BL O-483-21

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION NO. 503285

TO REVOKE ON THE GROUNDS OF NON-USE

TRADE MARK REGISTRATION
NO. 1454334

OF THE MARK:

VIDAS

OWNED BY

bioMérieux

Background

1. These proceedings concern the trade mark shown on the cover page of this decision. It was filed on 31 January 1991 (claiming an International Convention priority date of 6 August 1990 from an earlier filing in France) and entered in the register on 3 March 1995. The trade mark is registered in class 10 in the name of bioMérieux ("the proprietor") in respect of the following goods:

> Apparatus for analysis; all for medical use; all included in Class 10.

2. On 13 August 2020, Vidya Holdings Ltd ("the applicant") applied for the revocation in full of the above trade mark, relying upon sections 46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act"). Under section 46(1)(a), "the relevant period" is 4 March 1995 to 3 March 2000 (with revocation sought from 4 March 2000). Under section 46(1)(b), the relevant periods/date of revocation sought are as follows:

> 4 March 2004 to 3 March 2009 – 4 March 2009;
>
> 19 November 2013 to 18 November 2018 – 19 November 2018;
>
> 7 August 2015 to 6 August 2020 – 7 August 2020.

3. The applicant states:

> "If it is shown that the trade mark has been put to genuine use within the relevant periods in relation to some of the goods and not all, or that the use shown is not sufficient to prove use of the broad term "apparatus for analysis", the Applicant requests partial revocation of the Registration in accordance with s46(5) of the Trade Marks Act 1994. Similarly, if proper reasons for non-use within the relevant period is provided only in relation to part of the goods covered by the Registration and not all, the Applicant requests partial revocation of the Registration accordingly."

4 The proprietor filed a counterstatement in which it indicates it is defending the application in respect of all the goods for which it stands registered. It states:

> "1. It is denied the registration offends against the provisions of section 46(1)(a) of the Act. The mark in suit has been put to genuine use in the UK by the proprietor in relation to the goods for which it is registered within the period of 5 years following completion of the registration procedure. Indeed, the mark in suit has been in continuous use by the proprietor in the UK since the date of completion of its registration in relation for the goods for which it is registered.
>
> 2. It is denied that the registration offends against the provisions of section 46 (1)(b) of the Act. The use of the mark in suit has not been suspended for an uninterrupted period of five years in relation to the goods for which it is registered and in particular use has taken place within the five year periods referred to in the application for revocation and in any event in the five year period up to the date of the filing of the revocation."

5. In these proceedings the applicant is represented by Stratagem Intellectual Property Management Limited and the proprietor by Murgitroyd & Company. Although only the proprietor filed evidence, the applicant filed written submissions during the evidence rounds. While neither party asked to be heard, both filed written submissions in lieu of attendance. In reaching a conclusion I will bear all of these submissions in mind, referring to them to the extent I consider it appropriate.

6. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Legislation and leading case-law relating to revocation

7.The pertinent legislation is contained in section 46 of the Act, the relevant parts of which read:

"(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;

(c)...

(d)...

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(4) .....

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

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

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

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

8. Section 100 is also relevant; it reads:

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

9. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

"114……The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze*

Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

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

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

The proprietor's evidence

10. This consists of two witness statements. The first, filed as evidence-in-chief, is dated 9 December 2020 and is from the proprietor's Vice President Intellectual Property, Laurent Caucal; Mr Caucal has held that position since May 2013. He explains that the proprietor has been "leading the fight against infectious diseases for more than 55 years", with the roots of the company dating back to 1897. The proprietor employs over 11k people in 43 countries and serves more than 160 countries worldwide "through a network of distributors". Mr Caucal states:

> "3…The company operates in two main sectors. In the clinical field the company offers a wide range of solutions mainly for diagnosing and managing infectious diseases. For the agri-food, cosmetics and pharmaceutical industries [the proprietor] provides solutions for the enumeration of microbial flora, detection of specific pathogenic bacteria, the monitoring of air and surface quality and sterility testing…"

11. He adds that clinical diagnostics account for around "80% of worldwide sales which stood at approximately 2.7 billion Euros for the year ending 31 December 2019." He further states:

> "4 [the proprietor]…exercises ultimate control of its wholly owned subsidiaries including in the UK, bioMérieux UK Limited, which uses the trade mark VIDAS with the consent of my company."

12. Mr Caucal explains that VIDAS:

> "6…is a multiparametric immunoassay system for identifying bacteria in blood samples. The system incorporates the following components: a) the VIDAS immunoassay analyser, (b) reagent strips for use with the immunoassay analyser, (c) underlying software for enabling effective management of data and the processing thereof.
>
> 7. Complimentary to the above are related products such as cleansing solutions, waste liners and printing paper, dilution cups and sample tips…"

13. Exhibit LC1 consists of what Mr Caucal describes as “an historical analysis of the VIDAS system up until 1995.” The cover page of the document provided (which bears the proprietor’s name at the top right hand corner) is entitled “1963-2003”. The pages provided contain numerous reference to VIDAS in the context of immunoassays. Mr Caucal states that the proprietor’s immunoassay analyser is “currently sold in three versions branded VIDAS, MINI VIDAS and VIDAS 3.” He adds that:

> “9. At any one time over 30,000 VIDAS analysers are in operation around the globe.”

14. Insofar as the UK is concerned, he explains that the proprietor trades through its wholly owned subsidiary bioMérieux UK Limited and that the first use of “VIDAS” in relation to immuno analysers, reagent strips and associated products was “in the early 1990s and use has been continuous since that date.” He states that the value “of the UK sales of immune analysers and reagents” is as follows: **Immuno analysers** – 2016 - £0.3m, 2017 - £0.75m, 2018 - £0.3m, 2019 - £0.325m; **Reagents** – 2016 - £3.3m, 2017 - £3.2m, 2018 - £3.4m, 2019 - £3.5m.

15. Mr Caucal states that the proprietor’s customers in the UK include NHS Trusts, private hospitals and clinics. Exhibit LC2 consists of a range of invoices issued by bioMérieux UK Limited to undertakings in the UK which are dated between 2 January 2016 and 4 June 2018. I note that invoices dated 18 March 2016, 31 August 2017, 22 December 2017 and 8 October 2018, contain references to, inter alia, “VIDAS 3”, “MINI VIDAS”, “VIDAS 3” and “VIDAS 3” respectively. The cost of these items has been redacted.

16. Exhibit LC3 consists of what Mr Caucal describes as “pricelists.” The first page of the exhibit bears the proprietor’s name and is entitled “Product List UK Clinic 2018”. At the bottom of the pages there appears the words “Pioneering Diagnostics.” Page 2 of the pricelist includes a reference to “Biomerieux Innovative Diagnostic Solutions.” Page 3, which is headed “Sales Orders & Enquiries”, contains, inter alia, a reference to bioMérieux UK Limited. Page 4 of the exhibit looks like this:

17. Other pages include references to “VIDAS Consumables & Accessories” and “VIDAS Reagents for Clinical specimens”. Page 14 of the exhibit is entitled “Clinical Price List June 2015”, it contains a reference to bioMérieux UK Ltd and to “Bacteriology”, “Immunoassays” and “Molecular Diagnostics.” Page 16 of the exhibit looks like this:

18. Once again, the pages refer to “VIDAS Consumables & Accessories” and to “reagents” as well as to other trade marks used by the proprietor, for example, “VITEK” and “ATB”. Although the pages provided contains various prices, as far as I can tell the information relating to many of the “VIDAS” products including the “VIDAS 3 instrument”, the “mini VIDAS Blue System” and the “VIDAS Blue System” have been removed.

19. Exhibit LC4 consists of what Mr Caucal explains is “promotional material issued for the period 2016 to 2019.” The pages provided contain numerous references to the trade mark under attack, which is shown in, inter alia, the following formats:

VIDAS

(including in a range of colours)

20. The pages provided contain references to either www.biomerieux.com or www.biomerieux-diagnostics.com, or both. He further explains that the proprietor:

> “13…promotes and facilitates the sale of VIDAS branded products in the UK by way of a dedicated national sales force and appearances at exhibitions and expos. The products have also been the subject of regular articles appearing in medical and scientific journals.
>
> 14. The VIDAS system is recognised as the world’s leading immunoassay analyser and is regularly used in scientific studies and research. Indeed it is at the cutting edge of diagnostic technology and has been central to many scientific breakthroughs….

15. Up until November 2019 the VIDAS range of products was supported by a dedicated digital platform accessible via the website www.myvidas.com. This platform was a gateway to information concerning the operation and maintenance of VIDAS immunoassay analysers and associated products. During the period from January 2017 to November 2019 it received 54,000 visits of which about 6% were from the UK."

21. Exhibit LC5 is described by Mr Caucal as "summaries of scientific articles taken from my company's archives published in the UK since 2002." The pages provided contain articles (all of which mention, inter alia, "VIDAS") are dated between 2002 and 2017 from "European authors" and from between 1996 and 2015 from "UK authors."

22. In its written submissions filed during the evidence rounds, the applicant commented upon the proprietor's evidence. The main points emerging from which are, in my view, as follows:

- the sales figures provided and supporting material of these sales are limited to the years 2016-2019;

- there is no evidence to support the statement that the proprietor began using the "VIDAS" mark in the UK in the early 1990s;

- the evidence of use is in relation to limited time periods and does not prove genuine use in relation to each of the five year periods pleaded;

- the evidence provided in exhibit LC5 is an internal collection with no details of circulation to the general public;

- there is no evidence to show that the first and fourteenth pages of exhibit LC3 (dated 2018 and 2015 respectively) are linked to the pages in the exhibit which follow them;

- the majority of the promotional material provided as exhibit LC4 shows no clear date;

- the only clear dates shown on any significant proportion of the evidence are from 2016-2019;

- the evidence shows use of the word “VIDAS” as a word mark in varying colours, a red stylised mark and a logo form showing the word “VIDAS” enclosed in a white and red rectangle and the “V” presented in the shape of a tick;

- no evidence has been provided in support of the proprietor’s claim to have a dedicated national sales forces and to have attended exhibitions and expos;

- given the specification for which the proprietor’s trade mark is registered, any use in relation to reagents strips, software or rental of immunoassay analysers is not relevant;

- in the period 2016-2019, the proprietor only sold four immunoassay analysers, the cost of which has been redacted;

- the evidence is limited to use on immunoassay analysers for identifying bacteria in blood samples for clinical and medical use;

- the average consumer of the goods at issue is a medical professional who would refer to the proprietor’s “VIDAS” product as “a blood analyser for the particular conditions the analyser works for” and who would “be highly aware of the exact product function, buying to serve a specific need. Only specific terminology would be used by the average consumer based on the purpose of the product. The area of diagnostics is expansive and covers a vast range of both health conditions and technology used.”

23. The proprietor filed a second witness statement, dated 9 March 2021, in reply. It is from James Robertson, the proprietor’s new Vice President Intellectual Property, a position he has held since January 2021. He states:

> “1… By virtue of my position I am familiar with details of the business undertaken by bioMerieux (herein after referred to as "my company"). The facts in this Witness Statement are from my own knowledge, or from information provided to me from my company's books and records and/or from publically

available information on the internet and elsewhere. I am authorised by my company to make this Witness Statement in support of the above registration. I am fully conversant in the English language.

3. I note in paragraph 12 of the submission, that the complainant attempts to throw doubt on the credibility of Exhibit "LC3" by stating that there is no evidence to show that the pages which follow the title pages "Product List UK Clinic 2018" and "Clinical Price List 2015" are "linked" with the first page. Simply for the avoidance of doubt, I can confirm that the subsequent pages are all part of the publications respectively entitled "Product List UK Clinic 2018" and "Clinical Price List 2015" and that all of the materials exhibited under "LC3" are true copies of the originals."

24. Exhibit JR1 consists of three further invoices dated 26 November 2018 and 29 March 2019, issued by bioMérieux UK Limited to undertakings based in the UK. Although the value of the invoices has been redacted (because Mr Robertson states the information is commercially sensitive), I note that they contain references to, inter alia, "VIDAS Analyzer NSH [U]", "VIDAS 3" and "VIDAS Analyser", respectively.

25. In addition to the points made in its submissions filed during the evidence rounds, in its submissions filed in lieu of a hearing, the applicant further states:

- it is not clear if the sales figures (shown in paragraph 14 above) "are sales of products branded "VIDAS" only, or include immunoanalysers and reagents sold under other brands";

- the proprietor has not provided any evidence of the market share its "VIDAS" product enjoys in relation to goods in class 10. Although in its submissions the applicant has provided information (including an extract from a website) which it suggests shows the significant size of the market in which the proprietor's goods in class 10 fall, as the applicant has not sought leave to file such information as evidence, it will play no part in the conclusions I have to reach;

- given the short time Mr Robertson has held his current position, his evidence is of “low probative value”;

- it has not been shown how the promotional material provided has been distributed, directed at and who and how many people have assessed the material in the UK;

- no information has been provided about how a UK customer goes about purchasing the proprietor’s products or how the products are presented to customers;

- sales of seven immunoassay analysers in the period 2016-2016 is merely token;

- there is no evidence to show what price the product was sold for, but it can be inferred it is not low-priced;

- the additional evidence provided by Mr Robertson is insufficient to meet the challenges raised in the submissions filed during the evidence rounds;

- if the evidence is considered acceptable, the specification of the registration should be limited to “immunoassay analysers for identifying bacteria in blood samples for clinical use”.

DECISION

26. I begin by reminding myself of the relevant periods in play in these proceedings (shown in paragraph 2 above). I note that collinsdictionary.com defines the following terms as follows:

> **Immunoassay** – “immunology - a technique of identifying a substance by its ability to bind to an antibody”;
>
> **Reagent** – “a substance for use in a chemical reaction, esp for use in chemical synthesis and analysis”;

Reagent strip – “A reagent strip is a thin piece of paper impregnated with a reagent (= a substance that causes a chemical reaction) to a specific substance, used in testing for that substance in a body of fluid.”

27. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated:

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

and further at paragraph 28:

> “28. ..... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a

much narrower range should be critically considered in any draft evidence proposed to be submitted."

28. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated:

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

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

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

for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

29. Although there are a number of relevant periods in play in these proceedings, if I conclude that the proprietor has used its trade mark in the most recent relevant period i.e. 7 August 2015 – 6 August 2020, that is sufficient to save the registration.

30. The applicant has made a range of criticisms of the proprietor's evidence many of which I have summarised above and many of which are justified. For example, no evidence has been provided in relation to the market share the proprietor's "VIDAS" product enjoys nor has any evidence been provided to support its claim to having a dedicated national sales force or to having attended exhibitions, expos etc. Insofar as Mr Robertson's evidence is concerned, despite the short period in which he has held his current position, given his position as Mr Caucal's successor and as he confirms that he is familiar with the proprietor's business and has obtained the information in his statement from inter alia, his own knowledge and information obtained from the proprietor's books and records, I see no reason to give his evidence the low probative value the applicant suggests.

31. The evidence shows that within the most recent relevant period the subject trade mark has been used in the form in which it stands registered. As the applicant points out, the subject trade mark has also been used in a range of formats, for example, "VIDAS" (in varying colours), "VIDAS 3", "MINI VIDAS" as well as in the formats shown in paragraphs 17 and 19 above. In *Nirvana Trade Mark,* BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. …. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period…

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-

questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

32. Having applied the guidance in *Nirvana*, the use in the formats  and  do not qualify as acceptable variants of the subject trade mark. However, having applied the same guidance, I am satisfied that the use of "VIDAS 3" and "MINI VIDAS" (in which the numeral "3" will be understood by the average consumer as the product's third iteration and the word "MINI" as a smaller version) are acceptable variants. As for use in the format  , although more arguable, as the first character will, in my view, be understood by the relevant consumer as a stylised letter "V" (as opposed to being construed as a device of a tick), these are also acceptable variants of the trade mark as registered – see, for example, the decision of the Appointed Person, Mr Philip Johnson, in *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19.

33. Turning to the quantum of use, within the most recent relevant period the proprietor has sold seven immunoassay analysers under its "VIDAS" trade marks. While I agree with the applicant that sales of goods or services proper to other classes (reagents for example) are not relevant, the applicant further argues that it is not clear if the sales figures provided by Mr Caucal relate to sales of immunoassay analysers sold under the subject trade mark (as opposed to other trade marks). However, given the structure of Mr Caucal's witness statement in which there appears a heading entitled "Use of Vidas in the United Kingdom", followed by the sales figures mentioned, I think it reasonable for me to infer that the sales figures provided relate to sales under the subject trade mark. In addition, although the cost of the individual instruments has been redacted (as being commercially sensitive), in the period 2016-2019, sales of immunoassay analysers under the "VIDAS" trade marks amounted to some £1.7m. That is a not inconsiderable sum, irrespective of the cost of the individual instruments.

34. As to the goods upon which the subject trade mark has been used, in his statement, Mr Caucal states that:

> "6. VIDAS is a multiparametric immunoassay system for identifying bacteria in blood samples."

35. Broadly speaking, I agree that description appears to coincide with the evidence provided within, inter alia, the most recent relevant period. Having reached the conclusion that within the most recent relevant period the proprietor has made genuine use of the subject trade mark in relation to the goods shown above, I must now go on and determine what constitutes a fair specification.

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

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

38. In its written submissions, the applicant refers to the following comment of the General Court in *Polfarmex S.A. v EUIPO*, case T-677/19:

"116. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent

from the case-law that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service at issue is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services (judgments of 13 February 2007, *RESPICUR*, T-256/04, EU:T:2007:46, paragraph 29, and of 16 May 2013, *Aleris* v *OHIM – Carefusion 303 (ALARIS)*, T-353/12, not published, EU:T:2013:257, paragraph 22). In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services…".

39. The applicant concludes:

"49. It is submitted that the evidence, in the context of class 10, is limited to immunoassay analysers for identifying bacteria in blood samples as described in paragraph 6 of the Witness Statement and that there is no evidence demonstrating that the mark has been used on any other product within the category of diagnostic apparatus.

50. To answer the question, "how would the average consumer fairly describe the [goods] in relation to which the trade mark has been used" as put in the Thomas Pink case, the average consumer in this case is a medical professional, as the witness Laurent Caucal states in paragraph 12 of his witness statement, and would be required to consider and refer to the product as a blood analyser for the particular conditions the analyser works for, and which are specific to the needs of medical professional at the time. The specificity is vital in the market concerned. The average consumer would pay strict attention at the point of purchase and would be highly aware of the exact product function, buying to serve a specific clinical need. Only specific terminology would be used by the average consumer based on the purpose of the product.

51. As found in the Polfarmex case cited above, “the purpose or intended use of the product or service at issue is vital in directing their choices” and “since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services.” In the current case the exact purpose and function of the goods in question is crucial for the average consumer in forming their description of them. The area of diagnostics is expansive and covers a vast range of both health conditions and technology used. It is submitted that the specific product referred to in the Proprietor’s evidence, and which comprises the entirety of evidence in relation to class 10 and therefore relevant in these proceedings, falls within a subcategory of the broad category of diagnostic apparatus.

52. It is submitted that if the evidence provided by the Proprietor is in relation to any goods in class 10, it is in relation to only what the witness refers to; immunoassay analysers for identifying bacteria in blood samples for clinical use.”

40. In its written submissions, the proprietor states:

“It is submitted that the registered proprietor has readily met these tests and presented appropriate evidence to sustain UK Registration 1454334 for "apparatus for analysis; all for medical use; all included in Class 10", or to the extent that the Registrar is not persuaded that the existing specification is appropriate relative to the use described, then at the very least for "apparatus for analysis, namely immunoassay analysers; all for medical use; all included in Class 10" (my emphasis)

41. I begin by reminding myself that the subject trade mark stands registered for:

Apparatus for analysis; all for medical use; all included in Class 10.

42. That, in my view, is a very broad specification that would include all types of analytical apparatus for a wide range of medical uses. Consequently, while I agree

with the applicant's submissions in principle, to limit the specification to only those goods suggested by the applicant would, in my view, be contrary to the guidance provided in the case law. In this regard, the proprietor's fall-back specification represents what I consider to be a reasonable middle ground and it is for this specification i.e.

> "Apparatus for analysis, namely immunoassay analysers; all for medical use; all included in Class 10",

the subject trade mark will remain registered.

Conclusion

43. The application has been successful (albeit only partially). As the applicant specifically sought revocation from the earliest date possible, and as there is no evidence to suggest that the subject trade mark has ever been used upon any other goods in class 10 other than those for which I have found genuine use in the most recent relevant period, subject to any successful appeal, the registration will be revoked to that extent from 4 March 2000.

Costs

44. In its application, the applicant sought either full or partial revocation of the registration and the proprietor defended the application in full, up to and including its final written submissions in lieu. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying that guidance, I award costs to the applicant on the following basis:

Filing the application and reviewing the counterstatement:	£200
Official fee:	£200

Reviewing the proprietor's evidence:	£500
Filing of written submissions (x2)	£400
Total	**1300**

45. I order bioMérieux to pay to Vidya Holdings Ltd the sum of **£1300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 25th June 2021

C J BOWEN
For the Registrar,
The Comptroller-General