostic preparations in class 5 could be contained in a diagnostic test kit in class 10.

88. The uses of the respective goods are similar in that they are medical diagnostic goods. However, the specific purpose of the goods is different. C4C's goods are for diagnosing cancers. Quadratech's goods are for detecting pregnancy.

89. C4C's goods are unlikely to be available to the general public. However, the healthcare sector uses both types of goods. Therefore, there is some overlap between the respective users.

90. C4C's goods are medical apparatus. Quadratech's goods are preparations, which are usually in liquid form. However, the former is likely to include the latter. So there is some similarity in the physical form of the respective goods.

91. Those in the healthcare sector are liable to obtain the respective goods from potentially the same medical suppliers. Quadratech's evidence shows they could also be produced by the same undertaking.

92. The goods under consideration are not in competition or complementary.

93. In my view, they are similar to a medium degree.

Global assessment of the likelihood of confusion

94. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Average consumer and the selection process

95. C4C contends that its goods are used by medical professionals and others in the healthcare sector who will pay a high degree of attention when selecting goods for detecting cancers.

96. Quadratech does not dispute that analysis so far as medical professionals are concerned. However, it submits that those in the buying departments of hospitals and other healthcare providers will pay a lower degree of attention.

97. I accept C4C's submission on this point. The only evidence on the matter is contained in exhibit GJ6 to Mr Jones' statement on behalf of Quadratech.²⁹ The email enquiry from a researcher at the Southern England NHS Bowel Cancer Screening Hub suggests cancer diagnostic products are selected after a review of samples and product information literature. This points to a high degree of attention, which is what one would expect when it comes to procuring such important medical goods.

98. C4C's evidence indicates that its good/services are offered directly to the public via its website etc. This suggests that the selection process starts off as a visual one, although it will naturally lead to face to face contact where aural communications become relevant.

99. Mr Jones's evidence indicates that Quadratech sales managers market its products direct to businesses on a face-to-face basis. This suggests the selection process for its goods starts off on the basis of aural communications. However, this is likely to lead on to visual processes, such as reviewing samples of the product, packaging and product literature. Therefore, the selection process includes both visual and aural elements.

Distinctive character of the earlier 549 mark

100. I earlier found that the 549 mark had acquired a distinctive character to a significant proportion of the relevant public concerned with pregnancy-related diagnostic tests, particularly in the healthcare sector. This means that **Check4** was distinctive of such goods by 22nd July 2022 when C4C filed its application to invalidate the 549 mark.

101. Section 47(2G) and (2H) state that:

“(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set

²⁹ See page 9

out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) - ”

102. It is therefore necessary to consider the distinctive character of the 549 mark at the date of C4C’s application to register the 783 mark, i.e. as at 21st January 2021.

103. In *Lloyd Schuhfabrik Meyer & Co.* the CJEU stated that:

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


23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph51).”

104. I find that by 21st January 2021 the 549 mark had acquired a distinctive character to a significant proportion of the relevant public in relation to pregnancy-related diagnostic tests. However, although the **Check4** mark had acquired a secondary meaning as a trade mark this had not displaced its original descriptive meaning. Consequently, the level of distinctive character had been raised through use, but only from zero originally to ‘low.’

Comparison of the marks

105. The respective trade marks are shown below:

Earlier 549 trade mark	Contested 783 trade mark
<p>Check4</p>	

106. In *Bimbo SA v OHIM* the CJEU stated that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

108. Mr Muir Wood submitted on behalf of Quadratech that:

- (1) Both marks contain the element Check4/CHECK4;
- (2) Since this element appears at the start of the 783 mark, this will focus the attention of the average consumer;
- (3) The circular device in the 783 mark adds little to the impression created by that mark, but the word CANCER will be noticed;
- (4) As the 549 mark is registered in black and white, it covers the colours in the 783 mark;
- (5) As the circular device in the 783 mark will not be spoken, the marks are more similar to the ear than they are to the eye;
- (6) Conceptually, the 549 mark conveys the idea of checking for something, and the 783 mark conveys the idea of checking for cancer;
- (7) The marks at issue are therefore visually similar to a “*moderate to high*” degree, aurally similar to a higher degree, and conceptually similar to a high degree.

109. Mr Edwards for C4C relied on the absence of the word CANCER and the circular device in the 783 mark as differences which visually, aurally and conceptually distinguished that mark from the 549 mark.

110. The marks are plainly similar to the extent that they both contain the word and numeral ‘Check4/CHECK4’. I do not entirely accept Quadratech’s submission that this element will make a greater impression on relevant consumers because it appears at the start of the 783 mark. In fact to consumers accustomed to reading from left to right, the first visual element in the 783 mark is the coloured circular device. Admittedly, the

CHECK4 element will appear to be the first element of the 783 mark when the mark is spoken. And it is true that the beginnings of marks generally make more of an impression on consumers than the ends. Consequently, I accept that the marks are more similar to the ear than they are to the eye.

111. Quadragech's submission about the higher level of aural similarity implicitly acknowledges that the circular device in the 783 mark makes a more-than-negligible contribution to the visual impression created by that mark. In my view, it makes a significant contribution to the visual impression created by the mark, as does the word CANCER and the multi-colour scheme.

112. As to Quadragech's suggestion that its black and white mark "covers" the colours in which the 783 mark is registered, I note that the Court of Appeal has stated on two occasions that registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).³⁰ Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour. However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. This is because it is necessary to evaluate the likelihood of confusion on the basis of normal and fair use of the marks as registered or proposed to be registered.³¹ Applying a complex colour arrangement to a mark registered without colour would not represent normal and fair use of the mark.³² I therefore accept the 549 mark covers the use of **Check4** in blue or red, but not the specific combination of Check in blue and 4 in red as those elements appear in the C4C's 783 mark.

113. I find the marks are visually similar to medium degree and aurally similar to a medium-to-high degree.

³⁰ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

³¹ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 at paragraph 78

³² See, by analogy, paragraphs 39 – 42 of the decision of Iain Purvis KC as the Appointed Person in *Herno S.p.A. v Miss Sparrow Ltd* BL O/954/22 in relation to the notional stylisation of a word registered in plain characters

114. I accept Quadratech's submission as to the respective meanings conveyed by the marks. On that basis, I find that they are also conceptually similar to a medium-to-high degree.

Likelihood of Confusion

115. Quadratech's case is that use of the 783 mark will result in indirect confusion. i.e. consumers who know of the 549 mark will think the 783 mark is used by the same, or an economically related, undertaking. The suggested thought process is as follows:

- (1) Relevant average consumers will know of the **Check4** mark;
- (2) They will recognise CHECK4 as an element of the 783 mark;
- (3) They will take the word CANCER as an indication of the subject of the tests;
- (4) They will think that this is another diagnostic product from the user of the **Check4** mark;
- (4) The circular device and multi-colour scheme in the 783 mark will not be enough to prevent consumers forming this belief.

116. Mr Wishart's evidence indicates that C4C's customers are private individuals, medical insurance companies, and corporate clients providing medical cover for their employees. C4C's case is essentially that CHECK4 is descriptive and average consumers will immediately recognise this. Therefore, they will not assume that the appearance of that word/numeral combination in the 783 mark indicates a connection with the user of the 549 mark. C4C says that this is consistent with the absence of any evidence of confusion despite the parties having traded concurrently since 2015.

117. *L.A. Sugar Limited v By Back Beat Inc.*,³³ Mr Iain Purvis Q.C., as the Appointed Person, stated that the instances where indirect confusion may arise tend to fall into one or more of the following three categories:

³³ Case BL O/375/10

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

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

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

118. Although these are not exhaustive categories, Quadratech’s case appears to put the word CANCER into category (b). The difficulty with this aspect of Quadratech’s case is that, except in relation to pregnancy-related tests, the CHECK4 element is not distinctive of Quadratech when used in relation to diagnostic goods.

119. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*,³⁴ Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin*³⁵ and *Nicoventures Holdings Limited v The London Vape Co Ltd*.³⁶ Having done so, Ms Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness, as follows:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

³⁴ BL O/0368/23 at paragraph 44

³⁵ [2015] EWHC 1271 (Ch)

³⁶ [2017] EHC 3303 (Ch)

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

120. Although the word CANCER is presented below CHECK4 in the 783 mark, these elements form a term with a unitary meaning: CHECK-FOR-CANCER. This makes it less likely that average consumers will place particular significance on the CHECK4 element alone and make assumptions about a connection with the user of the **Check4** mark in relation to pregnancy-related tests. The visual impact of the circular device at the beginning of the 783 mark, and the multi-colour scheme applied to it, also contribute significantly to the overall visual impression created by that mark. They do nothing to suggest the 783 mark is a brand extension of the 549 mark. In fact they point the other way.

121. It is true that oral marketing, recommendations and orders are likely to play a role in the selection of medical diagnostic goods, where the visual differences between the marks may not be apparent. However, even when private individuals are involved, the selection process for obtaining a cancer diagnostic product is likely to involve medical professionals. Initial aural discussions are likely to lead to subsequent visual processes, such as reviewing samples of the product, packaging and product literature to check for suitability, side effects and method of application. It follows that the 783 mark is likely to be seen before an order is placed for the goods.

122. Further, average consumers of the goods covered by the 783 mark are likely to pay a high degree of attention to ensure they select an appropriate product. These are

not the sort of purchases where consumers are likely to jump to conclusions about the trade origin of the goods based on superficial (descriptive) similarities between the marks.

123. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,³⁷ Arnold LJ pointed out that there must be a “*proper basis*” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. In my judgment, Quadragech has not established there is a ‘proper basis’ for a finding of indirect confusion. At most, the similarity between the marks may be sufficient for the 783 mark to call the 549 mark to mind. However, that is not sufficient because it is mere association, not indirect confusion.

124. The parties appear to have been targeting different parts of the market for medical diagnostic goods whereas the potential markets for the goods overlap to a greater degree (e.g. the NHS). Therefore, although the absence of confusion is consistent with my findings under section 5(2) of the Act, I have reached my conclusions without attaching weight to the evidence of concurrent trading without apparent confusion.

125. As I have found there is no likelihood of confusion even where the marks are used in relation to the most similar goods still at issue, it follows that there is no likelihood of confusion if the 783 mark is used in relation to the other goods/services (still) covered by the registration.

126. For the avoidance of doubt, I would have reached the same conclusions if I had considered the section 5(2) case for invalidity based on the goods in class 5 for which the 783 was originally registered, but subsequently surrendered.

The section 5(4)(a) ground for invalidation

127. In *Discount Outlet v Feel Good UK*,³⁸ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

³⁷ [2021] EWCA Civ 1207

³⁸ [2017] EWHC 1400 IPEC

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

128. As noted above, C4C started using CHECK4CANCER in 2015. However, Mr Muir Wood argued that the first relevant date for the purposes of this part of Quadratech’s passing off right case is when C4C started using the words CHECK4CANCER with the logo shown in the 549 mark, i.e. the actual mark under consideration. This date is not clear, but it may have been in 2020. I do not accept this submission. Quadratech objection is directed at the word/numeral element of the 783 mark, not the logo. In these circumstances the relevant issue is when C4C started using the contested part of the mark (i.e. the sign complained about) in relation to the goods/services covered by the 783 mark. This appears to have been July 2015 when the sign was used in relation to at least some of the goods/services still covered by the 783 registration. The second relevant date is the date of the application to register the 783 mark, i.e. 21st January 2021.

129. Mr Wishart’s evidence is that C4C started using CHECK4CANCER in 2015 *“because we wanted an easily understood message that would immediately identify the nature of our clinical services.”* He says that C4C **currently** (in 2023) provides at-home cancer screening services and that it **currently** has around 100 clinics through which it offers services throughout the UK. The sales figures provided show a significant trade developing between 2017 (£1.15m) and 2021 (£5.8m). However, there is no breakdown of these sales into specific goods/services. Mr Wishart says that the CHECK4CANCER name is used on testing kits and he provides a picture of

one.³⁹ However, this appears to be a current picture rather than an historical one showing such use in 2015 – 2021. And the only invoice in evidence for a CHECK4 CANCER BowelCheck **service** is dated 2023.⁴⁰ I am prepared to accept that C4C has provided the medical services specified in class 44 of the 783 registration since 2015. However, the evidence before me does not show that it provided the other goods/services covered by the 783 mark prior to the second relevant date.

130. Mr Jones's evidence on behalf of Quadratch provides estimated UK sales figures for diagnostic kits bearing the **Check4** mark from 2010 to 2022. The figures up to 2015 are small but not insignificant. They range from nearly £200k in 2013 to just £12k in 2014 and £17k in 2015. It is not clear what proportion of these tests were for non-pregnancy related conditions. The breakdown of products provided for 2016 indicates that the vast majority of sales at that time were pregnancy-related tests. It seems unlikely that the position was much different in 2014/15.

131. Nevertheless, I have found that Quadratch used **Check4** in relation to haemoglobin tests for detecting bowel cancers since 1999. Further, it seems likely that it also used the mark on a small scale in relation to tests for other non-pregnancy related conditions, such as myoglobin, and rota and adeno virus.

132. The evidence does not enable me to establish the **extent** of such use of the mark prior to 2016. This is important because the law of passing off does not protect goodwill of only a trivial extent. As Mr Thomas Mitcheson QC, as the Appointed Person, noted in *Smart Planet Technologies, Inc. v Rajinda Sharma*:

".. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

133. I am not persuaded that Quadratch's evidence establishes that, prior to 2015, it had a more-than-trivial level of goodwill under **Check4** as a provider of anything other

³⁹ See exhibit GCW6

⁴⁰ Also in exhibit GCW6

pregnancy-related diagnostic tests. Quadratech's case under section 5(4)(a) based on its goodwill as a provider of pregnancy-related tests is no stronger than the case advanced and already rejected under section 5(2).

134. The evidence of use of **Check4** after 2015 is a little more helpful to Quadratech's case. It is sufficient to establish that by the second relevant date in 2021, Quadratech was known to a small number of its customers as a provider of other types of diagnostic tests, including tests used for detecting bowel cancers.

135. Does this materially enhance Quadratech's case under section 5(4)(a) over the case considered under section 5(2)? In my view, it does not. This is because:

(1) The **Check4** mark was (at best) weakly distinctive of Quadratech's diagnostic kits because of its descriptive nature;

(2) The use made of the mark prior to 2021 was only sufficient to endow the mark with a low degree of distinctiveness, and then only really in relation to pregnancy-related tests;

(3) It is well established that where marks are highly descriptive of the goods/services to which they relate, relatively small differences between them will be sufficient to avoid passing off;

(4) Although the absence of evidence of an intention to deceive is not fatal, it is relevant that there is no evidence that C4C adopted its name to dishonestly trade on Quadratech's reputation.

136. As Lord Simonds stated in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*:⁴¹

"Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of

⁴¹ [1946] 63 RPC 39

discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

137. I find the differences between the marks set out above, and the above-average degree of attention likely to be paid during the selection process, are sufficient to avoid deception amongst a substantial number of Quadratech’s actual or potential customers.

138. Even if I am wrong about this, I would have held that the differences between Quadratech’s goods and the goods/services still covered by the 783 mark are, with the exception of classes 10 and 44, sufficient (along with the other relevant factors) to avoid deception (and therefore misrepresentation).

139. So far as C4C’s medical services in class 44 are concerned, I would have accepted C4C’s fall-back position based on honest concurrent use between 2015 and 2021. Having reviewed the authorities on honest concurrent use, Recorder Purvis QC sitting in the Patents County Court concluded as follows in *W.S. Foster & Son Ltd v Brooks Brothers UK Ltd*:⁴²

“The authorities therefore seem to me to establish that a defence of honest concurrent use in a passing off action requires at least the following conditions to be satisfied:

(i) the first use of the sign complained of in the United Kingdom by the Defendant or his predecessor in title must have been entirely legitimate (not itself an act of passing off);

(ii) by the time of the acts alleged to amount to passing off, the Defendant or his predecessor in title must have made sufficient use of the sign complained of to establish a protectable goodwill of his own;

(iii) the acts alleged to amount to passing off must not be materially different from the way in which the Defendant had previously carried on business when

⁴² [2013] EWPC 18 at [61]:

the sign was originally and legitimately used, the test for materiality being that the difference will significantly increase the likelihood of deception.”

140. In *Match Group, LLC v Muzmatch Ltd*,⁴³ the Court of Appeal expressed doubts about whether condition (i) accurately represented the law, but that makes no difference here because there is insufficient evidence to establish that C4C was passing off in 2015. I am satisfied that C4C’s honest concurrent use case also fulfils conditions (ii) and (iii). Moreover, as this is a common law defence based on equitable principles (as opposed only to educating the public to distinguish between the marks so as to reduce or eliminate confusion), it is not fatal to C4C’s case that the parties have not so far targeted the same customers.

141. Therefore, for the reasons given above, I reject Quadratech’s application to invalidate the 783 mark on relative grounds.

C4C’S APPLICATION TO REVOKE THE DEVICE MARKS REGISTERED UNDER 2201437 FOR NON-USE

142. As I have found the 437 marks are only valid in relation to *pregnancy testing preparations and substances*, I will confine my examination of the application for revocation to these goods.

143. Mr Edwards conceded at the hearing that, in the light of section 46(3) of the Act, it is only necessary to consider whether there was genuine use of the 437 marks in the later of the two periods identified in the application for revocation, i.e. 20th January 2016 to 19th January 2021.

144. In *Walton International Ltd & Anor v Verweij Fashion BV*⁴⁴ Arnold J. (as he then was) summarised the law relating to genuine use 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.

⁴³ [2023] EWCA Civ 454

⁴⁴ [2018] EWHC 1608 (Ch)

(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.

(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. 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.

(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. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter.

(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.

(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.

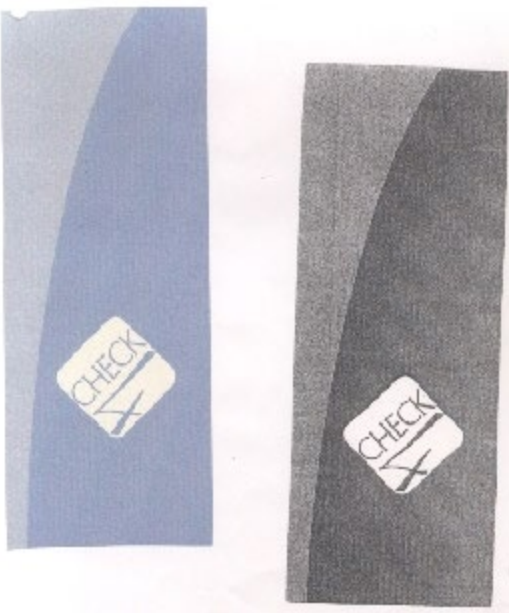

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, 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.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

145. There is no evidence of use the 437 marks as registered. As already noted, there is evidence of use of the mark shown at paragraph 71 above. I am satisfied that the evidence shows use of that sign, as a trade mark, in relation to *pregnancy testing preparations and substances* during the relevant period. Further, I am satisfied that the extent of the use was sufficient to constitute genuine use in the UK. Therefore, if the mark used is an acceptable variant of the marks as registered, Quadratech will have shown genuine use of the 437 marks.

146. The key issue, therefore, is whether use of that sign counts as an acceptable variation of the registered marks under section 46(2) of the Act. This depends on whether the difference between that sign used and the registered marks is sufficient to *alter the distinctive character of the mark[s] in the form in which [they] w[ere] registered.*

147. For ease of reference the marks are shown below.

Registered marks	Used mark
	

148. In *Lactalis McLelland Limited v Arla Foods AMBA*,⁴⁵ Phillip Johnson, as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

*“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 [EU’s] 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 Hyphen v

⁴⁵ BL O/265/22

EU IPO, 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 EU IPO, 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.”

149. In *Hyphen GmbH v EU IPO*, the General Court 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 registered.



150. In *Menelaus BV v EU IPO*⁴⁶ the General Court found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



151. The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73. [The sign on the left] differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element [the sequence of dots] for a laudatory

⁴⁶ Case T-361/13

element [the crown] when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74. That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

152. The diamond-shaped Check 4 device is relatively small compared to the whole marks. However, it is undoubtedly the feature to which the eye is drawn. Further, the evidence indicates that, at least by the second half of the relevant period, this element of the 437 marks had acquired a distinctive character, whereas the background element of the marks remained non-distinctive. In these circumstances I accept that use of the diamond-shaped Check4 device constituted an acceptable variation of the 437 marks as registered.

153. This means that the application for revocation of the marks registered under 437 fails in relation to the goods for which it is validly registered, i.e. *pregnancy testing preparations and substances*.

OVERALL OUTCOME

154. C4C’s application to invalidate trade mark 2201437 succeeds in relation to *diagnostic preparations and substances for medical diagnosis* (at large). However, it fails in relation to *pregnancy testing preparations and substances, all in kit form* for which the 437 mark will remain registered in class 5.

155. C4C’s application to invalidate trade mark 918123549 succeeds, except in relation to the following goods, for which it will remain registered:

Class 5: Pregnancy testing preparations for home use; Pregnancy testing preparations; Preparations for the diagnosis of pregnancy; Preparations for use in the diagnosis of pregnancy; Ovulation test kits; Preparations for the diagnosis

of ovulation; In vitro preparations for predicting ovulation; In vitro preparations for predicting ovulation for home use.

156. C4C's application to revoke the trade marks registered under 2201437 for non-use, fails for *pregnancy testing preparations and substances, all in kit form*.

157. Quadratech's application to invalidate trade mark 3582783 is rejected.

COSTS

158. Both sides have achieved a measure of success. In particular, the outcome of C4C's applications to cancel trade marks 2201437 and 918123549 can fairly be regarded as a draw. However, C4C was wholly successful in defending trade mark 3582783 from Quadratech's application 504906 for cancellation. I will therefore direct Quadratech to make a contribution towards the costs C4C incurred defending this trade mark.

159. I assess the required contribution to C4C's costs as follows:

(1) £500 for considering Quadratech's application for invalidation and filing a counterstatement;

(2) £500 towards the cost of filing evidence and considering Quadratech's evidence (representing a quarter of the contribution I would have awarded C4C if it been successful in all four applications);

(3) £600 towards the cost of the hearing.

160. As regards the hearing, I would have assessed the appropriate contribution towards C4C's costs as £400, representing a quarter of the contribution I would have awarded if C4C had been successful in all four applications. However, the hearing took longer than required because Quadratech had not paginated the exhibits to its evidence as required by Tribunal Practice Notice 5/2008. At one stage I had to stop the hearing while I page numbered an exhibit myself so that I could find the relevant pages again when writing this decision. This wasted C4C's time, and my time. This is why I have increased the contribution for the hearing to £600.

161. I therefore order Quadratech Diagnostics Ltd to pay Check4cancer Ltd the sum of £1600. This is to be paid within 21 days of the end of the period allowed for appeal, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 12th day of October 2023

Allan James
For the Registrar

Annex A

Goods/services for which trade mark 3582783 is registered:

Class 9: Computer software for the detection and diagnosis of cancer; artificial intelligence software for use in the field of cancer; artificial intelligence software for healthcare in the field of cancer; artificial intelligence software for medical purposes in the field of cancer; interactive software based on artificial intelligence in the field of cancer; software for the integration of artificial intelligence and machine learning in the field of Big Data for use in the field of cancer.

Class 10: Medical test kits for home use in the field of cancer; apparatus for carrying-out diagnostic tests for medical purposes in the field of cancer; diagnostic test kits for the detection of cancer; test equipment for medical use in the field of cancer; testing apparatus for medical purposes in the field of cancer; test probes for medical use in the field of cancer; apparatus for carrying-out diagnostic tests for medical purposes in the field of cancer; apparatus for DNA and RNA testing for medical purposes in the field of cancer; membrane test plates for use in medical diagnostics in the field of cancer; parts and fittings for the aforesaid.

Class 42: Software as a service, or software platforms as a service, in the field of cancer; design and development of computer software for use in the field of cancer; scientific and technological services and research in the field of cancer; providing artificial intelligence computer programs on data networks in the field of cancer; Platforms for artificial intelligence as software as a service [SaaS] in the field of cancer; Software as a service [SaaS] featuring computer software platforms for artificial intelligence in the field of cancer; Scientific research for medical purposes in the area of cancerous diseases; Scientific research for medical purposes in the area of cancerous diseases; information, consultancy and advisory services in relation to the aforesaid.

Class 44: Medical services in the field of cancer; medical testing in the field of cancer; cancer screening services; bowel cancer screening services; breast cancer screening

services; cervical cancer screening services; lung cancer screening services; prostate cancer screening services; testicular cancer screening services; medical analysis services for cancer diagnosis and prognosis; RNA or DNA analysis for cancer diagnosis and prognosis; information, consultancy and advisory services in relation to the aforesaid.

Class 45: Providing personal support services for cancer patients and their families; providing emotional support to cancer patients and their families via interactive online forums; information, consultancy and advisory services in relation to the aforesaid

Annex B

The goods for which trade mark 918123549 is registered:

Class 5: In vitro diagnostic preparations for medical use; Diagnostic preparations and materials; Diagnostic preparations for medical purposes; Diagnostic preparations for medical and veterinary use; Diagnostic preparations for medical or veterinary purposes; Diagnostic preparations for veterinary purposes; Diagnostic preparations for veterinary use; Pregnancy testing preparations for home use; Pregnancy testing preparations; Preparations for the diagnosis of pregnancy; Preparations for use in the diagnosis of pregnancy; Ovulation test kits; Preparations for the diagnosis of ovulation; In vitro preparations for predicting ovulation; In vitro preparations for predicting ovulation for home use; In vitro testing preparations for professional use.

Annex C

The goods/services for which C4C says it has acquired goodwill under CHECK4CANCER:

Diagnostic testing materials for medical use; medical diagnostic assays for use in diagnosis and detection of cancer; medical diagnostic test strips; chemical preparations for testing blood for medical purposes; medical diagnostic reagents and assays for testing of body fluids; medical diagnostic test strips.

Computer software for the detection and diagnosis of cancer.

Medical test kits for home use; apparatus for carrying-out diagnostic tests for medical purposes; diagnostic test kits for the detection of cancer; test equipment for medical use; testing apparatus for medical purposes; test probes for medical use; apparatus for carrying-out diagnostic tests for medical purposes; apparatus for DNA and RNA testing for medical purposes; membrane test plates for use in medical diagnostics; parts and fittings for the aforesaid.

Medical services; medical testing; cancer screening services; bowel cancer screening services; breast cancer screening services; cervical cancer screening services; lung cancer screening services; prostate cancer screening services; testicular cancer screening services; medical analysis services for cancer diagnosis and prognosis; RNA or DNA analysis for cancer diagnosis and prognosis.